

# **Topic 2: Patent Family Concepts and Sources for Family Information**

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Cybercity March 22, 2022

### Agenda

- Families why
  - Priority rights
  - PCT filings without priority
- Families which
  - Types (PCT, simple, extended)
- Families when
  - Do we need to pay attention to different types of families?
  - 10% of families have more than one PCT application as member
- Families where
  - Sources of family information



### Further reading on families

WIPO Handbook:

http://www.wipo.int/standards/en/pdf/08-01-01.pdf

EPO:

https://www.epo.org/searching-for-patents/helpful-resources/first-time-here/patent-families.html

PIUG:

http://wiki.piug.org/display/PIUG/Patent+Families

OECD:

https://www.oecd.org/sti/^inno/44604939.pdf

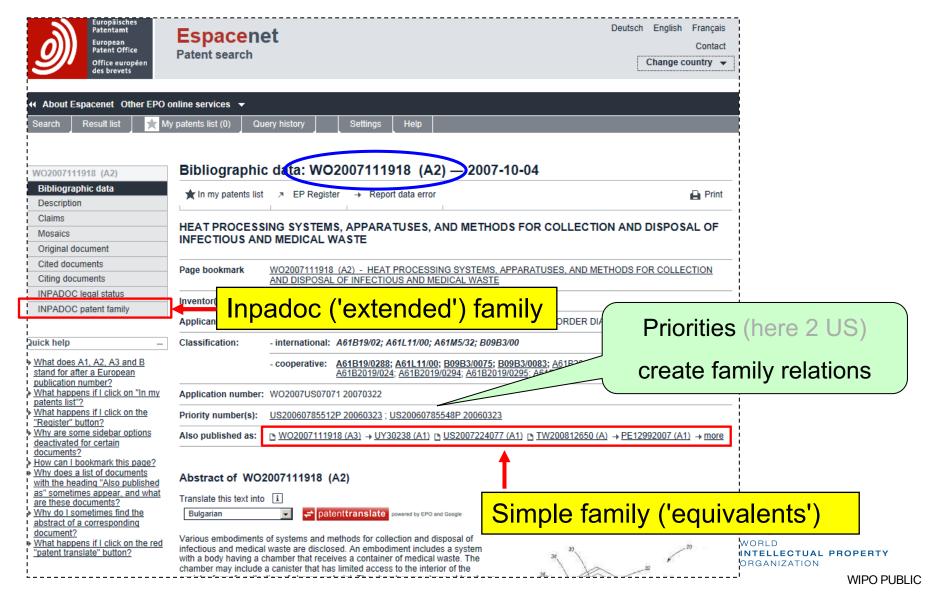


### Work-Sharing in the PCT national phase

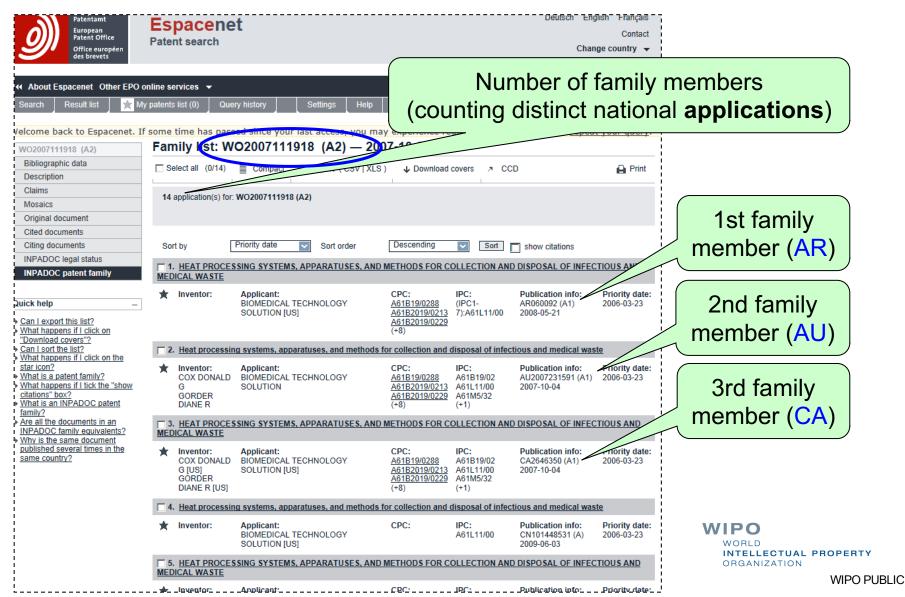
Utilizing examination work products from other national phases for improving **efficiency** and **quality** requires

- Databases/platforms providing
  - Patent family information (family table) [>Topic 2]
  - Examination status of family members [>Topic 3]
  - Access to examination work products (dossiers, file wrappers) of family members [>Topic 4]
- Ideally, platforms which integrate this information in a user-friendly manner, e.g. within family table; and with additional tools, for example, for comparing work products (Common Citation Document CCD) [>Topic 6]
- Information on differing national practices (naming and content of work products; important case law; exclusions; ..)

