

### Topic 2: Patent Family Concepts and Sources for Family Information

Lutz Mailänder Head, Cooperation on Examination and Training Section PCT International Cooperation Division

> Cybercity March 22, 2022

# Agenda

- Families why
  - Priority rights
  - PCT filings without priority
- Families which
  - Types (PCT, simple, extended)
- Families when
  - Do we need to pay attention to different types of families?
  - 10% of families have more than one PCT application as member
  - Families where
    - Sources of family information



# Further reading on families

WIPO Handbook:

http://www.wipo.int/standards/en/pdf/08-01-01.pdf

EPO:

https://www.epo.org/searching-for-patents/helpful-resources/first-time-here/patentfamilies.html

PIUG:

http://wiki.piug.org/display/PIUG/Patent+Families

OECD:

https://www.oecd.org/sti/^inno/44604939.pdf



# Work-Sharing in the PCT national phase

Utilizing examination work products from other national phases for improving **efficiency** and **quality** requires

### **Databases/platforms** providing

- Patent family information (family table) [>Topic 2]
- Examination status of family members [>Topic 3]
- Access to examination work products (dossiers, file wrappers) of family members [>Topic 4]
- Ideally, platforms which integrate this information in a user-friendly manner, e.g. within family table; and with additional tools, for example, for comparing work products (Common Citation Document CCD) [>Topic 6]
- Information on differing national practices (naming and content of work products; important case law; exclusions; ..)

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## Source of family information: Espacenet

Europäisches Patentamt European Patent Office Office européen des brevets	Espacenet Patent search	Deutsch English Français Contact Change country 🗸	
A About Espacenet Other EPO of the term of ter	online services 🔻		
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WO2007111918 (A2)	Bibliographic data: WO2007111918 (A2) —2007-10-04		1 1 1 1 1
Bibliographic data Description	★ In my patents list > EP Register → Report data error	🔒 Print	
Claims			
Mosaics	HEAT PROCESSING SYSTEMS, APPARATUSES, AND METHODS FOR INFECTIOUS AND MEDICAL WASTE	COLLECTION AND DISPOSAL OF	
Original document			
Cited documents	Page bookmark WO2007111918 (A2) - HEAT PROCESSING SYSTEMS, APPARAT	USES, AND METHODS FOR COLLECTION	
Citing documents INPADOC legal status	AND DISPOSAL OF INFECTIOUS AND MEDICAL WASTE		
INPADOC legal status	Applican Inpadoc ('extended') family		(here 2 US)
Quick help –	Classification: - international: A61B19/02; A61L11/00; A61M5/32; B09B3/00	1 Horidoo	
What does A1, A2, A3 and B stand for after a European publication number?	- cooperative: <u>A61B19/0288; A61L11/00; B09B3/0075; B09B3/008</u> <u>A61B2019/024; A61B2019/0294; A61B2019/0295; A</u>	Create far	mily relations
What happens if I click on "In my patents list"?	Application number: WO2007US07071 20070322		1
What happens if I click on the "Register" button?	Priority number(s): US20060785512P 20060323 ; US20060785548P 20060323		1
Why are some sidebar options     deactivated for certain	Also published as: <u> <u> </u> </u>	(W200812650 (A) → PE12992007 (A1) → more	
documents?			
<ul> <li>How can I bookmark this page?</li> <li>Why does a list of documents</li> </ul>	Abstract of WO2007111918 (A2)		
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are these documents? Why do I sometimes find the	Bulgarian  Patenttranslate powered by EPO and Google	ple family ('equiva	alents')
abstract of a corresponding document?	· · · · · · · · · · · · · · · · · · ·		
<ul> <li>What happens if I click on the red "patent translate" button?</li> </ul>	Various embodiments of systems and methods for collection and disposal of infectious and medical waste are disclosed. An embodiment includes a system with a body having a chamber that receives a container of medical waste. The chamber may include a canister that has limited access to the interior of the		WORLD INTELLECTUAL PROPERTY ORGANIZATION
l 		n. \	WIPO PUBLIC

### Espacenet: Extended (Inpadoc) family

Patentamt European Patent Office Office européen des brevets	Espacenet Patent search	Deūtščh" "Englišh" "Francjais" Contact Change country ↓	
	online services 👻 y patents list (0) Query history Settings Help	Number of family r (counting distinct nationa	
WO2007111918 (A2) Bibliographic data Description	Family Ist: WO2007111918 (A2) — 201           □ Select all (0/14)         □ compact		
Claims Mosaics Original document Cited documents Citing documents INPADOC legal status INPADOC patent family		Descending Sort Sort show citations	1st family member (AR)
INPADOC patent family           uick help	MEDICAL WASTE ★ Inventor: Applicant: BIOMEDICAL TECHNOLOGY SOLUTION [US] ■ 2. Heat processing systems, apparatuses, and methods for	CPC:         IPC:         Publication info:         Priority date:           A61B19/0288         (IPC1-         AR060092 (A1)         2006-03-23           A61B2019/0213         7):A61L11/00         2008-05-21         2008-05-21           A61B2019/0229         (+8)         vr collection and disposal of infectious and medical waste	2nd family member (AU)
	Inventor:         Applicant:           COX DONALD         BIOMEDICAL TECHNOLOGY           G         SOLUTION           GORDER         DIANE R           Image: Solution of the second	CPC:         IPC:         Publication info:         Infority date:           A61B19/0238         A61B19/02         AU2007231591 (A1)         2006-03-23           A61B2019/0213         A61L11/00         2007-10-04           A61B2019/0229         A61M5/32         (+1)           METHODS FOR COLLECTION AND DISPOSAL OF INFECTIOUS AND	3rd family member (CA)
	Inventor: Applicant: COX DONALD BIOMEDICAL TECHNOLOGY G [US] GORDER DIANE R [US]	CPC:         IPC:         Publication info:         Triority date:           A61B19/0288         A61B19/02         CA2646350 (A1)         2006-03-23           A61B2019/0213         A61L11/00         2007-10-04         2007-10-04           A61B2019/0229         A61M5/32         (+1)         2007-10-04	
	★ Inventor: Applicant: BIOMEDICAL TECHNOLOGY SOLUTION [US]	CPC: IPC: Publication info: Priority date: A61L11/00 CN101448531 (A) 2006-03-23 2009-06-03	WORLD INTELLECTUAL PROPERTY
	MEDICAL WASTE	LETHODS FOR COLLECTION AND DISPOSAL OF INFECTIOUS AND	organization WIPO PUB

