



Topic 8: **Utilizing Claims Granted in other Jurisdictions**

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January 30, 2018

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

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

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

Applicant(s): OPULENT ELECTRONICS INTERNAT PTE LTD [SG]; WEE KAI FOOK FRANCIS [SG]; STONA ANDREA [IT]; GROPPI LEOPOLDO [IT]; MAN KWOK WING [CN]; CHONG FOO WING [MY] ±

Classification:




- international: [H02M1/00](#); [H05B37/02](#); [H05B43/02](#)
- cooperative: [H02M3/33523](#); [H05B33/0815](#); [H05B33/0848](#); [H05B37/02](#); [H02M2001/0012](#); [H02M2001/0022](#)

Application number: WO2010SG00212 20100604

Priority number(s): WO2010SG00212 20100604

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 \(B2\)](#)
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Abstract of WO2011152795 (A1)

PROPERTY

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

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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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Espacenet retrieval - claims

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AU2010339630 (B2)

Bibliographic data
 Description
Claims
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 Original document
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 Citing documents
 INPADOC legal status
 INPADOC patent family

Claims: AU2010339630 (B2) — 2013-07-11

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Device and method for driving LEDs

Claims of AU2010339630 (A1)

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A device for providing electrical current to at least one Light Emitting diode (LED), at least one Integrated Circuit (IC), the IC programmable using a hardware description language (HDL), 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; a voltage comparator, the voltage comparator configured to obtain a digitized voltage input; a discharge time period; wherein in operation, the at least one IC is programmed to obtain the digitized voltage input; a reference constant, and the switching time period -on time of the electronic switch at each switching time period, so that the switch-on time of the electronic switch is calculated according to the following formula:

$$T_{on} = I_{OUT} \cdot T_{OFF} \cdot K \cdot V$$
 where T_{on} is the switch-on time of the electronic switch, I_{OUT} is the desired electrical current, T is the switching time period of the electronic switch, K is the reference constant; T_{OFF} is the discharge time of the inductive element of the switch and V is the digitalized voltage input.

A device according to claim 1, wherein the at least one IC is an application-specific integrated circuit (ASIC).

A device according to claim 2, wherein the switch-on time of the electronic switch is calculated according to the following formula:

$$T_{on} = I_{OUT} \cdot T_{OFF} \cdot K \cdot V$$
 where T_{on} is the switch-on time of the electronic switch, I_{OUT} is the desired electrical current, T is the switching time period of the electronic switch, K is the reference constant; T_{OFF} is the discharge time of the inductive element of the switch and V is the digitalized voltage input.

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Family → AU2010339630 (A1) → AU2010339630 (B2)

AU2010339630 (B2)

Bibliographic data

Description

Claims

Mosaics

Original document

Cited documents

Citing documents

INPAD legal status

INPAD patent family

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Original document: AU2010339630 (B2) — 2013-07-11

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Device and method for driving LEDs

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28/08 2011 10:07 FAX 61 2 8283 2518 RECU 26/08/2011 02:16 884122-338-8740 WIPO PCT PT1
 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

Examination procedure	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

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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/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 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**

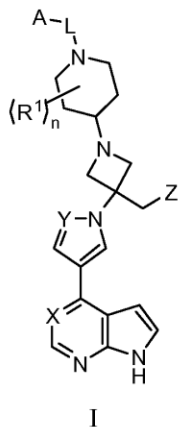
- G** determining the torsional oscillation frequency of the shaft (51) at a second set of operating conditions at which the stiffness of the shaft (51) can be determined (33) and
- H** determining the stiffness of the shaft (51) at the second set of operating conditions;
- I** the torque induced in 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 CR²;

Y is N or CR³;

Z is H, cyano, halo, C₁₋₃ alkyl, or C₁₋₃ haloalkyl;

L is C(R⁴)₂, C(=O), C(=O)N(R^{4a}), C(=O)C(R^{4b})₂, S(=O)₂, C(=O)O, C(=O)OC(R^{4b})₂ or C(=O)N(R^{4a})C(R^{4b})₂;

