Search Matters 2016

Event for patent search professionals

8-10 June 2016
The Hague, The Netherlands
Foreword

I am delighted to welcome you to Search Matters 2016. Dedicated to bringing you the latest information on patent searching, this annual event has a rich and varied programme featuring experts from around the EPO.

Search tools are evolving rapidly, and the amount of documentation and databases is also growing at a very fast rate. In order to give you the most accurate and detailed information on patent and non-patent prior art searching, classification, non-European documentation or specific EPO procedures, a team of experienced examiners and information specialists, will share their knowledge and expertise with you in the coming two days.

The Search Matters programme includes lectures and interactive workshops, as well as at-the-desk sessions, held on the day before the main event, where you can get hands-on search training from an examiner in the field of your choice.

Last but not least, there will be plenty of time to network with fellow search professionals and our EPO experts.

I hope you enjoy Search Matters 2016!

Guillaume Minnoye
Vice-President Operations
European Patent Office
Wednesday, 8 June 2016

At-the-desk sessions

13.45 - 17.00 Individual at-the-desk sessions with EPO examiners

17.15 - 20.00 Networking event for participants and EPO examiners of the at-the-desk sessions
Thursday, 9 June 2016

Moderator  Maria-Giuseppina Covone-van Hees, examiner, Biotechnology, EPO

from 08.30  Registration (with light breakfast buffet)
Foyer, conference centre

09.30  Opening speech
Gino Herreman, Director, Computers, EPO
Auditorium, conference centre

09.45  Lecture 1 (plenary) – key note speech:
Finding the right IP to build a business around
Ben Murphy, cleantech business builder and manager
Auditorium, conference centre

10.45  Coffee break
Foyer, conference centre

11.15  Workshop session 1

12.30  Lunch buffet
Foyer, conference centre

13.45  Workshop session 2

15.00  Coffee break
Foyer, conference centre

15.30  Workshop session 3

16.45  Break (technical)

17.00-17.45  Lecture 2 (plenary): Around the world in eighty seconds
Nigel Clarke, PI Research manager, Promotion, Patent Information, EPO
Auditorium, conference centre

18.15  Networking event
EPO canteen

Welcome address
Dan Peltz, Director, Medical and Consumer Technology, EPO

22.00  End of day 1
Friday, 10 June 2016

Moderator  Maria-Giuseppina Covone-van Hees, examiner, Biotechnology, EPO
from 08.15 Light breakfast buffet
Foyer, conference centre

08.45 Welcome
Guillaume Minnoye, Vice-President Operations, EPO

09.00 Lecture 3 (plenary):
Notorious knowledge
Giuseppe Fiorani, examiner, Handling and Processing, EPO
Auditorium, conference centre

09.45 Break (technical)

10.00 Workshop session 4

11.15 Coffee break
Foyer, conference centre

11.45 Workshop session 5

13.00 Lunch buffet
Foyer, conference centre

14.15 Workshop session 6

15.30 Coffee break
Foyer, conference centre

16.00 Lecture 4 (plenary):
Latest developments of the Cooperative Patent Classification
Frédéric Lequeux, team manager, Classification and Documentation, EPO
Auditorium, conference centre

16.45 Closing remarks
Auditorium, conference centre

17.00 End of event

A detailed workshop overview is to be found on the last two pages of this booklet.
Lecture 1
Finding the right IP to build a business around

This presentation will share insights into the world of early-stage investment, reflecting on how to maximise chances of success and minimise chances of failure. The particular focus will be on initial IP due diligence, analysing the crucial role of search. Practical examples will be taken from IP Group’s portfolio of over 100 businesses, each built on the foundations of world-leading IP. Over the past 12 years IP Group has grown from a newly founded private company to being publicly traded, now with a market cap over GBP1bn.

Ben Murphy, GB, cleantech business builder and manager. Ben leads on new cleantech investments for IP Group, finding new companies to fund and build up. He is on the board of several portfolio companies. He has previously held roles in research institutes, government departments, NGOs and major corporates. His last role was as a manager in the Carbon Trust, working primarily on low carbon technology innovations with governments and corporates. Ben led the UK’s prioritisation of select low carbon technologies, guiding multi-million-pound funding programmes. He also led several international expansion programmes at the Carbon Trust. Ben represented the Carbon Trust on the steering and advice group of the UK’s leading energy system model ESME. Prior to that, he held roles in the primary research arm of the European Commission (the Joint Research Centre - specifically in the Climate Change team), in renewable energy consulting and in Google’s cleantech investment division. Ben also holds a first-class degree from Durham in physics and mathematics and an MSc in environmental technologies from Imperial College London.

Lecture 2
Around the world in eighty seconds

Protection of intellectual property these days is an international activity. Establishment of intellectual property rights inevitably involves publication of the substance of those rights. It follows that patent publication is also an international activity. The EPO has embraced this concept and collects patent publications from the world, but makes them available to the world via its patent information products and services. This lecture will look at the scope of the EPO’s patent collections and how patent information is enhanced by access to international legal status and file history data. In other words, why distance, time and language are no longer barriers to retrieving and understanding patents worldwide.