# Source of family information: Espacenet



# Espacenet: Extended (Inpadoc) family



### Families and Work-Sharing

### Family table (PCT family)

CN CN-A/B Publications CN Dossier CN Citations  EP EP-A/B Publications EP Dossier EP Citations  JP JP-A/B Publications JP Dossier JP Citations  KR KR-A/B Publications KR Dossier KR Citations  US US-A/B Publications US Dossier US Citations  AU AU-A/B Publications AU Dossier AU Citations  CA CA-A/C Publications CA Dossier CA Citations	PCT/xx	to be examined in nationa	l phase	
JP JP-A/B Publications  KR KR-A/B Publications  KR Dossier  US US-A/B Publications  US Dossier  AU AU-A/B Publications  AU Dossier  AU Citations	CN	CN-A/B Publications	CN Dossier	CN Citations
KRKR-A/B PublicationsKR DossierKR CitationsUSUS-A/B PublicationsUS DossierUS CitationsAUAU-A/B PublicationsAU DossierAU Citations	EP	EP-A/B Publications	EP Dossier	EP Citations
US US-A/B Publications US Dossier US Citations  AU AU-A/B Publications AU Dossier AU Citations	JP	JP-A/B Publications	JP Dossier	JP Citations IP5
AU AU-A/B Publications AU Dossier AU Citations	KR	KR-A/B Publications	KR Dossier	KR Citations
	US	US-A/B Publications	US Dossier	US Citations
CA Citations CA Dossier CA Citations	AU	AU-A/B Publications	AU Dossier	AU Citations
	CA	CA-A/C Publications	CA Dossier	CA Citations
IN-A/B Publications IN Dossier IN Citations	IN	IN-A/B Publications	IN Dossier	IN Citations

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### Families and Work-Sharing

### Family table (simple family)

AR

PCT/xx	to be examined in national phase	
CN	CN-A/B Publications CN Dossier	CN Citations
EP	EP-A/B Publications EP Dossier	EP Citations
JP	JP-A/B Publications JP Dossier	JP Citations IP5
KR	KR-A/B Publications KR Dossier	KR Citations
US	US-A/B Publications US Dossier	US Citations
AU	AU-A/B Publications AU Dossier	AU Citations
CA	CA-A/C Publications CA Dossier	CA Citations
IN	IN-A/B Publications IN Dossier	IN Citations
BD		WIPO

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# Families issues for Work-Sharing

Family table (PCT, simple or extended)

CA

IN

CN	CN-A/B Publications	CN Dossier	CN Citations
CIA	CIN-A/D Fublications	CIA DOSSIEI	CIN Citations

<b>EPa</b> EPa-A/B Publications EPa Dossier EPa Citat
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<b>EPb</b> EPb-A/B Publications EPb Dossier EPb C
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KR	KR-A/B Publications	KR Dossier	KR Citations
1 1 1			IN CITATIONS

USb-A/B Publications USb Dossier U	USb Citations
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CA-A/C Publications	CA Dossier	CA Citations

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### Families issues for Work-Sharing

### Family table (simple or extended)

PCT/xx	to be examined in nation	onal phase	
CN	CN-A/B Publications	CN Dossier CN C	itations
EPa	EPa-A/B Publication	s EPa Dossier EPa 0	Citations
EPb	EPb-A/B Publication	s EPb Dossier EPb 0	Citations
KR	KR-A/B Publications		tations
USa	USa-A/B Publica	Vhich work products are useful? And to	Citations
USb	USb-A/B Publica		Citations
CA	CA-A/C Publication	Homework Topic 2	tations
PCT/yy	V	vill present examples	
	10% of cases ha	ve multiple PCT applications as	family me

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### Origin of patent families

There are various reasons for patent family relations between distinct applications/filings:

- A. Patent protection is territorial, i.e. inventors/investors may have to seek protection in various different jurisdictions ("extensions")
- B. ......
- Foreign applications usually claim **priorities** of earlier applications filed in other jurisdictions based on
  - Paris Convention
  - TRIPS agreement
- Family relations because applications share priorities
- PCT applications can be filed without claiming priorities
- Family relations because applications share PCT application number
- PCT family



### Priority claims - sample

### Bibliographic data: WO2008004425 (A1) — 2008-01-10

★ In my patents list 🔻 EP Register 🔠 Report data error

### PANTS-TYPE WEARING ARTICLE

Page bookmark	WO2008004425 (A1) - PANTS-TYPE WEARING ARTICLE		
Inventor(s):	KENMOCHI YASUHIKO [JP]; KINOSHITA AKIYOSHI [JP]; AOYAGI NATSUKO [JP]; TANAKA KAYOKO [JP] $\pm$		
Applicant(s):	UNI CHARM CORP [JP]; KENMOCHI YASUHIKO [JP]; KINOSHITA AKIYOSHI [JP]; AOYAGI NATSUKO [JP]; TANAKA KAYOKO [JP] $\pm$		
Classification:	- international: A61F13/49; A61F13/496; A61F13/56		
	- cooperative: A61F13/15; A61F13/15756; A61F13/56		
Application number:	WO2007JP62104 20070615 1 priority		
Priority number(s):	JP20060187165 20060706		
Also published as:	□ US2008009816 (A1) □ US7833207 (B2) → UA91294 (C2) □ TW200819114 (A) □ TWI336619 (B) → mo		

### Priority claims - sample

### Bibliographic data: WO2008035580 (A1) — 2008-03-27

★ In my patents list 🔻 EP Register 🏢 Report data error

### PLANT CULTIVATION SYSTEM

Page bookmark	WO2008035580 (A1) - PLANT CULTIVATION SYSTEM						
Inventor(s):	OKAMOTO AKIHIRO [JP]; FUJII MANABU [JP]; YOSHIOKA HIROSHI [JP]; MORI YUICHI [JP] <u>+</u>						
Applicant(s):	MEBIOL INC [JP]; OKAMOTO AKIHIRO [JP]; FUJII MANABU [JP]; YOSHIOKA HIROSHI [JP]; MORI YUICHI [JP] +						
Classification:	- international: A01G1/00; A01G13/00; A01G25/00; A01G27/00; A01G7/00						
	- cooperative: <u>A01G31/02</u> ; <u>Y02P60/216</u>						
Application number:	WO 2007JP67578 20070910						
Priority number(s):	<u>JP20060254439 20060920</u> ; <u>JP20070144202 20070530</u>						
Also published as:	EP2064942 (A1)						



### Priority claims - sample

The more priorities are claimed, the more complex the family relations may be!

