

# Topic 6: Further Retrieval of Examination Work Products: USPTO GD, WIPO CASE; more on citations

Lutz Mailänder

Head, International Cooperation on Examination and Training Section

Riyadh January 30, 2018

#### Agenda

- Further dossier retrieval options
  - USPTO Global Dossier
  - PATENTSCOPE
  - WIPO CASE
- Further retrieval options for citations
- Comparing citations in CCD



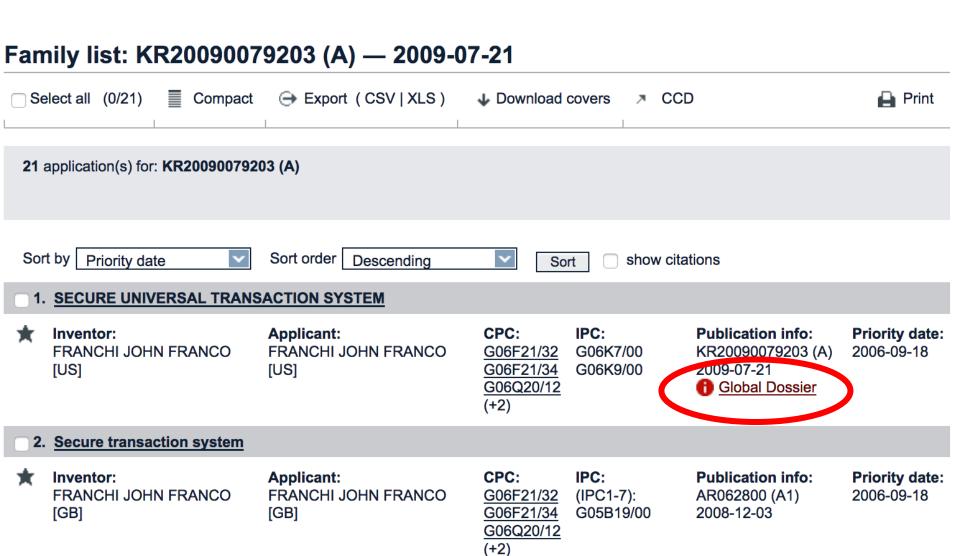
#### Further secondary access platforms

"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)
  - Accessible through
    - links in Espacenet, EP-Register
    - Stand alone USPTO Global Dossier website
    - Embedded in PATENTSCOPE
- WIPO CASE
  - Access to IP5 file wrappers (integration of Global Dossier)
  - Plus (currently) GB, CA, AU, IL, SG



