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New developments for IP practitioners

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EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



ACTING FOR THE IP PROFESSION WORLD WIDE



Session 2: Best Practices and Pitfalls of Reporting Examination Reports from Major IP Offices

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Expertise is mainly on patents, portfolio management and related litigation, primarily in Europe and Asia, internal training projects, the litigation team and foreign relations.

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Best Practices and Pitfalls of Reporting Examination Reports from Major IP Offices

European Patent Office Practice

Kim Finnilä
Assistant Reporter General of CET

Singapore
22nd November 2019



Topics

- Amendments
- Allowability of amendments
- Inventive step; problem-solution approach
- Summary



Amendments (1/3)

- A European patent application or patent (description, claims drawings) may be amended during examination, opposition and limitation proceedings
 - Application filed directly with the EPO; amendments not possible before receipt of European search report [Rule 137 (1) EPC]
 - Euro-PCT; amendments may be made on and/or after entry into regional phase [Rule 159, 161 EPC]



Amendments (2/3)

- Amendments may be made after receiving the European search report and search opinion
- Amendments may be made after receiving the first communication
- After first communication prosecution of amendments is within the discretion of the examining division



Amendments (3/3)

- Amendments [Rule 137(4) EPC]
 - (i) shall be clearly identified and
 - (ii) the basis for the amendments in the application as filed shall be [clearly] indicated

- Amended claims may **not** [Rule 137(5) EPC]
 - relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single inventive concept



Allowability of amendments (1/3)

- Article 123(2) EPC: The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.
- Article 123(3) EPC: The European patent may not be amended in such a way as to extend the protection it confers.



Allowability of amendments (2/3)

- Article 123(2) EPC
 - The EPO uses a disclosure test
 - Amendment **not** allowed, if the skilled person is presented with information (G2/10 – Golden rule)
 - Which is not directly and unambiguously derivable, and seen objectively and relative to the date of filing, from the whole of content of the application as filed
 - Even when account is taken of what is implicit to a person skilled in the art using common general knowledge
 - Literal support (basis) is not required
 - Extending scope of protection during application phase is in principle allowed



Allowability of amendments (3/3)

- The basis for amendments is primarily assessed by examiners as indicated by the applicant
- Sometimes examiners propose amendments; these should be carefully reviewed so as not to contravene particularly Article 123(2) EPC
- Article 123(3):
 - This relates to the patent after grant; e.g. oppositions, limitations, and proceedings (differences)
 - The “trap” between Article 123(2) and (3)



Inventive step (1/5)

- Person skilled in the art (*skilled person*)
 - Skilled practitioner in relevant field of technology, who is aware of common general knowledge in the art at relevant date
 - Access to everything in the state of the art
 - If prompted to do so, the person skilled in the art may seek a solution in other technical fields
 - Can be group of persons
 - Purpose driven; goal is to solve a technical problem



Inventive step (2/5)

- Problem-solution approach
 - Disclosing the invention, as claimed, so that the *technical problem* and its *solution* can be understood [requirement for description, Rule 42(1) EPC]
 - Three main stages
 - Determining *closest prior art*
 - Establishing the *objective technical problem* to be solved
 - Considering whether or not the claimed invention, starting from the *closest prior art* and the *objective technical problem*, would have been obvious to the *skilled person (the solution)*



Inventive step (3/5)

– closest prior art

- Simplification by selecting single reference
- Most promising starting point in view of invention
- Similar use and most relevant common technical features
- Similarity of problem



Inventive step (4/5)

– objective technical problem

- Aim and task of skilled person to modify closest prior art to provide the technical effects that the invention [distinguishing feature(s) of the claim] provide over the closest prior art
- The objective technical problem need not be the same problem as defined in the application



Inventive step (5/5)

– solution

- How a skilled person, having the teaching of the closest prior art and faced with the objective technical problem, develops the prior art to arrive at the solution
- The invention is obvious if the closest prior art (one other reference), including common knowledge, being combined with further prior art **would** have prompted the skilled person to modify the closest prior art to arrive at the invention
- The key is not what the skilled person could have done, but what he **would** have done hoping to solving the technical problem prompted by the prior art
 - e.g. when a problem is not known in the prior art, prior art would not prompt him to solve it



Summary

- Amendments for direct European filings cannot be made before the issuance of a search report
- Amendments for a Euro-PCT filing can be made when entering the European phase
- When considering amendments check and advise clearly the basis (support) for the amendments
- Remember that amendments can be made [in principle] only based on the application as filed
- In defending your invention in view of prior art, structure your defense based on the problem-solution approach



Thank you very much for your attention
– looking forward to a discussion at the
end of the session!