Bibliographic data: WO2008060725 (A3) — 2008-07-1 Different types of families depending on whether n my patents list EP Register I Report data error nt all priorities are shared SECURE UNIVERSAL TRANSACTION SYSTEM only some priorities are shared WO2008060725 (A3) - SECURE UNIVERSAL TRANSACTION SY Page bookmark Inventor(s): FRANCHI JOHN FRANCO [GB] + Applicant(s): FRANCHI JOHN FRANCO [GB] + 3 priorities Classification: - international: H04L9/00 3 countries - cooperative: G06F21/32; G06F21/34; G06Q20/12; G06Q20/401 Application number: WO2007US74327 20070725 Priority number(s): US20060532580 20060918; EP20060256440 20061219; GB20060025304 20061219 Also published as: WO2008060725 (A2) WO2008060725 (A8) EP1901248 (A1) → ZA200901870 (B) US2011125613 (A1) → more

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### Priorities: Paris Convention of 1883

- Covers patents, designs, trademarks,...
- Facilitates second/subsequent filings abroad
- Equal protection to nationals and foreigners (non-discrimination)
  - Foreigners: nationals and residents of any Union country
- Mutual recognition of (Paris Convention) priority rights:
  - at OSF: Treatment of application as if filed on date of first filing, i.e. same prior art is to be applied if claimed subject matter is fully disclosed in priority
  - 12 month period to file an application claiming the priority of an earlier application (Art. 4 C (1))
- Permits combination of multiple priority rights (same or different countries) (Art. 4 F)
- Permits additions of technical subject matter (Art. 4 F)
  - As long as national definition of unity is met



### Priorities: Benefits of claiming priorities

OFF (Office of First Filing) **Prior art** Filing date OFF OSF (Office of Second Filing) **Prior art** Filing date OSF **Priority date** WIPO **Conditions apply!** INTELLECTUAL PROPERTY ORGANIZATION

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### **Article 4 F Paris Convention**

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims multiple priorities, even if they originate in different countries, or on the ground

that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

### PCT application without priority

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization
International Bureau

(43) International Publication Date 3 September 2009 (03.09.2009)





(10) International I WO 2009/

no priority

- (51) International Patent Classification: C07C 46/02 (2006.01)
- (21) International Application Number:

PCT/IB2008/000451

(22) International Filing Date:

29 February 2008 (29.02.2008)

(25) Filing Language:

English

(26) Publication Language:

English

- (71) Applicant (for all designated States except US): LABO-RATOIRE MEDIDOM S.A. [CH/CH]; Enetriederstrasse 44, CH-6060 Sarnen (CH).
- (72) Inventors; and
- (75) Inventors/Applicants (for US only): DI NAPOLI, Guido [CH/MC]; 8, Lacets Saint-Leon, MC-98000 Monaco (MC). DI NAPOLI, Alessandro [CH/CH]; Chemin du Vent-Debout 18, CH-1245 Collonge Bellerive (CH).
- (74) Agent: REUTELER & CIE, S.A.; Chemin de la Vuarpillière 29, CH-1260 Nyon (CH).
- (81) Designated States (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ,

EC, EE, EG, ES, F first filing with IB

KZ, LA , LR, LS, LT, EU, ET, WIA, WID, WIL, MC , MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW.

(84) Designated States (unless otherwise indicated, for every kind of regional protection available): ARIPO (BW, GH, GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV, MC, MT, NL, NO, PL, PT, RO, SE, SI, SK, TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

### Declarations under Rule 4.17:

- as to applicant's entitlement to apply for and be granted a patent (Rule 4.17(ii))
- of inventorship (Rule 4.17(iv))

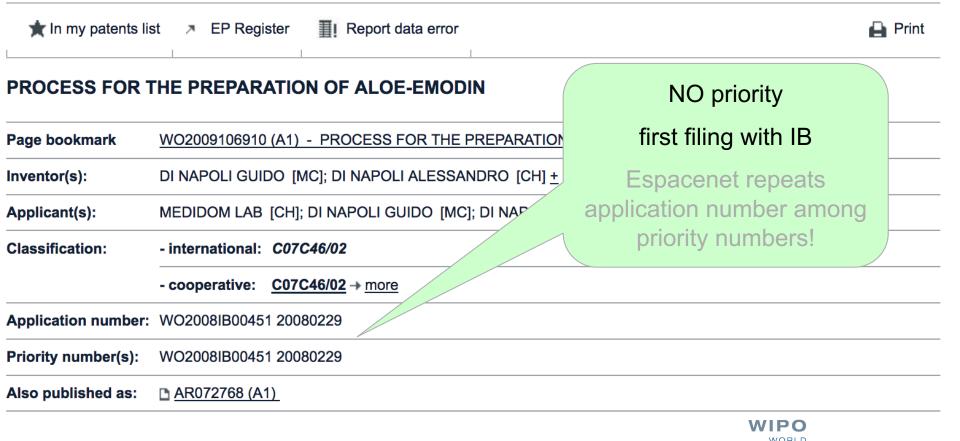
### Published:

with international search report (Art. 21(3))



