WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Topic 1: **Lessons Learned from Analyses of PCT National Phase Examination and Backlog Processing in Several Jurisdictions**

Lutz Mailänder
Head, Cooperation on Examination and Training Section
PCT International Cooperation Division

Daejeon
July 4, 2017

Agenda

- Situation of processing PCT NPEs in different countries
  - Pending workload: backlog or not?
- Small to medium size IPOs
- "Passive work-sharing": utilization of external examination work products
  - International phase
  - Other national phases
    - Final work products: claims granted or rejected
    - Intermediary work products (reports)
- Tools and other resources
- What is needed?
- What options exist and what may be recommended?
  - Backlog processing
  - Regular processing of new PCT NPEs

Trans Pacific Partnership Agreement (TPPA)

Article 18.14: Patent Cooperation and Work Sharing

1. The Parties recognize the importance of improving the **quality** and **efficiency** of their respective patent registration systems as well as simplifying and streamlining the procedures and processes of their respective patent offices for the benefit of all users of the patent system and the public as a whole.

2. Further to paragraph 1, the Parties shall endeavor to **cooperate** among their respective patent offices to facilitate the **sharing** and **use** of search and examination work of other Parties. This may include:

(a) making search and examination results available to the patent offices of other Parties; and

(b) exchanging information on quality assurance systems and quality standards relating to patent examination.

Case studies

- First case studies with systematic analysis and sampling of Bahrain PCT **backlog**
- Further analyses and hands-on workshops on **pending cases** in
  - Smaller IPOs: Sri Lanka, Laos, Cambodia, Qatar, Bhutan, Oman, Mongolia
  - Medium IPOs: Malaysia, Thailand, Philippines
- What work products are available for other PCT national phase in other jurisdictions, and how useful are they?
- How to implement systematic passive work-sharing to make examination more efficient?
- 23 arbitrarily selected sample cases used for training
  - Mostly older applications
    - > more likely that national phase examination is completed

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	Pendency range	Grants but in Extended Family	Observations Observations ISR (only A?)	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 ?	PCT/KR2007/002479 stable composition	24	1	AU, CA, EA, EP, US, JP, CN, 2xKR, UA, MY, MA, MX, NZ, UA, (CR, SV, GT), **PH**			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	**MY** 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) **PH** has US main claim as composition
BH 20090030 LA 96 MY 147396A PH 1-2009-500273 TH ?	PCT/JP2007/067578 plant cultivation	34	7	AP, AU, 2xCN, US, NZ, CA, KR, EA, JP, MA, MX, MY, TW, UA, E(i2g), **PH**			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, **MY** equal to WO-A1; CA is narrower; US narrower than CA **PH** mc equal to US mc
BH ? KH 2012/0150 MY 155685A PH 1-2013-501448 TH ?	PCT/JP2012/000237 solid liquid separation	16	1	AU, CA, CN, EP, JP, KR, MY, RU, US(i2g), **PH**				2011-01-24 JP(2); 2012-02-08 JP; 2016 US	1-5		only A ISA=EP		JP, KR, US more than ISR	**AU, CA, mc equal to WO-A1** EP mc (2 part claim) equivalent to WO-A1 **MY** equal to EP US different by one substantial detail **PH** equal to EP with one error ('preventing' instead of
BH 20080005 MY 150185A PH none TH ?	PCT/EP2007/053015 energy conversion	19	1	CA, CN, US, RU, MY, MA, MX		KR, JP	EP, BH	2006-03-31 DE(5); 2009-05-04 MA; 2014-12-09 CA	3-8+		5X ISA=EP		KR more than ISR rejected over citation of US, not in ISR	WO-A1 German language **MY**, US and CA equal, and **different from WO-A1**
BH 20090006 MY 153238A PH 1-2009-500135 TH ?	PCT/EP2007/057380 cryogenic engine	24	1	AP, CU, US, CN, AU, KR, EA, MX, MA, NZ, MY, **PH**	EP		CA, JP(?), BH	2006-07-21 FR; 2009-07-01 MA; 2015-01-29 MY	3-8+		4Y ISA=EP		AU, JP, KR more than ISR EA has seen only ISR	AU is equivalent to WO US is substantially different, includes more components of the engine **PH** mc is equal to US
BH 20090047 MY 151581A PH 1-2009-501523 TH ?	PCT/FR2008/050103 insulated tank	30	1	FR, US, EP, CA, AU, EA, NZ, RU, CN, EG, JP, MA, MX, MY, TW, UA, **PH**				2007-02-13 FR; 2010-06-23 EP; 2014-06-13 MY	3-7		3X ISA=EP		JP, US, AU more than ISR	**AU, EP, US all are different from each other** WO mc in French US being the narrowest **MY**=EP
BH 20090066 MY 150324A PH none TH ?	PCT/US2008/001119 remote control	7	1	AU, GB, US, MY				2007-01-31 US; 2011-04-28 AU; 2013-12-31 MY	4-6		X ISA=EP		US more than ISR AU only ISR	AU narrower than WO-A1; US narrower than AU **MY** equal to AU
BH 20090019 MY 151783A PH 1-2009-500417 TH ?	PCT/EP2007/059161 compressed air engine	25	1	AP, US, AU, FR, CN, KR, MA, MY, UA, NZ, **PH**		2xJP	EP, JP, CA, BH	2006-09-05 FR; 2009-09-01 MA; 2014-05-16 KR	3-8+		3Y ISA=EP		the 2 rejected JP applications used one JP prior art that was not considered by the other offices AU, AP only ISR KR, US more than ISR	AU, US and **MY** and **PH** equal to WO-A1
BH 20090028 MY 148768A PH 1-2009-500495 TH ?	PCT/US2007/074327 secure transaction	21	1	AU, US, NZ, TW, GB, EA, MX, MY, UA,	US, **PH**	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		JP, US more than ISR AU only ISR	AU and US equal an **different from WO** GB different from AU and US **MY** appears 2b equal to GB
BH 20080024 MY 150103A PH none TH ?	PCT/FI2007/050357 polyolefin	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	CA, EP and AU different from WO-A1; subtle differences of EP and AU re catalyst layer details; CA and AU very similar but not