# **Families and Work-Sharing**

### Family table (PCT family)

. . .

PCT/xx	to be examined in national	phase	
CN	CN-A/B Publications	CN Dossier	CN Citations
EP	EP-A/B Publications	EP Dossier	EP Citations
JP	JP-A/B Publications	JP Dossier	JP Citations - IP5
KR	KR-A/B Publications	KR Dossier	KR Citations
US	US-A/B Publications	US Dossier	US Citations
AU	AU-A/B Publications	AU Dossier	AU Citations
СА	CA-A/C Publications	CA Dossier	CA Citations
IN	IN-A/B Publications	IN Dossier	IN Citations

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# **Families and Work-Sharing**

### Family table (simple family)

PCT	/xx	to be examined in nationa	al phase		
CN		<b>CN-A/B</b> Publications	CN Dossier	<b>CN</b> Citations	
EP		EP-A/B Publications	EP Dossier	EP Citations	
JP		JP-A/B Publications	JP Dossier	JP Citations	- IP5
KR		KR-A/B Publications	KR Dossier	KR Citations	
US		US-A/B Publications	US Dossier	US Citations	
AU		AU-A/B Publications	AU Dossier	AU Citations	
СА		CA-A/C Publications	CA Dossier	CA Citations	
IN		IN-A/B Publications	IN Dossier	IN Citations	

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BD

# Families issues for Work-Sharing

### Family table (PCT, simple or extended)

. . .

PCT/xx	PCT/xx to be examined in national phase									
CN	CN-A/B Publications	CN Dossier	CN Citations							
EPa	EPa-A/B Publications	EPa Dossier	EPa Citations							
EPb	EPb-A/B Publications	EPb Dossier	EPb Citations							
KR	KR-A/B Publications	KR Dossier	KR Citations							
USa	USa-A/B Publications	USa Dossier	USa Citations							
USb	USb-A/B Publications	USb Dossier	USb Citations							
CA	CA-A/C Publications	CA Dossier	CA Citations							
IN	IN-A/B Publications	IN Dossier	IN Citations							

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# Families issues for Work-Sharing

### Family table (simple or extended)

PCT/xx	to be examined in national phase
CN	CN-A/B Publications CN Dossier CN Citations
EPa	EPa-A/B Publications EPa Dossier EPa Citations
EPb	EPb-A/B Publications EPb Dossier EPb Citations
KR	KR-A/B Publications
USa	USa-A/B Publica Which work products are useful? And to Ditations
USb	USb-A/B Publica what extent?
СА	CA-A/C Publication Homework Topic 2 tations
PCT/yy	will present examples
	10% of cases have multiple PCT applications as family mer

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# Origin of patent families

There are **various reasons** for patent family relations between **distinct applications**/filings:

A. Patent protection is territorial, i.e. inventors/investors may have to seek protection in various different jurisdictions ("**extensions**")

B. .....

- Foreign applications usually claim **priorities** of earlier applications filed in other jurisdictions based on
  - Paris Convention
  - TRIPS agreement
- Family relations because applications share priorities
- PCT applications can be filed without claiming priorities
- Family relations because applications share PCT application number
   PCT family



## Priority claims - sample

### Bibliographic data: WO2008004425 (A1) - 2008-01-10

🜟 In my patents list	7	EP Register	I Report data error	🕒 Print

#### PANTS-TYPE WEARING ARTICLE

Page bookmark	WO2008004425 (A1) - PANTS-TYPE WEARING ARTICLE					
Inventor(s):	Kenmochi yasuhiko [jp]; Kinoshita Akiyoshi [jp]; Aoyagi natsuko [jp]; Tanaka Kayoko [jp] <u>+</u>					
Applicant(s):	UNI CHARM CORP [JP]; KENMOCHI YASUHIKO [JP]; KINOSHITA AKIYOSHI [JP]; AOYAGI NATSUKO [JP]; TANAKA KAYOKO [JP] <u>+</u>					
Classification:	- international: A61F13/49; A61F13/496; A61F13/56					
	- cooperative: <u>A61F13/15; A61F13/15756; A61F13/56</u>					
Application number:	WO2007JP62104 20070615 1 priority					
Priority number(s):	JP20060187165 20060706					
Also published as:	□ US2008009816 (A1) □ US7833207 (B2) → UA91294 (C2) □ TW200819114 (A) □ TWI336619 (B) → more					

## Priority claims - sample

### Bibliographic data: WO2008035580 (A1) - 2008-03-27

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1						

#### PLANT CULTIVATION SYSTEM

Page bookmark	WO2008035580 (A1) - PLANT CULTIVATION SYSTEM				
Inventor(s):	OKAMOTO AKIHIRO [JP]; FUJII MANABU [JP]; YOSHIOKA HIROSHI [JP]; MORI YUICHI [JP] <u>+</u>				
Applicant(s):	MEBIOL INC [JP]; OKAMOTO AKIHIRO [JP]; FUJII MANABU [JP]; YOSHIOKA HIROSHI [JP]; MORI YUICHI [JP] <u>+</u>				
Classification:	- international: A01G1/00; A01G13/00; A01G25/00; A01G27/00; A01G7/00				
	- cooperative: <u>A01G31/02;</u> Y02P60/216				
Application number:	WO 2007 JP67578 20070910 ① Global Dossier 2 priorities				
Priority number(s):	JP20060254439 20060920 ; JP20070144202 20070530				
Also published as:	EP2064942 (A1) ■ EP2064942 (A4) ■ US2010186298 (A1) ■ US8001721 (B2) → UA93268 (C2) → more				

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## **Priority claims - sample**

The more priorities are claimed, the more complex the family relations may be!