### PCT application without priority

Bibliographic data: WO2009106910 (A1) — 2009-09-03



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### **PCT** family

- 'PCT family' includes the international application and all its national phase entries
- Linked through the PCT application number
- Linked as well through the **priorities** if any were claimed which the national phase entries inherit from the international application

### PCT family – simple family

- 'PCT family' includes the international application and all its national phase entries
- Linked through the PCT application number
- Linked as well through the priorities if any were claimed which the national phase entries inherit from the international application
- There may be additional applications in the simple family which are not PCT NPEs because country is not PCT member state, linked through priorities
  - For example, a BD application filed through the Paris route and claiming the same priorities like the PCT application
  - For example, a foreign application filed in JM
- It may also happen that a simple family includes several distinct PCT families; for example PCT/DK2006/000477 wipo

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# PCT/KR2012/001812: 2 x WO in family

33. AUCTION METHOD AND SERVER								
*	Inventor: LEE JEONG GAB [KR]	Applicant: LEE JEONG GAB [KR]	CPC: G06Q30/08	IPC: G06Q30/08	Publication info: US2013066737 (A1) 2013-03-14 Global Dossier	<b>Priority date:</b> 2011-09-14		
34. AUCTION METHOD AND AUCTION SERVER								
*	Inventor: LEE JEONG-GAB [KR]	Applicant: LEE JEONG-GAB [KR]	CPC: G06Q30/08	IPC: G06Q3 <mark>0/08</mark>	Publication info: WO2013039284 (A1) 2013-03-21 Global Dossier	<b>Priority date:</b> 2011-09-14		
35. AUCTION METHOD AND AUCTION SERVER								
*	Inventor: LEE JEONG-GAB [KR]	Applicant: LEE JEONG-GAB [KR]	CPC: G06Q30/08	IPC: G06Q30/08	Publication info: WO2013039294 (A2) 2013-03-21 WO2013039294 (A3) 2013-05-10 Global Dossier	<b>Priority date:</b> 2011-09-14		
☐ 36. <u>AUCTION METHOD AND SERVER</u>								
*	Inventor: LEE JEONG-GAB [KR]	Applicant: LEE JEONG-GAB [KR]	CPC: G06Q30/08	IPC:	Publication info: ZA201504960 (B)	Priority date: 2011-09-14		

2016-07-27

### **Article 4 F Paris Convention**

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims multiple priorities, even if they originate in different countries, or on the ground

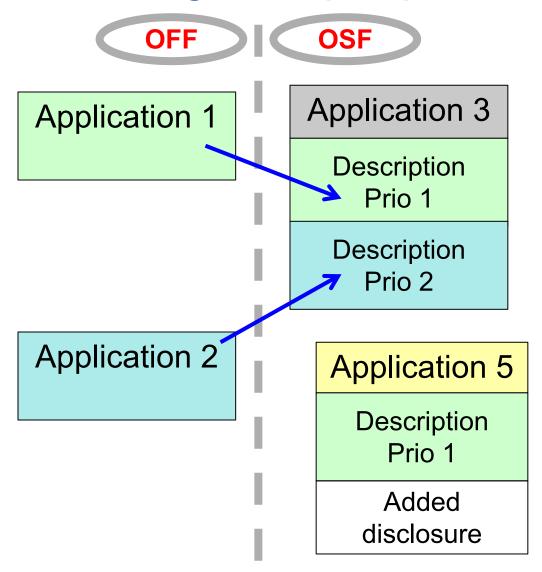
that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."



### Combining multiple priorities



Application 6

Description
Prio 1

Description
Prio 2

Added
disclosure

Description
Prio 2

Application 4

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### Technical disclosures of family members

- Even though priorities are claimed, technical disclosure (descriptions and drawings) may differ:
  - Combinations of different sets of descriptions
  - Parts of descriptions may be removed
  - Technical subject matter may have been added

Permitted by Paris Convention

- Claims may also be different since claims need to be supported by description
- Applicants are not obliged to reveal modifications when making a new application
- Differences are revealed only by comparing descriptions
- When are differences least likely?
  - When all claimed priorities are the same



### Family concepts based on priorities

- Simple family:
  - All members of the family have exactly the same priority or priorities
- Complex family:
  - All members of the family share at least one priority
- Extended family:
  - Any member shares at least one priority with at least one other member
  - Covers indirect sharing of priorities; is therefore the biggest possible family



### **Extended family**

**Application 1** 

Application 3

Prio 1

Prio 2

Application 6

Prio 1

Prio 2

Additional

Application 2

Application 5

Prio 1

Application 4

Prio 2

ROPERTY

### Simple family

Application 1

Application 3

Prio 1

Application 6

Prio 1

Prio 2

Prio 2

Additional

Application 2

Application 5

Prio 1

Application 4

Prio 2

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### Simple & PCT <> extended family?

