

Homework Topic 5 – Utilizing claims granted in other Jurisdictions – Solutions Homework Topic 6 – Retrieving and Comparing Citations - Solutions

Let us assume that you have to examine the following PCT applications in your national phase:

PCT/AU2017/050096

PCT/KR2017/010423

- Compare main claims granted in English language with each other, and with the claim of the international application searched by the ISA. Which one is the narrowest main claim?

[PCT/AU2017/050096](#)

AU-B main claim is narrower than WO-A; one can easily tell already at first glance when seeing the different length.

EP-B similar to AU but appears to include a clarification rather than an addition ("creating a blockchain transaction using comprising the metadata hash"; "document content metadata")

[compare claims by using compare document function of WORD]

US narrower than EP (includes additional "document verification revocation stage") [compare claims by using compare document function of WORD]

[PCT/KR2017/010423](#)

AU-B and CA-C are different from each other. Both appear to be narrower than the WO-A1 main claim (within the limits of machine translation).

- Briefly research the examination status and check if any rejections or oppositions have occurred.

[PCT/AU2017/050096](#)

EP granted

JP decision to grant (national search with Cat A only, see below)

CN pending

KR pending with request for examination (1020187022860 in [KR register](#))

US granted

[PCT/KR2017/010423](#)

EP pending

US final rejection; RCE

- Check if additional relevant prior art (category X or Y) was searched and considered in the national phases which was not yet found and considered in the international phase (ISR).

[PCT/AU2017/050096](#)

EP-A4 supplementary European search identified additional non patent literature (Swan et al) cat Y prior art (seen by US examiner as well)

US identified two additional cat Y prior art (US2011121066A1; US2017075938A1) (not considered by any other examiner, except US2011121066A1 seen by CN) [according to CCD; and US non final rejection of 04.09.2020 for categories]

JP identified 3 additional cat A prior art [see translated decision to grant & translated search report by registered search organisation]

CN supplementary national search with cat A documents only

[PCT/KR2017/010423](#)

The ISR includes only cat A documents (ISA=KIPO).

AU has identified US5748512A as additional cat X prior art; not considered in other national phases. [CCD and front page of AU-B publication]

EP and US have identified WO2012101636 as additional cat X prior art, and US2012326984A1 as cat X (EP) and cat Y (US). [CCD]

US has identified further cat Y prior art, considered also by CA. [CCD; CA examiner requisition]

- If you found additional prior art considered in national phases, check if it was considered in all national phases or only one national phase.

[PCT/AU2017/050096](#)

See above

[PCT/KR2017/010423](#)

See above

- What would you do in your national phase if you had to examine the application and if the applicant had filed the original claims of international application that were searched for preparing the ISR?

[PCT/AU2017/050096](#)

The US main claim is the narrowest compared to other main claims in English language. The US examiner has considered all prior art seen by other examiners and additional prior art of cat Y not considered by other examiners. That is an indication that the main claim is narrower because of this additional prior art. The US claim set may therefore be more valid and one may propose this claim set to the applicant after confirming that it is not excluded from patentability according to the applicable national legislation.

[PCT/KR2017/010423](#)

The original claims are not patentable in view of the prior art established in the national phases despite the ISR.

AU-B has been granted without considering prior art relevant in other national phases.

CA-C has been granted while US has rejected based on the same prior art. Request for continued examination at US based on amended claims

It may therefore be risky to grant AU or CA claim sets in your national phase.

EP is still examining the application; a possible outcome may be claims which are patentable in view of all the relevant prior art identified so far. One may therefore consider to await the EP and US results.