## Global Dossier in Espacenet

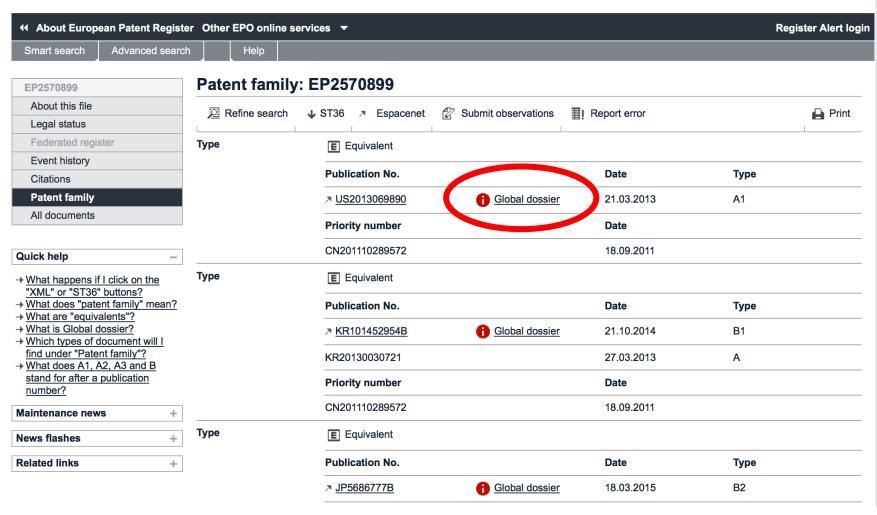


#### Global Dossier links in EP-Register

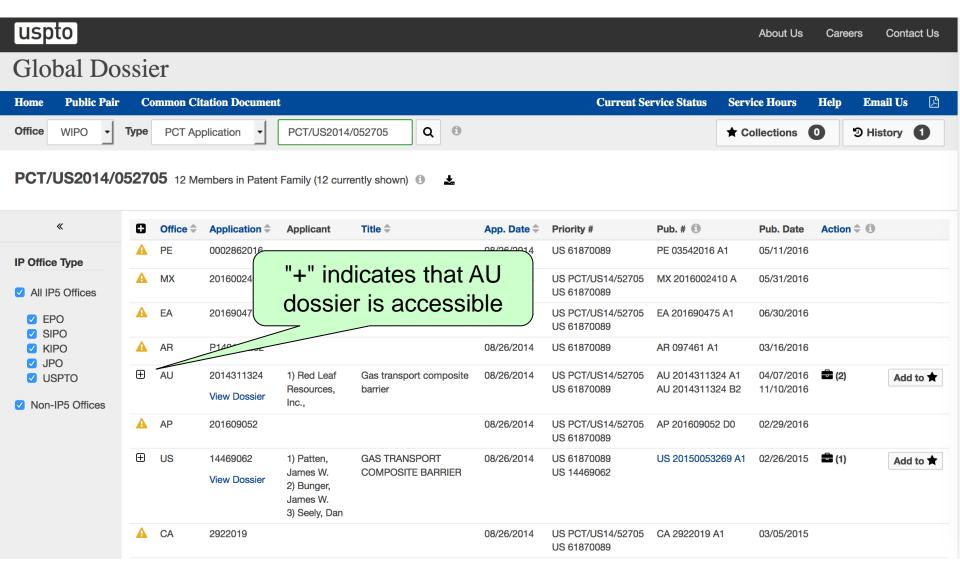


#### **European Patent Register**

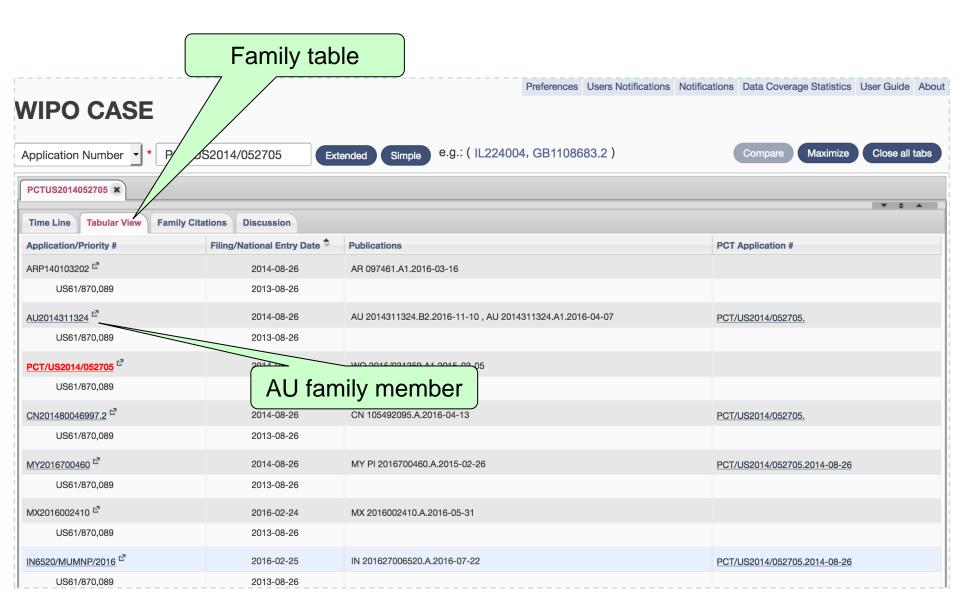
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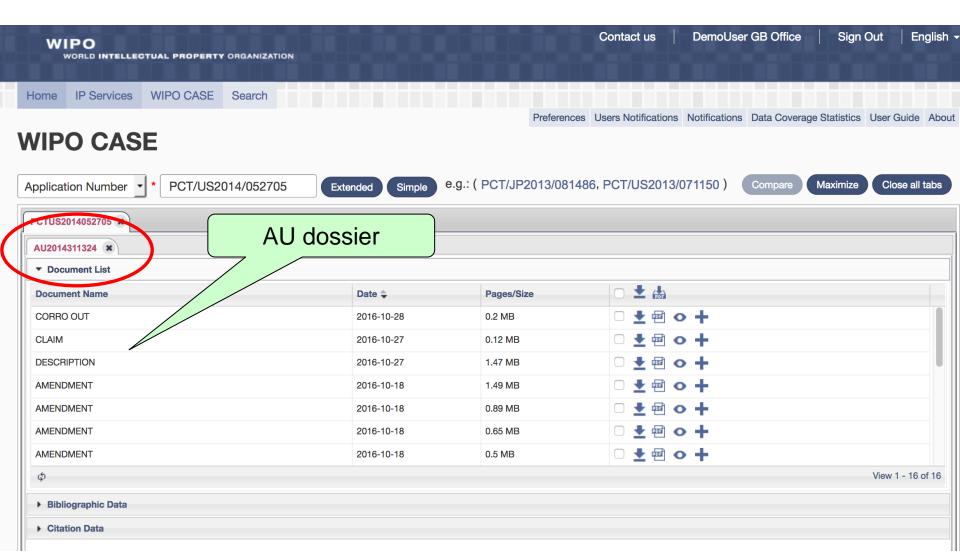
#### Global Dossier at USPTO



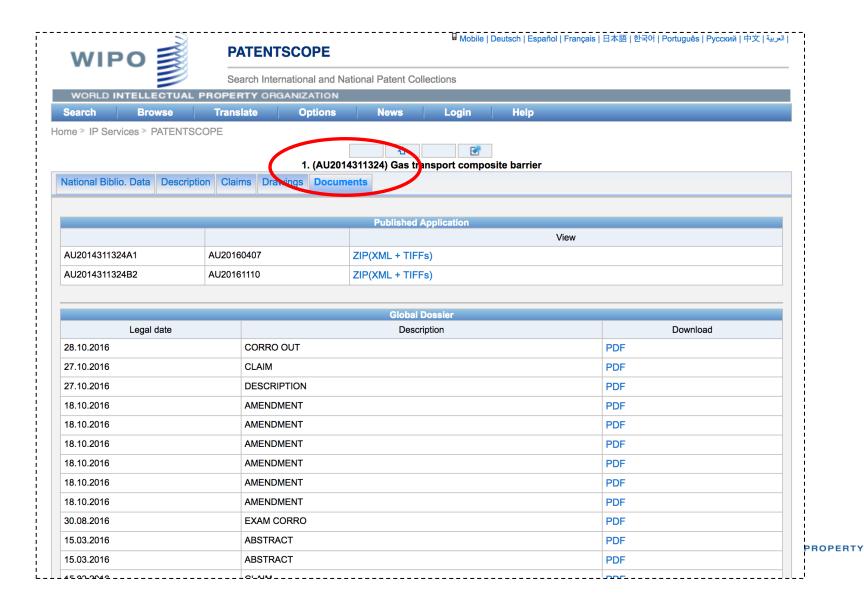
#### **WIPO CASE**



#### **WIPO CASE**



## 'GD' in Patentscope (WIPO CASE data)



#### Australian Register AusPat

MySearches (0) & **Application Details** MyList (0) 4 Start again Hide empty sections | Add to MyList | Expand all Collapse all 2014311324 • Gas transport composite barrier ▶ Bibliographic data Specification/e-Register eDossier **Document Date Document Title Document Type** Document Status File Size (KB) 2017-02-23 Standard Patent Certificate 23-02-2017 **CORRO OUT FILED** 1260 FILED 2017-02-23 CORRO OUT 129 Cover Sheet Patent ITP Payment 03-01-2017 2017-01-03 OTHER **FILED** 3 SGBI-0001149186 2017-01-03 SPEO-0002145542 - Main Document **CORRO IN FILED** 10 2016-10-31 ITP **CORRO OUT FILED** 120 2016-10-31 ITP **CORRO OUT FILED** 120 2016-10-28 Notice of Acceptance and Bibliographic **CORRO OUT FILED** 207 Attachment 28-10-2016

ERTY

# Patentscope 'GD' data coverage as of Jan 2018

	Data coverage for OPD services						
EPO	Patent applications filed on 01.06.1978 and onwards						
JPO	Patent applications filed after 1990						
CA	Patent applications published since 01.01.2008 <b>Note:</b> Only limited sets of documents are available (examination reports and search reports) for applications published between January 2008 and September 2015.						
AU	Patent applications filed after 2006						
US	Patent application filed on Jan 1, 2003 and onwards.  Prior to 2003, applications are available on a case by case basis.						