Nigel Clarke, GB, PI Research manager, Promotion, Patent Information, EPO Vienna. PhD in neutron science. After a career in R&D, joined the EPO in The Hague as a patent examiner, going on to become an IT project manager. Moved to international cooperation at the EPO Vienna, as co-ordinator of the PATLIB programme. This was followed by research into the patent information market. Currently responsible for Espacenet and the EP Register, Nigel has many years’ experience of presenting patent information to the user community worldwide.
Lecture 3
Notorious knowledge

In the past, the boards of appeal of the EPO have had to give decisions on claims that were refused on the grounds of lack of technical features, without citing any prior-art documents. The boards were unable to agree with the findings of the first-instance department and had to conclude that the claims did in fact comprise at least some technical features. The established practice of the boards is that a claim comprising technical features should always be based on a prior-art document. The boards however decided not to send the applications back for an additional search, and maintained the decision of the first-instance department. Knowing the reasons behind such decisions can prove very useful in daily practice.


Lecture 4
Latest developments in the Cooperative Patent Classification

Since its launch in 2013, the Cooperative Patent Classification scheme (CPC) has made it easier for examiners in patent offices and global users worldwide to access relevant patent documentation. This workshop will present an overview of the latest developments in CPC and explain how to use it to retrieve prior art.

Frédéric Lequeux, BE, team manager, Classification and Documentation, EPO The Hague. Member of the EPO’s Cooperative Patent Classification team since the project’s launch with responsibility for aspects related to quality assurance. He graduated as a mechanical engineer in 1990 in Brussels and also holds a degree from the French Institute of Petroleum (IFP). Joined the EPO in 2001, where he worked for eight years as a patent examiner before moving to the Directorate Classification and Documentation.
WS01
When to stop a search

With the expansion of available databases and search tools, the question of when to stop a search is becoming increasingly relevant. In the past, your search was finished when you reached the bottom of the pile of correct classification groups. Now, with new search strategies, better tools and a string of procedural changes, how do we decide when to end a search? What influence do these changes have on our skill in determining when to stop?

This workshop will assess the risk of missing relevant documents at each stage of a search in a standardised search strategy. We will also look at the EPO’s in-house search stop requirements, general parameters which influence searches, and the effect on the search of the clarity, complexity and the wording of the claims.

Günther Aichmayr, AT, examiner, Applied Physics, EPO The Hague. Studied physics at Kepler University Linz and at the Max-Planck-Institut für Festkörperforschung in Stuttgart. After a PhD in solid state physics from the Universidad Autónoma de Madrid (UNAM) he worked for seven years in DRAM development in the semiconductor industry in Germany. Joined the EPO in 2008 as an examiner in search and examination and is also involved now in projects to develop new tools for more efficient prior-art searches.
WS02
Searching Russian and Indian prior art
Hands-on computer training

The aim of this workshop is to show the rising importance of these two countries in the patent landscape. The patent law of Russia and India will be briefly discussed, and this will be followed by a practical demonstration of how to access Russian and Indian patent data.

We will look in particular at the use of IPAIRS (the Indian Patent Information Retrieval System), Espacenet and the ROSPATENT website to retrieve Indian and Russian prior art; all of this information is free. Real-life examples will be given and participants will be encouraged to discuss their own experiences, problems and interests. The opportunities for machine translation of Russian documents will also be presented.

Alan Bacon, GB, examiner, EPO The Hague. Graduated in chemistry from the University of Oxford, St. Peter’s College, in 1982. In 1985, he obtained a PhD in organic chemistry from the University of Southampton. Joined the EPO in 1985 as an examiner and has been working in the field of printing ever since. Since 1990, he has been a member of the classification board, as well as being involved in recruitment and as a trainer for new EPO examiners and the European Patent Academy. He has also worked for the EPO in Cairo, Lisbon, Baku and Bishkek.

WS03
Non-unity – from theory to practice

This presentation is designed to give patent professionals an overview of the legal basis for non-unity, and includes insight from an experienced examiner into why and how an examiner drafts a non-unity objection (the a priori vs the a posteriori approach, illustrated by a real-life case). The last part of the presentation provides guidance on how to draft claims so as to preclude an objection under Article 82 EPC or Rule 13 PCT.

Jérôme Bonnet, FR/CH, examiner, Telecommunications, EPO Munich. Studied communication systems at the Swiss Federal Institute of Technology in Lausanne. Prior to joining the EPO, he worked for two years at DoCoMo Euro-Labs on innovative receiver designs for mobile communication within the framework of the EU FP6 WINNER project. Joined the EPO in 2006 as an examiner in the field of data switching networks. He is responsible for CPC classification in H04L12 and has trained many students in the course of CPC revision projects.
Many applications are prosecuted in various patent offices in parallel. For a global overview, it is important for IP professionals to understand the prior art cited by the different patent offices. Asian and in particular Chinese documentation is growing extremely quickly and the proportion of Chinese publications with a family member in English has decreased dramatically. This means that IP professionals need to rely more and more on translations. This workshop will show you how to consult the search results of the various offices via the Common Citation Document and Global dossier, and provide information on the individual file inspection mechanisms of the patent offices, as well as the various possibilities available for translating Asian prior art.

The number of national offices classifying in CPC is growing and currently includes major Asian offices such as SIPO and KIPO. We will provide insight on how documents classified in CPC by SIPO and KIPO can be retrieved via Espacenet. We will also discuss the difference between CPC and IPC in terms of Asian documentation coverage. Finally, we will demonstrate how Espacenet can be used to analyse this difference in document coverage for a specific technical field. This analysis can help in determining an efficient classification-based search strategy.