Summary | #1 | #2 | template

Example: **WO2008035580**

- 2 JP priorities
- Inpadoc family: 39 members
- Simple family; 35 members

- Simple family: **grants** in AP, AU, 2xCN, US, NZ, CA, KR, EA, MA, MX, MY, TW, UA, PH, VN, EP
- Extended family: further grants in: 2xJP

- **Pendency: 2-10 years**
  - 2006-09-20 earliest priority date
  - 2008-09-03 JP grant
  - 2016-10-26 EP

- Still pending in BH, LA,..

Simple – extended family?

- Examination is based on claims; claims need to be supported by the description
- If claims or descriptions are not fully equivalent the utility of foreign work products may be limited
- Are the descriptions of family members equivalent?

- **Simple family**: all members share the same priorities
- **Simple family (PCT w/o priority)**: all members share the same PCT application number
  - **It is very likely that descriptions of family members are equal or very similar**
  - "Equivalents", "also published as"
  - "same invention" or group of very similar inventions

- **Extended (Inpadoc) family**: biggest possible family, may include several simple families sharing priorities indirectly
  - **If priorities are partly different: It is quite likely that descriptions are different**
  - Applications in the same extended but not the same simple family usually cover different but related inventions in same area of technology

→Topic 5

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.

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 man- ner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

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 man- ner 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.

ISR: 2 category A documents only

INTERNATIONAL SEARCH REPORT

International application No.
PCT/JP2007/067578

A. CLASSIFICATION OF SUBJECT MATTER
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. FIELDS SEARCHED

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 intern… practicable, search terms used)

C. DOCUMENTS CONSIDERED TO…

Category*	…tion of document, with … where appropriate, of the relevant passages	Relevant to claim No.
A	JP 2001-292643 A (Taiyo Kogyo Kabushiki Kaisha), 23 October, 2001 (23.10.01), Full text; all drawings (Family: none)	1-13
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

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

EP-A4: Supplementary EP search report

Europäisches Patentamt
European Patent Office
Office européen des brevets

SUPPLEMENTARY
PARTIAL EUROPEAN SEARCH REPORT

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

Application Number
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

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Differences of claims granted for family

Claims **WO2011107527**

1. Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.

