

Annex 2

DEFINITIONS FOR TERMS AND FOR STATISTICS ON PROCEDURES

This Annex contains firstly definitions of the main terms used in the report.⁶⁰ After that there is an explanation of the patent procedures relating to Fig. 4.8. Then finally there are definitions of the statistics on procedures that appear in Table 4.

APPLICATIONS, COUNTING OF

Application counts are mainly determined by counting each national, regional or international application only once. However, alternative representations are also given in Chapter 3 after cumulating the number of designated countries over applications.

In this report, applications are counted in terms of patent filings; first filings; requests for patents entering a grant procedure; and demand for national patent rights.

- Counts of ‘Patent filings’ include direct national, direct regional, and initial PCT applications;
- Counts of ‘First filings’ include initial patent applications filed prior to any later subsequent filings to extend the protection to other countries;
- Counts of ‘Requests for patents entering a grant procedure’ include direct national, direct regional, national stage PCT, and regional stage PCT applications;
- Counts of ‘Demand for national patent rights’ include direct national, designated regional, national stage PCT, and designated regional stage PCT applications.

These counting methods are used in various sections of the report, and particularly in Chapter 3. The methods are discussed in greater detail both at the beginning of Chapter 3 and at the beginning of the corresponding sections of Chapter 3.

BLOCS, GEOGRAPHIC

Six geographical blocs are defined in this report. The first five blocs, together, are referred to as the “IP5 Blocs”. They are:

- The EPC contracting states (EPC states in this report) corresponding throughout the period covered in this report to the territory of the 38 states party to the EPC at the end of 2011;
- Japan (Japan in this report);
- People’s Republic of China (P.R. China in this report);
- Republic of Korea (R. Korea in this report);
- United States of America (U.S. in this report).

⁶⁰ A more extensive glossary of terms appears as Annex 3 in the web based version of the report.

The remaining geographical areas are grouped together as:

- the rest of the world (Others in this report).

These blocs are referred to as blocs of origin on the basis of the residence of the applicant (throughout the report) or as filing blocs on the basis of the place where the patents are sought (in Chapters 3 and 5).

DEMAND FOR PATENT RIGHTS

Demand for patent rights refers to applications for patents for invention. Counts of patent applications (see above) are made principally by counting each national, regional or international application only once. However, alternative representations are also given in Chapter 3 in terms of the demand for national patent rights, after cumulating the number of designated countries over applications. This makes a difference only in regard to systems where multiple countries can be designated in an application (PCT and regional systems). Demand for 'national' patent rights effectively measures the number of national patent applications that would have been necessary to seek patent protection in the same number of countries if there were no international or regional systems. The counts include direct national filings, designations in regional systems, national stage PCT applications, and designations in regional stage PCT applications.

DIRECT APPLICATIONS

“Direct” applications are filed directly with the country or regional patent office where protection is sought and are counted in the year they are filed. They are distinguished from “PCT” applications in order to distinguish the two subsets of applications handled by Patent offices.

DOMESTIC APPLICATIONS

These are defined as all demands for patents made by residents of the country where the application is filed⁶¹. For the purpose of reporting statistics for the EPC contracting states considered as a bloc, domestic applications are given with regard to the applications made by residents from anywhere inside the EPC bloc. For example, applications made by residents of France in one of the other EPC contracting states are counted as domestic demand in the EPC bloc.

FIRST FILINGS

These are applications filed without claiming the priority⁶² of another previous filing and are counted in the year they are filed. They are usually made in the home country or region. All other applications are subsequent filings, usually made within one year of the

⁶¹ For the USPTO this is by the residence of the first named inventor; For the EPO, the JPO, the KIPO and the SIPO, this is by the residence of the first named applicant.

⁶² See the Article 4A to 4D of the Paris Convention at the WIPO web site;
http://www.wipo.int/export/sites/www/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf

first filings. In the absence of a complete set of available statistics on first filings, it is assumed in this report that domestic national filings are equivalent to first filings⁶³ and that PCT filings are subsequent filings. Currently, USPTO first filing data, unless otherwise noted, also include a substantial proportion of applications that are continuations of applications previously filed at the USPTO. See also APPLICATIONS, COUNTING OF.