**WS04**

Access to search results from the Asian patent offices, translations of the cited prior art and an update on CPC in relation to Asian documentation

**Bart Degroote**, BE, examiner, Electrical and Electronic Technology, EPO The Hague. Obtained a PhD in physics from the University of Leuven. Prior to joining the EPO, he worked for three years at Imec, a micro- and nanoelectronics research centre. He joined the EPO in 2006 and currently works in the field of printed circuits. He is a member of the Asia Patent Expert Group.

**Terese Englund**, SE, examiner, Telecommunications, EPO Berlin. Graduated in electrical engineering from Chalmers University of Technology and studied patent law at CEIPI in Strasbourg. She has also passed the EQE. She joined the EPO in 2001, where she has given internal and external training courses for many years. She is a member of the Asia Patent Expert Group’s committee.
WS05
Access to Japanese prior art using classification, indexing and citation information

The purpose of this workshop is to explore the added benefit of prior-art retrieval via Japanese FI classes and F-term indexing codes compared to pure keyword and/or international classification searches. Strategies are presented for efficient and complete search in Japanese documentation making use of publicly available sources and search tools.

The workshop will cover:
- The philosophy behind the Japanese FI classification and F-term indexing systems and their concordance with International Classification
- The dynamics of the Japanese FI- and F-term systems: amended and new schemes, reorganisation of existing classes/terms, international co-operation
- The most pertinent Japanese classification and indexing codes for your technical field of interest
- Publicly available sources, with the focus on J-PlatPat (https://www.j-platpat.inpit.go.jp/)
- Access to citation information on prior art retrieved by JPO and its outsourced search organisations
- Search engines, search syntax, search strategy
- Sample cases

This workshop will be of particular interest to participants who have to perform prior-art searches in Japanese patent and utility model documentation.

Christoph Wirner, DE, examiner, Applied Physics, EPO The Hague. Studied physics at Munich’s Technical University (TUM) and conducted research at TUM’s Walter Schottky Institute. Completed the EU Science and Technology Fellowship programme at Osaka University, and worked on a future electron devices research project at Fujitsu Laboratories, Japan. Joined the EPO in 1997 as an examiner in semiconductor technology, where he participated in the EPO-JPO bilateral and EPO-JPO-USPTO trilateral examiner exchange programme and promoted the use of the Japanese Fi/F-term classification system. He chaired and is currently a member of the Asia Patent Expert Group. He is a member of the EPO’s Japanese language expert group.

Adam Cohen, GB, examiner, Applied Physics, EPO The Hague. Obtained a PhD degree in electrical and information sciences/photonic engineering from Cambridge University. Worked in the optics/fibre optics industry in Japan, Canada and the USA, and on the development of telecom network management in the UK. Joined the EPO in 2003 as an examiner. Gives Japanese classification workshops at internal and external training seminars, manages internal IT projects and is involved in quality control activities and machine translation projects. Coaches new examiners and is an expert for Japanese translation queries. Member of the Asia Patent Expert Group’s committee.
WS06
How to apply examiner search strategies on Espacenet
Hands-on computer training

This workshop is about searching Espacenet for patent applications. A practical example of a search for a pharmaceutical patent application will be demonstrated. Together with the participants, a strategy for this search will be developed. The example will showcase how to use the CPC classification for searching and how to make a search table using this classification. The search will then be performed live in Espacenet. Based on the results the search will be evaluated with the participants. There will be a discussion on how it can be refined and re-focused to arrive at an even better overview of the closest prior art. For this part of the workshop the problem-solution approach will be applied to the search strategy.

This workshop is suitable for both beginners and searchers who have some experience with Espacenet.

Emmeline Marttin, NL, examiner, Pure and Applied Organic Chemistry, EPO The Hague. Joined the EPO in 1999 and works in the technical field of galenics (drug delivery systems). She also chairs opposition proceedings in this field, biomaterials, cosmetics, dentistry and pesticides. She is an experienced speaker at EPO seminars. Previously, she worked for Johnson & Johnson and obtained a PhD in biopharmaceutical sciences from the University of Leiden.
WS08
Searching functional features: tools and tactics

This workshop will look at the best way to search inventions based on functional features rather than structural elements. It will also show you how to efficiently retrieve relevant prior art when the target technology is more functionally than constructively defined, as, for example, in multi-use devices, programmable or multifunctional elements, as well as substances with equivalent effects.

In such cases, searches based on structural features are only complemented by a functional and conceptual approach, giving a solid representation to the technical scope of the invention, its intended use or uses and the expected technical advantages.

The workshop will also examine how the functional approach differs from the structural one, and will present some recommendations regarding their use in the search process. The first part of the workshop will therefore outline the most useful tactics for dealing with functional features, including the systematic description of equivalents, the elaboration of synonymic expressions, and result-oriented queries.

The workshop will conclude with a practical exercise: divided into sub-groups corresponding to different technical areas (electricity, physics, chemistry and/or biotechnology), participants will be invited to perform one or more searches based on specific functional concepts in each area. Finally, the general applicability of the proposed tools will be discussed and evaluated, also based on the search experience of the participants.

