



## Topic 9: Utilizing Claims Granted in other Jurisdictions

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**Harare**  
**September 20, 2017**

# Agenda

- Retrieval options
- Comparing claims
- Reasons for differences
- Standardized procedures
  - Patent Prosecution Highway
  - Validation

# 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,...

# 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 manner 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 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.

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WO2011152795 (A1)

**Bibliographic data**

Description

Claims

Mosaics

Original document

Cited documents

Citing documents

INPADOC legal status

INPADOC patent family

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### Bibliographic data: WO2011152795 (A1) — 2011-12-08

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#### DEVICE AND METHOD FOR DRIVING LEDS

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**Page bookmark**    [WO2011152795 \(A1\) - DEVICE AND METHOD FOR DRIVING LEDS](#)

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**Inventor(s):**    WEE KAI FOOK FRANCIS [SG]; STONA ANDREA [IT]; GROPPI LEOPOLDO [IT]; MAN KWOK WING [CN]; CHONG FOO WING [MY] ±

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**Classification:**    - international: [H02M1/00](#); [H05B37/02](#); [H05B43/02](#)

                          - cooperative: [H02M3/33523](#); [H05B33/0815](#); [H05B33/0848](#); [H05B37/02](#); [H02M2001/0012](#); [H02M2001/0022](#)

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**Application number:**    WO2010SG00212 20100604

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**Priority number(s):**    WO2010SG00212 20100604

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**Also published as:**    [US2013106304 \(A1\)](#) [TW201204170 \(A\)](#) [SG176544 \(A1\)](#) [JP201256367 \(A\)](#) [JP5472871 \(B2\)](#)  
[ES2460627 \(T3\)](#) [EP2589267 \(A1\)](#) → [EP2589267 \(A4\)](#) [EP2589267 \(B1\)](#) [DK2589267 \(T3\)](#)  
[CN102598866 \(A\)](#) [CA2746380 \(A1\)](#) [AU2010339630 \(A1\)](#) → [AU2010339630 \(A8\)](#) [AU2010339630 \(B2\)](#)  
 → [less](#)

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**Abstract of WO2011152795 (A1)**

ROPERTY

# Retrieval options

## ■ **Publications** of granted patents

- Can easily be identified by kind codes (B1, B2, C1, C2,..) of domestic family members
- PDFs of granted patents: represent the **official publications**
- Full text (HTML) version: often OCR errors and errors with special characters, formulas
- Publication doesn't mean that grant entered into force!!
- Check if opposition was filed, is still pending or was settled by
  - Maintaining the patent
  - Revoking the patent
  - Restricting the patent: New publication of restricted claims (different kind code)

- **File wrapper**: e.g., for cases where examiner was ready to grant but applicant abandoned application nevertheless; or for intentions to grant (before grants are published)

# Espacenet retrieval – full text claims

US7833207 (B2)

Bibliographic data

Description

**Claims**

Mosaics

Original document

Cited documents

Citing documents

INPADOC legal status

INPADOC patent family

Claims: US7833207 (B2) — 2010-11-16

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## PANTS-TYPE WEARING ARTICLE

Claims of US7833207 (B2)

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[BRPI0712274 \(A2\)](#) [CA2655926 \(A1\)](#) [CN101484116 \(A\)](#) [EA200900142 \(A1\)](#) [EP2039332 \(A1\)](#) [JP2008012115 \(A\)](#) [KR101369354 \(B1\)](#) [MX2009000135 \(A\)](#) [TW200819114 \(A\)](#) [WO2008004425 \(A1\)](#)

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### Original claims

Full text facilitates copy/paste

The EPO does not accept any responsibility for the accuracy of data and information originating from other authorities than the EPO; in particular, the EPO does not guarantee that they are complete, up-to-date or suitable for specific purposes.