FOREIGN APPLICATIONS

These are defined as all demands for patents made by residents of a location outside of the country or region where the application is filed⁶⁴. See the term definition for *Domestic Applications* for additional details.

GRANTS, COUNTING OF

Grant counts in Chapter 3 are based on the WIPO Industrial Property Statistics series⁶⁵. They are counted in the year that the grants are issued or published. As with the demand for patent rights, the demand for rights granted in each bloc are considered after cumulating the number of designated countries for which national patent rights have been granted via regional procedures. Counts in Chapter 4 are based on IP5 Offices data.

PATENT FAMILIES

A patent family is a group of patent filings that claim the priority of a single filing, including the original priority forming filing itself and any subsequent filings made throughout the world. The set of distinct priority forming filings (that indexes the set of patent families) in principle constitutes a better measure for first filings than aggregated domestic national filings. For the purposes of this report⁶⁶, IP5 Blocs patent families are a filtered subset of patent families for which there is evidence of patenting activity in all IP5 Blocs.⁶⁷

PATENTS IN FORCE

Patents in force are patents that have not expired. Patents may expire for several reasons, two of the most common being the completion of their patent term and the failure to pay a required maintenance fee.

⁶³ The data source used for patent families allows a precise count of first filings. Except in the sections on patent families, an approximation of the number of first filings in the EPC Bloc is made by adding first filings at the EPO to aggregated domestic national applications in the EPC contracting states.

⁶⁴ For the USPTO this is by the residence of the first named inventor; For the EPO, the JPO, the KIPO and the SIPO, this is by the residence of the first named applicant.

⁶⁵ <http://www.wipo.int/ipstats/en/statistics/pct/index.html>

⁶⁶ The statistical annex of this report, that is available at the web site, and previous editions of this report, also give statistics on Trilateral Patent families and Four blocs families. These are a filtered subset of patent families for which there is evidence of patenting activity in all the Trilateral blocs (EPC, Japan and U.S.), or all the Trilateral blocs and R. Korea, respectively.

⁶⁷ For discussion of patent families in general see the OECD working paper "Insight into different types of patent families", <http://www.oecd.org/dataoecd/21/32/44604939.pdf>

PCT APPLICATIONS

International applications filed under the PCT are first handled by appointed Offices during the international phase. About 30 months after the first filing, they enter the national/regional phase to be treated as national or regional applications according to the regulations of each designated Office where protection is sought. “PCT” applications are distinguished from “direct” applications in order to distinguish the two subsets of applications handled by Patent offices. PCT applications are usually counted in the year that they enter the national (or regional) phase although in some parts of this report they are counted in the year of filing in the earlier international phase⁶⁸.

REQUESTS FOR PATENTS ENTERING A GRANT PROCEDURE

These are filings that entered a grant procedure and include direct national, direct regional, national stage PCT, and regional stage PCT applications. Direct national and direct regional applications enter a grant procedure when filed, while in the case of PCT applications, the grant procedure is delayed to the end of the international phase.

SUBSEQUENT FILINGS

Subsequent filings are applications filed that claim the priority⁶⁹ of a previous filing and usually are made within one year of the first filings. See also FIRST FILINGS. Currently, USPTO subsequent filing data also include a substantial proportion of applications that are continuations of first filing and subsequent filing applications previously filed at the USPTO.

⁶⁸ An international phase PCT application can in theory be a first filing but is usually a subsequent filing made up to twelve months after a first filing. A national (or regional) phase PCT entry can follow on from the corresponding international phase PCT filing and is made up to 30 months after the first filing.

⁶⁹ See the Article 4A to 4D of the Paris Convention at the WIPO web site;
http://www.wipo.int/export/sites/www/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf

Additional explanations of the IP5 Offices patent procedures in Fig. 4.8 follow.

Examination: search and substantive examination

Each of the IP5 Offices examines a filed patent application based upon novelty, inventive step, and industrial applicability. At the EPO, this examination is done in two phases: a search to establish the state of the art with respect to the invention and a substantive examination to evaluate the inventive step and industrial applicability. For the second phase, a separate request has to be filed no later than six months after publication of the search report.

