



Topic 4: **Examination Status and Examination Work Products**

Lutz Mailänder

Head, International Cooperation on Examination and Training Section

Riyadh
January 29, 2018

Agenda

- Examination status
- Types of work products/examination results
 - Intermediary
 - PCT
 - final
- Overview of options and sources for retrieval
- Issues with work products

Work-Sharing opportunities through patent families

- If same or similar invention was **filed in several IPOs**, e.g. a PCT application entered several national phases, the results/work products of substantive examination for these members of the patent family may be utilized for improving **efficiency** and **quality**
- Types of family relations
 - Simple family (usually same invention; most likely similar description)
 - Extended family (at least similar invention; description may differ)
 - Technical family
- Requires **databases/platforms** providing
 - Family information
 - Examination status; to check if examination is pending
 - File inspection: access examination work products

Status and life cycle stages of patents

- **Pre-grant phase** (before decision to grant or refuse/reject)
 - Pending
 - With request for examination
 - Awaiting request for examination
 - Withdrawn by applicant
 - Deemed to be withdrawn, abandoned
 - Rejected, refused by examiner
- **Grant phase** (between publication of decision to grant and the entry into force of grant)
 - Intend to grant
 - Publication of grant
 - Opposition, reexamination, appeal
- **Post-grant phase** (after the entry into force of grant and lapse of patent)
 - Lapsed
 - Reexamination, nullification, revocation, invalidation

Legal status

- Status is related to legal **events or actions** as defined by the respective patent law and regulations of a particular **jurisdiction**

events > status changes over the lifetime of patents

jurisdiction > different definitions limit comparability; differing terminology

- Essential for determining validity of protection, potential infringements, public domain
- Less important for substantive examination purposes, except for
 - Work sharing: determining examination status at other IPOs and potential availability of work products
- Status may change from one day to another
- > National **registers** as primary (authoritative), up-to-date sources

Data sources

- **Primary sources:** each jurisdiction defines how **authoritative (official)** patent information is published and the respective authority in charge
 - Individual versions/editions:
 - National publications of applications, grants, Gazettes
 - Continuous: Legal status, file wrapper
- **Secondary sources:** collect data from various primary sources and make it accessible through a single interface
 - **Commercial patent databases (often include analysis tools)**
 - Free-of-charge searchable patent databases:
 - hosted by some IPOs: Depatisnet, Espacenet, Patentscope
 - Derived from proprietary search systems
 - hosted by others: Google Patents, Patentlens,..

Primary sources: Patent registers

- Provide up-to-date legal status information, i.e. whether
 - application/examination is pending
 - patent is in force, lapsed, ...
- Varying detailedness of data content
 - some include public file inspection
- Regularly updated (daily in some jurisdictions)
- However, in many countries no online register
- see WIPO register portal website



European Patent Register

About this file: EP1901248

Refine search ST36 Show history Espacenet Submit obser

EP1901248 - **Secure transaction system** [\[Right-click to bookmark this link\]](#)

Status

The application has been refused
Status updated on 29.06.2012
Database last updated on 04.11.2016

Don't confuse with
ESPACENET
EP Register is a separate
database covering only EP
and WO applications

Most recent event

29.06.2012 Refusal of application published on 01.08.2012 [\[2012/31\]](#)

Applicant(s)

For all designated states
Franchi, John F.
39 Plater Drive Oxford
Oxfordshire OX2 6QT / GB

[\[2008/12\]](#)

Inventor(s)

1 / see applicant
...

[\[2008/12\]](#)



SEARCH RESULT

Sign in Sign Up

- E-SERVICE
- IP DIGITAL LIBRARY
 - Quick Search
 - Advanced Search

JOURNAL
INFORMATION

Go to homepage

This system has been implemented by the grant of the government of the Republic of Korea.



ARIPO

NATIONAL

Select the designated States +

Patent Utility Model Industrial Design Trademark Help ?

PCT Application No.(FNA) ▾

Cellphone And SmartPhone

Search

Search result for : {FNA:PCT/EP13/058245}

Search from the result

Patent (1)

Utility Model (0)

Industrial Design (0)

Trademark(0)

Ranking ▾

Bibliography

Drawing

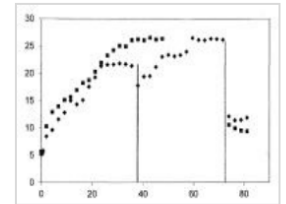
Magnetic separation of particles including one-step-conditioning of a pulp

Appl.No.: AP/P/2014/008061 Patent No.: Status: Substantive examination

IPC: B03C1/01(2006.01)

Filing Date: 22.04.2013 Applicant: BASF SE.