Bibliographic	c data: WO2008060725 (A3) — 2008-07-1	Differ	ent types of families		
★ In my patents lis	st		depending on whether		
SECURE UNIVER	RSAL TRANSACTION SYSTEM	- on	priorities are shared ly some priorities are		
Page bookmark	WO2008060725 (A3) - SECURE UNIVERSAL TRANSACTION S	sha	ared		
Inventor(s):	FRANCHI JOHN FRANCO [GB] <u>+</u>				
Applicant(s):	FRANCHI JOHN FRANCO [GB] <u>+</u> 3 priorities				
Classification:	- international: H04L9/00				
	- cooperative: <u>G06F21/32;</u> <u>G06F21/34;</u> <u>G06Q20/12;</u> <u>G06Q20/40</u> ·	10	3 countries		
Application number:	WO2007US74327 20070725				
Priority number(s):	US20060532580 20060918 ; EP20060256440 20061219 ; GB20060	0025304 2	20061219		
Also published as:	■ WO2008060725 (A2) ■ WO2008060725 (A8) ■ EP1901248 (A → more	<u>\1)</u> → <u>ZA</u> :	200901870 (B) 🗅 US2011125613 (/	<u>A1)</u>	

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## **Priorities: Paris Convention of 1883**

- Covers patents, designs, trademarks,...
- Facilitates second/subsequent filings abroad
- Equal protection to nationals and foreigners (non-discrimination)
  - Foreigners: nationals and residents of any Union country
- Mutual recognition of (Paris Convention) priority rights:
  - at OSF: Treatment of application as if filed on date of first filing, i.e. same prior art is to be applied if claimed subject matter is fully disclosed in priority
  - 12 month period to file an application claiming the priority of an earlier application (Art. 4 C (1))
- Permits combination of multiple priority rights (same or different countries) (Art. 4 F)
- Permits additions of technical subject matter (Art. 4 F)

As long as national definition of **unity** is met

### Priorities: Benefits of claiming priorities OFF (Office of First Filing) **Prior art** Filing date OFF OSF (Office of Second Filing) **Prior art** Filing date OSF **Priority date** WIPO WORLD **Conditions apply !** INTELLECTUAL PROPERTY ORGANIZATION

# Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims **multiple priorities**, even if they originate in **different countries**, or on the ground

that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

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# PCT application without priority

#### (12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

РСТ

(19) World Intellectual Property Organization International Bureau

> (43) International Publication Date 3 September 2009 (03.09.2009)

- (51) International Patent Classification: C07C 46/02 (2006.01)
- (21) International Application Number:
  - PCT/IB2008/000451
- (22) International Filing Date: 29 February 2008 (29.02.2008)
- (25) Filing Language: English
- (26) Publication Language: English
- (71) Applicant (for all designated States except US): LABO-RATOIRE MEDIDOM S.A. [CH/CH]; Enetriederstrasse 44, CII-6060 Sarnen (CII).
- (72) Inventors; and
- (75) Inventors/Applicants (for US only): DI NAPOLI, Guido [CH/MC]; 8, Lacets Saint-Leon, MC-98000 Monaco (MC). DI NAPOLI, Alessandro [CH/CH]; Chemin du Vent-Debout 18, CH-1245 Collonge Bellerive (CH).
- (74) Agent: REUTELER & CIE, S.A.; Chemin de la Vuarpillière 29, CH-1260 Nyon (CH).
- (81) Designated States (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ,

EC, EE, EG, ES, Er HR, HU, ID, IF KZ, LA, K, LR, LS, LT, EO, ET, MAX, MID, ME,

MC , MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW.

(10) International 1

(84) Designated States (unless otherwise indicated, for every kind of regional protection available): ARIPO (BW, GH, GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV, MC, MT, NL, NO, PL, PT, RO, SE, SI, SK, TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

#### Declarations under Rule 4.17:

- as to applicant's entitlement to apply for and be granted a patent (Rule 4.17(ii))
- of inventorship (Rule 4.17(iv))

#### Published:

- with international search report (Art. 21(3))

# PCT application without priority

### Bibliographic data: WO2009106910 (A1) — 2009-09-03

★ In my patents lis	st  ↗ EP Register		🔒 Print
PROCESS FOR T	THE PREPARATION OF ALOE-EMODIN	NO priority	
Page bookmark	WO2009106910 (A1) - PROCESS FOR THE PREPARATION	first filing with IB	
Inventor(s):	DI NAPOLI GUIDO [MC]; DI NAPOLI ALESSANDRO [CH] +	Espacenet repeats	
Applicant(s):	MEDIDOM LAB [CH]; DI NAPOLI GUIDO [MC]; DI NAP	application number among	g
Classification:	- international: C07C46/02	priority numbers!	
	- cooperative: <u>C07C46/02</u> → <u>more</u>		
Application number:	WO2008IB00451 20080229		
Priority number(s):	WO2008IB00451 20080229		
Also published as:	AR072768 (A1)		