Alessandro Colombo, IT, examiner, Electrical and Electronic Technology, EPO Munich. Studied electrical engineering at the Politecnico di Milano. Worked for several years as project manager at major firms in the electrical industry. Joined the EPO in 2003 to work as an examiner in the field of electrical power distribution and protection. Currently chairman of examining divisions as well as member of opposition divisions. Passed the EQE in 2010. Since 2011, instructor and coach for new examiners and trainer in various workshops on search and examination.
WS09
How to search the internet for relevant prior art without disclosing the invention to parties tracking the queries entered

Effective internet searching of prior art can involve different challenges: how to quickly find relevant patents and other forms of prior art; how not to miss relevant prior art; how to obtain prior art detailed enough to be useful; how to find prior art that is publicly available and has a verifiable date; how to prevent the queries you entered from being used by third parties tracking them to gain advantage.

This workshop will show you different effective approaches that can be chosen depending on the circumstances.

Frits Goeman, BE, examiner, Vehicle and General Technology, EPO The Hague. Holds a degree in mechanical engineering from the University of Ghent. He worked for Volvo Cars before joining the EPO in 1996. He currently performs searches, examination, classification and opposition in the field of mechanics (mainly gearings) and, as an in-house trainer, also has experience of search and examination in non-mechanical fields.
Non-patent literature

On average, one in every five EPO search reports contains a non-patent literature document citation, mainly from academic papers, while more than half of all search reports in chemistry and biotechnology cite non-patent literature. Hence, non-patent literature is essential for assuring the quality of EPO searches.

After a brief introduction to the importance of non-patent literature for our work, a demonstration of a typical non-patent literature search will be given. The new examiner tools (CiteNPL, SearchNPL) will be presented. A detailed overview of dedicated internet search engines for academic publications and their possible use (Google Scholar, Scopus, Medline) will then be delivered. The workshop will finish with a discussion of additional full-text resources such as e-print servers and open-access journals. Participants will have the opportunity to interact with the presenters on search strategy issues from the point of view of both the EPO examiner and the patent professional. The use of the internet to search and retrieve scholarly publications will also be covered.

Yves Verbandt, BE, examiner, Applied Physics, EPO The Hague. Obtained his degree in electrotechnics (with a major in applied physics) and his PhD in photonics from the Vrije Universiteit Brussel (Free University of Brussels) in 1996, before embarking on postgraduate studies at the Université Libre de Bruxelles in cardiorespiratory physiology and telemedicine. Joined the EPO in 2001 as a patent examiner in the fields of guided-wave optics, optical measurements and flow measurements. Member of the EPO’s Nanotechnology working group as the expert for nano-optics since 2003.

Els Vadot-Van Geldre, BE, examiner, Biotechnology, EPO The Hague. Studied pharmacy at the University of Ghent, where she obtained a PhD in pharmaceutical biotechnology. Joined the EPO in 2001, where she works in the field of drug screening and diagnostics. She regularly organises visits and exchanges with patent attorney firms and research institutes.
Establishing the publication date of internet citations
Legal framework and computer tools

Hands-on computer training

The prior art identified as potentially the most relevant for an invention is often found to have been made available to the public only on the internet, e.g. in a PDF document or on a webpage. A critical task for the examiner or the professional IP searcher is to establish the date on which the relevant content was made available as well as the circumstances of the disclosure, as this determines whether the disclosure can be relied upon as prior art pursuant to Article 54(2) EPC or if its status as such is rather to be challenged.

This workshop will provide general guidance as to the applicable legal framework regarding standard and burden of proof according to the EPO Guidelines and case law. Such knowledge is needed to ask the right questions when investigating the date of publication of an internet citation. A number of practical computer tools and techniques for investigating the publication date of an internet citation will also be presented. Real cases will be shown and discussed with the participants to illustrate the relevance of dates retrievable through internet services like WebArchive or Google cache, while simultaneously drawing attention to the related typical pitfalls.


Cristina Darolti, RO, examiner, Audio Video Media, EPO The Hague. PhD in computer science from the University of Lübeck and postdoc at McGill University, Montreal. Lecturer on computer science at the University of Lübeck. Joined the EPO in 2010. Examiner in the field of pattern recognition. Experienced chairperson and coach for newcomers.
WS12
Understanding and dealing with lack of unity

A lack of unity often arises at the search stage if the claims’ linking concept is found to be anticipated by the prior art. This finding can have severe consequences for the applicant. In this workshop we will review the reasoning of non-unity objections, pointing out typical mistakes, and discuss when and how a non-unity objection can be challenged or dealt with. Based on realistic examples, we will further present which situations may trigger a non-unity objection at the search stage. We will show how applicants can guide examiners through the search and avoid excessive non-unity findings. The workshop will be completed by hands-on examples and an exchange on experiences and suggestions to foster mutual efficiency.

Michael Olapinski, DE, examiner, Medical and Consumer Technology, EPO Munich. Studied physics at the University of Konstanz and Stanford University. Obtained a PhD in biophysics from the Ludwig Maximilian University of Munich in collaboration with start-up company Nanion Technologies. Joined the EPO in 2008 as an examiner in diagnostic medical technology. Directorate expert for lack of unity.

