(54) Title: PROSECUTION OF MEMBERS OF A PATENT FAMILY

(57) Abstract: ABSTRACT OF THE DISCLOSURE We suggest a computer based system and method for organizing prosecution of members of a patent family in a plurality of countries. Central are computer based means for data collection adapted to contain information central to the prosecution of the patent family in the different countries. The means for data collection comprise means for storing and reading at least one feature analysis of the claims in view of the prior art documents. The feature analysis can be accessed by the foreign associates, the patent applicant and/or a contact person. They can all retrieve information central for the prosecution of the application in their respective countries as well as write information into the data collection. In this way, all parties involved in the prosecution of members of the patent family in different countries can share the most relevant information necessary for the prosecution of the application. This enhances efficiency in international prosecution.
PROSECUTION OF MEMBERS OF A PATENT FAMILY

FIELD OF THE INVENTION

The present invention relates to organizing prosecution of members of a patent family in a plurality of countries.

DESCRIPTION OF RELATED ART

Until today, the processes used in international patent prosecution are very inefficient. Particularly on receiving an office action, foreign associates usually translate the office action, analyze the office action and prepare a corresponding report that the foreign associate sends to either a contact person or a patent attorney. That person will again analyze the office action trying to find out ways to respond to the office action. The results of this analysis will be sent again to the foreign associate, typically with the help of a contact attorney in the home country of the patent applicant. This contact attorney might again analyze the office action and finally send instructions to the foreign associate. The foreign associate will then respond to the office action.

Added to this are a number of tedious formalities that are typically involved with filing, grant and the fulfillment of for example information disclosure requirements or other formal requirements. All this makes the traditional process of international patent prosecution very time-consuming and inefficient. A lot of translations are involved and the costs are unpredictable.

OBJECT OF THE INVENTION

It is, therefore, an object of the present invention to improve the current ways for international prosecution.

BRIEF SUMMARY OF THE INVENTION

This aim is achieved by the inventions as claimed in the independent claims. Advantageous embodiments are described in the dependent claims.
We suggest a computer based system for organizing prosecution of members of a patent family owned by a patent applicant in a plurality of countries comprising:

- computer based means for data collection adapted to contain information central to the prosecution of the patent family in the countries;
- wherein the means for data collection comprise means for storing and reading at least one feature analysis of at least one claim of the patent family in view of at least one prior art document;
- means for accessing the means for data collection by
  - at least one foreign associate in a jurisdiction other than the jurisdiction of the patent applicant and by
    - the patent applicant and/or a contact person;
    - means for communication between
      - either the patent applicant and the at least one foreign associate;
    - or
      - the patent applicant and the contact person; and
      - the contact person and the at least one foreign associate.

Such a system considerably enhances the efficiency of the prosecution of a complete patent family in different countries. The data collection typically contains, besides the feature analysis of claims for the different countries, general remarks to point out to arguments of particular interest in the prosecution of the patent family.

This makes it possible for example for foreign associates to considerably shorten the time they need to analyze an office action, at least in those situations, in which the feature analysis contains the analysis of the prior art document that is also cited in the office action that the foreign associate currently has to analyze. Such a situation can very often be encountered if the prosecution is done in the different national phases that follow the international phase of a PCT application, because under these circumstances the prior art documents cited in the different national phases will correspond to a high degree to the prior art documents cited in the international phase.

All parties involved in the prosecution of the patent family can retrieve information essential for the prosecution of the application in their respective countries from the data collection as well as write information into the data collection. Thus, all parties involved in the prosecution of members of the patent family in different countries can share the most relevant information necessary for the prosecution of the application. This enhances efficiency in international prosecution.
The suggested system thus overcomes many of the difficulties currently experienced in prosecuting a patent family in different countries.

The data collection is stored in a computer-based form and accessible for those involved in the prosecution of the patent family from around the world. This can be done via the internet using e.g. a private or cloud server to store the data collection.