The present invention relates to a process for separating at least one first material from a mixture comprising this at least one first material and at least one second material, which comprises contacting of the mixture comprising at least one first material and at least one second material with at...



Item per page : 10

<< < 1 > >>

INPADOC: Secondary legal status source



Espacenet
Patent search

Deutsch English Français
Contact
Change country ▼

◀ About Espacenet Other EPO online services ▼

Search Result list My patents list (0) Query history Settings Help

[Refine search](#) → [Results](#) → [WO2008060725 \(A2\)](#) → [CN101529793 \(A\)](#) → CA2663217 (A1)

CA2663217 (A1)
Bibliographic data
Description
Claims
Mosaics
Original document
Cited documents
Citing documents
INPADOC legal status
INPADOC patent family

Quick help —

→ [What happens if I click on "In my patents list"?](#)

INPADOC legal status: CA2663217 (A1) — 2008-05-22

In my patents list Report data error Print

SECURE UNIVERSAL TRANSACTION SYSTEM

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 fit for specific purposes.

Legal status of CA2663217 (A1) 2008-05-22:

CA F 2663217 A (Patent of invention)

Event date : 2012/07/25

Event code : FZDE

Code Expl.: - DEAD

Secondary legal status source

- INPADOC data accessible through Espacenet is a **secondary source** of legal status data
because the data are collected from the national registers, (primary) authoritative sources of legal status, put in a single database and made accessible through a single interface ('one-stop-shop')
- Not necessarily up-to-date because it is not retrieved from the registers on the fly, but, for example, once a week
- Only certain jurisdictions are covered

WIPO patent register portal



<http://www.wipo.int/branddb/portal/portal.jsp>

Saudi Arabia

also part of [Patent Office of the Cooperation Council for the Arab States of the Gulf \(GCC\)](#)

Online National Register

Y

English Interface

Y

Inventor Search

Y

PCT Search

N

PCT National Phase Entry

N

Fee Payment

N

Most Recent Legal Status

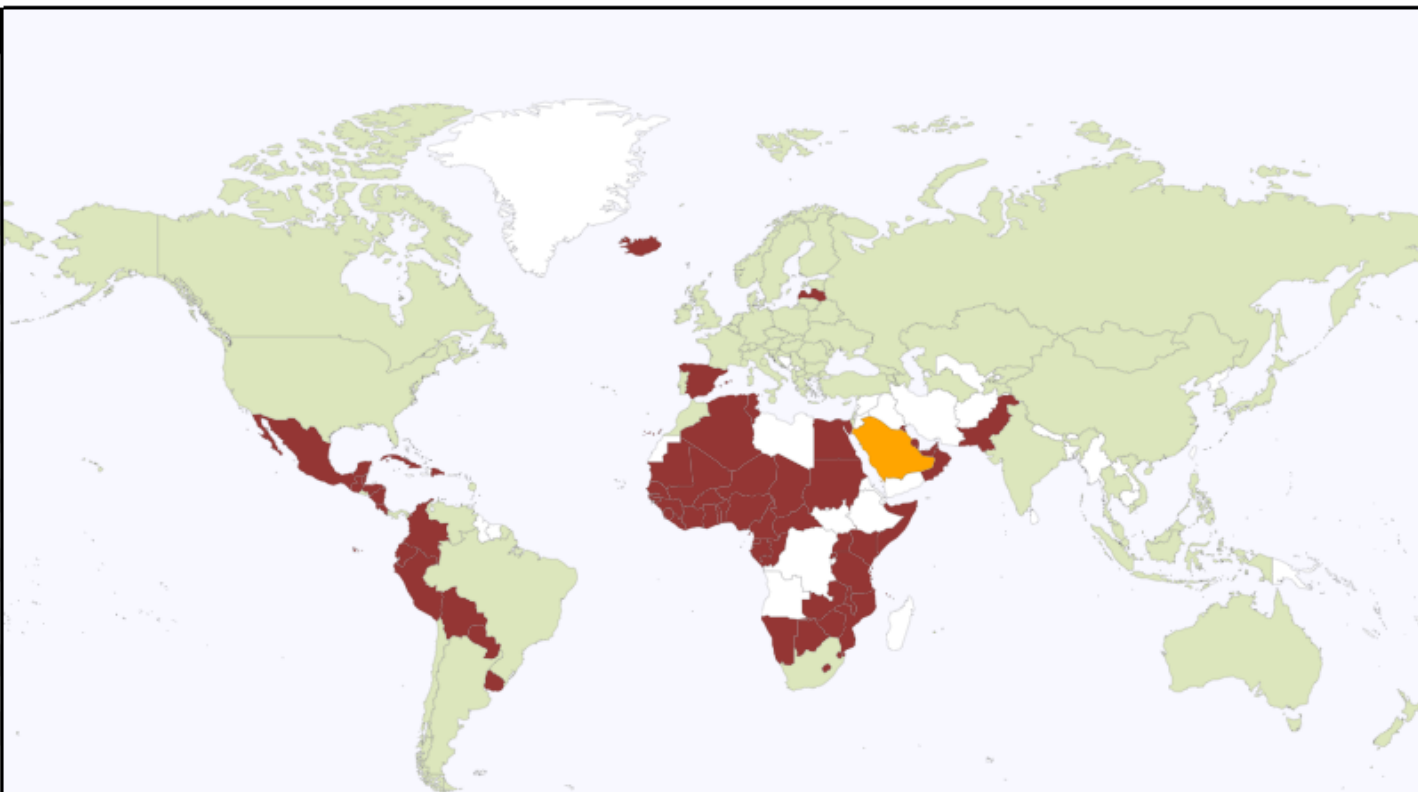
Y E.g. 'Lapsed' for application number 1210694