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- Started patent practices since 2000

Among 20 years experience of patent practices, in the first ten years I handled patent cases for global electronics company located in Osaka, Japan by doing drafting application, prosecution, invalidation, oppositions, opinion and so on.

- Established my own IP firm in 2011

•Among the last ten years, I handled more prosecution matters of the patent cases from overseas countries such as Korea, China, US, European countries.

- My academic background is chemical engineering.

Reporter CET Group 3 (International Patent Matters) and Regional Coordinator for Japan CET Group 8





Views on how to efficiently tackle the reasons of rejections in JAPAN

Katsumori ISEKI
FICPI CET3 Reporter
& CET8 Regional Coordinator-Japan
Singapore,
22 November 2019



Possible problems/improvements of a Japanese patent application based on overseas patent application

	Type of possible problems	Type of possible problems
1. Reasons of rejection are possibly issued: two types	Low foreseeable reasons of rejection arise but the number of OA should be minimized	High foreseeable reasons of rejection can be avoided before receiving OA
2. Reasons of rejection are NOT issued: types of overseas practices to be arranged under Japanese practice	Overseas practices leading to OA in overseas jurisdiction but NOT in Japan can trigger improvements of the patent application	Overseas practices not leading to OA in overseas jurisdiction or in Japan but causing possible problems in Japan can be fixed in the patent application

In relation to the office action, the **red parts** would be explained in the following



Two types of reasons of rejection: Low foreseeable reasons

- Low foreseeable reasons: novelty and inventive step
 - Affected by the database of IP Offices and subjectiveness of examiners of IP Office.
 - Not relatively easy to anticipate which prior art is cited.
 - Important to reduce the number of reasons for receiving such rejection, thus reducing the entire costs and also strengthening the patent rights with a short file history.
 - Efficient communication between a local patent attorney and an overseas patent attorney, especially knowing the differences between both patent practices, is very helpful.
 - Conducting an interview with the examiner to better understand this type of reason for rejection.



Two types of reasons of rejection: High foreseeable reasons

- High foreseeable reasons: deficiency in Description, Claims and Drawings
 - Sometimes caused by the differences of patent law and practices among jurisdictions and by translations
 - They can be precluded before receiving the rejection, especially at the time of filing, by making certain amendments to better comply with the Japanese law and practices and by doing appropriate translations
 - Making those amendments at the time of filing may prevent avoidable reasons of rejections from being raised, resulting in reducing the entire costs and also obtaining strong patent rights with a short file history



Two types of reasons of rejection: High foreseeable reasons-translation issue

- Basic: “Japanese words used in the patent application should be as simple and plain as possible although it probably makes the patent specification longer to some extent. Using more idiomatic words, often and easily used, can cause unnecessary disputes of the meaning of those words.”
- Some idiomatic words patent used in Japanese applications, especially in the mechanical field, are very familiar to patent specialized people, but some of them are not official Japanese language and should not be used.
- Patent specifications should be like general technical literatures.
- Japanese sentence structure, contrary to English and Chinese, may lead to mistranslation - deep understanding of technology and communication with local professionals are helpful to prevent such a problem.
- Poor quality of translation may:
 - Make it more difficult to obtain patents
 - Make it more difficult to enforce patent rights
 - Increase the costs (time spent by patent attorneys)



Two types of reasons of rejection: High foreseeable reasons-caused by the differences of patent law and practices

- Using approximate expressions such as ‘about’, ‘substantially’, ‘generally’ and etc. basically falls under the reasons of rejection since these words are deemed ambiguous, unlike in US practice.
- Product-by-process claims basically deemed ambiguous (thus rejected for lack of clarity), unless the claim satisfies very strict requirements; Japanese practice differs from those of other major jurisdictions accepting the PBP claim in a more relaxed way.
- In the above examples, reasons of rejections may be avoided via amendments made at the time of filing, thus reducing the costs and making the patent rights stronger.