In the national procedures before the JPO, the KIPO, the SIPO, or the USPTO, the search and substantive examination are undertaken in one phase.

Filing of a national application with the USPTO is taken to imply an immediate request for examination. At the JPO, the KIPO, and the SIPO where deferred examination systems exist, filing of a national application does not imply a request for examination; and this may be made up to three years after filing for the JPO and the SIPO, and up to five years after filing for the KIPO.

The international searches and international preliminary examinations carried out by the IP5 Offices as PCT authorities are not included in the flow chart.

Publication

In the IP5 Offices, the application is to be published no later than 18 months after the of earliest priority date, or otherwise the date of filing (in case of a first filing). The application can be published earlier at the applicant's request. In each of the IP5 Offices, the Publication process is independent of other Office processes such as Examination. Also, at the USPTO, an application that has not and will not be the subject of an application filed in foreign countries does not need to be published if an applicant so requests.

Grant, refusal / rejection, withdrawal

When an examiner intends to grant a patent, this information is communicated to the applicant - Announcement of grant (EPO); Decision to grant (JPO); Decision to grant (KIPO); Decision to grant (SIPO); Notice of allowance (USPTO). If a patent cannot be granted in the form as filed before the Office, the intention to reject the application is communicated to the applicant: (unfavourable) Examination Report (EPO); Notification of reason for refusal (JPO); Notification of reason for refusal (KIPO); Notification of reason for refusal (SIPO); Office action of rejection (USPTO). The applicant may then make amendments to the application, generally in the claims, after which examination is resumed. This procedural step is iterated as long as the applicant continues to make appropriate amendments. Then, either the patent is granted or the application is finally rejected - Intention to refuse (EPO); Decision of rejection (JPO); Decision of rejection

(KIPO); Decision of rejection (SIPO); Final rejection (USPTO) - or withdrawn by the applicant - Withdrawal (EPO); Withdrawal or Abandonment (JPO); Withdrawal or Abandonment (KIPO); Withdrawal or Abandonment (SIPO); Abandonment (USPTO). In addition, if no request for examination for an application is filed to the EPO, the JPO, the KIPO, or the SIPO within a prescribed period (six months after publication of the search report for the EPO, three years from the date of filing for the JPO and the SIPO, and five years from the date of filing for the KIPO), the application will be deemed to have been withdrawn. In all five procedures, an applicant may withdraw or abandon the application at any time before the application is granted or finally refused.

After the decision to grant the patent, the patent specifications are published if certain administrative conditions are fulfilled, known as Publication of patent (EPO, JPO, KIPO, SIPO, and USPTO). At the USPTO, this action also is referred to as “Patent issuance.”

Opposition

The opposition procedures allow third parties to challenge a patent granted before the granting Office.

There is no opposition system at the JPO, the KIPO, and the SIPO.

At the EPO, the period for filing opposition(s) begins after granting of the patents and lasts nine months. If successful, the opposition can lead to a revocation of the patent or to its maintenance in amended form. Furthermore, the patentee may request a limitation or a revocation of his own patents.

In the procedure before the USPTO, there are two features that may lead to the cancellation of a granted patent: interference proceedings and re-examination. The numbers are not reported because these features are not comparable to the opposition procedure at the EPO. At the USPTO, the first feature is a priority contest between applicants/patentees seeking to protect the same invention with the interference proceedings possible at various points during the examination process or shortly after patent grant. The second feature may be requested by third parties or by the patentee during the lifetime of a granted patent. In the near future, the USPTO will be implementing portions of the new America Invents Act which will affect both of these procedures.

Appeal

An appeal can be filed by any of the parties concerned against a decision taken by the IP5 Offices. In practice, applicants can appeal decisions to reject an application or revoke a patent, while opponents can appeal decisions to maintain a patent. The procedure is in principle similar for the IP5 Offices. The examining department first studies the argument brought forward by the appellant and decides whether the decision should be revised. If not, the case is forwarded to a Board of Appeal, which may take the final decision or refer the case back to the examining department.