- Simple family: all members share the same priorities
- PCT family: all members share the same PCT application number AND priorities
  - It is very likely that descriptions of family members are equal or very similar
  - "Equivalents", "also published as"
  - Ideally, family members are just translations in other languages
  - However, Paris Convention permits additions of subject matter
  - "same invention" or group of very similar inventions
- Extended (Inpadoc) family: biggest possible family, includes applications sharing priorities indirectly
  - It is quite likely that descriptions are different
  - More likely that they cover different but related inventions in same area of technology



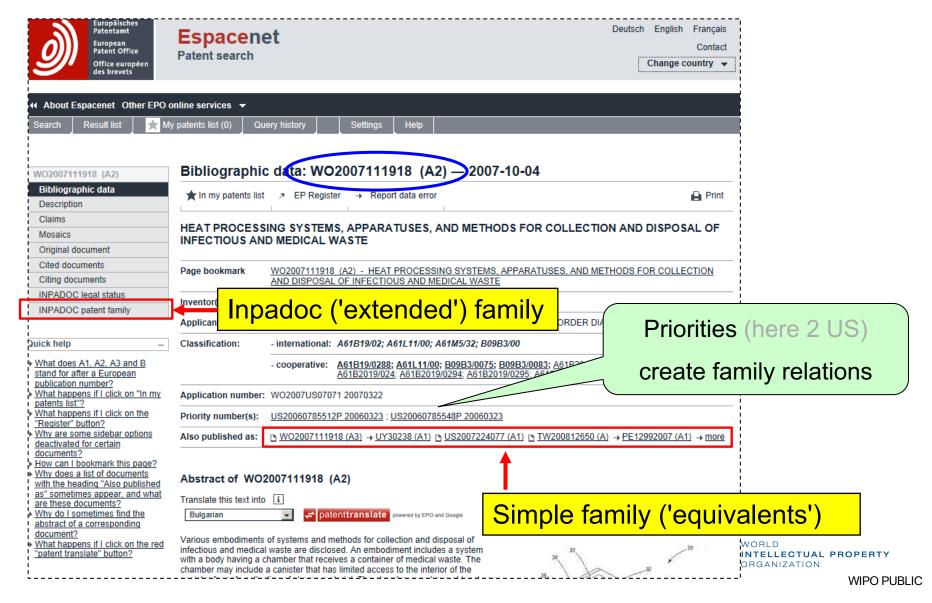
# Family building in databases

- Comparing priority numbers and/or
- Comparing PCT application numbers

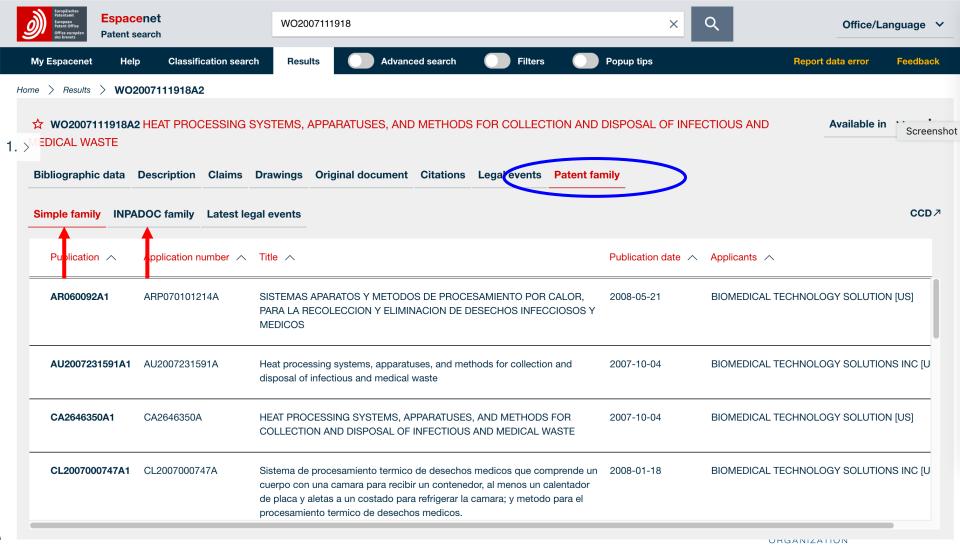
### Sources of family information

- EPO's INPADOC database is major source of such family information, accessible through:
  - Espacenet, EP-Register and CCD (simple and extended families; domestic families)
  - Other free patent information databases, like Depatis, Google Patents, ...
- WIPO PATENTSCOPE
  - aggregates national phase entry data <u>reported</u> from Designated/Elected Offices (obligation as from July 1, 2017; rule 95)
  - Proprietary family building (since 2021)
- WIPO CASE with proprietary family building based on application data shared by 'providing offices'; families are complex families (i.e. share at least one priority)
- Commercial patent databases obtain and use widely INPADOC data, and apply proprietary family building rules and data cleaning, e.g.
  - Clarivate/Derwent: WPI family
  - Questel/Orbit: Fampat family
  - ...
- Other specialized platforms, e.g. WIPO's Pat-Informed or MPP MedsPal
- India Form 3

