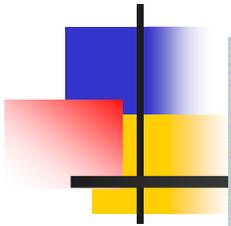
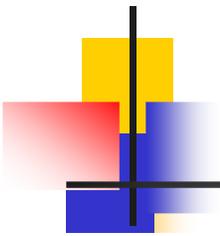


Patent Prosecution in Multiple Countries

Alessandro Steinfl

U.S. and EP Patent Attorney





Patent Prosecution in Multiple Countries

The problems

1. Timing

Length of prosecution varies

Request for Exam at time of filing or later

Extensions of time to respond vary from country to country

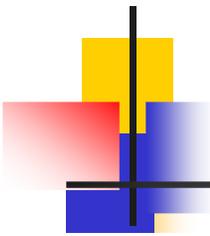
2. Duty to Disclose

Required in U.S., Australia, Israel

Not required in some countries—but shouldn't art be submitted?

No sense to have patent granted with broad claims if it is known to be anticipated.

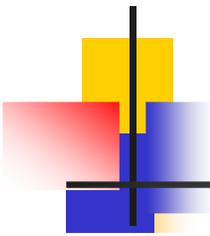
Antitrust issues in the U.S.



Patent Prosecution in Multiple Countries

What is needed

Streamlined approach to make **amendments, arguments,** and **cited art** available to patent professional throughout prosecution of an application in several jurisdictions



Patent Prosecution in Multiple Countries

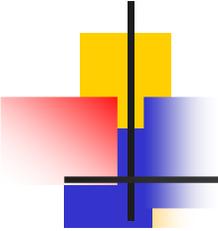
Presently companies and law firms use a docketing system that sets deadlines for a determined country

Examples

1. *PCT appln. enters national phase in Japan:
National phase deadline triggers deadline for filing an RFE*
2. *EPO direct filing—publication of Search Report
Publication triggers deadline for filing RFE and
designation of countries*

And, *maybe* the system has inter-jurisdiction trigger dates:

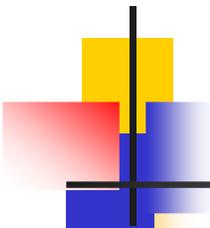
3. *EPO or China Publication triggers deadline date to file
in Hong Kong*
4. *EPO grant triggers 3-month deadline to validate in EP
countries*
5. *Chinese grant triggers deadline to register in Macau*



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However, can software be used to provide more than deadline dates?

Can an Office Action/Communication/Search Report from one country trigger an action to be taken in another country where the application is also pending?

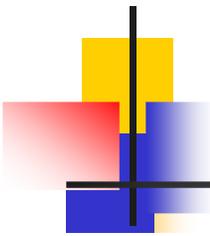


Patent Prosecution in Multiple Countries

Case 1- *An EPO official action (or an EPO supplementary search report) is issued, wherein new art (with respect to the International Search Report or the art cited so far) is cited against the application*

(paper-based solution) *As soon as the Action or Search Report is received, an internal paper is associated to the Action, requesting the professional or paralegal to check for the presence of foreign counterparts and act accordingly*

(software-based solution) *Docket entry should be provided in the docket, advising the professional or paralegal to submit that art also to the other patent offices, or at least consider doing so*



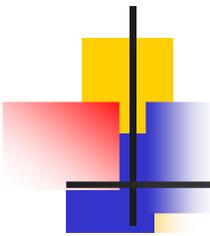
Patent Prosecution in Multiple Countries

Case 2- *A Japanese official action is issued, where some art is also cited against the application. The professional should be able to*

- 1. check whether the same art has already been cited in other jurisdictions and*
- 2. access arguments and/or claim amendments made in other jurisdictions with reference to that document*

(paper-based solution) *A check list is provided and a paraprofessional/secretary will*

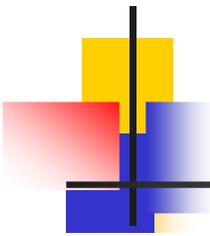
- 1. check whether the art cited by the Japanese Examiner has been cited in other jurisdictions (file search) and, if so,*
- 2. make a copy of any arguments that have been used in those jurisdictions as to that prior art document*



Patent Prosecution in Multiple Countries

(software-based solution)