Pau Montes, ES, examiner, Medical and Consumer Technology, EPO Munich. Studied telecommunication engineering at the Universitat Politècnica de València and the Friedrich Alexander University Erlangen. Obtained a PhD from Heidelberg University in collaboration with Siemens Healthcare Sector. Worked as a consultant in the field of mobile communications in France and Germany. Joined the EPO in 2007 in diagnostic imaging and passed the EQE in 2013.
Optimising search efficiency is key to good searching. Searches for prior art should end with the retrieval of the best available documents and, ideally, should be performed in the shortest time possible.

The best starting point for high-quality and efficient searching is to have a good strategy. First, you should select the initial criteria for searching the subject-matter, involving not just the technical tools or databases which will be the most appropriate, but also the precise scope of the search. This is the “where” and the “what”. Then, you should select an initial strategy for carrying out the search in what seems to be the most efficient manner. The main focus of the search has to be established. This is the “how”.

Once you have started your search, you should continuously revise and adapt the initial focus in an iterative process in response to the intermediate search results obtained. If necessary, you should change all the previous criteria and strategies as you go, so as to steer the search towards the best prior art in the shortest possible time.

With the help of examples and hands-on exercises, this workshop will show you how you can optimise your searches using the above-mentioned closed-loop iterative approach, with continuous monitoring of the quality of the search results and a critical review of the initial search criteria.

Ricardo Oltra García, ES, examiner, Medical and Consumer Technologies, EPO The Hague. Studied mechanical engineering at the Polytechnic University of Madrid and physics at Madrid’s National Distance Education University (UNED). Worked as an engineer for Robert Bosch and John Deere in Spain. Joined the EPO in 2002, where he deals with patents for agricultural machinery. He has been involved in coaching and assessing new patent examiners since 2005 and is first member in opposition cases since 2006. He was involved in developing the new classification system (CPC) for his technical area and, as part of the CKT team, gives in-house training courses to fellow examiners.
WS14
When no meaningful search can be carried out
Searching unclear and complex applications

Applications in the field of chemistry and life sciences are often complex and filed with such generalised claims that it is virtually impossible to see what has been invented. In such cases a meaningful search is often impossible. The first task of the search examiner is to search the description for the core of the invention. Particularly in the area of life sciences, applications can sometimes contain a multiplicity of claimed inventions, giving rise to unity objections. Rule 63 gives the search examiner a tool to ask for more guidance, but if there are no clues, the examiner will be unable to help the applicant to the protection he deserves - i.e. by finding the contribution to the art. In the discussion, examples of such cases will be given and possible ways of dealing with them will be proposed.

The aim of this workshop is to raise awareness of what is needed in drafting patent applications in order to avoid problems arising in the search and examination phase as a result of potential misinterpretation. You will discover more on this topic of unclear and complex applications through examples from several areas of the chemistry field, in particular life sciences.

Harald Schmidt-Yodlee, DE, senior expert, Biotechnology, EPO The Hague. Studied food chemistry and biochemistry at the Technical University in Berlin and the University of Magdeburg. Passed the EQE in 2006. He is a member of an EQE Examination Committee and a local training co-ordinator in the Biotechnology cluster. Joined the EPO in 2001, where he works in search, examination and opposition. He participated in the examiner exchange programme with the Japan Patent Office.

WS15
Meeting customer expectations: Asian documentation at the European Patent Office

The explosion in patent documentation from Asia over the last few years constitutes a challenge to examiners and applicants alike. This lecture gives you a unique opportunity to find out how EPO examiners successfully address this challenge during search and examination. It also looks at key figures arising from the present situation, especially with regard to the amount of documentation consulted and ending up in European search reports. Lastly, it explains how the EPO’s massive investments in the acquisition of documentation, working methods and tools are bearing fruit.

Norbert Glaser, DE, examiner, Computers, EPO Munich. Studied computer science at the Friedrich Alexander University Erlangen and LORIA Nancy, PhD from the Henri Poincaré University in Nancy. Worked for six years as an IT engineer and consultant for Siemens AG, IBM France, INRIA. Joined the EPO in 1998. Worked for five years as a quality auditor for the EPO’s Quality Audit directorate, special expertise in computer-implemented inventions and business methods. Member of the Examination Matters organising committee.
WS16
Inside the mind of an examiner

Are you curious to know how examiners think? How they balance quality, service and efficiency?
The key to high-quality search and examination lies in the consistent application of the legal concepts and procedures defined in the EPC and the Guidelines for Examination. In addition, experienced patent examiners bring in service orientation, strategic thinking, sound judgment and decision-making skills to complement their technical and legal expertise.
This workshop aims to provide insight into the many “soft issues”, constraints and challenges facing examiners, and to highlight those aspects of direct relevance to applicants.

Topics include:
- How do examiners come to an understanding of the invention?
- How are claims dissected and search & examination strategies developed?
- How do examiners communicate and co-operate with applicants and deliver high quality and service?

Participants will get a glimpse of what goes on behind the scenes and gain an increased understanding of the predictability of the examiner’s actions and the transparency of the EPO’s search and examination procedures. The lecture is recommended for anyone interested in optimising their patent searching and drafting as well as their interaction with EPO examiners.