A is C₁₋₆ alkyl, C₃₋₁₄ cycloalkyl, C₂₋₁₃ heterocycloalkyl, C₆₋₁₄ aryl, or C₁₋₁₄ heteroaryl; wherein said C₁₋₆ alkyl, C₃₋₁₄ cycloalkyl, C₂₋₁₃ heterocycloalkyl, C₆₋₁₄ aryl, and C₁₋₁₄ heteroaryl are each optionally substituted with 1, 2, 3, 4, 5, or 6 independently selected R⁵ groups;

each R¹ is, independently, C₁₋₄ alkyl, hydroxyl, C₁₋₄ alkoxy, fluoro, hydroxyl-C₁₋₄

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
- 1st 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, namely accelerate **1st office action**
- 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.

Simplified Examination

Examination Report

Application No.: 102
PCT Application No.: PCT/IT2006/000825
Date of report: x July 2017

1. The present application 102 is a PCT national phase entry of the International Application PCT/IT2006/000825. The Authority has reviewed the patents granted for other PCT national phase entries of this International Application in other jurisdictions, in particular following publications: AU2006351328B2, CA2670311C, EP2162617B1 and US8581431B2. The Authority has considered the prior art cited in the International Search Report as published in WO2008065684A1 as well as the prior art established in the other national phases.

2. The claims as received on *[date of receipt at office]* are not found to meet the requirements of Article 13 of the Law of Intellectual Property. However, the claims 1-19 granted by the European Patent Office as published in the document EP2162617B1 have been found to meet the requirements of Article 13 of the Law of Intellectual Property.

Simplified Examination

3. The applicant is therefore invited to submit a set of amended claims equivalent to the said claims as published in the document EP2162617B1. The applicant is further invited to amend accordingly the parts of the description relating to the claimed subject matter.

4. The applicant is further requested to confirm that the patents AU2006351328B2, CA2670311C, EP2162617B1 and US8581431B2, as well as other patents which have been granted for the same invention have not been subject to any post-grant reexamination, revocation, cancellation, invalidation or similar procedures.

5. If the applicant does not agree with the invitation of section 3 above, and wishes to amend the claims in other ways, the Authority will continue examination, taking into account any search and examination work products established by the International Search and Examination Authority and other patent authorities where the International Application entered the national phase. For that purpose, the applicant is requested to provide, according to Article 36 of the Law of Intellectual Property, information on any application filed in any jurisdiction and relating to the same claimed subject matter, and furnish copies of any such examination work products or decisions regarding these applications.

6. If the applicant fails to respond to this communication within 3 months from the date of receipt of this communication, the application will be considered abandoned according to Article 43 (2) and (5) of the Law of Intellectual Property.

Modified examination

- Some patent laws (MY) permit applicants to request examination based on grants issued in other jurisdictions
- 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 request, it would be obligatory to check other national phase work products.
- Claims subject to a 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, Moldova)
- 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
 - Lately a bit more relaxed; for example, offices may refuse grant of subject matter excluded from patentability according to their law (KH)
- 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)

Validation

Map showing the geographic coverage of European patents as of 1 December 2017

Member states (38)