- 1. The cases in the various countries are linked to a common page showing a list of all of the prior art cited (by Applicant or Examiner) with reference to that family
each time a new action is received, the documents cited in the new action are checked against the list, and list is updated if a document is cited for the first time*
- 2. The common page also lists Word/WordPerfect/PDF copies of documents filed by Applicant in the various jurisdictions, in this way, the professional working on the Japanese response can access the responses filed previously for review and shape arguments/claim amendments in Japan accordingly*



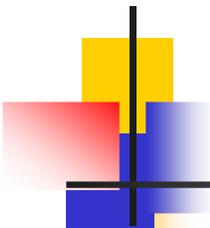
Patent Prosecution in Multiple Countries

In both cases discussed, the software-based approach appears to be the most effective to implement. A centralized page (or portal) seems necessary, also because quite often more than one professional works on the same family

The common page could be implemented as a *wiki-page* (*i.e.* a web page modifiable by any user or by a group of authorized users)

Each time a response is generated, a document is uploaded

RESULT: If professional # 2 is working on a case in Japan and an EPO response has been filed last year by professional # 1, professional # 2 will be able to access that response (and possibly cut-and-paste portions thereof) by accessing the common page



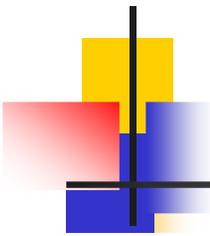
Patent Prosecution in Multiple Countries

A similar approach could also benefit an in-house counsel who wants not only to have an overview of a family of cases but also check the responses/claim amendments filed for each case (jurisdiction) of that family

In such case, the wiki-page could be shared along an Intranet having the in-house counsel and the outside counsels as nodes of the Intranet

RESULT: In-house counsel requesting a new outside counsel to prosecute an application in a new jurisdiction could simply provide the new counsel with a username and a password, to allow the new counsel to access the wiki-page to

1. benefit from Word/PDF documents accessible on that wiki-page
2. upload the outside counsel's response on the wiki-site

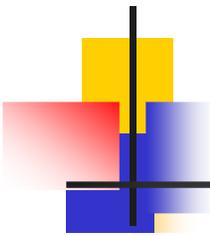


Patent Prosecution in Multiple Countries

Set-up of wiki-page

A separate ‘**claims**’ section could be provided, with one folder per country, each folder containing the various claim amendments filed in that country

Searching of the wiki-page could be implemented with a Google-like engine, *e.g.*, Google desktop



Patent Prosecution in Multiple Countries

IDS documents

It is always safe to alert the various patent offices to art cited in other jurisdictions, independently of whether this may be required or not.

The issue may be that of knowing:

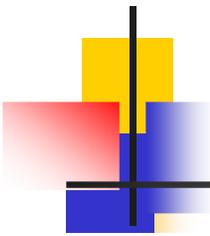
- 1) when to do it
- 2) how to do it

1. When

Whenever new art is cited - timing may be important –

In Australia, the more you wait the more you pay

Following the example above, new art is added to the wiki-page each time new art is cited in an Office Action or Search Report



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IDS documents *cont.*

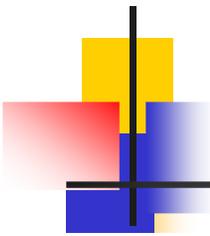
2. How

Addition of such new art may be set to 'populate' a Word document containing all of the art document cited so far against the family

the newly added documents could be asterisked

updated list can be sent to each local associate for filing with the
local patent office

Alternatively, the associate can be provided with a username/password for downloading the documents or with an FTP-like link for downloading



Patent Prosecution in Multiple Countries

Possible extensions of the prosecution-art wiki-page approach

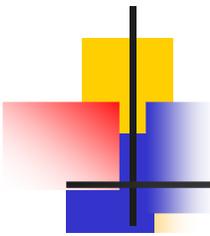
From the in-house counsel point of view

PDF collection of outside counsel/vendor debit notes

From the outside counsel point of view

Links to downloadable documents

(e.g. USPTO, EspaceNet, Delphion, Patent Fetcher
etc, IfdIP, etc.)

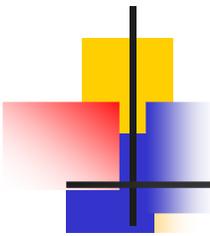


Patent Prosecution in Multiple Countries

Further extensions

A more general wiki-page could be formed with 'snippets' from various responses, e.g.:

- Inventive step arguments at the EPO
- Unity in Japan
- Computer software in Australia
- Morality issues in China



THANK YOU - QUESTIONS?

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