Interpreting and Utilizing Search and Examination Reports

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Work-sharing: Information that can be utilised

- Search reports
  - Citations
  - Document categories e.g. X, Y, A
  - Relevant passages of citations
  - Claims for which documents are cited
  - Classification information

- Written opinions / Grants / Refusals / Oral Proceedings
  - Patentability objections e.g. novelty, inventive step, clarity, unity
  - Interpretation of cited documents

- Documents with related subject-matter
  - Relevant cited and citing documents
  - Top-up search before grant

- Search strategies - if available
  - Elaborate and complement search queries

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Overview

- European Procedure
- European Search Procedure
- European Examination Procedure

The European procedure

Filing → **Search** → Publication → **Examination** → Grant → Opposition

Refusal → **Appeal**

Within the legal framework defined by the *European Patent Convention*
Overview of the Search Procedure

- Filing
  - Examination on Filing and on Formal requirements
    - 1st Examiner appointed (provisional ex. div. appointed)
      - Search (SR) / Opinion (ESOP)
      - A2 Publication (no SR)
      - A1 Publication (SR)
      - Search (SR) / Opinion (ESOP)
      - A3 Publication (SR)

- Request for Examination

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Overview of the Examination Procedure

- Request for Examination

- Examining Division appointed
  - Examining Division
  - Applicant (Attorney)
    - Intention to Grant
    - Decision to Refuse

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The European Patent Convention

- A. 82 Unity
- A. 83 Disclosure
- A. 84 Clarity

Article 92
- Search

Article 94(1)
- Examination

Art. 52
- A. 54 Novelty
- A. 56 Inv. step
- A. 57 Industrial Application

- R. 61, 62 SR, ESOP
- R. 42 Description
- R. 43 Claims
- A. 123 Amendments

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Overview

- European Procedure
- European Search Procedure
- European Examination Procedure
The Search Report

- Rule 61 EPC: Content of the European search report
  (1) The European search report shall mention those documents, [...] which may be taken into consideration in deciding whether the invention [...] is new and involves an inventive step.

- Rule 43.5 PCT: Citations
  (a) The international search report shall contain the citations of the documents considered to be relevant.

- Additionally, the Search Report in EP and PCT contain information about the classification, the fields searched, etc.

State of the Art

Everything made available to the public by means of ...

- written description
- oral description
- by use
- or in any other way

...before the filing date or the priority date of the application
### The Search Report

#### Application number

#### International Patent Classification

#### Category X, Y, A, etc.

#### Relevant to Claim ...

#### Cited documents

#### Technical Fields Searched

#### Place of Search

#### Date of Completion of the Search

#### Examiner

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### Categories of Citations

- **X** - particularly relevant if taken alone
  - Objection: Lack of novelty or lack of inventive step with one document
- **Y** - particularly relevant if combined with another Y-document
  - Objection: Lack of inventive step by combination of two (or more) documents, always in pairs
- **A** - Technological background, no objection of lack of novelty or inv. step
- **O** - Non-written (e.g. oral) disclosure
- **P** - intermediate document, published after priority date but before filing date of the application; used in combination with X, Y, A (e.g. XP)
- **T** - Theory or principle underlying the invention
- **E** - Earlier patent document, but published on, or after the filing date
- **D** - cited in the application
- **L** - cited for other reasons
The Search Opinion

- **Rule 62 EPC**: Extended European Search Report (EESR)
  
  (1) The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention [...].

- **Rule 43bis.1 PCT**: Written Opinion (WO-ISA)
  
  (a) [...] the International Searching Authority shall [...] establish a written opinion as to:

  (i) whether the claimed invention appears to be novel, to involve an inventive step, [...] and to be industrially applicable;

  (ii) whether the international application complies with the requirements of the Treaty and these Regulations [...].

A reasoned statement provides better insight than a citation.
European Search Opinion- Example

The examination is being carried out on the following application documents:

- Description, Pages
  1-15 as originally filed

- Claims, Numbers
  1-15 as originally filed

- Drawings, Sheets
  1-57 as originally filed

1. The following documents, cited in the European search report, are referred to in this communication:

2. The present application does not meet the requirements of Article 52(1) EPC because the subject-matter of claims 1, 2, 5-12 is not new in the sense of Article 54(1) and (2) EPC.