This system furthermore opens up the possibility for the patent holder to write information central to the prosecution strategy, in particular the limitation priorities, into the data collection. The question of how to limit the claim always comes into play if the main claim cannot be upheld after receipt of an office action with highly relevant prior art. It is then very important for the foreign associates to have possible limitations of the main claim on hand, as well as the priorities of the limitations. This gives the foreign associates an immediate guidance on how to react to the office action.

For confidentiality reasons it is advantageous if the means for accessing the means for data collection are configured such that access is limited to authorized persons only.

In order for the foreign associates to be oriented about how the claims were amended in the other jurisdictions, the data collection comprises means for storing and reading a claims correspondence table showing the amendments in the different countries together with a brief comment on the original disclosure or subclaims where the features come from and why the claim was amended.

It is also helpful for the foreign associates in the different countries to be informed about the status of the applications in all other countries. This is particularly helpful for those countries (e.g. India) where a status report concerning the other members of the patent family has to be filed regularly. To this end, the means for data collection comprise means for storing and reading the status of the members of the patent family in the different countries.

The same applies to the chances of success (the chances of being granted) of the members of the patent family in the different countries. The chances of success will be assessed by either the foreign associate or the patent applicant or the contact person.

If a document management system is used for the means for data collection, this will not only make it possible to also store the prior art as e.g. pdf-documents in the document management system. It will also allow simultaneous or parallel access to the data collection.
by different foreign associates or other parties. It will also log the changes made by those
who access the data collection.

The object of the invention is also achieved by a method. In what follows, individual
steps of a method will be described in more detail. The steps do not necessarily have to be
performed in the order given in the text. Also, further steps not explicitly stated may be part of
the method.

In order to achieve the object of the invention, we suggest a computer based method
for organizing prosecution of members of a patent family owned by a patent applicant in a
plurality of countries comprising the following steps:

- providing means for data collection in a computer system adapted to contain infor-
mation central to the prosecution of the patent family in the countries;

- wherein the means for data collection comprise means for storing and reading at least
one feature analysis of at least one claim of the patent family in view of at least one prior art
document;

- providing means for accessing the means for data collection by

at least one foreign associate in a jurisdiction other than the jurisdiction of the patent
applicant; and by

the patent applicant and/or a contact person.

This method allows a reorganization of the traditional process of international patent
prosecution. Answering an office action can now be organized as follows:

- When the foreign associate receives an office action, he/she can analyze the office
action using information taken from the means for data collection.

- In most cases, this will put him/her in a position to devise a response to the office ac-
tion based on the results of said analysis.

- The foreign associates can then update the information contained in the means for
data collection with information gained from the office action and/or the previous steps.

In this way, translations can be avoided. The information contained in the data collec-
tion will become more and more sophisticated and relevant for this foreign associate and the
foreign associates in other countries. The entire process becomes more efficient and more
cost-effective.

In particular, the foreign associate, after receipt of office action, analyzes prior art cited
in the office action and enters the results of the analysis into a suitable feature analysis within
the data collection. The feature analysis is generally established separately for every country, because the claims typically vary, at least in formal matters, from country to country.

In cases or countries where the patent applicant prefers to answer office actions himself/herself, the patent applicant then performs basically the same steps as a foreign associate after receipt of an office action or a translation of an office action into English or his/her mother tongue.

BRIEF DESCRIPTION OF THE DRAWINGS

Other objects and advantages of the present invention may be ascertained from a reading of the specification and appended claims in conjunction with the drawings therein. For a more complete understanding of the present invention, reference is established to the following description made in connection with an accompanying drawing in which:

Fig. 1 shows a network and the communications lines between the applicant, a contact attorney and foreign associates including the suggested data collection.

In a typical case of filing a patent family with members in a plurality of countries, the applicant communicates with a contact attorney located in his own country, who handles the filing and prosecution of the patent application in this country or jurisdiction, and who, in turn, communicates with foreign associates (who are typically patent attorneys themselves) in the other jurisdictions in which a member of the patent family is to be filed. This situation is shown by the solid arrows in the network in Fig. 1.