The SIPO has reexamination and invalidation procedures. Where an applicant for patent is not satisfied with the decision of the SIPO rejecting the application, the applicant may, within three months from the date of receipt of the notification, request the Patent Reexamination Board to make a reexamination. Where any entity or individual considers the grant of a patent right is not in conformity with the relevant provisions of the Patent Law, it or he may request the Patent Reexamination Board to declare the patent right invalid.

Additional definitions for terminology appearing in Table 4 follow.

Table 4 - EXAMINATION RATE

This rate shows the proportion of those applications, for which the period to file a request for examination expired in the reporting year, that resulted in a request for examination up to and including the reporting year.

For the EPO, the request for examination has to be filed no later than six months after publication of the search. For example the rate for 2011 relates to applications mainly filed in the years 2010 and 2011.

For the JPO, the period to file a request for examination is three years from filing date. The rate for 2011 relates mainly to applications filed in the year 2008.

For the KIPO, the period to file a request for examination is five years. The rate for 2011 relates mainly to applications filed in the year 2006.

For the SIPO, the period to file a request for examination is three years from filing date.

At the USPTO, as filing an application implies a request for examination, such a request is made for all applications.

Table 4 - GRANT RATE

For the SIPO, only the number of granted patents is currently available.

For the EPO, this is the number of applications that were granted during the reporting period, divided by the number of disposals in the reporting period (applications granted plus those abandoned or refused).

For the JPO, the grant rate is the number of decisions to grant a patent divided by the number of disposals in the reporting year (decisions to grant or to refuse and withdrawals or abandonment after first office action).

For the KIPO, the grant rate is the number of patent approvals divided by the number of disposals in the reporting year (sum of the numbers of patent approvals, rejections, and withdrawals after first office action).

The USPTO has revised its calculation to present a grant rate that is more consistent with the other IP5 Offices. In previous reports, a USPTO allowance rate was reported rather than a grant rate. In this report, the displayed USPTO grant rate is the total number of issued patents divided by the total number of applications disposed of in the reporting year. Requests for continued examination (RCEs) are not included in the disposals. This grant rate differs from the allowance rate usually reported by the USPTO which counts the total number of applications determined to be eligible by USPTO patent examiners for a patent divided by the total number of applications disposed of in a reporting year; for the allowance rate, RCEs are included in the disposals. Both the rates include plant and reissue patent applications in addition to utility patent applications. However, since utility applications comprise over 99 percent of these applications, the rates are almost identical to rates based strictly on utility applications.

Table 4 - OPPOSITION RATE and MAINTENANCE AFTER OPPOSITION RATE

These terms apply only to the EPO.

The opposition rate for the EPO is the number of granted patents for which the opposition period (which is nine months after the date of grant) ended in the reporting year and against which one or more oppositions were filed, divided by the total number of patents for which the opposition period ended in the reporting year.

The maintenance after opposition rate for the EPO is the number of decisions (in the opposition procedure) to maintain, possibly in amended form, a patent during the reporting year, divided by the total number of decisions in the opposition procedure taken during the reporting year.

Table 4 - APPEAL RATE

For the EPO, appeal rates are given for examination and opposition, being the numbers of decisions in the examination and opposition procedures respectively, against which an appeal was lodged in the reporting year, divided by the number of all decisions for which the time limit for appeal ended in the reporting year.

The USPTO appeal rate on examination, which includes utility, plant, and reissue categories, captures the number of appeals filed after an examiner's decision to issue a final rejection against a patent application. The rate is the number of examiner answers written during the year in response to appeal briefs divided by the number of final rejections issued that year. This rate includes plant patents and reissue patents in addition to utility patents (see comment at TABLE 4 - GRANT RATE).

For all five offices, any subsequent litigation proceedings in national courts are not included.

Table 4 - PENDENCY / SEARCH

This only applies to the EPO.

Number of pending applications is the number of applications received up to and including the reporting year for which a search report has not been made by the end of the reporting year.

Pendency time in search is defined as the median time to complete a search with a written opinion on patentability in the reporting year.