Differences of claims granted for family

AU2011223000B2

1. Thread or stripe, comprising at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.

Differences of claims granted for family

EP2542417B1

1. Security thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a first plastic foil which carries a first imprinting comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, wherein said graphic information is a repetitive seamless pattern of suitable repetition length, the security thread or stripe being **characterized in that** said first imprinting is a hardened structured coating in the form of indicia.

Differences of claims granted for family

US9216605B1

The invention claimed is:

1. A method for producing a security thread or stripe for incorporation into or onto a value document or a currency substrate, comprising:

coating a plastic foil with a coating composition comprising optically variable magnetic or magnetizable pigment particles;

orienting the magnetic or magnetizable pigment particles to represent graphic information;

hardening the oriented magnetic or magnetizable pigment particles coating to fix the magnetic or magnetizable pigment particles in their respective positions and orientations; and

slicing the plastic foil with the hardened into threads or stripes;

wherein the graphic information is produced with a magnetic orienting cylinder having a seamless and continuous repetitive magnetic field pattern having a repetition length.

Reasons for substantial differences

- Examiners may have applied different prior art
  - Different prior art searches, i.e. prior art documents
  - Different priority dates applied
- Differences in national legislation (exclusions) or case law
- Individual examiner's views
- Patents do not belong to same simple family, i.e. applicants have sought protection for different subject matter (e.g. continuations/divisions); descriptions most likely differ

Reasons for additional citations/searches

- Lack of trust in other work product, e.g. if
  - ISR with only category A documents
  - ISR including citations of only one single jurisdiction
- Claims amended before national phase entry (ISRs with X citations)
- Claims amended during national phase examination
- Familiarity/expertise of examiner with relevant documentation
- Strict prior art disclosure requirement, for example in the US

CONCLUSIONS

- ISR and WO may be very **useful for applicants** to assess potential success of application
- ISR and WO may be of **limited utility for examiners**, in particular, when claims are amended for national phase entry, and additional prior art searches often appear to be needed in national phases.