1. What is claimed is: 1. A pants-type wearing article, comprising:  
a first waist region corresponding to one of front and rear waist regions;  
a second waist region corresponding to the other of said front and rear waist regions;  
fastener members fastening said first and second waist regions together in a detachable and refastenable manner along transversely opposite edges of the waist regions so that,  
in a state where said first and second waist regions are put flat together, said fastener members respectively have, as viewed in a circumferential direction of the wearing article, a Z-shape and an inverted Z-shape being symmetrical to each other about a center line bisecting a width of said first and second waist regions;  
wherein each said fastener member includes  
a supporting element folded in said Z-shape or said inverted Z-shape, and  
a fastener element attached to said supporting element,  
wherein said supporting element in the circumferential direction has a top section, a bottom section extending in parallel to the top section, and an intermediate section extending between said top section and said bottom section,  
wherein

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AU2010339630 (B2)

- Bibliographic data
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- Claims
- Mosaics
- Original document**
- Cited documents
- Citing documents
- INPAD legal status
- INPAD patent family

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Device and method for driving LEDs

Page: 23/32 Claims    Maximize    Download

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IP AUSTRALIA    + WIPO    010/014

PCT/SG2010/000212  
Received 13 May 2011

**CLAIMS**

1. A device for providing electrical current to at least one Light Emitting diode (LED) via a switch mode power converter comprising:

5    at least one Integrated Circuit (IC), the IC programmable using a hardware description language;

an electronic switch configurable to have a switching time period;

an Analogue to Digital converter (ADC), the ADC configured to obtain a digitized voltage input;

10    a voltage comparator, the voltage comparator configured to obtain a discharge time of an inductive element of the switch mode power converter at each time period;

wherein in operation, the at least one IC is programmed to obtain the digitized voltage

PDF publications represent anyway the official publication

# Intention to grant: EP2140598

<b>Examination procedure</b>	30.12.2008	Request for preliminary International Preliminary Report on Patentability	
	19.11.2009	Amendment by applicant	
	19.11.2009	Examination request	
	18.02.2010	Despatch of a communication from the examining division	(time limit: M04)
	15.06.2010	Reply to a communication from the examining division	
	02.12.2010	Despatch of a communication from the examining division	(time limit: M04)
	05.04.2011	Reply to a communication from the examining division	
	28.02.2012	Communication of intention to grant the patent	
	10.07.2012	Application deemed to be withdrawn, date of legal effect [2013/03]	
	16.08.2012	Despatch of communication that the application is deemed to be withdrawn, reason: fee for grant / fee for printing not paid in time [2013/03]	


Withdrawn despite intention to grant

Patentable claims will therefore not be published as B1 document

Retrievable only by download from electronic dossier

# Intention to grant: EP2140598

28.02.2012 Communication about intention to grant a European patent

  28.02.2012 Intention to grant (signatures)

28.02.2012 Text intended for grant

10.05.2011 Communication of amended entries concerning the rep

05.04.2011 (Electronic) Receipt

  05.04.2011 Amended claims with annotations

05.04.2011 Claims

05.04.2011 Document concerning representation

Communication  
that amended  
claims are  
patentable

Most recently  
amended claims =  
claims intended for  
grant

# Comparing claims

# Claim sample – two part claim

Introducing part (category, purpose)

1. A method of determining the torque induced in a rotating shaft (51),  
**A** the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),  
**B** where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

characterized in that

generic expression

- C** the torsional oscillation frequency of the rotating shaft (51) is measured (35);  
**D** the twist induced in the rotating shaft (51) by the torque is measured (39);  
and  
**E** the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

Sequence of 5 features A – E (added)

# Deconstruction of claim wording

- Deconstruction of claim wording, i.e. structuring/sorting the subject matter of a claim into distinct features/elements facilitates:
  - Understanding of the subject matter
  - Checking the clarity of the claim wording
  - Searching of prior art
  - Assessing of novelty by comparing the distinct features with the prior art
  - Determination of the closest prior art
  - (Determination of the difference to the closest prior art)
  - **Comparison of claims** subject to examination at different IPOs (claims of different members of the patent family)

# Differences of claims granted for family

- Claims granted by different offices for 'same' invention (simple family) are often quite different:
  - Substantial differences
    - Some elements/features are different, i.e. some may be missing or others included
    - Different category
    - Totally different subject matter of independent claims
  - Non-substantial differences (“equivalent” scope of protection)
    - One part claim instead of two part claims, where all features are present and only listed in different order
    - Wording is basically similar but uses synonymous/equivalent expressions
    - Additional or missing reference numerals



# 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.

# Claim deconstruction

WO 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.

AU 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.

# Determining differences

WO 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.

AU 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.

// ~~Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a~~ 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.

Using document  
comparing function  
of WORD

# 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.

# Determining differences

WO 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.

EP 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.