If the system and/or the method of the invention is being used, relevant information will be entered into the data collection by all parties involved, which is shown by the dotted arrows in Fig. 1. In particular, the first person to receive an office action concerning a member of the patent family will enter a feature analysis of the claims versus the prior art cited by the corresponding examiner, as well as his response strategy. Those foreign associates (or perhaps the contact attorney) who receive office actions at a later date can then retrieve the feature analysis from the data collection and thus do not need to re-analyze prior art that has already been cited in the jurisdiction that issued its office action first. Especially in cases in which a response to an office action has been successful (in that objections could be overcome and/or a grant of the patent application be achieved), the same - proven - arguments
and/or response strategy can thus be employed by other foreign associates, who do not need to

- fully analyze the office action;
- translate the office action;
- send analysis and translation to the contact attorney, requesting instructions;
- wait for the applicant to be consulted;
- receive instructions from the contact attorney;
- translate these instructions;

before preparing their response to the office action. Instead, they can respond quickly and efficiently, taking into account the information available in the data collection. A short report to the contact attorney is all the communication that is required, and both the contact attorney and the applicant can follow the progress of the patent application in any jurisdiction by consulting the information from the data collection, intervening only if unforeseen circumstances arise (e.g. a change of strategy by the applicant).

While the present inventions have been described and illustrated in conjunction with a number of specific embodiments, those skilled in the art will appreciate that variations and modifications may be made without departing from the principles of the inventions as herein illustrated, as described and claimed. The present inventions may be embodied in other specific forms without departing from their spirit or essential characteristics. The described embodiments are considered in all respects to be illustrative and not restrictive. The scope of the inventions are, therefore, indicated by the appended claims, rather than by the foregoing description. All changes which come within the meaning and range of equivalence of the claims are to be embraced within their scope.
Glossary

claims correspondence table

A claims correspondence table sets the claims from different countries and different versions in table format one aside the other, including comments indicating the differences, making it straightforward to see the different versions of claims in different countries and to find differences.

contact person

The contact person can be either a patent professional from a patent department, e.g. of the applicant, an external patent attorney from a law firm or, if the patent applicant is an individual person, it could be the person himself or herself.

document management system

A document management system is a computer system (or set of computer programs) used to track and store electronic documents. It is usually also capable of keeping track of the different versions modified by different users (history tracking, versioning).

feature analysis of claims

A feature analysis is a table comparing the claims with their different features line by line with the features disclosed in a prior art document. For every prior art document there is typically one column.

foreign associate

A foreign associate is a person handling the prosecution in a country other than the country of the patent applicant. Typically, a foreign associate is patent attorney with admission in the country/jurisdiction in which he/she takes care of the prosecution.

jurisdiction

Jurisdiction (from the Latin ius, iuris meaning "law" and dicere meaning "to speak") is the practical authority granted to a formally constituted legal body or to a political leader to deal with and make pronouncements on legal matters and, by implication, to administer justice within a defined area of responsibility. The term is also used to denote the geographical area or subject-matter to which such authority applies. Areas of jurisdiction apply to local, state, and federal levels, as well as regional or continental levels like the European Union. In
patent law, a jurisdiction typically denotes either a country or a regional patent system like the European Patent Convention, the European Union with its Unitary Patent, the Eurasian Patent Convention, OAPI and ARIPO.

limitation

A limitation is a feature that is added to an existing claim and that limits the scope of its protection.

office action

An office action is the result of examination of a patent application by an examiner in the patent office transmitted to the patent applicant in written form. Typically, the applicant is requested to respond to the objections raised.

patent family

There are many definitions of which patent applications are part of a patent family. The simplest and most common definition is that a patent family covers all patent applications and granted patents that claim the priority of a common priority application.
1. Computer based system for organizing prosecution of members of a patent family owned by a patent applicant in a plurality of countries comprising:
   1.1 computer based means for data collection adapted to contain information central to the prosecution of the patent family in the countries;
   1.2 wherein the means for data collection comprise means for storing and reading at least one feature analysis of at least one claim of the patent family in view of at least one prior art document;
   1.3 means for accessing the means for data collection by
      1.3.1 at least one foreign associate in a jurisdiction other than the jurisdiction of the patent applicant; and
      1.3.2 the patent applicant and/or a contact person;
   1.4 means for communication between
      1.4.1 either the patent applicant and the at least one foreign associate;
      1.4.2 or
      1.4.2.1 the patent applicant and the contact person; and
      1.4.2.2 the contact person and the at least one foreign associate.