Table 4 - PENDENCY / EXAMINATION / NUMBER OF APPLICATIONS AWAITING REQUEST FOR EXAMINATION

This does not apply to the USPTO.

This figure indicates the number of filed applications awaiting a request for examination by the applicant: for the EPO after publication of the search report; for the JPO and the SIPO at any time during three years after filing; for the KIPO during five years after filing.

For the EPO, this indicates the number of applications for which the search report has been published by the end of the reporting year and for which the prescribed period for the request has not expired (six months after publication of the search report).

For the JPO and the KIPO, numbers of applications awaiting request for examination indicate the number of applications for which no request for examination has been filed by the end of the reporting year, and for which the prescribed period for the request has not expired.

For the JPO, numbers include the number of abandoned/withdrawn applications.

Table 4 - PENDENCY / EXAMINATION / NUMBER OF PENDING APPLICATIONS

For the EPO, this is the number of applications filed for which the search was completed and the request for examination was filed, yet they have not received a final decision by the examining division (announcement to grant, to refuse or abandonment) by the end of the reporting year.

For the JPO and the KIPO, pending applications in examination are applications for which the requests for examination were filed and which have been waiting for a first action and have not been subject to a final action such as withdrawal or abandonment by the end of the reporting year.

For the JPO, the applications for which the applicants wished to make deferred payment of examination request fee and have been still deferring the payment are not counted in the number of pending examinations.

For the USPTO, pending applications in examination are applications which are waiting for a first action and have not been subject to a final action such as withdrawal or abandonment by the end of the reporting year.

Table 4 - PENDENCY / EXAMINATION / PENDENCY TIME TO FIRST OFFICE ACTIONS

For the EPO, this is the average time period, in months, measured from filing at the EPO to issue of the first communication in examination. The search report that is sent to the applicant is accompanied by an opinion on patentability. As long as the applicant then makes a request for examination, this opinion is then resent as the first communication in examination. The pendency first office action is the average time measured from the filing at the EPO to the issue of this first communication in examination.

For the JPO, pendency first office action is the average time period, in months, from the request for examination to first office action in examination.

For the KIPO, pendency first office action is the average time period, in months, from the request for examination to first office action in examination.

For the SIPO, pendency first office action is the average time period, in months, from when applications entered the substantive examination phase following the request for examination to first office action in examination.

For the USPTO, pendency first office action is the average amount of time, in months, from filing to First office Action On Merits (FAOM). A FAOM is generally defined as the first time an examiner either formally rejects or allows the claims in a patent application.

Table 4 - PENDENCY / EXAMINATION / PENDENCY TIME IN EXAMINATION

For the EPO, the counts relate to pendency until dispatch of the decisions. This is the number of pending applications in examination as of the end of the reporting year, divided by the average monthly number of disposals (decisions to grant or refuse, withdrawals, abandonments) during the reporting year.

For the JPO and the KIPO, pendencies for examination in months are the total number of months taken for disposing applications as final actions (decisions to grant or to refuse, withdrawals or abandonments) in the reporting year, divided by the number of final actions during the reporting year.

For the SIPO, pendency for examination refers to the average time period taken, in months, for disposing applications, calculated from the date on which the applications enter the substantive examination phase to the date on which the final actions (decisions to grant or of rejection, withdrawals, or abandonments) are issued.

For the USPTO, pendency examination in months is calculated by measuring the time from filing to abandonment or issue for all applications that are abandoned or issued during a three month period. The average of these times is the pendency in months. This number includes plant patents and reissue patents in addition to utility patents (see comment above at TABLE 4 - GRANT RATE).

Table 4 - PENDENCY OPPOSITION

This is only reported for the EPO.

Number of pending applications is the number of patents against which one or more oppositions have been filed and for which no decision has been taken by the end of the reporting year.

Pendency time in opposition is the number of pending applications in opposition at the end of the reporting year, divided by the average number of disposals in opposition per month in the reporting year.

Table 4 - PENDENCY INVALIDATION

This is only reported for the SIPO.

“Pendency time in invalidation” refers to the duration from the date on which the notification of acceptance of request for invalidation is issued to the date on which the examination decision on request for invalidation is issued.