2.1 D1 discloses a package (Figs. 24-26 and corresponding text passages) comprising a substrate (10) with a longitudinal direction and a lateral direction perpendicular thereto, said substrate having a recess (4) formed in a first surface and extending in the longitudinal direction of the substrate (Fig. 24b), said recess having an inner

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Cited documents

Objections

European Patent Register

PCT - WOISA - Example

WITTREN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)

Re item V
Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Reference is made to the following documents:
   D1 US 2002/196624 A1 (SCHUMACHER LYNN C [CA]) ET AL 12 December 2002 (2002-12-12)

2. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1, 4-15, 17-18, 20 is not new in the sense of Article 33(3) PCT.

2.1 D1 discloses
   an optical fiber capable of being diagnosed non-invasively comprising an optical fiber (12) for conveying a light beam; said optical fiber comprising a first end for receiving said light beam and a second end opposite thereto, a core (14) comprising an inner wall, and a cladding (16) surrounding said core, said optical fiber further comprising at least one unclosed portion comprising a plurality of quantum dots (26) dispersed in a medium
   wherein said quantum dots become activated by evanescent wave coupling resulting from total internal reflection of said light beam contacting said inner wall of said optical fiber core and wherein said activation results in emission of light from said quantum dots (Fig. 2c; paragraphs [0033], [0045]).

Therefore, the subject-matter of present claim 1 is not novel over the teachings of D1.

D1 also discloses

2.2

European Patent Register

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Overview

- European Procedure
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- European Examination Procedure

The Examination Process

- Start of Examination Process when objections apply: Amendments by applicant or issue of a communication by the examining division

- Most of the Communications in Examination usually follow a structure:
  - Prior Art
  - Unallowable Amendments
  - Clarity issues, Insufficiency of Disclosure
  - Assessment of Novelty and Inventive Step
  - Formal Comments: reference signs, acknowledgement of prior art

- A Communication shall contain all the grounds hindering the grant of a Patent (Rule 71(2) EPC)

- Grounds may be supported by references to the Case Law
The Examination Process

...and looks like this

1. The following documents are referred to in this communication:
   D1: US 6243 026 B1 (JUDGE KEVIN ET AL) 5 June 2001 (0001-06-05)
   D2: US 6243 026 B1 (JUDGE KEVIN ET AL) 5 June 2001 (0001-06-05)

2. The present application refers to a traffic signal priority system although the
   wording of claim 1 is such that it is not clear to encompass a generic entity/exit control
   system. This is not in line with the description, page 3, lines 3-6, where it
   is clearly stated that the invention relates to a traffic signal priority system. As such
   the full scope of the claim must be supported by the

3. Independent claims
   3.1 The present application does not meet the criteria of Article 52(2) EPC because
       the subject matter of claim 1 (not clear) is not described in the sense of Article 54(1) and (2) EPC.
       Document D1 discloses (the references in parenthesis applying to this document):

       A mobile event triggering method, comprising:
       detecting an event of a vehicle into a defined event location (D1, col. 14, line 55);
       evaluating a vehicle status with respect to at least one event criterion (D1, col. 14, line
       54);
       (D1, col. 14, line 54);
       conducting an event entry action when the vehicle status meets said at least one
       event criterion (D1, col. 14, line 56; lines 26-27);
       evaluating the vehicle status with respect to at least one mobile event criterion
       corresponding to at least one mobile event
       (D1, col. 14, line 65);
       evaluating the vehicle status with respect to at least one exit criterion
       and
       conducting an event exit action when the vehicle status meets said at least one
       exit criterion (D1, col. 14, lines 63-65).

The Examination Process

...or like this

4 Inventive Step - Article 56 EPC
   The applicant is also reminded that the Board of Appeal has already discussed the case
   of invalid claims in its decision T939/02. In the current application, the technical
   problem consists of forecasting the compressive strength of a cementitious material,
   wherein the first step corresponds to measuring a physical parameter over a
   predetermined time-interval. When applying the reasoning of the Board of Appeal
   decision, the question which arises is whether all the options covered by the claimed
   method solve the technical problem. The fact that the use of some physical
   parameters (e.g. sound wave velocity, electrical conductivity, viscosity, heat capacity,
   relaxation time distribution) allows one to solve the aforementioned technical problem,
   could not be regarded as sufficient evidence to lead to the inference that the use of
   any physical parameter would solve the technical problem. For example, measuring
   the temperature of the cementitious material over a predetermined time-interval would
   obviously not allow the skilled person to carry out the claimed invention.
Refusal

• The Examining Division cannot find any subject-matter that could be granted (or if the applicant does not amend the application accordingly)

• The Applicant always has the right to be heard

• He can request Oral Proceedings (as well as the Examining Division)

• If at least two members of the Examining Division agree, the application is refused

Oral Proceedings

Oral Proceedings may be held at request of the applicant or at the examining division's discretion

• In the Summons to oral proceedings a detailed explanation of the outstanding objections is given

• Minutes of the oral proceedings are provided and contain essentials of the objections, arguments, etc.
The Right to be heard

• Art. 113 (1) EPC
  "The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."

