

Workshop on Examination in the PCT National Phase (Work-Sharing)

This is an assessment of your skills acquired at the workshop. The skills are required for using examination work products from other national phases. They are related to

- *Researching family information*
- *Researching examination status for selected family members*
- *Researching whether the ISR includes observations on lack of unity*
- *Retrieving and comparing prior art cited by different examiners in different national phases (citations)*
- *Identifying the X/Y/A category of a citation if that is not included in the respective search report*
- *Comparing claims granted in different national phase*

Selection of cases:

*It is suggested that each of you **treat 2 or 3 different cases of International Applications** that entered the ZA national phase. You may select the cases yourself. Ideally, you pick applications covering technologies which you are familiar with although this assessment is not aiming at examining novelty or inventive step. Ideally, you select national phase entries that are a bit older (**NPE in ZA in 2017 or earlier**); then there will already be results from some national phases including grants (remember the long pendencies that we have observed when we treated some sample cases at the workshop)*

Please enter your findings in a soft copy the table of sample cases distributed at the workshop. The top record of the table (1st case) gives an example of how the researched information should be recorded in the table. Please return the table with your findings to lutz.mailander@wipo.int.

For Information on where and how the information to be researched can be found, please refer to the PPTs of the workshop accessible at: https://www.wipo.int/meetings/en/details.jsp?meeting_id=55346 You will find there also a soft copy of the table. Please feel free to contact me at the above address if you have any questions or if the instructions below are not clear.

Relevant links:

https://worldwide.espacenet.com/advancedSearch?locale=en_EP
<https://patentscope.wipo.int/search/en/search.jsf>
<https://globaldossier.uspto.gov/#/>
<http://ccd.fiveipoffices.org/CCD-2.2.0/>
https://www.wipo.int/patent_register_portal/en/index.html

Part 1 (Topic 3: family relations and priority claims)

- check the size of the Inpadoc (extended) family of the PCT application (to be recorded in column D of the table) [*use Inpadoc family table in Espacenet*]; check if there is another PCT application in the extended family or even in the simple family;
- check if the Inpadoc (extended) family includes more than one simple family (to be recorded in column E), i.e. further simple families which do not include the PCT application of column C [*use CCD*];
- [*if you wish, you may as well: determine the earliest priority date and enter it in the top line of each cell in column J [use Inpadoc family table in Espacenet]; add the priority country code after the date; if there are several distinct priority countries, include each country code, separated by colons; if there are several priorities from the same country, indicate their number in brackets.*]
- for some cases, check as well the family information available in USPTO-GD, in WIPO CASE, and in the NPE tab of Patentscope.]

Part 2 (Topic 4: examination status)

- Check if the simple family includes publications of grants (check the kind codes of publication numbers; see the list of kind codes below): please record all country codes of those grants in column F;

- Check if all IP5 offices (CN, EP, KR, JP, US) have published grants; whenever you notice that there is **no** grant of an IP5 office in the simple family, check if the application(s) were withdrawn or rejected or are still pending by reviewing the most recent communications in Global Dossier (for CN, KR, JP, US) or in EP Register. If Global Dossier is empty, check the Inpadoc legal status. Record the country code(s) accordingly in columns G, H and I; please record as well, if you notice an 'intention to grant' or a 'notification of allowance' (by adding an 'i2g' in brackets after country code). In addition, you may try AU or CA by using 'Inpadoc legal status' or by accessing the national registers.

Kind codes for publications of grants:

AU-B2 AU-C CA-C CN-B EA-B1 EG-A EP-B1 FR-B1 JP-B2 KR-B1 MA-B1
MY-A RU-C2 SE-C2 TW-B UA-C2 US-B2

[if you wish, you may as well:

- Try to find the shortest and longest pendency of the grants in the simple family (column F);
- determine the earliest and the most recent publication date of grants (record them in column J and add the country codes after the dates); and
- calculate the pendency range in years (and record it in column K).

- For some of the cases where an application was withdrawn or deemed to be withdrawn, can you find the reason why it was withdrawn or deemed to be withdrawn?]

Part 3 (Topic 10: comparing citations from different national phases)

- check if the ISR includes only A citations, and record that in column M; indicate as well the country code of the ISA;

- check if the ISR includes observations (Box III) on the unity of patent (column N of the table);

- check if additional citations were used in the different national phases (column O of the table); whenever you find a national phase where an examiner did a supplementary search, please enter the country code of that national phase and record one sample citation from that examiner which is not in the ISR, in particular:

- check if there is a published supplementary EP search report (please enter 'EP-A4' in the table if that is the case),

- use the CCD for finding citations not included in the ISR.

Part 4 (Topic 12: comparing main claims granted in different national phases)

- Check if any granted main claim is equivalent or equal to the WO-A1/2 main claim, and record this in column Q;

- Check if main claims granted in different jurisdictions are different from each other (substantially or not), in particular (column Q):

- look for examples of grants with exactly the same wording of main claims,
- look for examples of grants with substantially different wording of the main claims,
- look for examples of grants of different category of subject matter (process, use, product),

- look for examples of grants of different type (one part – two part claims).

(Please enter your answers in the table and also prepare a word document in which differences of two grants are highlighted in track changes mode.)