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# PCT family

- PCT family' includes the international application and all its national phase entries
- Linked through the **PCT application number**
- Linked as well through the **priorities** if any were claimed which the national phase entries inherit from the international application



# PCT family – simple family

- PCT family' includes the international application and all its national phase entries
- Linked through the PCT application number
- Linked as well through the priorities if any were claimed which the national phase entries inherit from the international application

There may be **additional applications** in the simple family **which are not PCT NPEs because country is not PCT member state**, linked through priorities

- For example, a BD application filed through the Paris route and claiming the same priorities like the PCT application
- For example, a foreign application filed in JM

It may also happen that a simple family includes **several distinct PCT families**; for example PCT/DK2006/000477 **WIPO** 

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# PCT/KR2012/001812: 2 x WO in family



# Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims multiple priorities, even if they originate in different countries, or on the ground

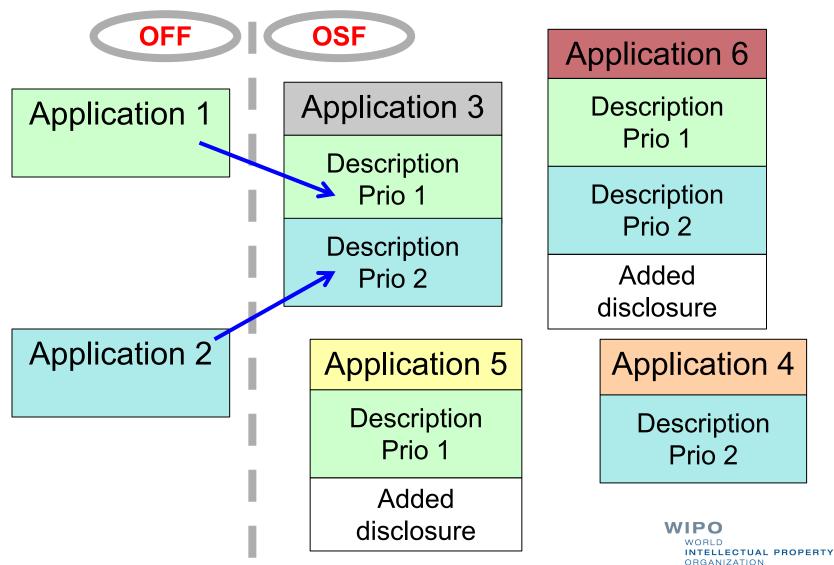
that an application claiming one or more priorities contains **one or more elements that were not included** in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

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## **Combining multiple priorities**



## Technical disclosures of family members

- Even though priorities are claimed, technical disclosure (descriptions and drawings) may differ:
  - Combinations of different sets of descriptions
  - Parts of descriptions may be removed
  - Technical subject matter may have been added

Permitted by Paris Convention

- Claims may also be different since claims need to be supported by description
- Applicants are not obliged to reveal modifications when making a new application
- Differences are revealed only by comparing descriptions
- When are differences least likely?
  - When all claimed priorities are the same



# Family concepts based on priorities

### Simple family:

All members of the family have exactly the same priority or priorities

### Complex family:

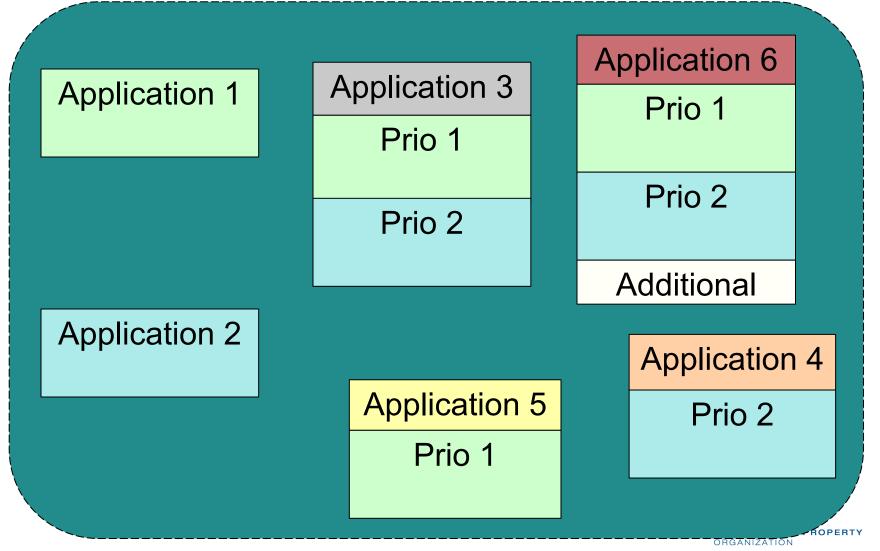
All members of the family share at least one priority

