



## Topic 8: **Types of Work Products and Sources for their Retrieving**

Lutz Mailänder

Head, International Cooperation on Examination and Training Section

Pretoria  
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# Agenda

- Types of work products/examination results
  - Intermediary
    - PCT
  - final
- Overview of options and sources for retrieval
  - Patent registers (primary sources)
  - Work-sharing platforms (secondary sources)

# Work-Sharing opportunities through patent families

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

# Actions during life cycle of application

Actions are performed by

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

As defined by

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

Communicated usually in written form

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

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

# Types of examination work products

- Intermediary or **pre-grant** work products
  - Search reports
    - basic list of citations (cited by examiner, by applicant)
    - Enriched search reports (citation category X, Y, ..; relevant claims;...)
  - Search strategies
  - Written opinions, examination reports
  - Communications from applicant to examiner
  - Protocols of hearings
  - Third party observations
- **Final** work products/results
  - Granted claims; claims after opposition
  - Rejections; withdrawals following substantive reports; abandoned claims
- **Post-grant** work products/results
  - Additional prior art from opposition/re-examination
  - Amended claims
  - Communications between involved parties (3+)

# Overview of different terminology

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

# Main products of PCT international phase

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

# International publications

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



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

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

# PCT – WO

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)

International application No.

PCT/US2010/020787

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

1. Statement

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

2. Citations and explanations

see separate sheet

Form PCT/ISA/237 (April 2007)

Statements  
(Rule 70.6)

Explanations  
(Rule 70.8)

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1 Reference is made to the following documents:

- D1 US 2002/186921 A1 (SCHUMACHER LYNN C [CA] ET AL) 12 December 2002 (2002-12-12)
- D2 WO 2007/136816 A2 (MASSACHUSETTS INST TECHNOLOGY [US]; BULOVIC VLADIMIR [YU]; KYMISSIS IO) 29 November 2007 (2007-11-29)

2 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1, 4-15, 17-18, 20 is not new in the sense of Article 33(2) PCT.

2.1 D1 discloses

an optical fiber capable of being diagnosed non-invasively comprising an optical fiber (12) for conveying a light beam; said optical fiber comprising a first end for receiving said light beam and a second end opposed thereto, a core (14) comprising an inner wall, and a cladding (16) surrounding said core, said optical fiber further comprising at least one uncladded portion comprising a plurality of quantum dots (26) dispersed in a medium, wherein said quantum dots become activated by evanescent wave coupling resulting from total internal reflection of said light beam contacting said inner wall of said optical fiber core and wherein said activation results in emittance of light from said quantum dots (Fig. 2c; paragraphs [0033], [0045]).

Therefore, the subject-matter of present claim 1 is not novel over the teachings of D1.

2.2 D1 also discloses

# Summary: Access to written opinions, etc

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

# Selected **primary** online resources

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

# Work-sharing platforms

**Secondary work-sharing platforms** ("one-stop-shop") aggregate information or enable access to work products from several authoritative sources (Registers)

## Espacenet

- Includes **INPADOC data**:
  - Very (most?) comprehensive extended and simple family data
  - National and regional legal status of jurisdictions sharing such data with EPO
- Includes **Global Dossier** (IP5 initiative)
  - Access to **IP5 Offices' file wrappers/dossiers** (One Portal Dossier)
    - always up-to-date because it is retrieved on-the-fly from IP5 national registers
    - Machine translation for non-English documents
    - Status may often be derived from recent dossier documents
    - **Inpadoc legal status** sometimes include complementary status that cannot be derived from most recent communication
  - Access to **non-IP5 dossiers** of 'providing' Offices of WIPO-CASE
    - partly operational (AU, CA, ..)

# Work-sharing platforms

Secondary platforms ...

## Espacenet ...

- Includes Global Dossier
- integrated access to Common Citation Document (CCD):
  - viewing and comparing of citations from members of extended and simple families from AP, AU, CA, CN, DE, EA, EP, JP, KR, RU, TW, US, WO, ....
  - 'comparing': which examiners have seen a particular citation or an equivalent thereof

## USPTO Global Dossier

- Website dedicated to Global Dossier (appears to be still under development)
- Access to same dossiers like Espacenet GD (IP5 and CASE 'providing offices')
- presents **only extended family information** (without WO member); i.e. doesn't permit to view/select only simple family/PCT family
- Integrated application 'Citation List' (under development) to view comprehensive lists of citations from family members (backward and forward); **not suitable for 'comparing'**

# Global Dossier at USPTO



## Global Dossier

Home Public Pair Common Citation Document

Current Service Status Service Hours Help Email Us

Office WIPO Type PCT Application PCT/US2014/052705

Collections 0 History 1

PCT/US2014/052705 12 Members in Patent Family (12 currently shown)