Family table for PCT NPEs sample cases

	B	C	D	E	F	G	H	I	J	K	L	M	N	O	P
1	**Case studies BH, LK, MY, TH, BT, PH, KH, LA workshops**														
2	**Status: Aug 17, 2016**														
3					Simple Family										
4	**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**	**Pendency range**	**Grants but in Extended Family**	**Observations Observations ISR (only A?)**	**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?)**
5	BH 20080018 MY 149627A PH 1-2008-502595 TH ?	PCT/KR2007/002479 stable composition	24	1	AU, CA, EA, EP, US, JP, CN, 2xKR, UA, MY, MA, MX, NZ, UA, (CR, SV, GT), **PH**			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	**MY** 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) **PH** has US main claim as composition
6	BH 20090030 LA 96 MY 147396A PH 1-2009-500273 TH ?	PCT/JP2007/067578 plant cultivation	34	7	AP, AU, 2xCN, US, NZ, CA, KR, EA, JP, MA, MX, MY, TW, UA, E(i2g), **PH**			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, **MY** equal to WO-A1; CA is narrower; US narrower than CA **PH** mc equal to US mc
7	BH ? KH 2012/0150 MY 155685A PH 1-2013-501448 TH ?	PCT/JP2012/000237 solid liquid separation	16	1	AU, CA, CN, EP, JP, KR, MY, RU, US(i2g), **PH**				2011-01-24 JP(2); 2012-02-08 JP; 2016 US	1-5		only A ISA=EP		JP, KR, US more than ISR	**AU, CA, mc equal to WO-A1** EP mc (2 part claim) equivalent to WO-A1 **MY** equal to EP US different by one substantial detail **PH** equal to EP with one erro ('preventing' instead of
8	BH 20080005 MY 150185A PH none TH ?	PCT/EP2007/053015 energy conversion	19	1	CA, CN, US, RU, MY, MA, MX		KR, JP	EP, BH	2006-03-31 DE(5); 2009-05-04 MA; 2014-12-09 CA	3-8+		5X ISA=EP		KR more than ISR rejected over citation of US, not in ISR	WO-A1 German language **MY**, US and CA equal, and **different from WO-A1**
9	BH 20090006 MY 153238A PH 1-2009-500135 TH ?	PCT/EP2007/057380 cryogenic engine	24	1	AP, CU, US, CN, AU, KR, EA, MX, MA, NZ, MY, **PH**	EP		CA, JP(?), BH	2006-07-21 FR; 2009-07-01 MA; 2015-01-29 MY	3-8+		4Y ISA=EP		AU, JP, KR more than ISR EA has seen only ISR	AU is equivalent to WO US is substantially different, includes more components of the engine **PH** mc is equal to US
10	BH 20090047 MY 151581A PH 1-2009-501523 TH ?	PCT/FR2008/050103 insulated tank	30	1	FR, US, EP, CA, AU, EA, NZ, RU, CN, EG, JP, MA, MX, MY, TW, UA, **PH**				2007-02-13 FR; 2010-06-23 EP; 2014-06-13 MY	3-7		3X ISA=EP		JP, US, AU more than ISR	**AU, EP, US all are different from each other** WO mc in French US being the narrowest **MY**=EP
11	BH 20090066 MY 150324A PH none TH ?	PCT/US2008/001119 remote control	7	1	AU, GB, US, MY				2007-01-31 US; 2011-04-28 AU; 2013-12-31 MY	4-6		X ISA=EP		US more than ISR AU only ISR	AU narrower than WO-A1; US narrower than AU **MY** equal to AU
12	BH 20090019 MY 151783A PH 1-2009-500417 TH ?	PCT/EP2007/059161 compressed air engine	25	1	AP, US, AU, FR, CN, KR, MA, MY, UA, NZ, **PH**		2xJP	EP, JP, CA, BH	2006-09-05 FR; 2009-09-01 MA; 2014-05-16 KR	3-8+		3Y ISA=EP		the 2 rejected JP applications used one JP prior art that was not considered by the other offices AU, AP only ISR KR, US more than ISR	AU, US and **MY** and **PH** equal to WO-A1
13	BH 20090028 MY 148768A PH 1-2009-500495	PCT/US2007/074327 secure transaction	21	1	AU, US, NZ, TW, GB, EA, MX, MY, UA,	US, **PH**	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		JP, US more than ISR AU only ISR	AU and US equal an **different from WO** GB different from AU and US **MY** appears 2b equal to GB
	BH 20080024 MY 150103A PH none TH ?	PCT/FI2007/050357 polyolefin	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	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

Summary | #1 | #2 | template

Evidence derived from sample set (PCT)

- 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 set of claims?
  - The first foreign grant (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 different from WO-A1/2 claims: >90%
- Granted claims substantially different from claims granted in other jurisdictions: >60%
  - Careful selection of suitable claim sets
- Usually supplementary prior art searches in national phases: >90%
  - Take into account for claim selection or decision to await further results
    - Do not trust a single grant based solely on an ISR
  - Do not solely rely on ISR
- Grants in some, rejections and withdrawals on other jurisdiction: 20%
  - Carefully analyze reasons for rejections/substantial withdrawals

Strategy for backlog processing I

- **Preparatory stage**
  - Research family and examination status
  - If still pending in other jurisdiction(s): check if additional prior art applied there warrants further waiting for completion of examination in that/those jurisdiction(s)
  - Compare claims and select suitable claim set (e.g. narrowest main claim; more citations;..); even if applicant submitted specific request, e.g. claims granted by EPO
  - Confirm compatibility of selected set with national legislation
  - Check if selected set is supported by description of (your) pending application
  - Optionally, sort and prioritize in
    - Easy cases: only grants, no rejections, no substantial withdrawals in family

    > grant is likely

    > one should attempt to get the applicant adopt the selected claim set

    > an analysis of the patentability of the pending claims may be avoided then

    - Complex/contentious cases: grants and rejections in same simple family

    > rejection may be due

    > Contentious cases may require a detailed analysis of the patentability of the pending claims and the claims granted by other IPOs