### Extended family:

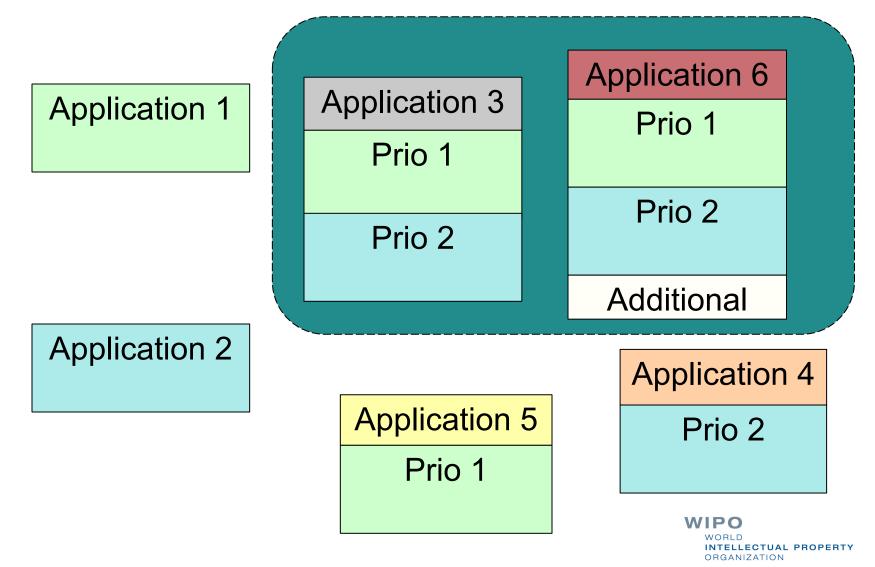
Any member shares at least one priority with at least one other member
 Covers indirect sharing of priorities; is therefore the biggest possible family



## **Extended family**



# Simple family



## Simple & PCT <> extended family?

- **Simple family**: all members share the same priorities
- **PCT family**: all members share the same PCT application number AND priorities
  - It is very likely that descriptions of family members are equal or very similar
  - "Equivalents", "also published as"
  - Ideally, family members are just translations in other languages
  - However, Paris Convention permits additions of subject matter
  - "same invention" or group of very similar inventions

Extended (Inpadoc) family: biggest possible family, includes applications sharing priorities indirectly

- It is quite likely that descriptions are different
- More likely that they cover different but related inventions in same area of technology

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# Family building in databases

Comparing priority numbers and/or

Comparing PCT application numbers



# Sources of family information

- EPO's INPADOC database is major source of such family information, accessible through:
  - Espacenet, EP-Register and CCD (simple and extended families; domestic families)
  - Other free patent information databases, like Depatis, Google Patents, ...

### WIPO PATENTSCOPE

- aggregates national phase entry data <u>reported</u> from Designated/Elected
   Offices (obligation as from July 1, 2017; rule 95)
- Proprietary family building (since 2021)
- WIPO CASE with proprietary family building based on application data shared by 'providing offices'; families are complex families (i.e. share at least one priority)
- Commercial patent databases obtain and use widely INPADOC data, and apply proprietary family building rules and data cleaning, e.g.
  - Clarivate/Derwent: WPI family
  - Questel/Orbit: Fampat family
  - ...
- Other specialized platforms, e.g. WIPO's <u>Pat-Informed</u> or MPP <u>MedsPal</u>
- India Form 3

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## Source of family information: Espacenet

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WO2007111918 (A2)	Bibliographic data: WO2007111918 (A2) —2007-10-04		1 1 1 1 1
Bibliographic data Description	★ In my patents list 🦻 EP Register 🔶 Report data error	🔒 Print	
Claims			
Mosaics	HEAT PROCESSING SYSTEMS, APPARATUSES, AND METHODS FOR ( INFECTIOUS AND MEDICAL WASTE	COLLECTION AND DISPOSAL OF	1 1 1
Original document			
Cited documents	Page bookmark WO2007111918 (A2) - HEAT PROCESSING SYSTEMS, APPARATU	SES, AND METHODS FOR COLLECTION	
Citing documents INPADOC legal status	AND DISPOSAL OF INFECTIOUS AND MEDICAL WASTE	<b>_</b>	
INPADOC patent family	Applican Inpadoc ('extended') family		(here 2 US)
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What does A1, A2, A3 and B stand for after a European publication number?	- cooperative: <u>A61B19/0288; A61L11/00; B09B3/0075; B09B3/0083</u> ; A61B2019/024; A61B2019/0294; A61B2019/0295; A61B2009/0295; A61B2009/009/0009/0009/00000000000000000000	create far	mily relations
What happens if I click on "In my patents list"?	Application number: WO2007US07071 20070322		
What happens if I click on the "Register" button?	Priority number(s): US20060785512P 20060323 ; US20060785548P 20060323		1 1 1
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<ul> <li>Why does a list of documents</li> <li>with the heading "Also published</li> </ul>	Abstract of WO2007111918 (A2)		
as" sometimes appear, and what	Translate this text into		
<ul> <li>are these documents?</li> <li>Why do I sometimes find the abstract of a corresponding</li> </ul>	Bulgarian 🕞 🖛 patenttranslate powered by EPO and Google Simp	ole family ('equiv	alents')
document? What happens if I click on the red	Various embodiments of systems and methods for collection and disposal of		WORLD
"patent translate" button?	infectious and medical waste are disclosed. An embodiment includes a system with a body having a chamber that receives a container of medical waste. The chamber may include a canister that has limited access to the interior of the	34 30 20 20	ORGANIZATION
<u>.</u>			WIPO PUBLIC