Office	Application	Applicant	Title	App. Date	Priority #	Pub. #	Pub. Date	Action
PE	0002862016			08/26/2014	US 61870089	PE 03542016 A1	05/11/2016	
MX	20160024				US PCT/US14/52705 US 61870089	MX 2016002410 A	05/31/2016	
EA	20169047				US PCT/US14/52705 US 61870089	EA 201690475 A1	06/30/2016	
AR	P1401002			08/26/2014	US 61870089	AR 097461 A1	03/16/2016	
<b>+</b> AU	2014311324 <a href="#">View Dossier</a>	1) Red Leaf Resources, Inc.,	Gas transport composite barrier	08/26/2014	US PCT/US14/52705 US 61870089	AU 2014311324 A1 AU 2014311324 B2	04/07/2016 11/10/2016	(2) <a href="#">Add to ★</a>
AP	201609052			08/26/2014	US PCT/US14/52705 US 61870089	AP 201609052 D0	02/29/2016	
<b>+</b> US	14469062 <a href="#">View Dossier</a>	1) Patten, James W. 2) Bunger, James W. 3) Seely, Dan	GAS TRANSPORT COMPOSITE BARRIER	08/26/2014	US 61870089 US 14469062	<a href="#">US 20150053269 A1</a>	02/26/2015	(1) <a href="#">Add to ★</a>
CA	2922019			08/26/2014	US PCT/US14/52705 US 61870089	CA 2922019 A1	03/05/2015	

"+" indicates that AU dossier is accessible

- IP Office Type
- All IP5 Offices
  - EPO
  - SIPO
  - KIPO
  - JPO
  - USPTO
  - Non-IP5 Offices

# Work-sharing platforms

Secondary platforms ...

## WIPO-CASE (non public)

- **Accessible only for 'accessing' and 'providing' Offices**
- 'providing' offices share their dossiers with other participating offices
- Includes IP5 dossiers obtained from GD/OPD & AU, CA, GB, IL, **IN**, NZ, ..
- Family information includes only so-called 'complex' families
  - Proprietary family building based on applications of 'providing' Offices recorded in CASE, and NPEs recorded in Patentscope
- Majority of dossiers are also **publicly accessible through Patentscope** 'document' tab (labelled as 'Global Dossier') and Global Dossier

## PATENTSCOPE

- Access to WIPO CASE dossiers in 'document' tab (labelled as 'Global Dossier')
- Includes PCT family (limited; only NPEs reported to WIPO from Designated and Elected Offices); only visible for WO publications; no separate family building
- No extended or simple families (EPO data are not integrated)
- No citation data



# 'GD' in Patentscope (WIPO CASE data)

WIPO PATENTSCOPE  
Search International and National Patent Collections

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Search Browse Translate Options News Login Help

Home > IP Services > PATENTSCOPE

**1. (IN201637003071) COMPOSITIONS AND METHODS FOR IDENTIFYING A RISK OF CANCER IN A SUBJECT**

National Biblio. Data Documents

Legal date	Description	
24.07.2017	FORM 18	
31.10.2016	FORM-13	
25.07.2016	FORM 3	
25.07.2016	OTHER PATENT DOCUMENT	
24.02.2016	CORRESPONDENCE	
24.02.2016	OTHERS	
28.01.2016	CORRESPONDENCE	
28.01.2016	FORM-1	
28.01.2016	FORM-2	<a href="#">PDF</a>
28.01.2016	FORM-3	<a href="#">PDF</a>
28.01.2016	FORM-5	<a href="#">PDF</a>
28.01.2016	INTERNATIONAL PUBLICATION	<a href="#">PDF</a>
28.01.2016	PCT SEARCH REPORT & OTHERS	<a href="#">PDF</a>
28.01.2016	WO7692A1	<a href="#">PDF</a>

Dossier is retrievable only if national application or publication number is known  
(NB Patentscope includes only NPE family information reported to WIPO, and only when viewing the respective PCT)

RTY

# 'GD' in Patentscope (WIPO CASE data)

- Patentscope 'Global Dossier' presents dossier data from WIPO CASE
- Does not include family information
  - Does therefore not permit direct access to dossiers of other family members
  - Requires separate family search, e.g., via
    - Espacenet or
    - NPE tab in Patentscope (if PCT application or publication numbers are known)

[pAU2014311324](#)

[eWO2015031359](#)

[pWO2015031359](#)

# Work-sharing platforms

- Espacenet, US-Global Dossier, WIPO-CASE and Patentscope are (at the present) complementary to each other
- Shall, in future, cover access to same set of dossiers
- Which one to use then?
  - Better user interface?
    - Searching, viewing, exporting, ...
  - Additional tools (comparing, translations, alerts, ..)
  - Additional information (citations, enriched citations, different types of families, ...)
- Many national registers already enable deep linking
- Do we still need secondary platforms then? Or just a 'federated register' linking to national registers

Thank you

[lutz.mailander@wipo.int](mailto:lutz.mailander@wipo.int)