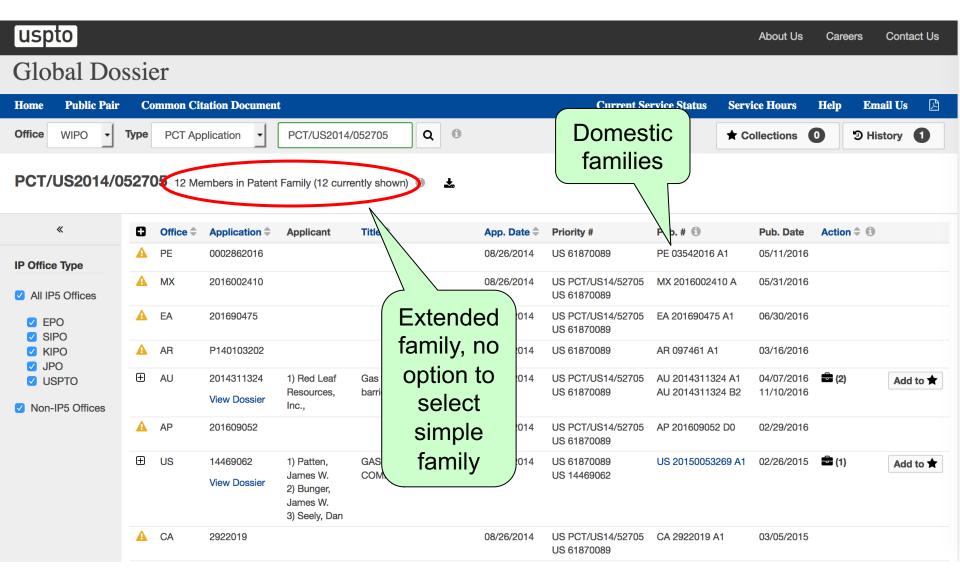
# Source of family information: Espacenet