Overseas practices leading to OA in overseas jurisdiction but **NOT** in Japan can trigger improvements in the patent application

- Different types of Claims format are acceptable under Japanese practice, even though certain types of Claim format are required in some jurisdictions. Thus, **the element-by-element formulation of the Claims can be recommended by considering the prosecution process and enforcement process.**
- Multi-dependent Claims depending on multi-dependent Claims are acceptable under Japanese practice. Thus, **this type of multi-dependent Claims can be introduced by considering comprehensive and strong protection of invention without increasing the number Claims under the certain budgets.**
- There is no self-collision issues under Japanese practice if the applicant or inventors are completely the same between the prior and present applications. Thus **the oversea applications subject to the self-collision issue in some jurisdictions can be patentable in Japan.**
- The above examples are good ones for applicant to improve the application by considering the acceptable practices in Japan, which are not acceptable in some jurisdictions



Summary

- Reasons of rejections for Japanese patent application based on the overseas application are categorized into two types:
- One type is for high foreseeable reasons, such as deficiency in Claims, Description and Drawings, which should be avoided before the applicant receives the office action; the other type is for low foreseeable reasons, such as novelty and inventive step, which should be overcome by receiving fewer OA.
- Efficient communication between the local patent attorney and the overseas patent attorney is very useful. According to the types of reasons of rejections, the roles of local and overseas patent attorneys varies so as to prepare the best replies including an interview with the least costs and to secure strong protection of inventions at the least costs.
- Some overseas practices leading to OA in overseas jurisdiction can be good practices in Japan to strengthen the protection of inventions since some of such overseas practices does not fall under the reasons of rejections.



Thank you

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CET3 Reporter
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M. Sc. Chemistry, Masters degree in Law, diploma in IP Rights from the premier Indian Law Institute (ILI), Delhi.

Swarup is a founder member and elected Secretary of FICPI, India. He Chairs the Litigation and Alternative Dispute Resolution group - CET 7 at FICPI.

Swarup speaks regularly on Indian IP law and practice at national and international platforms and has contributed many research papers, articles and pieces in renowned IP journals and publications. He has proposed advisory to the DIPP on feasibility of “Utility Model” in India.