File Inspection

N

Full Publications

Y Documents are available in random manner, e.g. for application number 5260065: Open the link behind the title and select whether you want to see the publication of the application or the



Jurisdiction	Online National Register	English Interface	Inventor Search	PCT Search	PCT National Phase Entry	Fee Payment	Most Recent Legal Status	File Inspection	Full Publications	Online Gazette
African Intellectual Property Organization (OAPI)	N	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N	N
African Regional Intellectual Property Organization (ARIPO)	N*	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N	N
Asiatic	N*	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N	N

Actions during life cycle of application

Actions are performed by

- Applicant/representative
- Office officials
- (Third parties)

As defined by

- Law
- Regulations
- other (codified) legal instructions
- Habitual practice

Communicated usually in written form

- Paper copies
- Electronic copies in file wrapper/dossier
 - > 'examination work products'

publicly accessible ('laid open') for published applications:
'file inspection'

Types of examination work products

- Intermediary or **pre-grant** work products
 - Search reports (basic; enriched, e.g. including search strategies) > Topic 6
 - Listings of citations/references
 - Written opinions, examination reports > Topic 7
 - Communications between applicant and examiner
 - Third party observations
- **Final** work products/results
 - Granted claims; claims after opposition > Topic 8
 - Rejections; withdrawals following substantive reports; abandoned claims
- **Post-grant** work products/results
 - Additional prior art from opposition/re-examination
 - Amended claims
 - Communications between involved parties (3+)

Overview of different terminology

- Search reports (basic; enriched)/Citations
 - USPTO: "List of references cited by examiner", "List of references cited by applicant and considered by examiner"
 - JPO: "Search Report by Registered Searching Organization"
 - EPO: "European Search Report"
- Written opinions, examination reports
 - PCT: "Written opinions" = examiner statements before IPRP issuance (sent to applicant)
 - PCT: IPRP = Written opinion sent to designated/elected offices at the end of the international phase
 - EPO: "European search opinion", "Communication from the examining division" (subsequent written opinions during examination)
 - USPTO: "Non-final rejections", "Final rejections"
 - JPO: "Notification of reasons for refusal"
 - CA: "Examiner requisition"

Main products of PCT international phase

- **Publication of international application** (bibliographic data, abstract, description, drawings, claims)
- **International search report (ISR)**
- **Written opinion of ISA (WO-ISA)**
 - prepared as part of international search, but deals in substance with examination matters
- (Where applicable) supplementary international search report (SISR)
- (Optional) informal comments by applicant on WO-ISA
- **International preliminary report on patentability (IPRP)**
 - IPRP (Chapter I) = WO-ISA plus cover sheet
 - IPRP (Chapter II) = international preliminary examination report (IPER)

International publications

- 18 month after filing/priority date: **WO-A1** or **WO-A2**
- **WO-A1**: international application + international search report
- **WO-A2**: international application only if ISR not yet available
 - Front page, description, drawings, claims
 - Declaration that no ISR will be established (Article 17(2)(a))
- **WO-A3**: Later publication international search report + front page
- **WO-A4**: Later publication of amended claims and/or statement (Article 19)
- **WO-A8**: Republication front page with corrections
- **WO-A9**: Republication of full application or ISR with corrections, alterations or supplements