2. The computer based system according to the previous claim, wherein the means for data collection comprise means for storing and reading limitations of the at least one claim of the patent family as well as the priorities of the limitations.

3. The computer based system according to any one of the previous claims, wherein the means for accessing the means for data collection are configured such that the access is limited to authorized persons only.

4. The computer based system according to any one of the previous claims, wherein the means for data collection comprise means for storing and reading a claims correspondence table.

5. The computer based system according to any one of the previous claims, wherein the means for data collection comprise means for storing and reading the status of the members of the patent family in the different countries.
6. The computer based system according to any one of the previous claims, wherein the means for data collection comprise means for storing and reading the chances of success of the members of the patent family in the different countries.

7. The computer based system according to any one of the previous claims, comprising a document management system providing the means for data collection.

8. Computer based method for organizing prosecution of members of a patent family owned by a patent applicant in a plurality of countries comprising the following steps:
   8.1 providing means for data collection in a computer system adapted to contain information central to the prosecution of the patent family in the countries;
   8.2 wherein the means for data collection comprise means for storing and reading at least one feature analysis of at least one claim of the patent family in view of at least one prior art document;
   8.3 providing means for accessing the means for data collection by
      8.3.1 at least one foreign associate in a jurisdiction other than the jurisdiction of the patent applicant; and
      8.3.2 the patent applicant and/or a contact person.

9. The method according to the previous claim, wherein the at least one foreign associate performs the following steps:
   9.1 receiving an office action;
   9.2 analyzing of the office action using information taken from the means for data collection;
   9.3 devising a response to the office action based on the results of said analysis;
   9.4 updating the information contained in the means for data collection with information gained from the office action and/or step 9.2 or 9.3.

10. The method according to the previous claim, wherein the foreign associate analyzes prior art cited in the office action and enters the results of the analysis into a suitable feature analysis within the data collection.

11. The method according to any one of the previous method claims, wherein the patent applicant, for countries in which the patent applicant answers office actions him/herself, performs the following steps:
11.1 receiving an office action or a translation of an office action into English or his/her mother tongue;
11.2 analyzing of the office action using information taken from the means for data collection;
11.3 devising a response to the office action based on the results of said analysis;
11.4 updating the information contained in the means for data collection with information gained from the office action and/or step 11.2 or 11.3.
Fig. 1

Foreign Associate

Contact attorney

Data collection

Applicant
INTERNATIONAL SEARCH REPORT

A. CLASSIFICATION OF SUBJECT MATTER

G06Q 50/18 (2012.01)  G06Q 10/10 (2012.01)

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Documentation searched and (where applicable) classification of earlier patent documents considered

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Documents are listed in the continuation of Box C

Further documents are listed in the continuation of Box C

See patent family annex

Date of the actual completion of the international search
30 June 2015

Date of mailing of the international search report
30 June 2015

Name and mailing address of the ISA/AU

AUSTRALIAN PATENT OFFICE
PO BOX 200, WODEN ACT 2606, AUSTRALIA
Email address: pct@ipaustralia.gov.au

Authorised officer

Neil Miller
AUSTRALIAN PATENT OFFICE
(ISO 9001 Quality Certified Service)
Telephone No. 0262104089

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<td>US 2002/0093528 A1 (GRAINGER) 18 June 2002 Abstract, [0004], [0006]-[0008], [0010], [0013], [0022], [0029], [0031], [0034]-[0036],[0039]-[0044], [0040],[0046], [0048], [0050], [0051], [0053] and Figs 2 and 3B-7</td>
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<td>US 8560367 B2 (ROTH et al.) 15 October 2013</td>
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This Annex lists known patent family members relating to the patent documents cited in the above-mentioned international search report. The Australian Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

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End of Annex

Due to data integration issues this family listing may not include 10 digit Australian applications filed since May 2001.
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