Philippe Lahorte, BE, team manager, Medical and Consumer Technologies, EPO Munich. Studied engineering physics and biomedical engineering. Obtained his PhD from Ghent University and MBA from Warwick Business School, Warwick University. Joined the EPO in 2000 and currently manages a team of examiners in medical technology. Active in quality and knowledge management. Extensive coaching experience and enthusiastic presenter for internal and external audiences.
How to identify patent thickets and related patents

Hands-on computer training

Patent thickets are dense webs of overlapping intellectual property rights. Firms who wish to be active in a particular area of technology need to ensure that their products will not infringe existing patents or existing patent applications which might later be granted. This requires an adequate patent search to uncover all interrelated patents and applications. Frequently, interrelated patents and applications are from a single applicant, but often with multiple inventors, or sets of inventors, and concern similar, but not identical subject-matter. The challenge is to identify such relationships between patents and applications, as distinct from other relationships such as families, citations and divisionals. This workshop presents simple-to-use but effective techniques which anyone can apply, using freely available data, to retrieve such related applications. The techniques are based on the applicant name, inventors and titles. Additional possibilities derive from the application number, priority dates and classes. These techniques are based on ones used at the European Patent Office to find similar applications at the pre-search stage, ones which have proven their value in widespread systematic use for over a decade. Compared to existing techniques such as patent landscaping the techniques proposed here are simpler to use, quicker and less expensive. Examples from various fields of technology will be presented using Espacenet.

Alain Materne, FR, examiner, Audio Video Media, EPO Berlin. Holds a degree in electronic engineering from ENSEA in Cergy-Pontoise, which he completed with a thesis project at Berlin’s Technical University. He worked in the electronics industry at Wandel & Goltermann in Reutlingen prior to joining the EPO in 1988. Develops various ranking scripts in ooRexx for retrieving related files and prior art.

Gershom Sleightholme-Albanis, GB/AU, examiner, Vehicle Technology, EPO Berlin. Holds a degree in mechanical engineering from the University of Melbourne and a doctorate from the University of Cambridge. Worked for several years in the steel industry, at Jaguar Cars and in the British civil service prior to joining the EPO in 1996.

Nigel Clarke, GB, PI Research manager, Promotion, Patent Information, EPO Vienna. PhD in neutron science. After a career in R&D, joined the EPO in The Hague as a patent examiner, going on to become an IT project manager. Moved to international cooperation at the EPO Vienna, as co-ordinator of the PATLIB programme. This was followed by research into the patent information market. Currently responsible for Espacenet and the EP Register, Nigel has many years’ experience of presenting patent information to the user community worldwide.
The basics of patent searching

There may be many reasons why you, in particular, want to search patents. There will be specific kinds of information that you’re looking for. You’ll need to know where to look and, since the patent landscape is constantly changing, you’ll need to know when to look. In order for you to make the best searches possible, you’ll want to know how to look. In this workshop we will identify the reasons for searching patents and the different types of search possible. We will look at the different ways of searching patents and the techniques that can be used. The collection of patent documents is vast, but structured, and we will look at the ways that the structure and interrelationships between patent publications can be leveraged. And we will exploit the metadata surrounding all patent publications.

Nigel Clarke, GB, PI Research manager, Promotion, Patent Information, EPO Vienna. PhD in neutron science. After a career in R&D, joined the EPO in The Hague as a patent examiner, going on to become an IT project manager. Moved to international co-operation at the EPO Vienna, as co-ordinator of the PATLIB programme. This was followed by research into the patent information market. Currently responsible for Espacenet and the EP Register, Nigel has many years’ experience of presenting patent information to the user community worldwide.

Searching peptides and their functions in medical use claims

Every year the European Patent Office receives hundreds of patent filings relating to peptides and their functional applications in the fields of biotechnology, pharmacology and cosmetics. This workshop will give you an overview of the patent search tools, relevant databases and strategies for searching claims for short amino acid sequences and their functions. It will emphasise how to use the relevant patent classification to improve the search results. The use of practical examples will illustrate how an efficient search strategy can be developed in line with the requirements of novelty, inventive step, unity of invention and sufficiency of disclosure provided by the European Patent Convention (EPC).

WS20
Biomaterials: how is a medical use affecting your search?

The field of biomaterials is developing at a rapid rate. Materials for implants, tissue engineering and other medical uses are constantly adapted to changing medical needs. Searchers in this field face challenges because these rapid developments cause applicants to draft claims related to medical devices defined by a use in methods of treatment on the human or animal body (Article 53(c) and 54(4), (5) EPC).

To what extent could certain medical devices fall under the definition of a substance or composition in order to fulfil the criteria of novelty under Article 54(4), (5) EPC? In other words, to what extent are the claimed medical devices limited by their medical use? By properly understanding the impact of the medical use limitation (or not) the correct strategy and fields for the search can be determined, and the quality of the search will be enhanced.

The presenters will restrict the present topic to medical devices such as stents, scaffolds for tissue engineering, implants, wound dressings, catheters and coatings thereon (international classification A61L15-33). The workshop will deal with the interpretation of claims directed to these devices and its effect on searches. Examples will be presented and worked out interactively to ensure that participants have a thorough understanding of the claimed subject-matter in order to be able to carry out complete and efficient searches.

