



Wrap up and discussion

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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
- Use of PCT international phase results and national phase results (including non-PCT applications) is an effective strategy

Different categories of IPOs

Expertise

- IPOs with **long experience** (DPMA, EPO, JPO, USPTO, ...)
- IPOs having **established patent prosecution** ("emerging Offices"; e.g. Jordan, Malaysia, Thailand, Viet Nam,...)
- IPOs just **embarking on patent prosecution** (e.g. Bahrain, Oman, Bhutan, Cambodia, Kuwait, Ghana ...)

Size

- **Small IPOs** with very few examiners (e.g. Bahrain, Oman, Bhutan, Jordan, Syria, Kuwait, Ghana) and the capacity to **cover very few areas of technology**
- **Medium size IPOs** with the capacity to **cover some but (may be) not all areas of technology** (Thailand, Viet Nam)
- **Large IPOs** with sufficient number of staff to cover all areas of technology (IP India, USPTO, EPO, JPO)

- What is the sufficient size of an IPO to deliver quality patents?
- How can a small IPO with limited resources deliver effective patent prosecution ?
- I think: Yes, if trained as "state patent attorney,, and trained in the exploitation of external examination results for members of the patent family
- Agree?

Required examiner capacities

Patent Examiner

Scientist / Engineer

Legal Specialist

„**State Patent Attorney**“

Dependent on
application

Specific technical expertise in area of subject
matter

Knowledge in patent law, regulations:
Novelty, Inventive Step, Claim Wording,...

Independent of
application

Checklist for using external examination products

- Active retrieval by examiner, i.e.
 - **Research family information** and
 - Check examination status and
 - **Retrieve results** from online resources
- Request applicant to submit information
- Carefully check whether results are applicable:
 - Same or similar claims (claim correspondance table) ?
 - Compatible with your exclusions from patentability,...?
 - Is priority valid?
 - New search needed, eg if claims were not searched by ISA?
 - Can you wait for results from other IPOs ?
 - Are the results of other IPOs consistent ?

Thank you

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