Strategy for backlog processing II

- **Applicant interaction stage**
  - Selected claims may not be granted immediately
  - Principles of 'party disposition' and 'fair trial' require communications/reports and consent of applicant

  Easy cases
  - Propose selected claim set to applicant
  - "Motivate" applicant to adopt proposal, e.g. by issuing a 'smart' report mentioning the comparison of results of other national phase, additional citations,..
  - Initially avoid as much as possible discussion of patentability of pending claims (time consuming)
  - If applicant doesn't agree, place case in contentious category

  Contentious cases
  - Most likely requires regular substantive examination procedure
  - 1st action: report explaining non-patentability of pending claims

Summary

- Preparatory stage**:** External work products may enable you to
  - **Avoid your own prior art search**
  - **Avoid your own analysis of novelty and inventiveness**
  - Takes 1-3h per case for a skilled examiner

- Applicant interaction stage:
  - May be time consuming for contentious cases, i.e.
    - If applicants disagree with proposed claim set and insist on their own claims
    - Additional prior art search may become necessary, e.g. if amended claims or parts thereof were never searched before
    - Rejection ruling may have to be issued
    - May require examiner with technical expertise, e.g. for conducting a supplementary search or analyzing obviousness
  - Difficult to estimate the time needed for contentious cases

Which work load is backlog? What is delay?

- Just pending, or pending with examination request?
- Awaiting first substantive examiner action?
- Examiner actions already taken but application still pending?
- Set timelines, for example older than 5 years?
  - From earliest priority?
  - From filing date?
  - From national phase entry?
- Availability of external work products?
- Completed in one, or in several other jurisdictions?
- Still pending in major Office?

TPPA

Article 18.46: Patent Term Adjustment for Unreasonable Granting Authority Delays

1. Each Party shall make best efforts to process patent applications in an efficient and timely manner, with a view to avoiding unreasonable or unnecessary delays.

2. A Party may provide procedures for a patent applicant to request to expedite the examination of its patent application.

3. If there are unreasonable delays in a Party's issuance of patents, that Party shall provide the means to, and at the request of the patent owner shall, adjust the term of the patent to compensate for such delays.[36]

https://www.tpp.mfat.govt.nz/text

TPPA: What is unduely delayed?

"4. For the purposes of this Article, an **unreasonable delay** at least shall include

a delay in the issuance of a patent of more than five years from the date of filing of the application in the territory of the Party, or

three years after a request for examination of the application has been made, whichever is later.

A Party may exclude, from the determination of such delays,

- periods of time that do not occur during the processing of, or the examination of, the patent application by the granting authority;
- periods of time that are not directly attributable to the granting authority; as well as
- periods of time that are attributable to the patent applicant."

Outsourcing of backlog processing?

- Outsourcing the preparatory/selection stage to other IPO:
  - Preparatory/selection stage doesn't consume considerable time and resources (3h per case)
  - Why paying other IPOs to do the work they have to do or have done for their own PCT NPEs and which are readily available?
  - Wouldn’t they just propose the claims they have granted themselves?
  - Would the quality of grants suffer from outsourcing the selection?

- Outsourcing the applicant interaction stage to other IPO:
  - Can the communication with the applicant be outsourced at all (legal restrictions)?
  - More challenging and time consuming than selection: several rounds of communications may be needed for complex/contentious cases
  - Therefore difficult to estimate the cost per case

- Options: Outsourcing of contentious cases only
- Options: Hiring temporary staff instead of outsourcing

Regular PCT NPE examination:
Strategies for small/under-resourced IPOs

When examiners have no expertise in technical field or number of staff is limited:

- Avoid as much as possible resource consuming patentability analysis of pending claims, in particular conducting prior art searches
- Rather await final results from other IPOs
- For PCT NPEs, mostly likely a grant will become possible
- However, for the sake of quality patents:
  - Await several grants of other jurisdictions, and compare for consistency
  - Expected average waiting period: 2-3 years after PCT NPE
  - **At least**, compare citations applied in different jurisdictions, e.g. when processing a PPH request, or validating any foreign patents
    - If additional citations appear to be relevant and patentability is at issue in other jurisdictions, the further progress there should be monitored before adopting results from first to grant grant authority
- Apply "**active waiting/monitoring**": regularly check availability of further work products or use RSS feeds; then no one can complain about a delay caused by the office (e.g. for TPPA, or FTA provisions on patent term extensions)

What is needed for work-sharing?