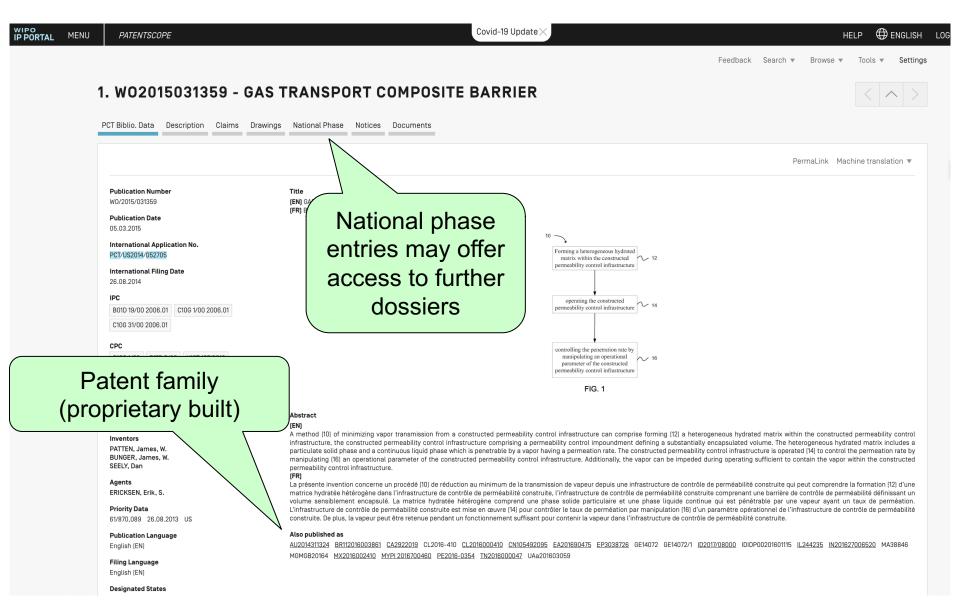
### Family tables in New Espacenet



# Family table in Global Dossier (USPTO)

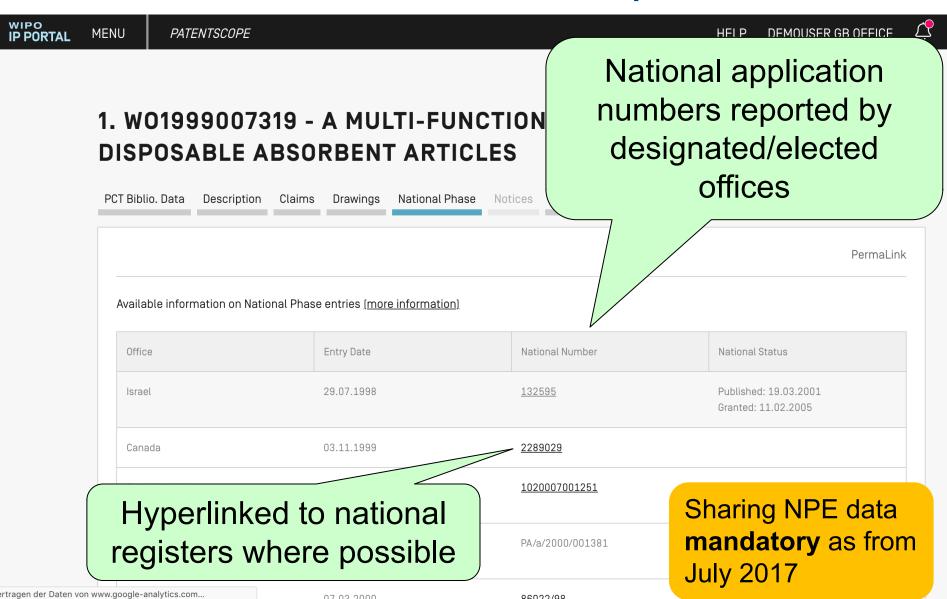


# PATENTSCOPE: built family information





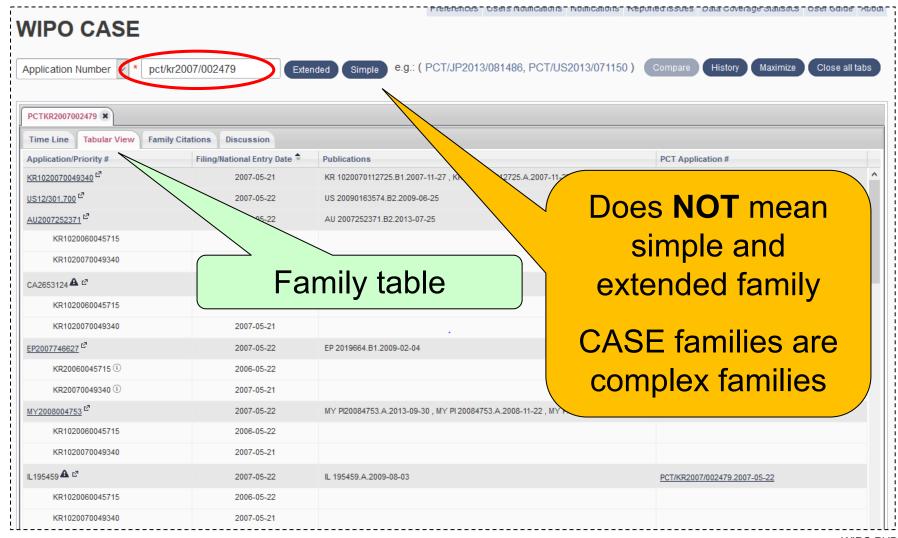
### PATENTSCOPE: National phase entries



86022/98

07 03 2000

#### Family table in WIPO CASE



## Legal obligations for disclosing family information

- Some jurisdictions, for example India, systematically require applicants to disclose and update family information
- Disclosure to be found in IN dossier as 'Form 3'
- Represents up to now the most comprehensive source of family information
- Can be retrieved by searching IN application number in Indian register inPASS



#### Form 3 of IP India

PCT/EP2017/056134

#### **UPDATED ANNEXURE TO FORM 3**

Details of Foreign Applications corresponding to

INDIAN PATENT APPLICATION NO. 201817038931 FILED ON ... October 2018 in the name of SOLVOTRIN THERAPEUTICS LTD

Corresponding PCT Application No.: PCT/EP2017/056134 Dated 15 March 2017

	COUNTRY	APPLN. NO.	PCT FILING DATE	STATUS Such as pending,accepted,refused, abandoned,withdrawn, opposed etc.	GRAI PATI
	United Arab Emirates	P6001293/2018	15/03/2017	Pending	
	ARIPO	AP/P/2018/011052	15/03/2017	Abandoned	
	Australia	2017232266	15/03/2017	Pending	
	Bahrain	167/2018	15/03/2017	Pending	
	Brazil	BR112018068571-2	15/03/2017	Abandoned	
	Canada	3,017,556	15/03/2017	Pending	
. (	Chile	2018002632	15/03/2017	Abandoned	1
	China	2017800245532	15/03/2017	Response due by 11 February 2021	-
	Colombia	CO2018010940	15/03/2017	Response filed on 1 October 2020	
	Costa Rica	2018-000488	15/03/2017	Pending	
	Cuba	2018-0108	15/03/2017	Abandoned	
	Djibouti	DJ/B/2018/0002	15/03/2017	Abandoned	İ
	Algeria	180499	15/03/2017	Pending	[
	Eurasia	201892065	15/03/2017	Response to be filed by 21	1
		2010 55000	1.5/02/2017	March 2021	
	Ecuador	2018-77068	15/03/2017	Abandoned	
	Egypt	1439/2018	15/03/2017	Pending	1
	lEPO	17710019.5	15/03/2017	Pending	

India: Obligation for applicants to disclose all PCT national phase entries and submit respective examination results (Rule 12)

47 national phase entries

Only 22 recorded in INPADOC

Accessible via patent register of India in PASS

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#### Family coverage of different sources

(PCT/IB2014/02991)

- Consolidated family (Espacenet, WIPO CASE, PATENTSCOPE, India Form 3) (97+10)
- AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, DZ, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HK, HN, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LC, LK, LT, LY, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA
- India Form 3 (96+0) in dossier of IP India (provided by applicant)
- AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, DZ, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JD, JM, JP, KH, KN, KP, 2xKR, LA, LB, LC, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA
- **Espacenet** (32+10) (family building based on priority and PCT application numbers)
- AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, DZ, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, LY, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 2xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA



#### Family coverage of different sources

- PATENTSCOPE national phase entry data (26+1) (provided by designated/elected offices)

  AG, AO, AP, AR, AU, BB, 2xBD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JO, JM, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA
- PATENTSCOPE family build (43+5) (based on priority and PCT application numbers)
- AG, AO, AP, AR, AU, BB, BD, BI, BN, BO, BR, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JO, JM, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 2xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA
- WIPO CASE (33) (based on priority and PCT application numbers)
- AG, AO, AP, AR, AU, BB, BD, BI, BN, BO, BR, BS, BT, BZ, CA, CG, CL, CN, CO, CR, CU, DJ, DK, DM, DO, 2xEA, EC, 2xEG, EP, ES, GC, GD, GE, GT, HN, HK, HT, HR, HU, ID, IL, IN, IQ, IR, JM, JO, JP, KH, KN, KP, 2xKR, LA, LB, LK, LT, MA, ME, MG, MO, MN, MU, MX, MY, NG, NI, NP, NZ, OA, PA, PE, PG, PH, PK, PL, PT, RS, PY, RW, SC, SG, SI, SV, SY, TH, TN, TO, TT, TW, UA, 3xUS, UY, UZ, VC, VE, VN, WO, WS, YE, ZA