Bastiaan Siebum, NL, examiner, Pure and Applied Organic Chemistry, EPO The Hague. Studied materials science at the University of Twente, ending with a PhD on the study of collagen substrates for hematopoietic stem cell culture. Joined the EPO in 2007, where he works in the field dealing with chemical aspects of implants and prosthesis, as well as in opposition. He has given several presentations on various aspects of search and examination, both inside and outside the EPO.

Heidi Van den Bulcke, BE, examiner, Pure and Applied Organic Chemistry, EPO The Hague. Studied life science and technology and biomolecular sciences at the Universities of Leiden, Delft and Utrecht. Joined the EPO in 2007, where she works in the field of biomaterials, focusing on the biocompatibility or the therapeutic effect of medical devices, implants and bandages. Mainly working in search, examination and opposition, she also chairs examination proceedings in the field of galenics.
WS21
Searching Markush formulae in organic and inorganic chemistry

Markush formulae are undoubtedly the most efficient way of claiming a generic group of compounds. Indeed, they are necessary if applicants are to be given adequate protection for their invention. However, due to their complex nature, it is not always easy to determine their exact scope.

In this workshop we will look at Markush formulae in both organic and inorganic chemistry. An overview will be provided of the databases/search tools available. We will discuss the search strategy for several practical cases – with special focus on non-unity, incomplete search, clarity and support.

This workshop will cover the subject of Markush non-unity in detail, and will complement the general workshops on unity (WS03, WS12).

Thomas Maxisch, DE, examiner, Industrial Chemistry, EPO The Hague. Studied physics at the University of Marburg and obtained a PhD in physics from the Swiss Federal Institute of Technology in Lausanne. Spent three years in materials science research at MIT before joining the EPO in 2006, where he works in the field of batteries and fuel cell technology; he is also involved in opposition cases and the coaching of new examiners.

Miren Langer, DE, examiner, Pure and Applied Organic Chemistry, EPO, The Hague. Studied Pharmacy at the Universities of Marburg, Paris South and Santiago de Compostela. Obtained a PhD in pharmacology from Munich’s Ludwig Maximilian University (LMU). Prior to joining the EPO, she worked for three years as a project manager (medical department) in the pharmaceutical industry. Since 2006, she is an examiner in the field of second medical use and bioconjugates. Chairperson in opposition proceedings. Passed the EQE in 2012.
WS22
Searching chemical inventions by name

Commodity chemicals and drugs in the pharmaceutical and agrochemical industry can appear in prior art under a variety of different names. This workshop will illustrate ways to find synonymous names, tools for converting names into structures and the usefulness of alternative identifiers like CAS Registry Numbers, InChI and Smiles codes.

Searches using different naming conventions (IUPAC nomenclatures, traditional names, development names, trade name etc.) will be performed and we will show the results they produce in databases such as Chemical Abstracts, ChemSpider, Pubchem, Google, Integrity and Reaxys.

The usefulness of the various compound identifiers for searching in the above databases will be demonstrated.

Tim Lange, DE, examiner, Pure and Applied Organic Chemistry, EPO The Hague. Studied chemistry at the University of Heidelberg, Complutense University of Madrid and Strasbourg’s Louis Pasteur University, and obtained a PhD from ETH Zurich. Prior to joining the EPO he spent 10 years in research, working for Aventis, Bayer and finally AstraZeneca. Passed the EQE in 2013 and has been working in search, examination and opposition since 2007.

WS23
Examiner vs applicant search
Optimised search in mechanical fields

Developing effective search strategies is a key part of the patenting procedure. An applicant and an examiner will apply different strategies to obtain the best results when drafting a patent application or finding the closest prior art for a set of claims.

This workshop will present a dual approach to identifying constraints and important steps during searches. Working interactively, participants will use real-life examples to develop search strategies for applicants and search examiners.

We will focus on the “search-evaluation loop” and perform in-depth analysis to set up “feature groups” for applications from fields related to mechanics. Participants will learn how to optimise their search strategies in line with the mindset of the examiner.

András Szap, HU, examiner, Vehicles and General Technology, EPO The Hague. Obtained a PhD in multidisciplinary sciences from the Budapest University of Technology and Economics (BME) and an MSc in automotive engineering from the University of Karlsruhe and the BME. Holds the EUR ING professional title from FEANI, Brussels. Before joining the EPO in 2003, he worked as a simulation engineer for the German Space Agency. Member of opposition divisions and Asia Patent Expert Group representative. Efficiency coach for new and existing colleagues, represents the EPO at international job fairs.
Supporting global initiatives on climate change — the EPO’s “Y02/Y04S” tagging scheme for climate change mitigation technologies

Technological innovation has long been considered a key element in fighting climate change, and the parties to the United Nations Framework Convention on Climate Change (UNFCCC) have established the “Technology Mechanism” to support innovation and global technology transfer in green technologies. The exact role of the patent system, designed to foster innovation and provide a legal framework for licensing and technology transfer, has been the subject of much debate.

The EPO has developed a dedicated tagging scheme for climate change mitigation technologies (CCMTs), which

— is fully integrated into the CPC,
— enhances the EPO’s patent information services, including Espacenet, improving access — worldwide and free of charge — to patent information on CCMTs,
— is used in conjunction with the EPO’s PATSTAT by institutions such as the OECD, WIPO and the London School of Economics to produce information on which to base policy for CCMT innovation and transfer.