Written Opinion (WO), IPRP (chapter I,II)

- WO is established together with ISR but not published with ISR
- Deals in substance with examination matters; presents a preliminary opinion on:
 - novelty (not anticipated)
 - inventive step (not obvious)
 - industrial applicability
- Priority dates are taken into account
- Sent to applicant with ISR
- WO is converted to IPRP (chapter I) if no chapter II preliminary examination is requested, and communicated to DO (30 months) together with any informal comments of the applicant on WO-ISA
- Not binding for national phase examination
- Made publicly accessible (file inspection) after 30 months (Rule 44ter), e.g. in
 - Patentscope, EP-Register, Global Dossier
 - not yet in CCD

PCT – WO

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)

International application No.

PCT/US2010/020787

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	<u>3, 19</u>
	No: Claims	<u>1, 2, 4-18, 20</u>
Inventive step (IS)	Yes: Claims	
	No: Claims	<u>1-20</u>
Industrial applicability (IA)	Yes: Claims	<u>1-20</u>
	No: Claims	

2. Citations and explanations

see separate sheet

Form PCT/ISA/237 (April 2007)

Statements
(Rule 70.6)

Explanations
(Rule 70.8)

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 2002/186921 A1 (SCHUMACHER LYNN C [CA] ET AL) 12 December 2002 (2002-12-12)
- D2 WO 2007/136816 A2 (MASSACHUSETTS INST TECHNOLOGY [US]; BULOVIC VLADIMIR [YU]; KYMISSIS IO) 29 November 2007 (2007-11-29)

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(2) 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 opposed thereto, a core (14) comprising an inner wall, and a cladding (16) surrounding said core, said optical fiber further comprising at least one uncladded 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 emittance 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.

2.2 D1 also discloses

Summary: Access to written opinions, etc

- **File inspection** gives access to all communications between applicant and office/examiner, in particular
 - E.g. **examination reports/written opinions** which are not published like search reports
 - Amended claims
 - Final **rejection rulings, grant decisions**
- Possible usually through **authoritative registers**; e.g., at Patentscope, EP-Register, US-PAIR, AIPN, DPMA Register
 - Provide also up-to-date legal status information, i.e. whether
 - Application/examination is pending
 - Patent is in force, lapsed, ...
- For availability of online register access see WIPO register portal (see browse tab of Patentscope) or at: <http://www.wipo.int/branddb/portal/portal.jsp>
- One stop shop file inspection portals: Global Dossier, WIPO CASE

Selected online resources

- European Patent Register (EP)
 - <https://register.epo.org/espacenet/regviewer>
- Patentscope
 - <http://www.wipo.int/patentscope/search/en/search.jsf>
- Public Pair (US)
 - <http://portal.uspto.gov/external/portal/pair>
- AIPN (JP) (non public, for foreign examiners only)
 - <https://aipn.j-platpat.inpit.go.jp/AI2/cgi-bin/AIPNSEARCH>
- K-PION (KR) (non public, for foreign examiners only)
 - <http://k-pion.kipo.go.kr/>
- KOPD (KR) (public dossier access)
 - <http://kopd.kipo.go.kr/>
- DPMAregister (DE)
 - <http://register.dpma.de/DPMAregister/Uebersicht?lang=en>

Online resources

- European Patent Register (EP)
 - EP applications: enriched SR, ER, examination status, file wrapper)
 - Global Dossier (CN, JP, KR, US)
- Patentscope
 - WO applications: enriched SR, ER, file wrapper
- Public PAIR (US)
 - US applications: file wrapper with SR, ER, search strategy, status
- AIPN (JP) [now in GD]
 - SRs, ERs, status, family information
- K-PION (KR)
 - SRs, ERs, status, family information
- KOPD (KR)
 - Similar to K-PION, no SRs
- DPMAregister (DE)
 - DE applications: SR, ER, status

Further secondary access platforms

"One-stop shop" file inspection platforms:

- Global Dossier (= IP5 One Portal Dossier)
 - Access to all communications between offices/examiners and applicants for IP5 Offices (EPO, JPO, KIPO, SIPO, USPTO) & WIPO
 - “On the fly”, i.e. up-to-date
 - Access to dossiers of WIPO CASE (AU, CA, IL already now, more in future)
 - Legal status can be inferred/deducted from recent communications
 - Embedded in ESPACENET, EP-Register, US-GD, PATENTSCOPE

- WIPO CASE
 - Access to IP5 file wrappers (integration of Global Dossier)
 - Plus (currently) GB, CA, AU, IL, SG

Thank you

lutz.mailander@wipo.int