#### Challenges

- Don't worry IP5 family members are included in all sources plus many other major jurisdictions
- Limitations exist mostly for regional cooperation because many medium and smaller IPOs don't share bibliographic data with database hosts
- No source that permits to select only PCT family
- Essential for work-sharing (to be able) to identify the members of the PCT family
- Family members linked to other PCT applications are less useful or not useful at all

#### Families within one jurisdiction

- National, regional, PCT jurisdictions
  - National families
  - Domestic families



#### Origin of patent families - reasons

There are various reasons for patent family relations between distinct applications/filings:

- A. Patent protection is territorial, i.e. inventors/investors may have to seek protection in different jurisdictions ("extensions")
- B. An application may have certain deficiencies
  - Lack of unity
  - Flaws or gaps of the disclosure (description, drawings)
- C. Further improvements of an invention



## Claiming national priorities

Bibliographic data: US2008274698 (A1) — 2008-11-06

★ In my patents list I Report data error



#### METHOD AND APPARATUS FOR INDICATING A TEMPORARY BLOCK FLOW TO WHICH A PIGGYBACKED ACK/NACK FIELD IS ADDRESSED

Page bookmark  US2008274698 (A1) - METHOD AND APPARATUS FOR INDICATING A TEMPORARY BLOCK FLOW TO A PIGGYBACKED ACK/NACK FIELD IS ADDRESSED				
Inventor(s):	LI YAN [US]; DICK STEPHEN G [US]; CHITRAPU PRABHAKAR R [US]; RUBEHROUZ [US]; MANSETA KHUSHALI N [US] $\pm$	US '138 claims		
Applicant(s):	INTERDIGITAL TECH CORP [US] +	3 national		
Classification:	- international: H04B1/00	priorities		
	- cooperative: H03M13/09; H04L1/0041; H04L1/0073; H04L1/1664; H04L H04L2001/125			
Application number:	US20080106138 20080418			
Priority number(s):	US20080106138 20080418 ; <u>US20070913179P 20070420</u> ; <u>US20070974293</u> 20071023	P 20070921 ; US20070981980P		
Also published as:	□ US8296619 (B2) □ WO2008130694 (A1) □ US2013326320 (A1) □ US2 → more	2013039210 (A1) 🗅 US8539308 (B2)		

#### Domestic second filings

#### "Continuation (in part)"

- New national/local application claiming priority of one or several earlier national/local applications
- "in part": Additions of technical subject matter to initial disclosure of parent (priority) application or other amendments are permitted, and usually intended, only part of the new application originates in earlier application
- (Up to 12 months after filing date of claimed priority)
  - Remedy for flaws in first application
  - Opportunity to specify further improvements of an invention

#### Patent of addition (in some jurisdictions)

- Improvement of original invention of parent patent
- Unity with parent patent to be given; i.e. as if further independent claim of parent patent
- Depends on validity of parent patent
- Request possible up to 18 months after filing of patent patent



#### Domestic second filings

#### **Division (and US 'continuations')**

Paris Art. 4 G (1)

- E.g. for healing a lack of unity: mandatory division
- Permits filing of an application with new set of claims based on previously filed disclosure (i.e. **no additions to initial disclosure** permitted): **voluntary division**

Paris Art. 4 G (2)

- Initial disclosure (parent application) may comprise several inventions
- Lack of unity is given only if different inventions are "claimed", i.e. if covered explicitly by claims
- Strategic approach by some applicants
- Divisions are possible usually anytime as long as parent application is pending (EPC: only within 24 months after 1st office communication)
- Retains application date and claimed priorities; no explicit priority claim type relation to parent application

## Further sources of family information

National registers (e.g. EP-Register, US PAIR) include patent family information on national level (domestic families, national families (continuation in part, **divisions**; US continuations)

## **EP-Register - divisions**

Parent application(s)	EP04771314.4 / > EP1651658	
Divisional application(s)	EP14194507.1 / > EP2896397	
	The date of the Examining Division's first communication in respect of the earliest application for which a communication has been issued (EP20040771314) is 20.10.2011	



## **US-PAIR**: national family/divisions

11/689,638 Heat Processing Systems, Apparatus	uses, and Methods for Collection and Disposal of Infectious and Medical Waste			57015-340945						
Select Application Transaction Image File Continuity Published Address & Display New Case Data History Wrapper Data Documents Attorney/Agent References										
Parent Continuity Data										
Description	<b>Parent Number</b>	Parent Filing or 371(c) Date	AIA(First Inventor to File)	Parent Status	Patent Number					
This application Claims Priority from Provisional Application	60/785,512	03-23-2006	-	Expired	-					
Claims Priority from Provisional Application	60/785,548	03-23-2006	-	Expired	-					
Child Continuity Data										
No Child Continuity Data Found										



# Summary: multiple family members from same country

- When do we have multiple family members from same jurisdiction? In case of:
  - Divisional applications (US continuations)
  - Continuations in part
  - Several PCT applications in same family
- These reasons may co-occur!
- You need to understand/identify the reason(s) and select the proper family members for work-sharing purposes
- Don't worry: only some 10-20% of PCT applications are affected
- Temporary problem until comprehensive PCT families can be selected in family tables



## Thank you

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