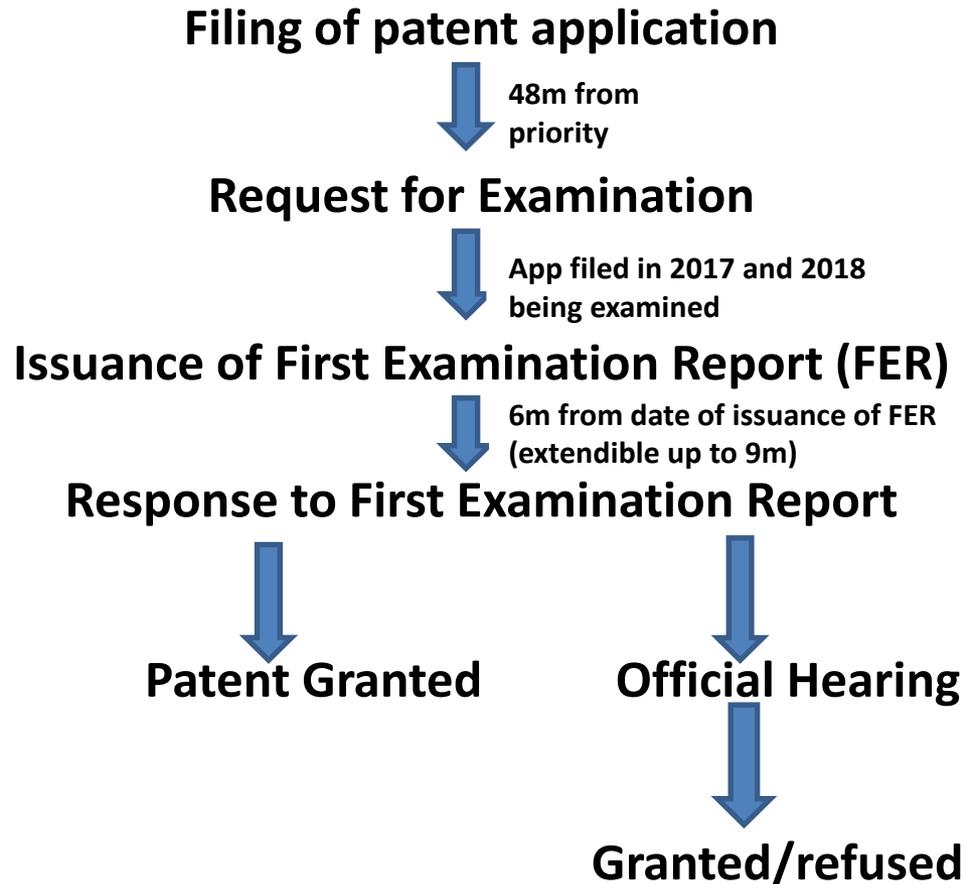


Best Practices and Pitfalls of Reporting Examination Report - Indian Perspective

Swarup Kumar
Chair CET – 7
Partner, Remfry & Sagar



BRIEF OVERVIEW OF PROSECUTION





REPORTING FER TO CLIENT

Key factors :

- Individualized process;
- High level of Technical knowledge + Legal nuance;
- Understanding of Best Practices of the IPO

Aim of reporting FER:

- Simplify the techno-legal jargons;
- Explain the objections and advice practical strategy to deal with it;
- Provide opinion/advice that balances the need to overcome the objection(s) and to meet commercial interest



Upon issuance of FER, first and foremost...

Communicate the deadline to file a response + copy of the FER

- Limited timeframe to respond to an examination report;
- Instils a sense of urgency;
- Gives client an opportunity to re-evaluate;
- Possibility of seeking extension may be pondered over



PART-I: SUMMARY OF THE REPORT

क्र. सं. /Sl. No.	अधिनियम के तहत आवश्यकताओं पर विस्तृत टिप्पणियां /Requirements under the Act	दावों की संख्या /Claim Numbers	टिप्पणी /Remarks	
1.	धारा 2(1)(न) के तहत आविष्कार /Invention u/s 2(1)(j)	आविष्कारी कदम / Inventive step	दावे /Claims: दावे /Claims: 1-165	हाँ /Yes नहीं /No
		औद्योगिक उपयोगिता /Industrial Applicability	दावे /Claims: 1-165 दावे /Claims:	हाँ /Yes नहीं /No
	धारा 3 के अधीन पेटेंट-अयोग्यता (यदि हाँ, खंड 3(क-त) /Non-patentability u/s 3 (if yes, specify section3(a-p))	दावे /Claims: (1-165)(127-136)(131-147)(124-126)	हाँ /Yes 3(d),3(e),3(i),3(j)	
		दावे /Claims:	नहीं /No	
3.	धारा 10 (5) के अधीन आविष्कार की एकत्वता /Unity of invention u/s 10 (5)	दावे /Claims:	हाँ /Yes	
		दावे /Claims: 1-165	नहीं /No	
4.	धारा 10(4) के अधीन प्रकटन की दक्षता (हाँ/नहीं निर्दिष्ट करें)/Sufficiency of disclosure u/s 10 (4) (Specify Yes/No)	claims8,25,26,32,33,53,54,70,71,74,116,117,126,131,134,143,146 NO		
5.	[धारा 10(5) व 10(4) (ग) के अधीन दावे /Claims [u/s 10(5) & 10(4) (c)]	स्पष्टता/ संक्षिप्तता /Clarity / Conciseness	दावे /Claims: दावे /Claims: 1	हाँ /Yes नहीं /No
		परिभाषिकता /Definitive	दावे /Claims: दावे /Claims: 122-123	हाँ /Yes नहीं /No
	विवरण द्वारा समर्थित /Supported by description	दावे /Claims:	हाँ /Yes	
		दावे /Claims: 8,25,26,32,33,53,54,70,71,74,116,117,126,131,134,143,146	नहीं /No	
6.	अन्य आवश्यकता (एँ) /Other requirement(s): The applicant has to file fresh form-1,form-2,form-5 for the change in the applicant.			



TYPES OF OBJECTIONS

- Substantive objections
 - Section 2(1)(j): Novelty and Inventive step
 - Section 3: Subject matter excluded from patentability;
 - Section 10(4)(c) and 10(5): Clarity, Conciseness, Scope, Definitiveness, Unity of Invention
- Formal objections
 - Forms and format;
 - Petitions u/r 137 and/or 138
 - Request for amendments on F 13 (marked up copy) etc



Novelty and Inventive Step

- Advice whether the objection u/s 2(1) (j) has been raised validly
- Advice whether the prior art references (D1, D2 etc) were also cited in the ISR and/or IPRP or during prosecution of counterpart EP and US application
- Identify the novel, inventive features to compare *vis-à-vis* the cited prior art documents and provide detailed comments and strategy to overcome objections including claim amendments
- Study the claims and prosecution history in EP and US and adapt