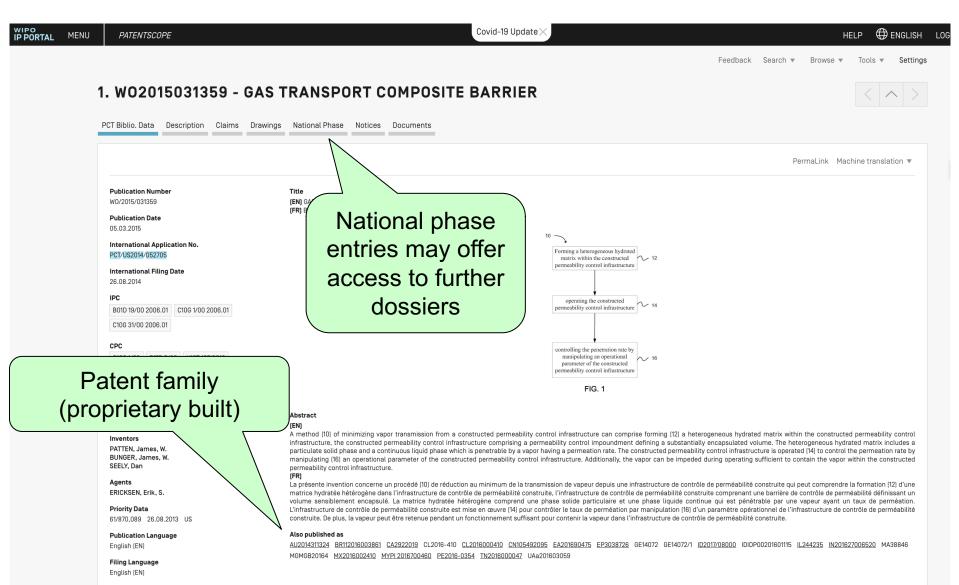
### Family tables in New Espacenet

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My Espacenet Help	o Classification searcl	n Results Advanced search Filters	Popup tips	Report data error Feedback
lome > Results > <b>WO2</b>	:007111918A2			
>MEDICAL WASTE		YSTEMS, APPARATUSES, AND METHODS FOR COLLEC		CTIOUS AND Available in Screensho
	DOC family Latest leg			CCD 7
Puplication A	Application number 🔨	Title A	Publication date 🔨	Applicants A
AR060092A1	ARP070101214A	SISTEMAS APARATOS Y METODOS DE PROCESAMIENTO POR PARA LA RECOLECCION Y ELIMINACION DE DESECHOS INFEC MEDICOS	,	BIOMEDICAL TECHNOLOGY SOLUTION [US]
AU2007231591A1	AU2007231591A	Heat processing systems, apparatuses, and methods for collection disposal of infectious and medical waste	and 2007-10-04	BIOMEDICAL TECHNOLOGY SOLUTIONS INC [U
CA2646350A1	CA2646350A	HEAT PROCESSING SYSTEMS, APPARATUSES, AND METHODS COLLECTION AND DISPOSAL OF INFECTIOUS AND MEDICAL W		BIOMEDICAL TECHNOLOGY SOLUTION [US]
CL2007000747A1	CL2007000747A	Sistema de procesamiento termico de desechos medicos que cor cuerpo con una camara para recibir un contenedor, al menos un c de placa y aletas a un costado para refrigerar la camara; y metodo procesamiento termico de desechos medicos.	alentador	BIOMEDICAL TECHNOLOGY SOLUTIONS INC [U
				ORGANIZATION

# Family table in Global Dossier (USPTO)

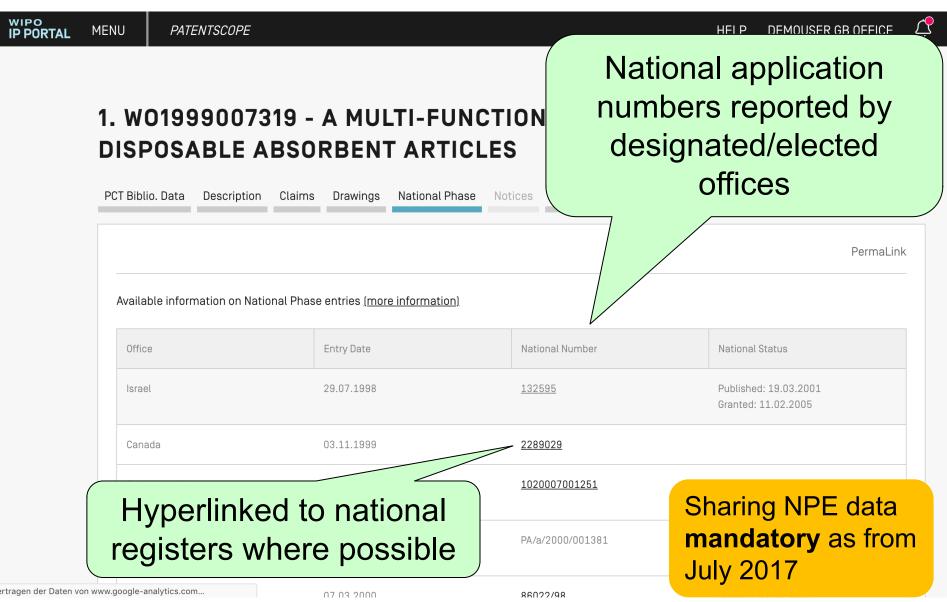
uspto									About Us	Careers Contact Us
Global Dossier										
Home Public Pair	Common C	itation Documen	t				Current Se	ervice Status Serv	vice Hours H	Help Email Us 🖻
Office WIPO -	Type PCT A	pplication	PCT/US2014	/052705			Domes	tic 🔹 🕻	ollections 0	ා ව History 1
PCT/US2014/052705 12 Members in Patent Family (12 currently shown)										
«	Construction Office	Application \$	Applicant	Title	Ар	op. Date 🌲	Priority #	P p. # 🛈	Pub. Date	Action ≑ 📵
IP Office Type	🛕 PE	0002862016		١	08	/26/2014	US 61870089	PE 03542016 A1	05/11/2016	
<ul> <li>All IP5 Offices</li> <li>EPO</li> <li>SIPO</li> <li>KIPO</li> <li>JPO</li> <li>USPTO</li> <li>Non-IP5 Offices</li> </ul>	A MX	2016002410			08	/26/2014	US PCT/US14/52705 US 61870089	MX 2016002410 A	05/31/2016	
	🛕 EA	201690475			Extended		US PCT/US14/52705 US 61870089	EA 201690475 A1	06/30/2016	
	🛕 AR	P140103202			family, no		US 61870089	AR 097461 A1	03/16/2016	
	🕀 AU	2014311324 View Dossier	1) Red Leaf Resources, Inc.,	Gas barri	option to select	014	US PCT/US14/52705 US 61870089	AU 2014311324 A1 AU 2014311324 B2	04/07/2016 11/10/2016	🖶 (2) Add to ★
	AP	201609052			simple	014	US PCT/US14/52705 US 61870089	AP 201609052 D0	02/29/2016	
	⊕ US	14469062 View Dossier	1) Patten, James W. 2) Bunger, James W. 3) Seely, Dan	GAS COM	family	014	US 61870089 US 14469062	US 20150053269 A1	02/26/2015	🖶 (1) Add to ★
	🔥 CA	2922019			08	/26/2014	US PCT/US14/52705 US 61870089	CA 2922019 A1	03/05/2015	