// Thread 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 ~~hardened coating~~ first imprinting 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 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



# Differences of national patent legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature, sufficient disclosure)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
  - US do grant business methods, software patents,..
  - DE/EP grants new use of known compound, PK does not,..
  - Islamic countries exclude, e.g., inventions related to pork
  - Temporary exclusions in Myanmar: Section 8 (b)
- For analysis of different national practices, see e.g. SCP studies and surveys on WIPO website:
  - [http://www.wipo.int/edocs/mdocs/scp/en/scp\\_13/scp\\_13\\_3.pdf](http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf)
  - <http://www.wipo.int/scp/en/exceptions/>

# Evolution of claims

- Claims of a patent application are usually different at different publication and prosecution stages of the application
- Before examination, the initially filed independent claims in applications have a broader scope because applicants seek to get as much protection as possible
- Claims of granted patents are, in comparison to the initially filed claims,
  - Usually narrower, i.e. include additional features, or
  - May be totally different
- Claims after opposition have often narrower scope than claims after grant

# Claim sample – as filed

1. A method of determining the torque induced in a rotating shaft (51),
  - A** the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),
  - B** where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),characterized in that
  - C** the torsional oscillation frequency of the rotating shaft (51) is measured (35);
  - D** the twist induced in the rotating shaft (51) by the torque is measured (39); and
  - E** the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

# Claim sample – as granted

1. A method of determining the torque induced in a rotating shaft (51),  
**A** the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),  
**B** where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

the method comprising:

- C** measuring (35) the torsional oscillation frequency of the rotating shaft (51);
- D** measuring (39) the twist induced in the rotating shaft (51) by the torque; and
- E** using (41) the measured value of the torsional oscillation frequency and the measured value of the induced twist to determine the torque induced in the shaft (51);

**F** the torsional oscillation frequency of the shaft (51) and the induced twist are measured (35) at the second set of operating conditions;

the method is **characterized by**

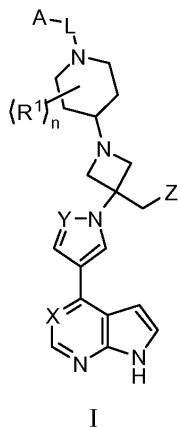
- G** determining the torsional oscillation frequency of the shaft (51) at a second set of operating conditions at which the stiffness of the shaft (51) can be determined (33) and
- H** determining the stiffness of the shaft (51) at the second set of operating conditions;
- I** the torque induced in the shaft (51) at the first set of operating conditions is determined (41) using the measured torsional oscillation frequency and the induced twist at the first set of operating conditions, and the measured torsional oscillation frequency and the stiffness at the second set of operating conditions

Added during examination

# Claim sample – as filed

## WHAT IS CLAIMED IS:

1. A compound of Formula (I):



or a pharmaceutically acceptable salt thereof; wherein:

X is N or CR<sup>2</sup>;

Y is N or CR<sup>3</sup>;

Z is H, cyano, halo, C<sub>1-3</sub> alkyl, or C<sub>1-3</sub> haloalkyl;

L is C(R<sup>4</sup>)<sub>2</sub>, C(=O), C(=O)N(R<sup>4a</sup>), C(=O)C(R<sup>4b</sup>)<sub>2</sub>, S(=O)<sub>2</sub>, C(=O)O, C(=O)OC(R<sup>4b</sup>)<sub>2</sub> or C(=O)N(R<sup>4a</sup>)C(R<sup>4b</sup>)<sub>2</sub>;

A is C<sub>1-6</sub> alkyl, C<sub>3-14</sub> cycloalkyl, C<sub>2-13</sub> heterocycloalkyl, C<sub>6-14</sub> aryl, or C<sub>1-14</sub> heteroaryl; wherein said C<sub>1-6</sub> alkyl, C<sub>3-14</sub> cycloalkyl, C<sub>2-13</sub> heterocycloalkyl, C<sub>6-14</sub> aryl, and C<sub>1-14</sub> heteroaryl are each optionally substituted with 1, 2, 3, 4, 5, or 6 independently selected R<sup>5</sup> groups;

each R<sup>1</sup> is, independently, C<sub>1-4</sub> alkyl, hydroxyl, C<sub>1-4</sub> alkoxy, fluoro, hydroxyl-C<sub>1-4</sub>

# Claim sample – as granted

What is claimed is:

1. A compound, which is {1-{1-[3-Fluoro-2-(trifluoromethyl)isonicotinoyl]piperidin-4-yl}-3[4-(7H-pyrrolo[2,3-d]pyrimidin-4-yl)-1H-pyrazol-1-yl]azetidin-3-yl}acetonitrile, or a pharmaceutically acceptable salt thereof.