Subject matter excluded from Patentability

Section 3 refers to inventions, which are not patentable :

- Section 3(c) : Living thing or substance existing in nature
- Section 3(d) : New form of known substance
- Section 3(e) : Synergistic composition
- Section 3(i) : Method of treatment
- Section 3(j) : Plants or animals or any parts thereof

Unique Requirement :

National Biodiversity Authority (NBA) approval



Clarity Conciseness, Scope, Definiteness

- Section 10(4) – best method, scope, abstract; and 10(5) – single inventive concept
- Terms considered vague/unclear in the claims-
 - “about”
 - “at least”
 - “less than”, “greater than”, “one or more”
 - “essentially”, “substantially”
 - “and/or”
 - “adapted to”



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Undergraduate degree in Behavioral Biology, from Johns Hopkins University in 1984

Studied Neuroscience of Virginia from 1984-86, and then received a Ph.D. in 1990 in Molecular Biology and Genetics from the Biochemistry, Cellular and Molecular Biology Program at the Johns Hopkins University School of Medicine.

Dr. Crane works in all aspects of biotechnology and pharmaceutical patent law, including patent preparation and prosecution, client counseling and opinions, post-grant proceedings and district court litigation.

She has written and lectured particularly on current issues in patent subject matter eligibility Chair of the Biotechnology and Pharmaceutical working group (CET5) of Fédération Internationale des Conseils en Propriété Intellectuelle (FICPI).



Best Practices and Pitfalls of Reporting Examination Reports from Major IP Offices

United States



Know Your Audience!



- **Is your client proactive?**
 - Does your client like to propose a response strategy?
 - Does your client like to prepare a draft response for your review?
- **Is your client reactive?**
 - Does your client want you to propose a response strategy?
 - Does your client want you to prepare a draft response?



Be Punctual!



This should be obvious, but the earlier you report the Communication to your client, the sooner your client can be involved in the response strategy!



IMHO

(in my humble opinion)

- My preference is to report the rejections with proposed potential strategies to address each rejection
- Ask client if they would prefer that you prepare the draft response
- Ask client if they are aware of state of the art references to address enablement issues
- Ask client if they have insights into cited references if they have not previously been cited
- Ask client if they have data to support unexpected results to address any obviousness rejections





Time Period for Responding to US Office Actions

- Notice to File Missing Parts– 2 month response period with 5 potential extensions of time
- Restriction Requirements – 2 month response period with 4 potential extensions of time
- Non-final Office Action – 3 month response period with 3 potential extensions of time
- Final Office Action - 3 month response period with 3 potential extensions of time – **BUT** if you submit an “early response” within 2 months, the Examiner must respond within 1 more month – allows you to avoid an extension of time by receiving an Advisory Action and having to extend period to either appeal or file a Request for Continuing Examination (RCE)



Time Period for Responding to US Office Actions (con't)

- *Ex parte Quayle* Action (claims allowable; minor issues to be addressed) – 2 month response period with 4 potential months extension
- Advisory Action – need to file either RCE or Notice of Appeal prior to 6 months from date of Official Action
- **In general, think 6 month statutory response period**





Time Periods in Appeals to the PTAB

- Notice of Appeal prior to 6 month expiration of period for response to Office Action
- Appeal Brief due 2 months after Notice of Appeal
- Reply Brief due 2 months after Examiner's Answer
- Request for Oral Hearing due with Reply Brief
- Actual date for Oral Hearing?? (2 years...?)