### **PATENTSCOPE:** built family information

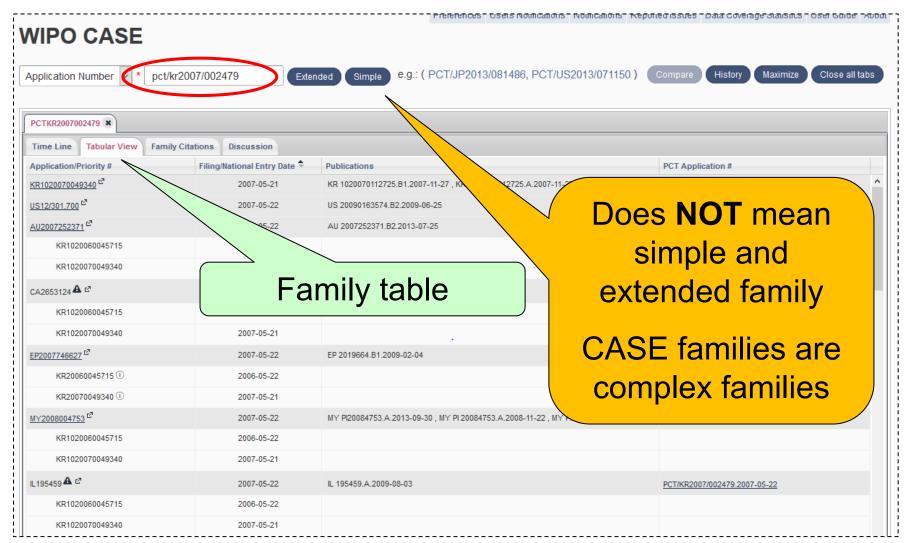


**Designated States** 

### **PATENTSCOPE:** National phase entries



## Family table in WIPO CASE



# Legal obligations for disclosing family information

- Some jurisdictions, for example India, systematically require applicants to disclose and update family information
- Disclosure to be found in IN dossier as 'Form 3'
- Represents up to now the most comprehensive source of family information
- Can be retrieved by searching IN application number in Indian register in PASS



#### Form 3 of IP India

PCT/EP2017/056134

	India: Obligation for applicants to					
COUNTRY	APPLN. NO.	PCT FILING DATE	STATUS Such as pending,accepted,refused, abandoned,withdrawn, opposed etc.	GRAN PATI		
United Arab Emirates	P6001293/2018	15/03/2017	Pending		examination results (Rule 12	
ARIPO	AP/P/2018/011052 2017232266	15/03/2017 15/03/2017	Abandoned Pending		47 national phas	
Australia Bahrain	167/2018	15/03/2017	Pending			
Brazil	BR112018068571-2	15/03/2017	Abandoned	1	entries	
Canada	3,017,556	15/03/2017	Pending			
Chile	2018002632	15/03/2017	Abandoned		· ·	
China	2017800245532	15/03/2017	Response due by 11 February 2021	-	Only 22 recorded in INPADOC	
Colombia	CO2018010940 I	15/03/2017	Response filed on 1 October 2020			
Costa Rica	2018-000488	15/03/2017	Pending			
Cuba	2018-0108	15/03/2017	Abandoned			
Djibouti	DJ/B/2018/0002	15/03/2017	Abandoned	1.		
Algeria	180499	15/03/2017	Pending		l pa	
Eurasia	201892065	15/03/2017	Response to be filed by 21 March 2021			
Ecuador	2018-77068	15/03/2017	Abandoned			
Egypt	1439/2018	15/03/2017	Pending		WIP	
EPO	17710019.5	15/03/2017	Pending			

**UPDATED ANNEXURE TO FORM 3** 

е

#### se

Accessible via atent register of India inPASS

Ο RLD INTELLECTUAL PROPERTY ORGANIZATION

## Family coverage of different sources

(PCT/IB2014/02991)

Consolidated family (Espacenet, WIPO CASE, PATENTSCOPE, India Form 3) (97+10)
 AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, DZ, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HK, HN, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LC, LK, LT, LY, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, S/, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

India Form 3 (96+0) in dossier of IP India (provided by applicant)

AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, *DK*, DM, DO, DZ, 2xEA, EC, 2xEG, EP, *ES*, GC, GD, GE, GT, HN, HK, HT, *HR*, *HU*, ID, IL, IN, IQ, IR, JD, JM, JP, KH, KN, KP, 2xKR, LA, LB, LC, LK, *LT*, MA, *ME*, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, *PL*, *PT*, *RS*, PY, RW, SC, SG, *SI*, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

<u>Espacenet</u> (32+10) (family building based on priority and PCT application numbers)

AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, DZ, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, LY, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 2xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

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#### Family coverage of different sources