• General principle: the applicant should not be surprised by objections used in refusals.

• Always allow the applicant to comment on objections either in writing or orally (telephone, oral proceedings)

• Often further communications include replies to arguments presented by the applicant

Refusal - structure and arguments

• Summary of facts and submissions

  I. Facts and Submissions
  I.1 Application number 04/01234.9 was filed on 22.07.2004 in the name of Fujitsu Limited claiming priority from Japanese application JP2004/007288 filed on 10.03.2004.
  I.2 A European search report was completed on 13.09.2004. A first communication was issued on 25.11.2005 informing the applicant that the set of claims lacked unity. In response the applicant filed a new set of claims on 05.04.2006 which was considered by the examining division as being unitary.
  Further communications were issued on 04.08.2006 and 14.09.2007 informing

• Reasons for the decision

  II. Reasons for the decision:
  II.1 Main request:
  II.1.1 The present application does not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 does not involve an inventive step within the meaning of Article 56 EPC.
  02 discloses an optical module comprising an optical element (213), a protective component (105) for protecting an optical transmission medium (101, 102) to be optically coupled to said optical element (column 3, lines 29-31); and an electric wiring (104, 105) formed on said protective component for said

  II.5.3 Concerning the applicant's arguments:
  The applicant's representative argued that the combination of teachings of three documents to prove lack of inventive step is not allowable. However, as shown in the previous section the subject-matter of claim 1 is seen as a mere juxtaposition of non-Inventive features with no synergistic effect arising from their combination. In this case features from more than two documents may be combined to prove lack of inventive step.

• Reply to arguments by applicant

• Refusals may be a good source for arguments etc. - detailed reasoning
Grant

- The Examining Division can find subject-matter that could be granted
- The Examining Division may help the Applicant by making suitable suggestions, but the Applicant is responsible for them
- If at least two members of the Examining Division agree, the application is granted
- The application is informed of the text with which the examining division intends to grant (Rule 71(3) EPC)

Suggestions to the applicant

- Even though it is not the responsibility of the examiner or examining division, many applicants appreciate suggestions to patentable subject-matter
- Suggestions often help to speed up the procedure
- Suggestions can be made by:
  - Writing a communication (e.g. in combination with objections to pending claims)
  - Telephone Conversation
  - Personal interview
  - Oral Proceedings or Summons thereto
- Examples of suggestions:
  - Invite the applicant to include a feature of a dependent claim into the independent claim
  - Invite the applicant to claim a certain embodiment
  - Clarifications
  - Formulate allowable claims
Suggestions to the applicant - by telephone

The first Examiner telephoned the Applicant's representative on 09 August 2011.

The first Examiner explained the Applicant's representative that the application appears to provisionally fulfill the requirements of novelty and inventive step according to Articles 54(1), 54(2), 54(3), and 56 EPC in the light of the prior art.

However, in order for the application to be likely to proceed to the grant phase, the application should still be amended:

- **Clarity (Article 84 EPC)**: The arrangement defined in claim 1 is ambiguous (e.g. on lines 13 and 14, an adhesion promoting layer is said to be disposed on the analyte sensing layer, whereas it is disposed on the protein layer, see description page 8, line 12 - page 12, line 15, figures 2 and claim 19). Claim 1 should therefore be redrafted in order to be supported by the description, and to be in line with claim 19.
- **Unallowable Amendment (Article 123(2) EPC)**: In the International Preliminary Report on Patentability, an objection of clarity was raised due to a functional feature in apparatus claim 1. When entering the regional phase, claim 1 has been amended by deleting said feature. The mere deletion of said feature has, however, for effect to enlarge the scope for which a protection is sought, and therefore contravenes the requirements of Article 123(2) EPC.

The first examiner therefore suggested to draft independent claim 1 as follows:

An analyte sensor apparatus (100) for implantation within a mammal, the analyte sensor apparatus comprising:

- a base layer (102);
- a conductive layer (104) disposed upon the base layer (102) wherein the conductive layer (104) includes a working electrode;
- an analyte sensing layer (110) disposed on the conductive layer (104), wherein the analyte sensing layer (110) detectably alters the electrical current at the working electrode in the conductive layer (104) in the presence of an analyte.

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The End

- Thank you very much for your attention

Questions?

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