2. A salt, which is {1-{1-[3-Fluoro-2-(trifluoromethyl)isonicotinoyl]piperidin-4-yl}-3-[4-(7H-pyrrolo [2,3-d]pyrimidin-4-yl)-1H-pyrazol-1-yl]azetidin-3-yl}acetonitrile adipic acid salt.

# Admissible claim amendments

Applicant may usually amend/narrow claims anytime during examination, e.g. if originally filed claims are not patentable:

- Adding further features taken **from description** or from other claims
- Replacement of features
- Completely reworded claims
  
- All features have to be **supported by the original description**
- When adopting claims granted in another jurisdiction, the adopted claims have to be supported by the description of the local application.
  
- For applications in the same simple family it is very likely that descriptions are the same, and that adopted claims are therefore supported by it.
- For applications that are national phase entries of the same international application, it is almost guaranteed that descriptions are identical.

# Strategy for using claims

## ■ Preparatory stage

- Research family and examination status
- If several grants: compare claims and select suitable claim set (e.g. narrowest main claim; more citations considered; most recent grant)
- 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)
- Confirm compatibility of selected set with national legislation
- Check if claims are supported by description
- Optionally, sort and prioritize in
  - **Easy cases**: only grants, no rejections, no substantial withdrawals in family
    - > grant is extremely likely
    - > an analysis of the patentability of the pending claims may be avoided
    - > one should attempt to get the applicant adopt the selected claim set
  - **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
- 1<sup>st</sup> action: report explaining non-patentability of pending claims

# Summary

- **Preparatory stage:** Focusing on external grants may enable you to (most likely)
  - **Avoid your own prior art search**
  - **Avoid your own analysis of novelty and inventiveness**
  - Selection of claim set takes 1-3h per case for a skilled examiner
  
- **Applicant interaction stage:**
  - Most cases are expected to be easy cases: proposals likely to be adopted by applicant > efficient processing
  - 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

# Patent Prosecution Highway PPH

- JPO initiative to accelerate granting in case of grants at other IPOs, in case 'Office of Earlier Examination' has determined allowable / patentable subject-matter
- Bilateral agreements between IPOs
- Commitment to prioritize/accelerate examination in case of grant at other IPO
- No obligation to adopt claims/conclusions
- **Accelerated examination** has to be requested by applicant
- Condition: applicant submits identical claims that were granted
  
- Even if there is a PPH request, it would be obligatory to check other national phase work products.
- Claims subject to a PPH request must **not** be granted without further examination if the OEE examiner overlooked relevant prior art.

# Validation

- EPC validation:
  - EPO grants patents
  - Patents are then "validated" in designated member countries, i.e. they become national patents
- EPO now concludes bilateral validation agreements with jurisdictions not being members of the EPC (e.g. Morocco, Tunisia, {OAPI})
- Morocco: entry into force on March 1, 2015
- Designation as extension countries in EPO application, therefore no need to file separate application > applicant driven
- Not possible retroactively for pending applications
- Requires harmonization of national laws with EPC
- Validating EPO decision includes effective adoption of case law as well

# Validation

- 33.2** Es ist beabsichtigt, die Validierungsgebühr(en) für die nebenstehend angekreuzten Staaten zu entrichten. / It is intended to pay the validation fee(s) for the states marked opposite with a cross. / Il est envisagé de payer la (les) taxe(s) de validation pour les Etats dont le nom est coché ci-contre.

**Hinweis:** Im automatischen Abbuchungsverfahren werden nur für die hier angekreuzten Staaten Validierungsgebühren abgebucht, sofern dem EPA nicht vor Ablauf der Zahlungsfrist ein anderslautender Auftrag zugeht.

**Note:** Under the automatic debiting procedure, validation fees will be debited only for states indicated here, unless the EPO is instructed otherwise before expiry of the period for payment.

**Veillez noter** que dans le cadre de la procédure de prélèvement automatique des taxes de validation, le compte est débité du montant dû seulement pour les Etats cochés ici, sauf instruction contraire reçue avant l'expiration du délai de paiement.

VAPT

**MA** Marokko/  
Morocco/  
Maroc

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(Platz für Staaten, mit denen Validierungsabkommen nach Drucklegung dieses Formblatts in Kraft treten) / (Space for states with which validation agreements enter into force after this form has been printed) / (Espace prévu pour des Etats avec lesquels des accords de validation entreront en vigueur après l'impression du présent formulaire)

# 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!

Thank you

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