PATENTSCOPE national phase entry data (26+1) (provided by designated/elected offices)
AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM,
DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JO, JM, JP,
KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA,
PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY,
UZ, VC, VE, VN, WO, WS, YE, ZA

PATENTSCOPE family build (43+5) (based on priority and PCT application numbers)

AG, AO, AP, AR, AU, BB, BD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JO, JM, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 2xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

WIPO CASE (33) (based on priority and PCT application numbers)

AG, AO, AP, AR, AU, BB, BD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

ORGANIZATION

### Challenges

- Don't worry IP5 family members are included in all sources plus many other major jurisdictions
- Limitations exist mostly for regional cooperation because many medium and smaller IPOs don't share bibliographic data with database hosts
- No source that permits to select only PCT family
- Essential for work-sharing (to be able) to identify the members of the PCT family
- Family members linked to other PCT applications are less useful or not useful at all

## Families within one jurisdiction

National, regional, PCT jurisdictions

- National families
- Domestic families



## Origin of patent families - reasons

There are **various reasons** for patent family relations between **distinct applications**/filings:

- A. Patent protection is territorial, i.e. inventors/investors may have to seek protection in different jurisdictions ("extensions")
- B. An application may have certain deficiencies
  - Lack of unity
  - Flaws or gaps of the disclosure (description, drawings)
- C. Further improvements of an invention



### **Claiming national priorities**

#### Bibliographic data: US2008274698 (A1) — 2008-11-06

📩 In my patents list 🛛 📳 Report data error

Print

#### METHOD AND APPARATUS FOR INDICATING A TEMPORARY BLOCK FLOW TO WHICH A PIGGYBACKED ACK/NACK FIELD IS ADDRESSED

Page bookmark	US2008274698 (A1) - METHOD AND APPARATUS FOR INDICATING A TEMPORARY BLOCK FLOW TO WHICH A PIGGYBACKED ACK/NACK FIELD IS ADDRESSED						
Inventor(s):	LI YAN [US]; DICK STEPHEN G [US]; CHITRAPU PRABHAKAR R [US]; RUBEHROUZ [US]; MANSETA KHUSHALI N [US] $\pm$	US '138 claims					
Applicant(s):	INTERDIGITAL TECH CORP [US] <u>+</u> 3 national						
Classification:	- international: H04B1/00	priorities					
	- cooperative: <u>H03M13/09; H04L1/0041; H04L1/0073; H04L1/1664; H04L</u> H04L2001/125						
Application number:	US20080106138 20080418 (1) Global Dossier						
Priority number(s):	US20080106138 20080418 ; <u>US20070913179P 20070420</u> ; <u>US20070974293P 20070921</u> ; <u>US20070981980P</u> 20071023						
Also published as:	□ <u>US8296619 (B2)</u> □ <u>WO2008130694 (A1)</u> □ <u>US2013326320 (A1)</u> □ <u>US2</u> → <u>more</u>	2013039210 (A1) 🗈 US8539308 (B2)					

#### **Domestic second filings**

#### "Continuation (in part)"

- New national/local application claiming priority of one or several earlier national/local applications
- "in part": Additions of technical subject matter to initial disclosure of parent (priority) application or other amendments are permitted, and usually intended, only part of the new application originates in earlier application
- (Up to 12 months after filing date of claimed priority)
  - Remedy for flaws in first application
  - Opportunity to specify further improvements of an invention

#### Patent of addition (in some jurisdictions)

- Improvement of original invention of parent patent
- Unity with parent patent to be given; i.e. as if further independent claim of parent patent
- Depends on validity of parent patent
  - Request possible up to 18 months after filing of patent patent

WIPO world intellectual property organization

#### **Domestic second filings**

#### **Division (and US 'continuations')**

- E.g. for healing a lack of unity: mandatory division
- Permits filing of an application with new set of claims based on previously filed disclosure (i.e. no additions to initial disclosure permitted): voluntary division

Paris Art. 4 G (2)

Paris Art. 4 G (1)

- Initial disclosure (parent application) may comprise several inventions
- Lack of unity is given only if different inventions are "claimed", i.e. if covered explicitly by claims
- Strategic approach by some applicants
- Divisions are possible usually anytime as long as parent application is pending (EPC: only within 24 months after 1st office communication)
- Retains application date and claimed priorities; no explicit priority claim type relation to parent application

WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION

### Further sources of family information

National registers (e.g. EP-Register, US PAIR) include patent family information on national level (domestic families, national families (continuation in part, **divisions**; US continuations)



#### **EP-Register - divisions**





#### **US-PAIR:** national family/divisions

_11/689,638	Heat Processing Systems, Apparatu	uses, and Methods for Collection and Disposal of Infectious and Medical Waste			57015-340945					
Select New Case         Application Transaction         Image File         Continuity         Published         Address & Display           New Case         Data         History         Wrapper         Data         Documents Attorney/Agent References										
Parent Continuity Data										
Description		Parent Number	Parent Filing or 371(c) Date	AIA(First Inventor to File)	Parent Status	Patent Number				
This application Claims Priority from Provisional Application		60/785,512	03-23-2006	-	Expired	-				
Claims Priority from Provisional Application 60/785,548		60/785,548	03-23-2006		Expired	-				
Child Continuity I	Data									
No Child Continuity Data Found										



# Summary: multiple family members from same country

When do we have multiple family members from same jurisdiction? In case of:

- Divisional applications (US continuations)
- Continuations in part
- Several PCT applications in same family
- These reasons may co-occur!
- You need to understand/identify the reason(s) and select the proper family members for work-sharing purposes
- **Don't worry**: only some 10-20% of PCT applications are affected
- Temporary problem until comprehensive PCT families can be selected in family tables

#### Thank you

### lutz.mailander@wipo.int