This scheme has been continually expanded in recent years and is now considered complete for CCMTs, covering seven main categories, namely energy, carbon capture, buildings, production, transport, waste, and smart grids. An overview is presented of the Y02/Y04S scheme and how it is used (i) to find relevant technologies and their owners and (ii) to provide technical, legal and business information to support strategic decisions and policy-making in the climate change field.

Stefano Angelucci, IT, examiner, Civil Engineering and Thermodynamics, The Hague. Graduated as an aerospace engineer and worked at the European Space Agency and German Space Operations Centre. Joined the EPO in 2001, where he works in the field of turbo machinery and wind power generation. He is involved in coaching, internal quality control, classification, search and examination of patent applications as well as in opposition procedures. He was involved from the beginning in the project to develop the CPC Y02 classification scheme, which he now helps to co-ordinate.
Procedural changes

Patent examination is a dynamic process, often requiring changes to procedures and practices. The reasons for procedural changes are manifold, and include PCT developments, IT changes, and efficiency and quality improvements, to name but a few. Over the last few years, the EPO has seen many procedural changes, mainly due to the process of modernising its IT infrastructure and further improving the quality of its products. And there are many more changes still to come.

This poster provides an overview of recent and forthcoming legal and procedural changes that will affect applicants, the public and EPO examiners alike.

Timelines

For users of the European patent system, it is generally considered that a preliminary opinion on patentability provides applicants and the public with information about the possible outcome of the examination procedure. So in July 2014, the EPO therefore introduced the “Early Certainty from Search” (ECfS) scheme, which reprioritised its search and examination workload to provide a maximum of legal certainty as early as possible in the patent granting process. With ECfS, the first office action - the search report accompanied by a preliminary opinion on patentability - is given highest priority and is always delivered in good time, at the latest six months after receipt of the file by the search division.

As it has delivered the expected results in terms of search timeliness, the EPO is ready to extend the concept of early certainty to the whole patent granting process.

Based on a careful assessment of the estimated workload, manpower and the legal requirements set out in the European Patent Convention, the EPO aims to achieve compliance with the following timeliness objectives by the end of 2020:

- Prior art searches with written opinion on patentability concluded within six months after receipt of the file by the search division (already achieved under ECfS).
- Grants concluded on average within 12 months after the start of substantive examination.
- Standard opposition cases concluded within 15 months after the start of the opposition procedure on expiry of the nine-month opposition period.

To achieve these objectives, the Office will continue to further streamline its practices and procedures with regard to both internal handling/processing and interaction with applicants.

The poster will demonstrate the measures that are envisaged and show how they would be implemented.

Piotr Wierzejewski, BE/PL, administrator, Patent Procedures Management, EPO The Hague. Studied computer science. Worked as a university lecturer and IT/telecom consultant. Joined the EPO in 2003. Worked for nine years as an examiner in the area of computer-implemented inventions. Since 2012, he has been working as an administrator in the Patent Procedures Management directorate, where he is entrusted with the development and implementation of patent procedures and maintenance of the Guidelines for Examination. He also co-ordinates procedural aspects of international co-operation within the PCT legal framework as well as in the context of IFS.
EPO’s approach to search in Asian documentation

Searching in Asian documentation is essential to ensuring comprehensive coverage of the prior art in EPO search reports.

The poster shows:
- the coverage of Asian patent documents in the EPO’s databases (including classification information)
- the EPO search tools that can be used to retrieve Asian prior art
- integrated access to the world’s largest citations database and file wrapper
- state of the art translation tools

The poster will help applicants get an overview of the EPO’s approach to searching in Asian documentation.

Christoph Wirner, DE, examiner, Applied Physics, EPO The Hague. Studied physics at Munich’s Technical University (TUM) and conducted research at TUM’s Walter Schottky Institute. Completed the EU Science and Technology Fellowship programme at Osaka University, and worked on a future electron devices research project at Fujitsu Laboratories, Japan. Joined the EPO in 1997 as an examiner in semiconductor technology, where he participated in the EPO-JPO bilateral and EPO-JPO-USPTO trilateral examiner exchange programme and promoted the use of the Japanese Fi/F-term classification system. He chaired and is currently a member of the Asia Patent Expert Group. He is a member of the EPO’s Japanese language expert group.

Patent Information

Visit the Patent Information stand to find out more about:
- EPO online products
- European Patent Register
- Register Alert
- Federated Register
- Global Dossier
- Espacenet
- Patent Translate
- Common Citation Document
- CPC browser
- Global Patent Index
- Publication server

Nigel Clarke, GB, PI Research manager, Promotion, Patent Information, EPO Vienna. PhD in neutron science. After a career in R&D, joined the EPO in The Hague as a patent examiner, going on to become an IT project manager. Moved to international co-operation at the EPO Vienna, as co-ordinator of the PATLIB programme. This was followed by research into the patent information market. Currently responsible for Espacenet and the EP Register, Nigel has many years’ experience of presenting patent information to the user community worldwide.
The Organising Committee Search Matters 2016

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Karin Stumvoll, project assistant
Katie Tantaro, project assistant
### Workshop overview

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**Venue**
European Patent Office (EPO)
Conference centre
Entrance via Van Bentheimlaan 16
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