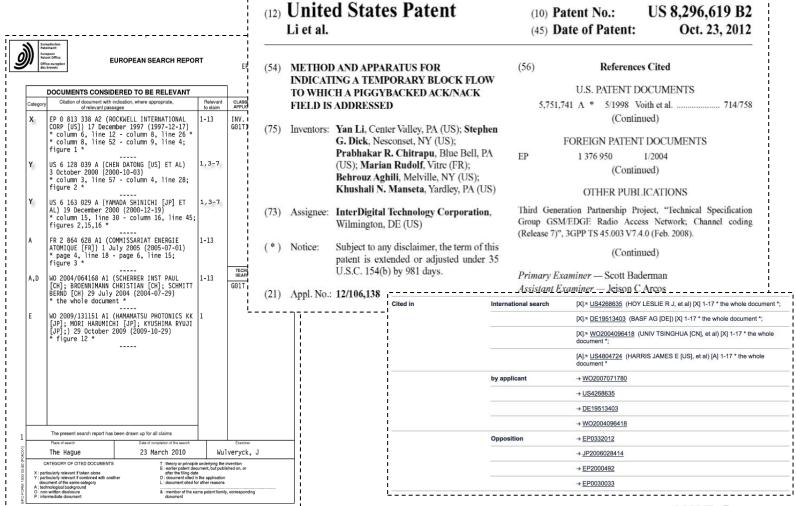


#### Types of citations/references

- Prior art relevant for patentability of claimed subject matter may be
  - Cited by an applicant
  - Cited by an examiner or other official search/examination bodies
  - Cited by third parties (for example, Sect. 801 of PCT AI)
- Citations may originate from
  - Substantive examination before grant
  - Opposition, re-examination, revocation, ... after grant
- Patents
  - can cite other patents as prior art (backward citations)
  - can be cited by other patents (forward citations)



#### Samples of prior art citations



WIPO

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#### Overview: Access to prior art citations

#### Citations/references are usually presented as

- Bare listings of citations, for example lists of publication numbers only
- Citations in search reports supplemented with further useful information

#### Search reports are available as:

- Regular patent publications (EP-A1/A3/A4, WO-A1/A3)
- Electronic documents accessible through file/dossier access platforms, such as online registers, Global Dossier, WIPO CASE

#### Bare lists of citations are usually available

- On front pages of publications of granted patents, republications after opposition (EP-B1/B2..)
- Through separate links or integrated tables in patent databases, such as national registers (e.g. DE or EP Register) when viewing individual applications
- Trilateral Common Citation Document (CCD)



## International Search Report (ISR)

- Established by (selected) competent ISA
- Search based on claims as originally filed (Article 15)
  - > Limited utility of ISR for amended claims in national phase
- Search performed according to PCT Examination Guidelines
- Prior art is everything made available to the public (Rule 33)
  - in written disclosure (ISR may refer to oral disclosure, exhibition, though)
  - prior to the international filing date (i.e. priorities are not taken into account for the international search)
- Not any written disclosure is to be searched: only PCT minimum documentation (Rule 34)
- In case of lack of unity, only the "first" invention will be searched (Rule 40), unless additional fees are paid
- ISA can decline search of certain subject matter (Rule 39), namely subject matter that is excluded from patentability in national law (PCT does not define what is patentable!)

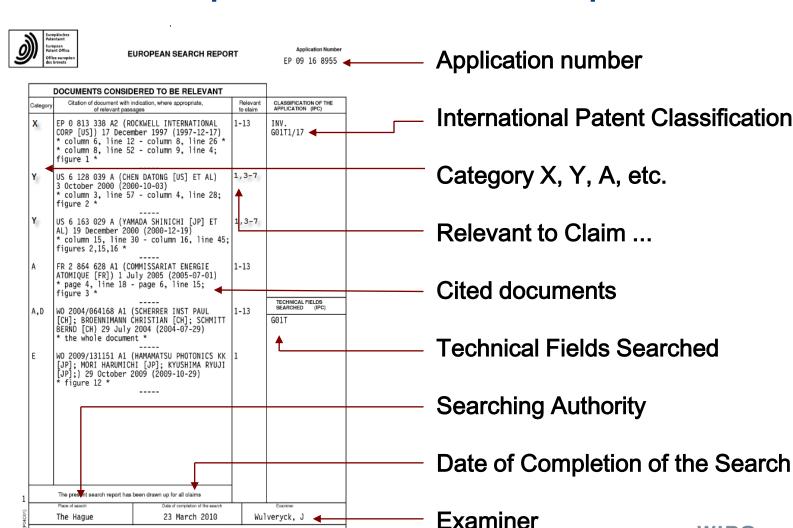


#### **ISR**

- ISR is "enriched" search report as it includes
  - List of relevant prior art documents (citations) plus indications:
  - Claims for which a citation is relevant
  - Parts of the cited document which are relevant (e.g. 'line 5-6, page 7; drawing 6') for those claims
  - Why the document is relevant (challenging novelty, inventive step; describing background art)
  - IPCs of the claimed subject matter
  - Limited search strategy: technology areas (IPC) searched
- Includes observations regarding lack of unity (Box III), or whether no meaningful search could be performed (clarity of claims)



#### Enriched prior art search reports



CATEGORY OF CITED DOCUMENTS

particularly relevant if combined with another

X : particularly relevant if taken alone

document of the same category

A ; technological background O : non-written disclosure P ; intermediate document T: theory or principle underlying the invention E: earlier patent document, but published on, or

& : member of the same patent family, corresponding

after the filing date

D : document cited in the application L : document cited for other reasons WIPO
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#### Categories of citations

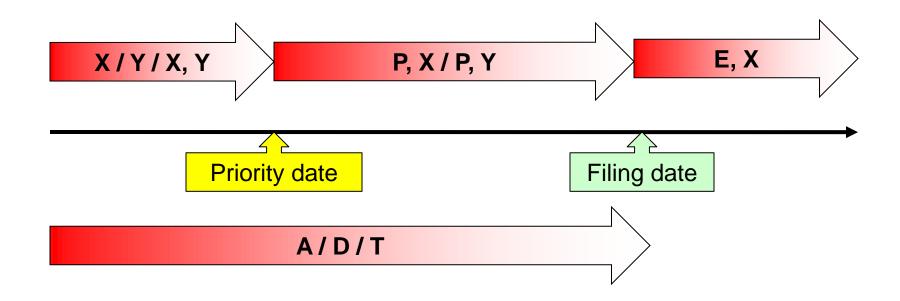
- X particularly relevant if taken alone (novelty)
- Y particularly relevant if combined with another document of the same category (inventive step)
- A technological background
- O non written disclosure
- P intermediate document, i.e. published between the earliest priority date and the filing date
- E earlier document but published on or after the filing date
- T theory or principle underlying the invention
- D document cited in the application
- I (applied by EPO for limited period time)

See 16.59ff of the PCT Examination Guidelines



#### Prior art categories

Publication dates of prior art documents





#### Publications of search reports

- ISRs are published as WO-A1 or WO-A3 documents
- In addition to the PCT, only the EPO publishes search reports
  - EP-A1 or A3 similar to WO-A1 or A3
  - EP-A4 for supplementary European search reports if examiners conduct additional searches
- No other IPO publishes search reports, they are only made publicly available through national registers ('laid open for public inspection')
- Accessible as well through Global Dossier and WIPO CASE
- Citation information is also made available through other interfaces of various databases (not in Patentscope, though)



# CCD or US-PAIR: US search report

Notice of References Cited					Application/Control No. 11/689,638		Applicant(s)/Patent Under Reexamination COX ET AL.		
		Notice of Helerence	3 Cheu		Examiner REGINA YOU		Art Unit 1773	Page 1 of 1	
				U.S. P	ATENT DOCUME		1		
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY			b.ame		Classification	
*	Α	US-4,662,516 A	05-1987	Baker	et al.			206/363	
*	В	US-5,003,892 A	04-1991	Bricke	n, Jonathan			110/346	
	С	US-				119 000	arch ro	eports are	
	D	US-							
	Е	US-				not en	riched	<b>d</b> , i.e. no X,	
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	L	US-							
	М	US-							
				FOREIGI	N PATENT DOCU	MENTS			
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY		Country	Name		Classification	
	N								

## US-PAIR: prior art in image file wrapper

"Image File Wrapper" contains search and examination reports





# **US-PAIR**: prior art tab

_11/689,638	Heat Processing Systems,	Apparatuses, and Methods for Cocition and Disposal of Infectious and Medical Waste					
Select Applicatio New Case Data	n Transaction Image File Cor History Wrapper D	ntinuity Published Address & Display Data Documents Attorney/Agent References					
Reference Forms							
Mail Room Date 🕂 Document Code 👫 Document Description 🖟							
02-24-2011	892	List of references cited by examiner					
09-16-2010	1449	List of References cited by applicant and considered by examiner					
08-16-2010	IDS	Information Disclosure Statement (IDS) Form (SB08)					
06-23-2009	892	List of references cited by examiner					
06-23-2009	1449	List of References cited by policant and considered by examiner					
09-12-2007	IDS	Information Disclosure Statema (IDS) Form (SB08)					
Foreign Patent and	Non-Patent Docum	\$					
Mail Room Date	Document	Document Description 👫					
08-16-2010	NPL	Non Patent Literature					
08-16-2 <u>010</u>	NPL	Non Patent Literature					
08-16- List of rof	erences cited by	Non Patent Literature  List of references cited by					
108-16-1	•	Non Patent Literature					
<sub>09-12-</sub> ; a	applicant	Foreign Reference examiner					
09-12-2007	FOR	Foreign Reference					
09-12-2007	FOR	Foreign Reference					



#### **US Final and Non-Final Rejections**

 Relevance of citations (X, Y) can (currently) only be derived from the reasons of rejections stated in US examination reports and decisions ('final' and 'non-final rejections')

9. Claims 1, 8-10, 15-16, 34, 39-40, 42, 51, 63, 68, 69 and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Tibor (Tibor) (US Pub. No. 2004/0234117).

As per claim 1 Tibor discloses:

A secure universal transaction system, comprising: an operation ource component, including a first biometric security component, a second security component, (page 1) 33, the central system 12 can be remotely located from the electronic transaction station location as the electronic transaction station, e.g., an in-store central processor a location with the electronic transaction station of the electronic transaction station of the electronic transaction station location as the electronic transaction station, e.g., an in-store central processor and location with the electronic transaction station of the electronic transaction station as the electronic transaction station, e.g., an in-store central processor and location with the electronic transaction station of the elect

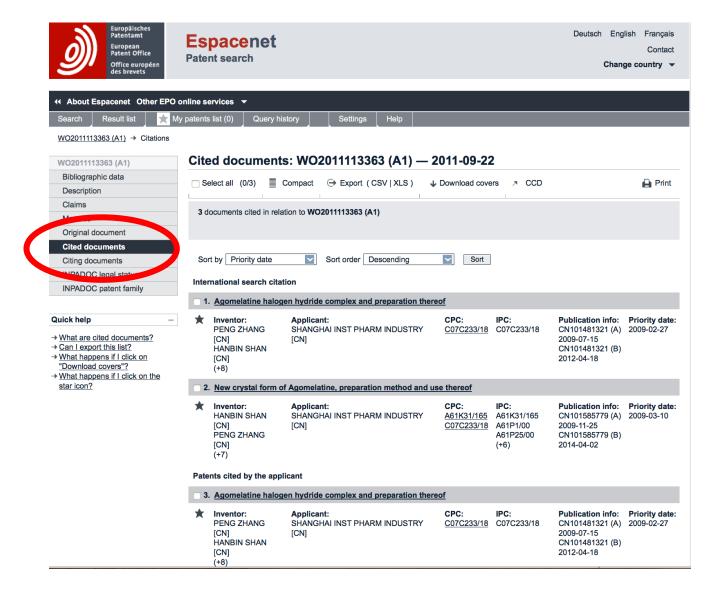


## US search reports in Global Dossier

17.11.2011	List of References cited by applicant and considered by examiner
17.11.2011	Notice of Allowance and Fees Due (PTOL-85)
17.11.2011	Examiner's search strategy and results
17.11.2011	Search information including classification, databases and other search related notes
17.11.2011	List of References cited by applicant and considered by examiner
17.11.2011	Bibliographic Data Sheet
17.11.2011	Foreign Reference
17.11.2011	List of References cited by applicant and considered by examiner
17.11.2011	Issue Information including classification, examiner, name, claim, renumbering, etc.
17.11.2011	List of references cited by examiner

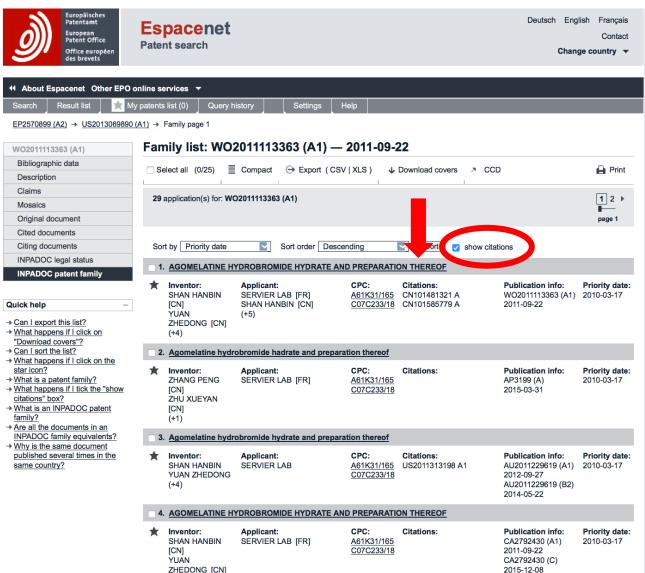


#### **Espacenet: Backward Citations**



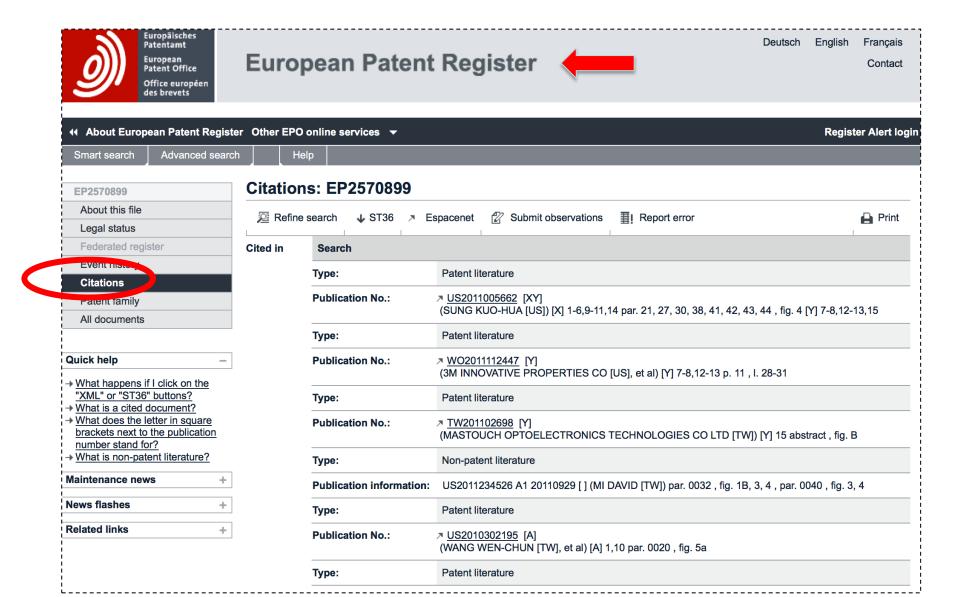


## Citations in Inpadoc family list



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## Citations (enriched) in EP-Register - 1



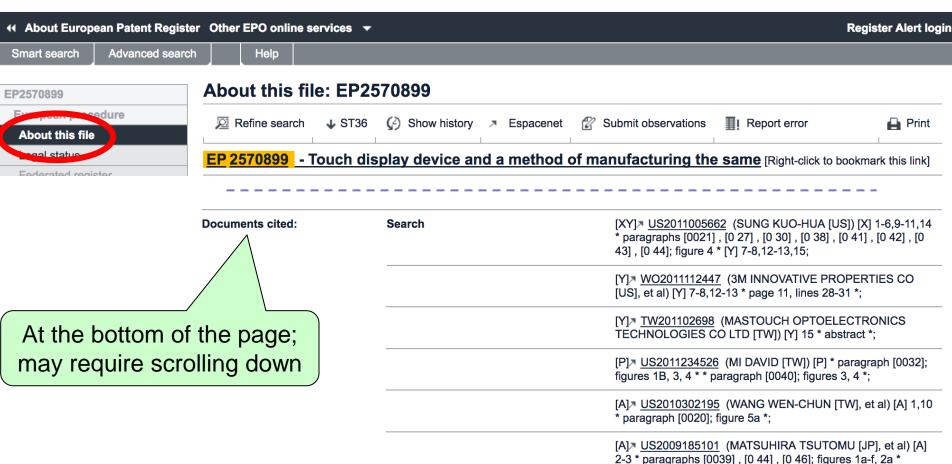
## Citations (enriched) in EP-Register – 2



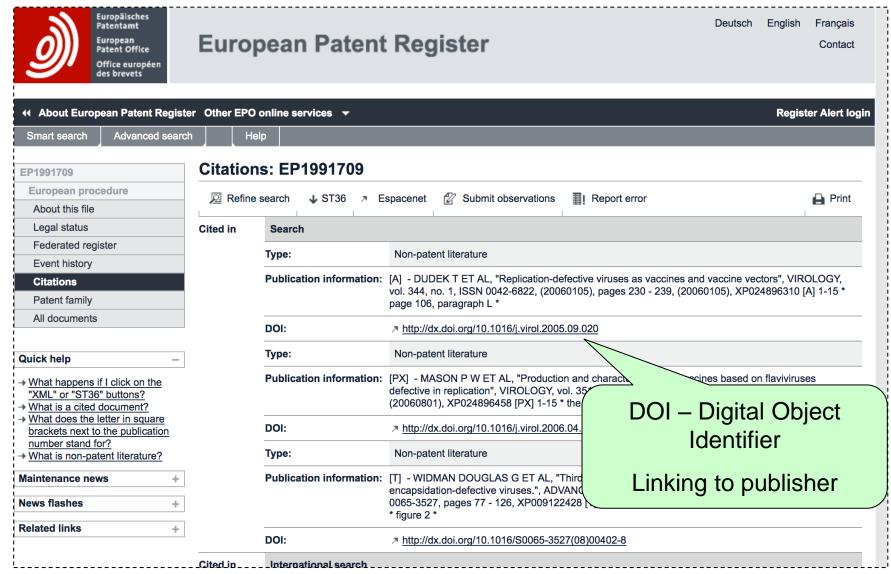
**European Patent Register** 



Deutsch English Français
Contact



## NON- PL Citations in EP-Register



# Citation during opposition (EP Register)

Cited in	International search	[X] <sup>▶</sup> <u>US4268635</u> (HOY LESLIE R J, et al) [X] 1-17 * the whole document *					
		[X] <sup>▶</sup> DE19513403 (BASF AG [DE]) [X] 1-17 * the whole document *;					
		[X] <sup>▶</sup> WO2004096418 (UNIV TSINGHUA [CN], et al) [X] 1-17 * the whole document *;					
		[A] US4804724 (HARRIS JAMES E [US], et al) [A] 1-17 * the whole document *					
	by applicant	→ <u>WO2007071780</u>					
		→ <u>US4268635</u>					
		→ <u>DE19513403</u>					
		→ <u>WO2004096418</u>					
-	Opposition	→ <u>EP0332012</u>					
		→ <u>JP2006028414</u>					
		→ <u>EP2000492</u>					
		→ <u>EP0030033</u>					



# Citations on front pages of grant publications

#### Patent literature

References cited: GB-A- 2 131 952

282

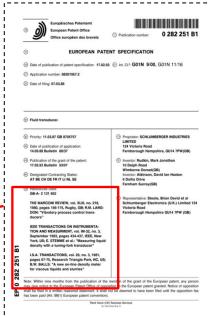
THE MARCONI REVIEW, vol. XLIII, no. 218, 1980, pages 156-175, Rugby, GB; R.M. LANG-DON: "Vibratory process control transducers"

IEEE TRANSACTIONS ON INSTRUMENTA-TION AND MEASURMENT, vol. IM-32, no. 3, September 1983, pages 434-437, IEEE, New York, US; E. STEMME et al.: "Measuring liquid density with a tuning-fork transducer"

I.S.A. TRANSACTIONS, vol. 20, no. 3, 1981, pages 67-75, Research Triangle Park, NC, US; B.W. BALLS: "A new on-line density meter for viscous liquids and slurries" raninani suney(us)

Representative: Stoole, Brian David et al Schlumberger Electronics (U.K.) Limited 124 Victoria Road Farnborough Hampshire GU14 7PW (GB)

Non patent literature



Note: Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid (Art. 99(1) European patent convention).

WIPO WORLD

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#### Third party observations

- Overview: <a href="http://www.wipo.int/scp/en/revocation\_mechanisms/third\_party/index.html">http://www.wipo.int/scp/en/revocation\_mechanisms/third\_party/index.html</a>
- For PCT, possible according to Section 801ff of Administrative Instructions
- Searchable in Patentscope: TPO:(\* to \*)
- Retrievable through tab "Documents"

Search and Examination-Related Documents							
Date	Title	View	Download				
26.05.2017	Third Party Observation	PDF (2p.)	PDF (2p.), ZIP(XML + TIFFs)				
26.05.2017	Additional comments submitted with observation	PDF (15p.)	PDF (15p.), ZIP(XML + TIFFs)				
24.04.2017	Third Party Observation	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)				
24.04.2017	Third Party Observation	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)				
16.03.2017	International Search Report	PDF (4p.)	PDF (4p.), ZIP(XML + TIFFs)				
16.03.2017	Written Opinion of the International Search Authority	PDF (9p.)	PDF (9p.), ZIP(XML + TIFFs)				
16.03.2017	Search Strategy	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)				



## Third party observations

		į -					
		-	Applicant's c	or agent's file ref	erence		
	16F064-				F064-PCT		
				International application number			ational filing date (day/month/year)
				PCT/JI	P2016/071237		20 Jul 2016 (20/07/2016)
		į	Applicant				
		- !			(EN) HIROSI	HIMA UN	IVERSITY (+1)
		i	Third party o	bservation subn	nitted by	Obser	rvation submitted on behalf of
		,		Ar	nonymous		
		ľ	Date of subr	nission(day/mon	, ,	Langu	uage of observation
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111				·		]	Reference
Page range of article within	ISBN:		IS	ISSN:		i	
periodical:							
2716–12721							
DOI:			<b>'</b>				
Most relevant passages or drawings:				Relevant to Claims:			
p12719 Discussion			1-2, 4-17			l_i	Explanation
Brief explanation of relevance:				•			
Discussionには、TAI	ENsのゲノム編集技術を用い	て、アレ	ルギーの』	原因であるc	vomusiaをノックアウト	、     ;	
した卵作成が可能であることが開示され、さらにCRISPR-Casゲノム編集技術も利用可能であることが開示されている。従って、CRISPR-Casゲノム編集技術で鶏のovomucoid遺伝子をノックアウトすることは容易に思いつく(進歩性の否定)。							
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						WORLD INTELLECTUAL PROPERT	
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#### Google patents: Citations

#### Agomelatine hydrobromide hydrate and preparation thereof

#### **Abstract**

An agomelatine hydrobromide hydrate of formula (I), in which X is Br, preparation method and use thereof as well as pharmaceutical composition containing it are provided. The solubility of the agomelatine hydrobromide hydrate obtained by the present method is significantly higher than that of agomelatine. Therefore, it is more suitable for manufacturing pharmaceutical formulations. In addition, the product has higher stability and purity. The present product of high purity can be obtained through a simple process, rather than process with complicated steps.

#### Classifications

C07C233/18 Carboxylic acid amides having carbon atoms of carboxamide groups bound to hydrogen atoms or to acyclic carbon atoms having the nitrogen atom of at least one of the carboxamide groups bound to a carbon atom of a hydrocarbon radical substituted by singly-bound oxygen atoms with the substituted hydrocarbon radical bound to the nitrogen atom of the carboxamide group by an acyclic carbon atom having the carbon atom of the carboxamide group bound to a hydrogen atom or to a carbon atom of an acyclic saturated carbon skeleton

View 1 more classifications

#### W02011113363A1

**WO** Application

Application number: PCT/CN2011/071912

Other languages: French

Inventor: Hanbin Shan , Zhedong Yuan , Xueyan Zhu , Peng Zhang , Hongjuan Pan , Xiong Yu

Original Assignee: Les Laboratoires Servier

Priority date: 2010-03-17

Filing date: 2011-03-17

Publication date: 2011-09-22

Info: Patent citations (2), Non-patent citations (1), Cited by (4), Also published as (16), Legal events, Similar documents

External links: Espacenet, Global Dossier,

PatentScope, Discuss



#### Backward and forward citations

- Patents
  - can cite other patents as prior art (backward citations)
  - can be cited by other patents (forward citations)

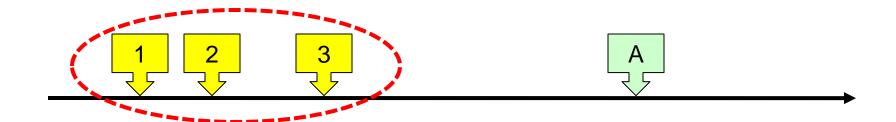


#### Backward and forward citations

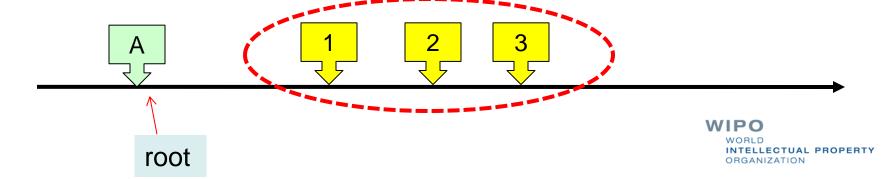
For any publication A:

**Time dimension** 

Publications cited in A → Backward citations of A

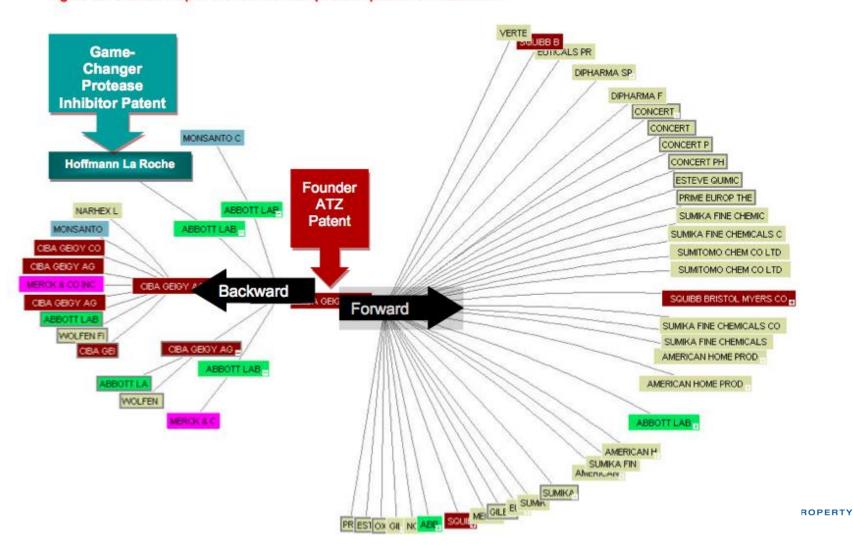


Publications citing A → Forward citations of A

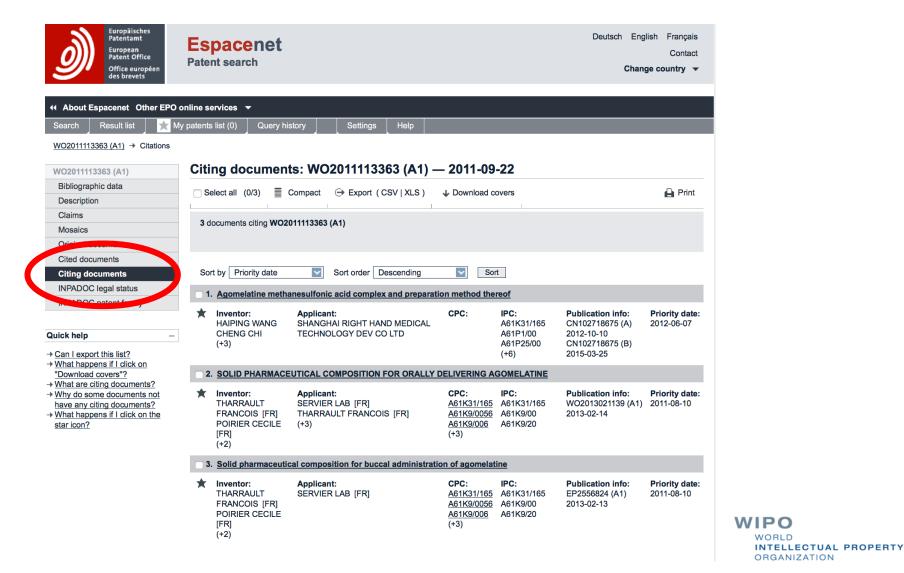


#### Atazanavir – citation map

Figure 29. Citation map of the founder composition patent for Atazanavir

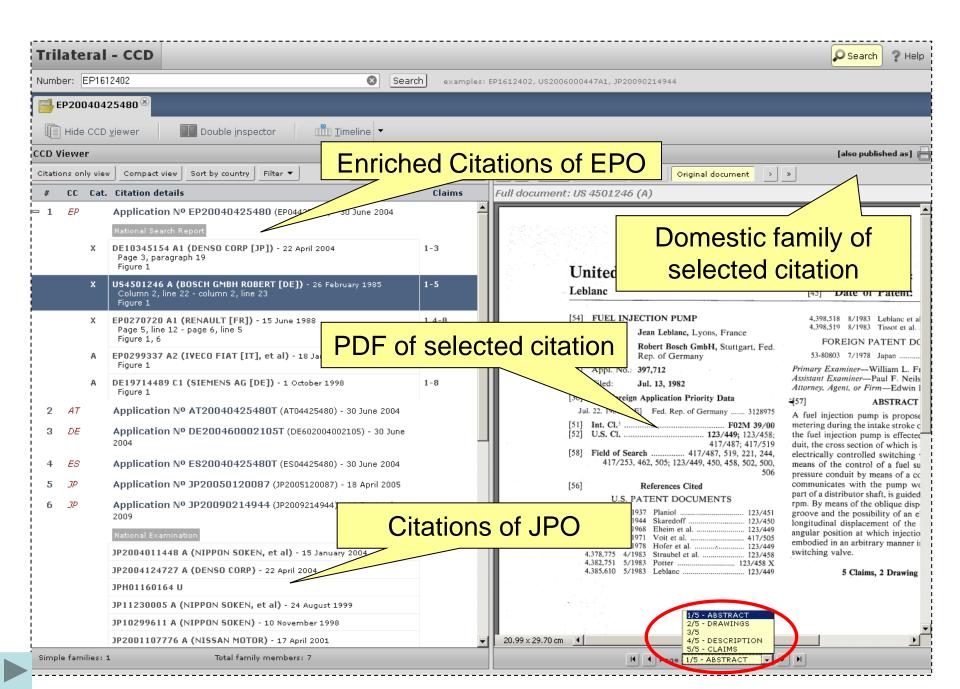


#### **Espacenet: Forward Citations**

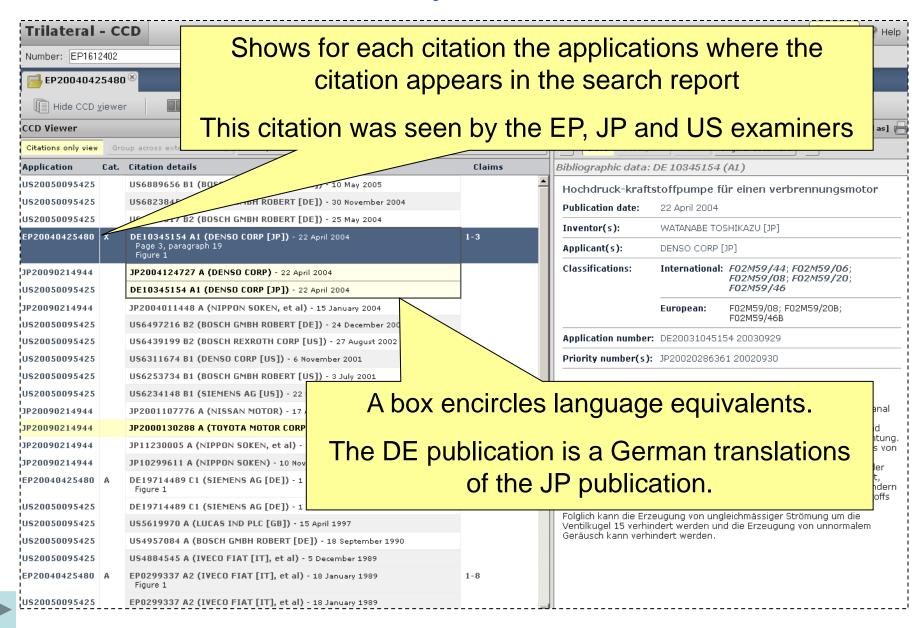


# Comparing citations in CCD

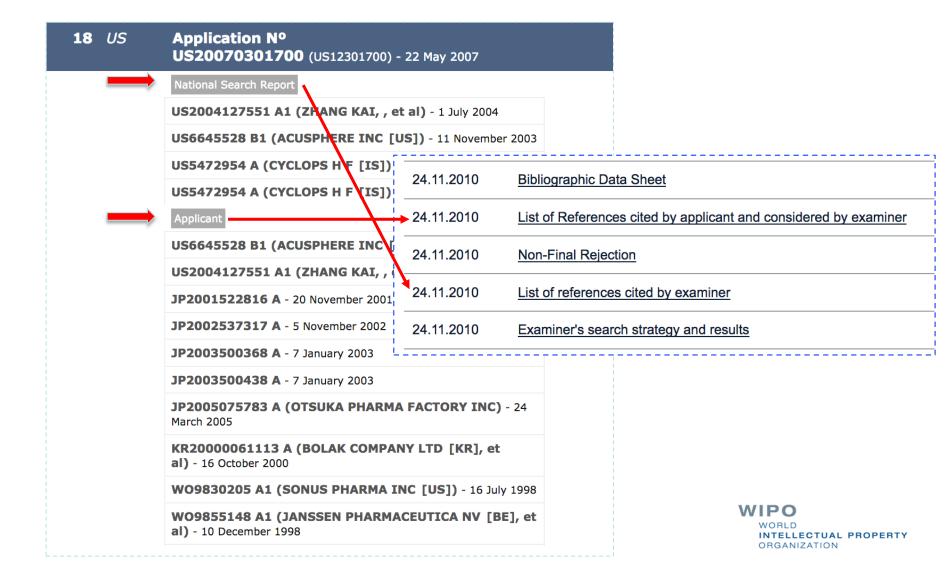




## CCD - citations only view



#### US citations in CCD



## Thank you

lutz.mailander@wipo.int