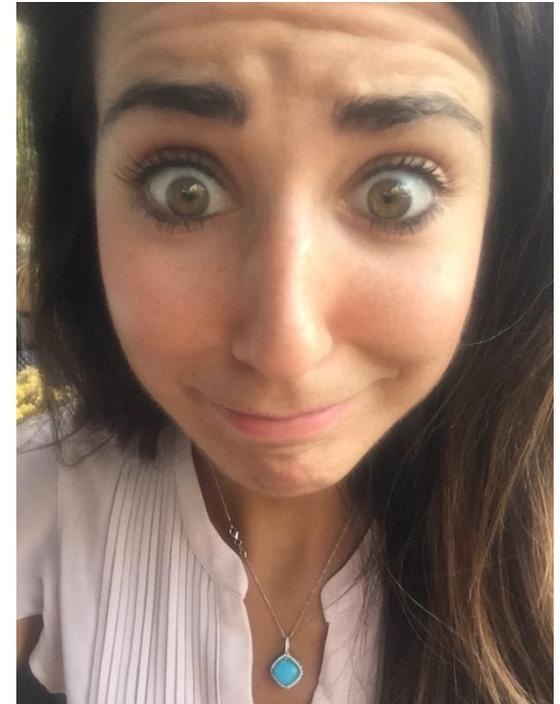




Extensions of time are nice, but... **EXPENSIVE** and cut into your PTA

- Within First month = \$200
- Within Second month = \$600
- Within Third month = \$1400
- Within Fourth month = \$2200
- Within Fifth month = \$3000

Patent Term Extension (PTA) – for every extended **DAY** applicant takes, they lose a day of PTA calculated on PTO delay





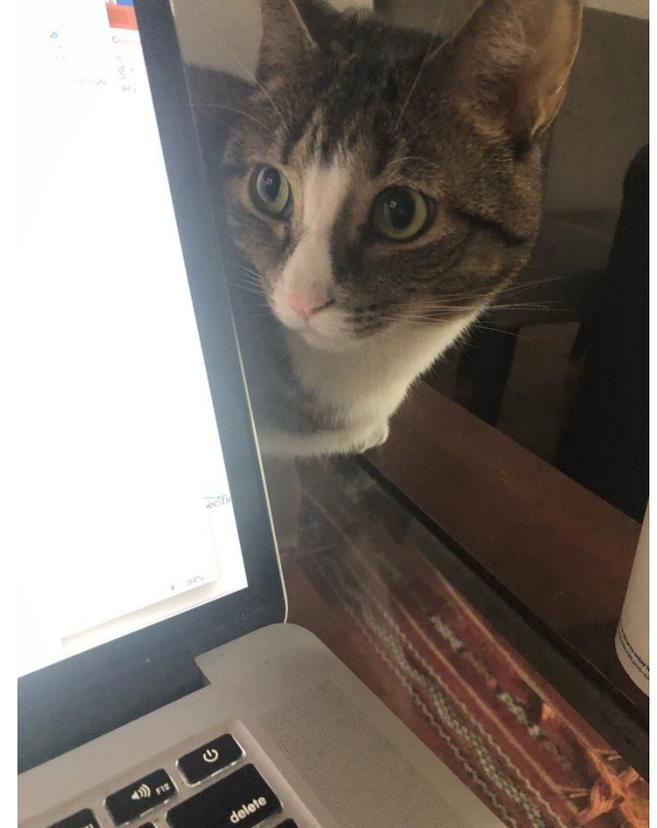
Reporting Restriction Requirement

- Consider traversing
 - But consider ramifications
 - Arguments that the claims are not separately patentable could come back to bite you later (e.g., requiring a terminal disclaimer)
- Better option may be to argue that an examination of certain groups of claims together may not be a serious burden to the Examiner
- If US National Phase, remember unity of invention!
- Acceding to the Restriction gives you the ability to file divisional applications without a terminal disclaimer!
- Consider commercial value of composition vs. method claims
- Consider amending to add linking claims and argue they should be examined together
- Consider requesting examination of a subset of groups
- Remember that if composition claims are allowed, the Examiner may rejoin method claims



Reporting Non-final Office Action

- Consider interviewing the case
 - Many Examiners “hotel” but you may be able to insist on an in-person interview
 - Otherwise, WebX or phone interviews are generally easy to schedule
- Harder for the Examiner to not consider your arguments when you meet “face to face”
- Considerable leeway to submit arguments, declarations, etc.





Reporting Final Office Action

- Unlikely that Examiner will conduct an interview or accept a Declaration without filing an RCE
- Consider your options:
 - Is there sufficient evidence to support an appeal?
 - Should you file an RCE to submit a declaration?
 - Are you close enough to allowance that you might be able to address all the Examiner's concerns?





Consider Appeal after Final Office Action

- Consider backlog at PTAB – could be years to get a decision
 - May get PTA, but only if you are successful!!
- Should you request a pre-Appeal conference?
 - If the Examiner's rejection is untenable, pre-Appeal conference may get traction





Reached the Finish Line!

(IP in DC)



Thank you! Any Questions?