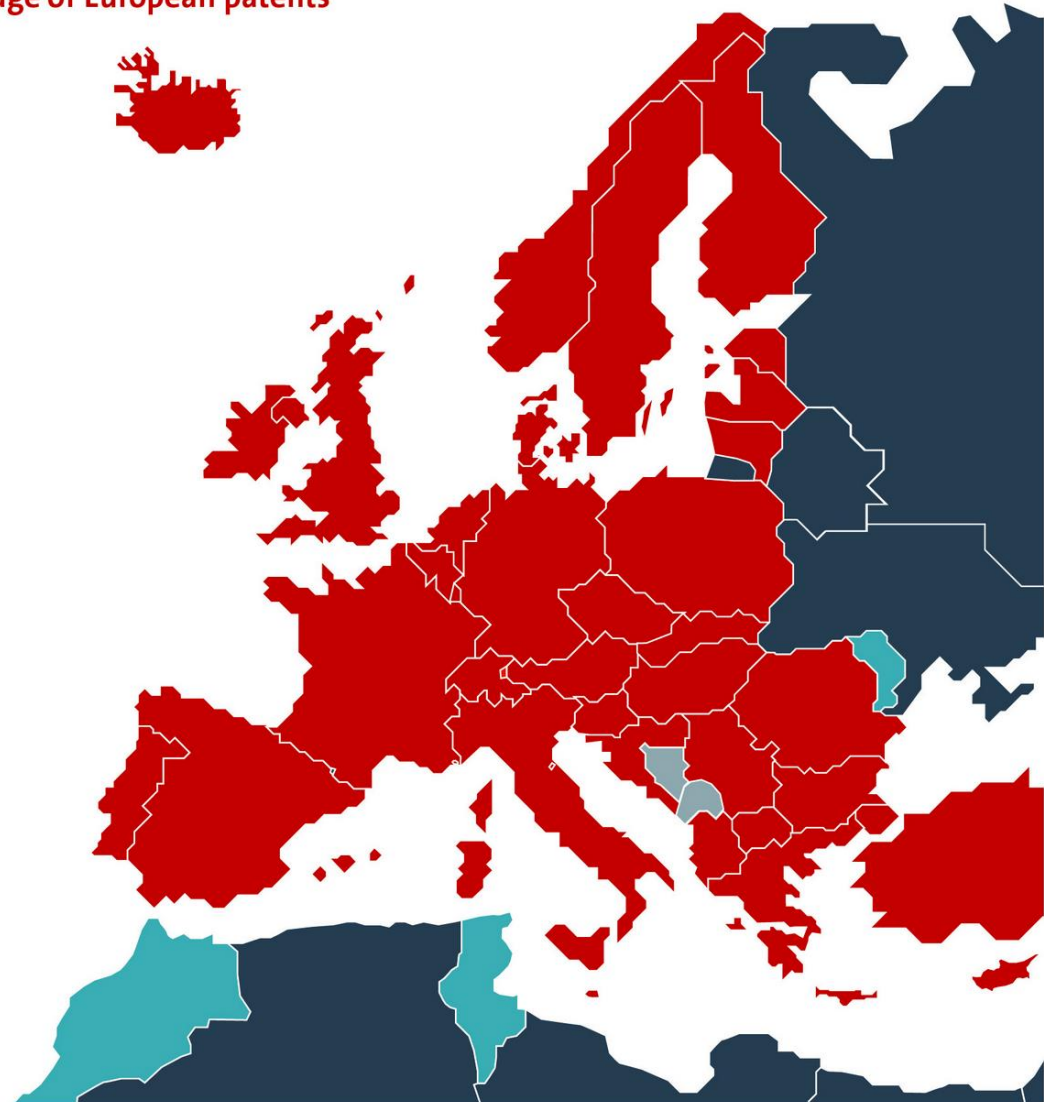
- | | |
|----------------|---------------------------------------|
| Albania | Luxembourg |
| Austria | Former Yugoslav Republic of Macedonia |
| Belgium | Malta |
| Bulgaria | Monaco |
| Croatia | Netherlands |
| Cyprus | Norway |
| Czech Republic | Poland |
| Denmark | Portugal |
| Estonia | Romania |
| Finland | San Marino |
| France | Serbia |
| Germany | Slovakia |
| Greece | Slovenia |
| Hungary | Spain |
| Iceland | Sweden |
| Ireland | Switzerland |
| Italy | Turkey |
| Latvia | United Kingdom |
| Liechtenstein | |
| Lithuania | |

Extension states (2)

- Bosnia-Herzegovina
- Montenegro

Validation states (3)

- Republic of Moldova
- Morocco
- Tunisia



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
- 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

lutz.mailander@wipo.int