Top priority:

- Comprehensive patent family information, detailed as
  - Simple (all priorities are the same)
  - Extended family
- Examination status information

Lower priority:

- Access to examination work products
- Translation tools for work products
- Tools for comparing work products
  - Citations (search reports)
  - Claims
- Information on differing national practices (naming and content of work products; important case law; exclusions; ..)

What is available for work-sharing?

- Primary sources: **National Patent Registers**
  - **authoritative** information on status and national family relations
  - National file inspection; national publications
  - For some countries accessible online and therefore useful for work-sharing

- Two major secondary platforms ("one-stop-shop") provide access to family and status information and work products from several offices
  - **Espacenet**
    - Includes most comprehensive compilation of family data:
      - Systematically derived from bibliographic data of all jurisdictions sharing such data with EPO and updated weekly
      - Largest coverage of jurisdictions (distinguishing simple, extended, domestic, national families)
    - Includes national legal status (INPADOC) covering jurisdictions sharing such data with EPO; updated weekly
    - ...

What is available for work-sharing?

- Espacenet [continued]
  - Global Dossier: one-stop-shop for accessing IP5 Offices' file wrappers; always up-to-date because retrieved on-the-fly from IP5 national registers; includes derived up-to-date status
  - Common Citation Document: viewing and comparing of search reports/citations of members of extended and simple families of AU, CN, DE, EP, JP, KR, US, WO
- Global Dossier (stand alone version)
- WIPO-CASE
  - One-stop-shop for file inspection
  - Accessible only for 'accessing' and 'providing' Offices
  - Family information includes only so-called for 'complex' families and only family members of 'providing' Offices (IP5 plus GB, CA, CL, AU, IL) recorded in the system
  - Complementary to Espacenet for file inspection: in addition to IP5 files it includes access to files of GB, CA, CL, AU, IL

What is needed for small IPOs?
For efficient PCT NPE examination anywhere?

- **National policies/strategies for substantive examination of PCT NPEs and other foreign applications, e.g.**
  - **Emphasize quality, i.e. don't grant as soon as a first grant has become available; don't rely on ISR only**
  - **strategy of "active waiting", i.e. regular monitoring progress at other IPOs**
- Suitable national legislation enabling work-sharing
- Tailored competency models for examiners in smaller IPOs
- Specific training for work-sharing
  - Selection stage
  - Applicant interaction stage
    - Contentious cases

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 1st paragraph of this Article.

For much of this we now have retrieval tools

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

+ authorization to base grant on foreign grant

Competency models for small Offices

- Generic prior art search competencies: **basic to medium**
- Generic examination: **basic to medium**
- Technology specific search and examination: **no**
- Legal/statutory framework: **advanced**
- Patent information: **advanced**
- Work-sharing: **advanced**

- Variety of supplementary competencies

Observations/Conclusions

- Duplication/repetition of work is not a bad thing as such
  - Improves the overall quality of patents
  - For PCT NPEs, examiners should not fully rely only on ISR/WO
  - Awaiting results from other national phases may be an option to enhance quality and efficiency
- Cooperative examination would be the ideal way for improving
  - Quality of all patents of a family, and not just those ones granted last, and
  - Efficiency of procedures overall
  - Avoid delaying examination
- Sharing of application and legal status data needs to improve a lot, e.g. for regional cooperation
- Family building needs to be expanded, in particular with a view to IPOs in emerging and developing economies
- Patent families are global: Only one-stop-shop type platforms for work-sharing including as many family members as possible make work-sharing efficient
  - regional solutions are not really useful

Thank you

lutz.mailander@wipo.int

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION