

e-Seminars



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STN[®]: Is that Patent Still Valid?
Finding Patent Expirations
and Extensions

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Today's presenters are...



John
Zabitski



Steve
Dueball



Kathy
Schmidt

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Goals for this seminar include...

- Defining normal patent terms
- Identifying common causes for patent extensions
- Exploring sources of expiration and extension information on STN

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Why should I care about finding expirations and extensions?

- Knowing if a certain patent is still in-force affects many business decisions including determining Freedom-to-Operate
- There are many events and legal situations that affect the standard term of patent documents

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The term for US patents is subject to change

- Standard term changed on June 8, 1995
 - 17 years from grant before that date
 - 20 years from filing on or after that date
 - Change in term referred to as GATT Extensions
- Extensions provide for delays
 - Within the patent office
 - Outside the patent office
- Standard terms may be shortened by
 - Terminal disclaimers
 - Failure to pay maintenance fees

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US patents may be extended due to delays within the USPTO

- **Patent Term Extension (PTE)** provides for a delay up to 5 years if patent is
 - Filed between June 8, 1995 and May 29, 2000
 - Delayed due to interference, secrecy orders, or for appellate review
- **Patent Term Adjustment (PTA)** as described by 35 USC 154(b)
 - For patents filed after May 29, 2000
 - American Inventors Protection Act extends term to recover processing delays
- Patents filed before June 8, 1995 and design patents are not eligible for PTA

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35 USC 156 provides for regulatory delays

- **Hatch-Waxman Act** (1984) added two major adjustments for pharmaceuticals
 - Restored time lost while awaiting approval from regulatory agencies
 - Provided for early drug testing without infringement for the purpose of an Abbreviated New Drug Application (ANDA) which allows for more rapid approval of generics
 - The first generic to file ANDA has 180 days of generic exclusivity
- Maximum extension of 5 years after 9/9/84

The normal patent term may also be shortened

- Filing a **Terminal Disclaimer** by applicant disclaims entire term or portion of the term
- Patent expires if **maintenance fees** are not paid
 - Due by 4, 8, and 12 years
 - Expired patent may be reinstated for unavoidable or unintentional delay
- Term may also be shortened due to interference or withdrawal

Standard expiration is 20 years for European patents (EPO)

- Extensions
 - Supplementary Protection Certificate (SPC)
 - Complementary Protection Certificate (CPC)
- Reduction in term results from
 - Opposition from third party
 - Lapse or withdrawal

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SPCs provide additional protection after European patent (EP) has expired

- Began in 1993 for European countries
- SPCs provide protection beyond expiration but do not extend term of patent
- Must be applied for separately in each desired country
- Some countries (most notably France and Italy) have national systems that predate 1993
 - Both countries have issued Complementary Certificates of Protection (CCP)

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Several files cover extensions

- FRANCEPAT for SPCs
- IFICLS/IFIPAT/IFICDB/IFIUDB for US patents
- IMSPATENTS for drug patents
- INPADOC for several authorities including SPCs
- PATDPA/PATDPASPC for German patents

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Several STN files provide information on expirations

- Single-authority files include
 - IFI files for U.S. patents
 - EPFULL for European patents
 - FRANCEPAT for French patents
 - PATDPA/PATDPASPC for German patents
- INPADOC covers legal status for 47 authorities
- IMSPATENTS covers drug patents from many authorities

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There are several files that provide anticipated expiration dates

- Several STN files have Expiration Date (/XPD) and Expiration Year (/XPY) fields
 - IFIPAT/CDB/UDB provide calculated standard expiration dates for US patents
 - IMSPATENTS (DRUGPAT) provides standard expiration (expiry) information for many authorities
- IFICLS provides adjusted expiration date information for US granted patents

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IFI files supply searchable expiration date fields

- Use Expiration Date (/XPD) to search a specific date or a range of dates using an eight-digit format
 - E.g., => S 20060601-20061231/XPD
- Use Expiration Year (/XPY) to search years in a four-digit format
 - E.g., => S XPY>2006

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Use the Expiration Year (/XPY) field to find patents due to expire

```
=> S MERCK/PA,PPA AND XPY=2007  
L1 199 MERCK/PA,PPA AND XPY=2007
```

PPA is the Probable Patent Assignee field.

```
=> D STD XPD
```

```
L1 ANSWER 1 OF 199 IFIPAT COPYRIGHT 2006 IFI on STN  
AN 02381414 IFIPAT;IFIUDB;IFICDB  
TI PILL CONTAINER  
IN Bunin Leo  
PA Merck & Co Inc (54136)  
PI US 337725 S1 19930727  
AI US 1991-706460 19910528  
FI US 337725 19930727  
DT Design  
FS DESIGN  
GRANTED  
MRN 006537 MFN: 0262  
NCL NCLM: D03203300  
NCLS: D09416000  
XPD 27 Jul 2007
```

Design patents have a 14 year term and are not subject to extensions.

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IFI files cover adjustments to standard expiration dates

- Document Type (DT) field shows status flags including expired, extended, and reinstated
 - 35 USC 156 extensions
 - Consult IFICLS for further details
- Note (NTE) field includes
 - Extension term notices under 35 USC 154(b)
 - Terminal disclaimers

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IFI files include EXTENDED flag in Document Type (DT) field

```
L52 ANSWER 2 OF 409 IFIPAT COPYRIGHT 2006 IFI on STN
AN 03115950 IFIPAT;IFIUDB;IFICDB
TI ANTIOXIDANT AROMATIC FLUOROPHOSPHITES; STABILIZER FOR ORGANIC
   COMPOUNDS
INF Burton; Lester P. J., Wilmington, DE
IN Burton Lester P J
PAF Albemarle Corporation, Richmond, VA
PA Albemarle Corp (33638)
EXNAM Daus, Donald G
AG Connolly + Hutz
PI US 36128 E1 19990302
   US 4912155 E1 19900327 ORIGINAL PATENT
AI US 1991-714441 19910613
   US 1987-20023 19870227 ORIGINAL APPLICATION
DCD 19 Sep 2006
FI US 36128 19990302
   US 4912155 19900327
DT Reissue; EXTENDED
FS CHEMICAL
   GRANTED
MRN 007109 MFN: 0340
CLMN 30
```

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USC 154(b) PTAs display in NTE field

```
=> D STD XPD NTE
L3 ANSWER 15 OF 57359 IFIPAT COPYRIGHT 2006 IFI on STN
AN 04405277 IFIPAT;IFIUDB;IFICDB
TI BIOABSORBABLE WOUND DRESSING
IN Ambrosio Archel A; Greene Sharon L; Malik Sohail; Matthews Kaylor
   Rosann
   M; Soerens Dave A
PA Kimberly-Clark Worldwide Inc (42059)
PI US 7041868 B2 20060509
   US 2002111576 A1 20020815
AI US 2001-26292 20011219
PRAI US 2000-259120P 20001229 (Provisional)
FI US 7041868 20060509
DT Utility; Granted Patent - Utility, with Pre-Grant Publication
FS CHEMICAL MECHANICAL
   CHEMICAL
   MECHANICAL
   GRANTED
NCL NCLM: 602048000
   NCLS: 424444000
   [08]
IC ICM: A61F0005-00
   ICS: A61L0015-16
XPD 19 Dec 2021
NTE Subject to any Disclaimer, the term of this patent is extended
   or adjusted under 35 USC 154(b) by 764 days.
```

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Terminal Disclaimers appear in NTE

```
=> D STD XPD NTE
ANSWER 1 OF 1 IFIUDB COPYRIGHT 2006 IFI on STN
AN 04078134 IFIPAT;IFIUDB;IFICDB
TI ADJUSTABLE WIDTH DISPLAY RACK
IN Nagel Thomas O
PA Trion Industries Inc (43831)
PI US 6745906 B1 20040608
AI US 2002-219800 20020816
RLI US 2001-24153 20011217 CONTINUATION-IN-PART 6719152
FI US 6745906 20040608
US 6719152
DT Utility; DISCLAIMER/DEDICATION; Granted Patent - Utility, no Pre-
Grant
Publication
FS MECHANICAL
GRANTED
MRN 013294 MFN: 0186
INCL INCLM: 211059300
NCL NCLM: 211059300
[07]
IC ICM: A47F0007-00
XPD 17 Dec 2021
NTE Subject to any Disclaimer, the term of this patent is
extended or adjusted under 35 USC 154(b) by 18 days.
This Patent is subject to a Terminal Disclaimer.
```

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IFICLS covers...

- **Granted US Patents** extended beyond their normal 17 or 20 year term, expired patents, and reinstated patents
- Detailed extension, expiration, and reinstatement records including
 - Patent number
 - Patent assignee
 - Expiration, extension, or reinstatement date
- Publication date of the *Official Gazette* of the USPTO containing the announcement of action

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IFICLS covers premature expirations and reinstatements

- Premature expirations occur due to failure to pay maintenance fees
 - All maintenance fee expirations are included from September 1985 forward
 - Flagged as **EXPIRED** in DT field
 - Search Expiration Date (/XPD) and date of appearance as Expiration Date Gazette (/XPG)
- Expired patents may be reinstated with acceptance of late fee payment
 - Flagged as **REINSTATED** in DT field
 - Search Reinstatement Date (/RID) and Reinstatement Date Gazette (/RIG)

EXPAND to identify document types

```

=> E EX/DT
E1      3401      DD/DT
E2      3401      DISCLAIMER/DEDICATION/DT
E3      0        --> EX/DT
E4      788497    EXPIRED/DT
E5      408      EXTENDED/DT
E6      1644842   P/DT
E7      1644842   PATENT/DT
E8      856075    REASSIGNED/DT
E9      6833      REEXAMINATION REQUESTED/DT
E10     4926      REEXAMINED/DT
E11     16202     REINSTATED/DT
E12     12727     REISSUE REQUESTED/DT

=> E
E13     12727     RER/DT
E14     16202     RI/DT
E15     6833      RR/DT
E16     856075    RS/DT
E17     4926      RX/DT
E18     788497    XP/DT
E19     408      XT/DT
**** END OF FIELD ****
    
```

Abbreviated document type codes are available:

RI = REINSTATED
XP = EXPIRED
XT=EXTENDED

IFICLS has extension details and trade name identification

=> D L16 9 ALL

L16 ANSWER 9 OF 220 IFICLS COPYRIGHT 2006 IFI on STN

AN 2308836 IFICLS

PA Pfizer Inc

PI US 5164402 19921117

DT EXTENDED

XTD 20001231 (761 days) XTG: 20001231

ORIG. EXPIRATION DATE: 20091117, NEW EXPIRATION DATE:
20111218

TN Trovan

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IFICLS provides details on terminal disclaimers

ANSWER 1 OF 1 IFICLS COPYRIGHT 2006 IFI on STN

AN 4078134 IFICLS

PA Trion Industries Inc

PI US 6745906 20040608

DT DISCLAIMER/DEDICATION

DDI DDD: 20040527 DDG: 20041005

DDTX: The term of this patent shall not extend
beyond the expiration date of Pat. No. 6,719,152.

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IFICLS fields include date of action plus publication date in the *Official Gazette*

Field Name	Search	Example	Display
<i>Official Gazette</i> Issue Date with Expiration Announcement	/XPG	S XPG>19970901	XPG
<i>Official Gazette</i> Issue Date with Extension Announcement	/XTG	S XTG>19950900	XTG
<i>Official Gazette</i> Issue Date with Reinstatement	/RIG	S RIG>=19971123	RIG
Reinstatement Date	/RID	S RID>19930500	RID

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Summary for US patents

- Use IFIPAT/IFICDB for
 - Calculated expiration dates in XPD field
 - Expired flag in Document Type (DT) field
 - Extended flag in DT for USC 156 extensions
 - USC 154(b) extension terms in Note (NTE) field
 - Terminal disclaimer flags in NTE
- Use IFICLS for details on
 - Expiration dates and reinstatement dates
 - USC 156 patent term extensions
 - Terminal disclaimer details

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INPADOC covers legal status information from 47 authorities

- Legal status events may be searched by
 - Code, in [Legal Status Code \(/LSC\)](#)
 - Text description, in [Legal Status Text \(/LSTX\)](#)
- Legal status descriptions are labeled with a plus (+) for positive events and a minus (–) for negative events
- Search POSITIVE/LSCI or NEGATIVE/LSCI in the [Legal Status Indicator \(/LSCI\)](#) field

Find legal status information for Merck patents

Search Question:

Identify expired patents assigned to Merck

- What expiration information is available for US, EP, and CA patents?
- Are there any extensions or SPCs?
- How many patents have been withdrawn?
- Have any oppositions been filed?
- Identify any French SPCs

Search Strategy

To find legal status events for a patent assignee

- Step 1. EXPAND and search on patent assignee name in both /PA and the Patent Assignee Standardized (/PAS) fields when available
- Step 2. EXPAND and search on legal status events
- Step 3. Combine both searches and display results using format containing Legal Status (LS)
- Step 4. Extend the search to other files

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Identify Patent Assignee and Patent Assignee Standardized

```
=> FILE INPADOC
=> E MERCK/PA 5
E1          1      MERCJ/PA
E2          1      MERCJ PATENT GESELLSCHAFT,DE/PA
E3          62239 --> MERCCK/PA
E4          1      MERCK CO.,INC/PA
E5          6      MERCK CO INC/PA

=> E MERCK/PAS 5
E1          1      MERCJ/PAS
E2          1      MERCJ PATENT GES/PAS
E3          62780 --> MERCCK/PAS
E4          66     MERCK & AMP/PAS
E5          24     MERCK & AMP CO INC/PAS

=> S MERCK/PA,PAS
          62239 MERCCK/PA
          62780 MERCCK/PAS
L1        62807 MERCCK/PA,PAS
```

Individual terms from patent assignee names are double-posted for easier searching.

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Expand in Legal Status Text (/LSTX) field to identify events

=> E EXPIR/LSTX

```

E1      279      EXISTENCE/LSTX
E2      71      EXPEDITION/LSTX
E3      0  -->  EXPIR/LSTX
E4      610780  EXPIRATION/LSTX
E5      910648  EXPIRED/LSTX
E6      99947   EXPIRY/LSTX
E7      5622   EXPLOITATION/LSTX
E8      55     EXTEND/LSTX
E9      642   EXTENDED/LSTX
E10    627897  EXTENSION/LSTX
E11    206   EXTENSIONS/LSTX
E12    174   EXTINGUISHMENT/LSTX
    
```

Several terms appear in the LSTX field that describe expirations and extensions.

=> S L1 AND E4-E6

```

          610780 EXPIRATION/LSTX
          910648 EXPIRED/LSTX
          99947  EXPIRY/LSTX
L2      6514 L1 AND (EXPIRATION/LSTX OR EXPIRED/LSTX OR
          EXPIRY/LSTX)
    
```

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Display Legal Status (LS) to find Legal Status Code (LSC)

=> D LS

```

L2      ANSWER 1 OF 6514  INPADOC  COPYRIGHT 2006

LEGAL STATUS
AN      281211895  INPADOC
20050901  WOAK      + DESIGNATED STATES
                    WO
                    A2
                    AE AG AL AM AT AU AZ BA BB BG BR BW BY BZ CA CH CN CO CR CU
                    CZ DE DK DM DZ EC EE EG ES FI GB GD GE GH GM HR HU ID IL IN
                    IS JP KE KG KP KR KZ LC LK LR LS LT LU LV MA MD MG MK MN MW
                    MX MZ NA NI NO NZ OM PG PH PL PT RO RU SC SD SE SG SK SL SY
                    TJ TM TN TR TT TZ UA UG US UZ VC VN YU ZA ZM ZW
                    .....20050916
20050901  WOAL      + DESIGNATED COUNTRIES FOR REGIONAL PATENTS
                    WO
                    A2
                    GM KE LS MW MZ NA SD SL SE TZ UG ZM ZW AM AZ BY KG KZ MD RU
                    TJ TM AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE IS IT
                    LT LU MC NL PL PT RO SE SI SK TR BF BJ CF CG CI CM GA GN GQ
                    GW ML MR NE SN TD TG
                    .....20050916
20050929  WODPEN    REQUEST FOR PRELIMINARY EXAMINATION FILED PRIOR TO
                    EXPIRATION OF 19TH MONTH FROM PRIORITY DATE (PCT
                    APPLICATION FILED FROM 20040101)
                    .....20060126
    
```

The term EXPIRATION describes a standard patent prosecution event for WO patents.

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Eliminate standard requests for preliminary examination

```
=> E WODPEN/LSC
E1 553625 WODFPE/LSC
E2 553625 WODFPE REQUEST FOR PRELIMINARY EXAMINATION FILED PRIO/LSC
E3 22169 --> WODPEN/LSC
E4 22169 WODPEN REQUEST FOR PRELIMINARY EXAMINATION FILED PRIO/LSC
E5 6 WOEF/LSC
E6 6 WOEF FR: CONVERSION TO FRENCH PATENT APPLICATION/LSC
E7 10 WOEFNL/LSC
E8 10 WOEFNL NL: LAYING OPEN TO PUBLIC INSPECTION OF TRANSL/LSC
E9 360 WOEL/LSC
E10 360 WOEL FR: TRANSLATION OF CLAIMS FILED/LSC
E11 1 WOEM/LSC
E12 1 WOEM FR: REVISED TRANSLATION OF CLAIMS FILED/LSC

=> S L2 NOT (WODPEN OR WODFPE) /LSC
22169 WODPEN/LSC
553625 WODFPE/LSC
L3 3375 L2 NOT (WODPEN OR WODFPE) /LSC
```

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Display complete record including legal status using MAX format

```
=> D MAX 2
L3 ANSWER 2 OF 3375 INPADOC COPYRIGHT 2006 EPO on STN
LEVEL 1
AN 170534695 INPADOC ED 20020325 EW 200212 UP 20020325 UW 200212
TI PERFLUORO-N-ALKYLSULFONIC ACID DERIVATIVES.
IN WAECHTLER ANDREAS; DERWENSKUS KARL-HEINZ; MEUDT ANDREAS
INS WAECHTLER ANDREAS; DERWENSKUS KARL-HEINZ; MEUDT ANDREAS
INA DE; DE; DE
PA MERCK PATENT GMBH
PAS MERCK PATENT GMBH
PAA DE
DT Patent
PIT USBA PATENT (NO PREVIOUS PRE-GRANT PUBLICATION)
PI US 6353125 BA 20020305
AI US 2000-600295 A 20000925
PRAI DE 1998-19801248 A 19980115 (EDPR 19990729)
WO 1999-EP119 W 19990111 (EDPR 20001107)
AIT USA patent application
PRAIT DEA patent application
WOW international application number
ICM (7) C07C0303-00
ICS (7) C07C0305-00; (7) C07F0009-50
IPCR C07C0309-65 [I,A]; C07F0009-50 [I,A]
C07C0309-00 [I,C*]; C07F0009-00 [I,C*]
EPC C07C309/65; C07F9/50Z4F; C07F9/50Z4H
NCL 558 54; X568 8; X568 17
AB Described are bis(perfluoro-n-alkane-sulfonate) compounds, methods for
preparing these compounds and use of these compounds, for example as...
```

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Legal status is included in MAX

LEGAL STATUS
 AN 170534695 INPADOC
 20000925 USAS ASSIGNMENT
 MERCK PATENT GMBH FRANKFURTER STRASSE 250 D-64293
 ASSIGNMENT OF ASSIGNORS INTEREST;ASSIGNORS:WACHTLER,
 ANDREAS;DERWENSKUS, KARL-HEINZ;MEUDT, ANDREAS;
 REEL/FRAME:011109/0137
 20000712
20040722
 20060502 USFP - EXPIRED DUE TO FAILURE TO PAY MAINTENANCE FEE
 20060305
20060504

This record shows a premature expiration for U. S patents.

Remove US records and ANALYZE to find additional countries

```
=> S L3 AND USFP/LSC
      801352 USFP/LSC
L4    2752 L3 AND USFP/LSC

=> S L3 NOT L4
L5    623 L3 NOT L4

=> ANA L5 LSC 1- ; D
```

TERM #	# OCC	# DOC	% DOC	LSC
1	386	88	14.13	EPREG
2	217	88	14.13	EPAK
3	143	143	22.95	CAMKEX
4	143	142	22.79	GBPE20
5	138	88	14.13	EPREF
6	88	88	14.13	EP17P
7	82	82	13.16	CHPL
8	76	76	12.20	EPET
9	69	69	11.08	EP26N
10	67	67	10.75	EPITF

Legal status codes start with the ISO 2-digit country code.

Explore codes relating to EP patents

```

=> E EPAK/LSC
E1      1      EPAF/LSC
E2      1      EPAF SUCCESSIVE APPLICATION (ART. 61)/LSC
E3      1652225 --> EPAK/LSC
E4      1652225 EPAK DESIGNATED CONTRACTING STATES:/LSC
E5      15      EPAKNL/LSC
E6      15      EPAKNL NL: CORRECTIONS (PART 1 HEADING G)/LSC
E7      313994 EPAKX/LSC
E8      313994 EPAKX PAYMENT OF DESIGNATION FEES/LSC
E9      603571 EPAX/LSC
E10     603571 EPAX EXTENSION OF THE EUROPEAN PATENT TO/LSC
E11     9094   EPAXX/LSC
E12     9094   EPAXX PAYMENT OF EXTENSION FEES/LSC

=> E
E13     5647   EPBE20/LSC
E14     5647   EPBE20 BE: PATENT EXPIRED/LSC
E15     4694   EPBECA/LSC
E16     4694   EPBECA BE: CHANGE OF HOLDER'S ADDRESS/LSC
E17     3776   EPBECH/LSC
E18     3776   EPBECH BE: CHANGE OF HOLDER/LSC
E19     3517   EPBECN/LSC
E20     3517   EPBECN BE: CHANGE OF HOLDER'S NAME/LSC
E21     161518 EPBERE/LSC
E22     161518 EPBERE BE: LAPSED/LSC
E23     137    EPBERR/LSC
E24     137    EPBERR BE: REESTABLISHED/LSC
    
```

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Explore codes relating to EP patents

```

=> S L1 AND EPAX/LSC
603571 EPAX/LSC
L7      2007 L1 AND EPAX/LSC
    
```

This code describes a standard event designating extension states.

```

=> D LS
    
```

```

L7      ANSWER 1 OF 2007 INPADOC COPYRIGHT 2006 EPO on STN
    
```

LEGAL STATUS

```

AN      300575171 INPADOC
20060510 EPAK + DESIGNATED CONTRACTING STATES:
           EP                A2
           AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE
           IT LI LU MC NL PL PT RO SE SI SK TR
           .....20060512
20060510 EPAX + EXTENSION OF THE EUROPEAN PATENT TO
           LT LV
           .....20060512
20060510 EP17P + REQUEST FOR EXAMINATION FILED
           20060308
           .....20060512
    
```

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EP codes point to expired patents

```

=> S L1 AND EPBE20/LSC
      5647 EPBE20/LSC
L8      40 L1 AND EPBE20/LSC

=> D TI PA PI AI PRAI LS

L2      ANSWER 1 OF 40 INPADOC COPYRIGHT 2006 EPO on STN
TI      SUCRALFATE SUSPENSION .
PA      MERCK PATENT GESELLSCHAFT MIT BESCHRANKTER HAFTUNG
PI      EP 192640          B1 19890315
AI      EP 1984-903631    A 19840922
PRAI    DE 1984-3430809  A 19840822
      WO 1984-EP294      W 19840922

LEGAL STATUS
AN      5356979 INPADOC
19860903 EPAK      + DESIGNATED CONTRACTING STATES:
      EP          A1
      AT BE CH DE FR GB LI NL SE
19860910 EP17P    + REQUEST FOR EXAMINATION FILED
      19860715
19880629 EP17Q    + FIRST EXAMINATION REPORT
      19880516
19890315 EPAK      + DESIGNATED CONTRACTING STATES:
      EP          B1
      AT BE CH DE FR GB LI NL SE
  
```

This record shows a normal EP expiration 20 years after filing.

EP codes point to expired patents

```

19890315 EPREF    CORRESPONDS TO:
      AT 41308          T 198904
19890412 EPGBT    + GB: TRANSLATION OF EP PATENT F
      77 (6) (A)/1977)
19890420 EPREF    CORRESPONDS TO:
      DE 3477138          19890420 P
19890526 EPET    + FR: TRANSLATION FILED
19900321 EP26N    + NO OPPOSITION FILED
19950131 EPEAL    + SE: EUROPEAN PATENT IN FORCE IN SWEDEN
      EP 84903631.4          F
20020101 EPREG    REFERENCE TO A NATIONAL CODE
      GBIF02      + GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
20040930 EPBE20-BE: PATENT EXPIRED
      *MERCK PATENT G.M.B.H.
      20040922
      .....20050304
20041013 EPREG    REFERENCE TO A NATIONAL CODE
      GBPE20      - GB: PATENT EXPIRED AFTER TERMINATION OF 20 YEARS
      .....20041014
20041029 EPREG    REFERENCE TO A NATIONAL CODE
      CHPL        - CH: PATENT CEASED
      .....20041104
20041102 EPEUG    - SE: EUROPEAN PATENT HAS LAPSED
      .....20041111
20041201 EPNLV7  - NL: LAPSED BECAUSE OF REACHING THE MAXIM LIFETIME OF A
      PATENT
      20040922
      .....20041209
  
```

This record shows a normal EP expiration 20 years after filing.

Display codes relating to Canada

```

=> D WITH "CA"
L6          ANALYZE L5 1- LSC :      156 TERMS

TERM #    # OCC  # DOC  % DOC LSC
-----
      3      143   143  22.95 CAMKEX
     84       3     3   0.48 CAMKEC
     86       3     3   0.48 EPTCAT

=> E CAMKEC/LSC
E1      115045     CAFZDE/LSC
E2      115045     CAFZDE DEAD/LSC
E3      4604  --> CAMKEC/LSC
E4      4604     CAMKEC EXPIRY (CORRECTION)/LSC
E5      97336     CAMKEX/LSC
E6      97336     CAMKEX EXPIRY/LSC
E7      68423     CAMKLA/LSC
E8      68423     CAMKLA LAPSED/LSC
E9        94     CAMKLC/LSC
E10     94     CAMKLC LAPSED (CORRECTION)/LSC
E11     166     CAMZSU/LSC
E12     166     CAMZSU SURRENDER/LSC
    
```

Use SELECT to extract codes relating to Canada

```

=> S L5 AND (E3 OR E5)
      97336 CAMKEX/LSC
      4604 CAMKEC/LSC
L9      143 L5 AND (CAMKEX/LSC OR CAMKEC/LSC)

=> D LS

L9      ANSWER 1 OF 143  INPADOC  COPYRIGHT 2006 EPO on STN

LEGAL STATUS
AN      26615297 INPADOC
20050524 CAMKEX-EXPIRY
.....20051202
    
```

EXPAND to find codes for Extension

```

=> E EXTEND/LSTX
E1      99947      EXPIRY/LSTX
E2      5622      EXPLOITATION/LSTX
E3      55  -->  EXTEND/LSTX
E4      642      EXTENDED/LSTX
E5      627897    EXTENSION/LSTX
E6      206      EXTENSIONS/LSTX
E7      174      EXTINGUISHMENT/LSTX
E8      17574    F/LSTX
E9      1        FAILED/LSTX
E10     938641   FAILURE/LSTX
E11     189     FAULTY/LSTX
E12     4887    FAVOURABLY/LSTX
    
```

EXTINGUISHMENT
applies to Brazilian
patents.

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Identify countries from the Legal Status display

```

=> S E3
L10     55  EXTEND/LSTX
=> D L10 LS
    
```

Records with EXTEND refer
to IL patents.

```

L10     ANSWER 1 OF 55  INPADOC  COPYRIGHT 2006 EPO on STN
LEGAL STATUS
AN      142073124  INPADOC
20050725  ILPEL  + INTENSION OF COMMISSIONER TO EXTEND PERIOD OF
PROTECTION
    
```

.....20050908

```

=> S EXTENSIONS/LSTX
L15     206  EXTENSIONS/LSTX
=> D LS
    
```

Records with EXTENSIONS
refer to AU patents.

```

L15     ANSWER 1 OF 206  INPADOC  COPYRIGHT 2006 EPO on STN
LEGAL STATUS
AN      142236113  INPADOC
20000203  AUNB  APPLICATIONS ALLOWED - EXTENSIONS OF TIME
SECTION 223 (2)
THE TIME IN WHICH TO CLAIM THE CONVENTION
PRIORITY DATE HAS BEEN EXTENDED TO 7 JUL 1999.
    
```

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Identify countries for "extended"

=> S EXTENDED/LSTX

Includes GB patents...

=> D LS 1 500

L16 ANSWER 1 OF 642 INPADOC COPYRIGHT 2006 EPO on STN

LEGAL STATUS

AN 277919924 INPADOC

20041229 GB710B PROCEEDING UNDER RULE 110(4) PATENTS ACT 1977 -
REQUEST OF ALTER TIME LIMITS

EXTENSION APPLICATION: APPLICATION FOR EXTENSION OF
THE PERIOD(S) PRESCRIBED BY RULE(S) 85(1), 85(7)
FILED ON 20041029.

.....20050728
20050525 GB9110 PERIOD PRESCRIBED HAS BEEN EXTENDED UNDER RULE
110(6)/1990

EXTENSION ALLOWED: PERIOD(S) PRESCRIBED BY RULE(S)
85(1), 85(7) EXTENDED UNDER RULE 110(6) IN
ACCORDANCE WITH THE DECISION OF THE COMPTROLLER
DATED 20050309.

L16 ANSWER 500 OF 642 INPADOC COPYRIGHT 2006 EPO on STN

LEGAL STATUS

AN 44345937 INPADOC

19920827 DDEPE - EXTENDED PATENT HAS CEASED

...and DD patents

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Identify withdrawn patents

=> E WITHDRAW/LSTX

E1 902323 WIPO/LSTX

E2 54436 WITH/LSTX

E3 0 --> WITHDRAW/LSTX

E4 149684 WITHDRAWAL/LSTX

E5 575810 WITHDRAWN/LSTX

E6 97080 WITHOUT/LSTX

E7 2 WITHRAWN/LSTX

E8 37 WRITTEN/LSTX

E9 2521 XE/LSTX

E10 3640 Y/LSTX

E11 2929 YEAR/LSTX

E12 67654 YEARS/LSTX

=> S L1 AND WITHDRAW?/LSTX

716572 WITHDRAW?/LSTX

L20 2941 L11 AND WITHDRAW?/LSTX

=> D LS

L20 ANSWER 1 OF 2941 INPADOC COPYRIGHT 2006 EPO on STN

LEGAL STATUS

AN 300401075 INPADOC

20050608 EP18D - DEEMED TO BE WITHDRAWN
20041201

.....20060512

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EPFULL versus INPADOC

- EPFULL contains EPO Patent Register Legal Status (LSEP) including Legal Status Codes (LSC) and Legal Status Text (LSTX)
- EPFULL may contain unique details beyond what is available in the INPADOC Patent Register Service (PRS)
- EPFULL has unique display formats
 - **LSEP** - EPO Patent Register Legal Status
 - **LSEP.M** - LSEP with detailed historical data

EPO legal status in EPFULL

```
=> FILE EPFULL
=> S MERCK/PA
L1      6837 MERCK/PA

=> S L1 AND (OPPOSITION (NOTL) NO)/LSTX
      725702 OPPOSITION/LSTX
      680065 NO/LSTX
      48440 (OPPOSITION (NOTL) NO)/LSTX
L2      99 L1 AND (OPPOSITION (NOTL) NO)/LSTX
```

This strategy looks for legal status text with the word OPPOSITION, but without the word NO.

Display legal status with full history using **LSEP.M**

=> D LSEP.M 2

L2 ANSWER 2 OF 99 EPFULL COPYRIGHT 2006 EPO/FIZ KA on STN

LEGAL STATUS INCLUDING HISTORY

```

AN      2001:96817  EPFULL
20020508 EPB430  Unexamined document without grant, (first publication)
                20020508
20020508 EPB840  Designated contracting states
                AT BE CH CY DE DK ES FI FR GB GR IE IT LI LU MC NL PT SE TR
                EP 1203794          A1 20020508
20020508 EPB844EP Extension of the European patent to
                AL LT LV MK RO SI
20030102 EPB241  Request for examination
                20021106
20030129 EPB840N Payment of designation fees
                AT BE CH CY DE DK ES FI FR GB GR IE IT LI LU MC NL PT SE TR
20041229 EPB452EP Intention to grant
                20040302
20041229 EPB450  Document with grant, second publication
                20041229
20041229 EPB840  Designated contracting states
                AT BE CH CY DE DK ES FI FR GB GR IE IT LI LU MC NL PT SE TR
                EP 1203794          B1 20041229
    
```

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LSEP.M format (cont)

```

20050615 EPB475  Lapse of patent
                FI: 20041229
20050629 EPB475  Lapse of patent
                GR: 20050329
20051116 EPB475  Lapse of patent
                IE: 20041229

.....20051116
20051207 EPB780  Opposition
                20050923 Admissible opposition
                Eckart GmbH & Co. KG

.....20051207
20060322 EPB475  Lapse of patent
                ES: 20050409

.....20060322
20060322 EPB475  Lapse of patent
                DK: 20050329

.....20060322
20060405 EPB475  Lapse of patent
                NL: 20041229

.....20060406
    
```

Admissible opposition
leads to lapse of patent.

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INPADOC has additional search fields for SPC information

Field Name	Field Code	Example	Display Code
Legal Status SPC Number	/LSSPC	S EU/1/00/137/011/LSSPC	LS
Legal Status SPC, Expiry Date	/LSSPC.XD	LSSPC.XD>2005	LS
Legal Status SPC, Extension Date	/LSSPC.EX	S 20100901/LSSPC.EX	LS
Legal Status SPC, Filing Date	/LSSPC.FD	S 19950101-19961231/LSSPC.FD	LS

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FRANCEPAT covers legal status from the French patent office (INPI)

- FRANCEPAT covers French applications, granted patents and utility models from 1966
- Pharmaceutical patents covered back to 1961
- INPI legal status from 1969 onwards including **SPCs**
- Includes titles, abstracts, and controlled terms in French, plus English controlled terms
- Updated weekly on day of publication

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FRANCEPAT includes SPCs

```
=> FILE FRANCEPAT
=> S MERCK/SPC.PA
L6          7 MERCK/SPC.PA
=> D BIB SPC
```

FRANCEPAT has a special field for the patent assignees with SPCs.

```
L6 ANSWER 1 OF 7 FRANCEPAT COPYRIGHT 2006 INPI on STN
AN 710284 FRANCEPAT ED 20031101 UP 20031101
TI Derives de 2-acyl-4-oxopyrazino-isoquinoleine et leur procede
de preparation.
PA Applicant: MERCK PATENT GMBH DE
PIT Patent
PI FR 2254343 A1 19750711 197528 Application, first publ.
FR 2254343 B1 19780630 197826 Patent, second publication
AI FR 1974-41356 19741216
PRAI DE 1973-2362539 19731217
FA AG AI ICM ICS LS PA PI PRAI SPC
SPC Applicant: MERCK PATENT GMBH
Application Date: 19920521 (CCP Francais)
Publication: FR92C0246 (CCP Francais)
Date of Publication: 19920904 (BOPI 199236)
Drug: PRAZIQUANTEL;DRONCIT SOLUTION
Drug Approval: 8844 19821112
Date of Grant: 19930108
Deadline of Validity 19991111
```

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PATDPASPC covers SPCs from the German Patent Office (DPMA)

- PATDPASPC covers SPCs from Germany from 1992 to date
- Compound-based records containing CAS Registry Numbers® (CAS RNs), chemical names, and trade names
- Updated with 60 new SPCs per year (no alerts (SDIs))

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Example: PATDPASPC record

L1	ANSWER 1 OF 1	PATDPASPC	COPYRIGHT 2006 DPMA on STN
Accession Number	827		
SPC Document Number	DE 10075027		} SPC information
SPC Product Type	medicinal		
SPC Term	20080205-20130204		
SPC Grant Date	20040121		
SPC Application Date	20000920		
Examiners field	1.43		
Patent Number	DE 3850789		} Patent information
Patent Application Date	19880204		
Int. Patent Classif.	C07K007-06 (6) C07K007-06 (7)		
Index Terms			} CAS RNs and chemical names
Certified Compound(s)			
Cas Registry No.	123246-29-7		
Chemical Name	Ganirelix		
Cas Registry No.	124904-93-4		
Chemical Name	Ganirelix		
Trade Name(s)	Orgalutran Injektionsloesung		
Legal Status			
Approved Compound(s)	Ganirelix		
SPC Requested Compound(s)	Ganirelix ; Salze		
SPC Granted Compound(s)	Ganirelix; Salze		

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IMSPATENTS contains patent data for commercially significant drugs

- Patent information includes
 - Patent numbers
 - Expirations
 - Extensions
 - Supplementary protection certificates (SPCs)
- Standard expiration dates
 - Display in Expiration Date (XPD) field
 - Search specific date or range of dates in /XPD
- Search extension#, SPC#, or CPC# in the basic index to find extensions

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Find extension information for Merck drugs

Search Question:

What drugs in patents assigned to Merck have extensions or SPCs?
Find non-US patents on beta blockers expected to expire from June 2006 to January 2007 and identify possible extensions.

IMSPATENTS includes SPCs

```

=> FILE IMSPATENTS

=> S MERCK/PA
L1      4239 MERCK/PA

=> S L1 AND (EXTENSION# OR SPC#)
        21106 EXTENSION#
        9943 SPC#
L2      1056 L1 AND (EXTENSION# OR SPC#)

=> D ALL

L2      ANSWER 1 OF 1056 IMSPATENTS  COPYRIGHT 2006 IMSWORLD on STN

AN      2006:5104 IMSPATENTS
SO      Patents International, (28 Apr 2006)
CN      Generic Name: timolol
CN      Trade Name: AQUAMIL; BETIM; BLOCADREN; CUSIMOLOL; MODUCREN;
        NYOLOL;
        TIMOLIDE; TIMOP; TIMOPTIC; TIMOPTOL
RN      26839-75-8
STR
    
```

Search extension terms in the basic index.

ALL display includes IDE and derivatives

Absolute stereochemistry. Rotation (-).
 RN Derivative(s): 26839-75-8 timolol
 60469-65-0 maleate
 26921-17-5 maleate (1:1)
 33305-95-2 maleate (2:1)
 33305-92-9 sulfate
 69267-58-9 hydrochloride
 79955-54-7 embonate (2:1)
 91524-16-2 hemihydrate
 115056-08-1 hemihydrate, mixt with ethoxzolamide
 115090-54-5 hemihydrate, mixt with acetazolamide
 126882-28-8 monohydrochloride, mixt with timolol
 73788-01-9 maleate (1:1), mixt amiloride monoHCl,
 hydrochlorothiazide
 74335-22-1 maleate (1:1), mixt with
 bendroflumethiazide
 116475-11-7 maleate (1:1), mixt with pilocarpine
 monohydrochloride
 116553-86-7 maleate (1:1), mixt with pilocarpine
 134845-42-4 maleate (1:1), mixt with bimakalim
 135821-06-6 maleate (1:1), mixt with SR 43845
 80513-00-4 mixt with amiloride and
 hydrochlorothiazide
 112268-09-4 mixt cont
 117682-02-7 mixt with saralasin
 128374-53-8 mixt with apraclonidine
 126882-27-7 monohydrochloride
 131628-37-0 replaced by 26839-75-8
 194288-09-0 replaced by 26839-75-8

CC C7A Beta Blockers, Plain
 APP hypertension
 PA Merck & Co (USA)
 ST Composition

Classification Code (CC)
 denotes therapeutic application.

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Details on SPCs display in TX field

	Number	Publication Date	Expiration Date
PI	LV 10388	19951020	20121230
	Number	Filing Date	Publication Date
AI	LV 1992-581	19921230	19941020
PRAI	US 1991-686718	19910417	
	US 1992-834913	19920213	
TX	Expiry Comments: SPC Granted		
	Country Comments: Latvian patent 10388 is a non-convention equivalent. A supplementary protection certificate (SPC) for the COSOPT formulation of dorzolamide hydrochloride with timolol maleate has been granted in Latvia citing Latvian patent 10388. The SPC expires on 15 December 2014 and comes into force on expiry of the cited patent.		
AB	The patent family listed here claims an ophthalmic composition for ocular hypertension and glaucoma comprising dorzolamide and timolol.		

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Refine search with Classification Code (/CC) and expiration date range

```

=> S L2 AND C7A/CC
      2193 C7A/CC
L3      56 L2 AND C7A/CC

=> S L3 NOT (US OR EP)/PC
      6293 US/PC
      50015 EP/PC
L4      27 L3 NOT (US OR EP)/PC

=> S L4 AND 20060901-20070101/XPD
      1265 20060901-20070101/XPD
          (20060901-20070101/XPD)
L5      7 L4 AND 20060901-20070101/XPD
  
```

Refine by CC and eliminate US and EP entries.

Search date range in Expiration Date (XPD) field.

Country Table (CYTAB) displays multi-country records

```

=> D CYTAB 1-
YOU HAVE REQUESTED DATA FROM
L5      File IMSPATENTS COPYRIGHT 2006 IMSWORLD
  
```

CAUTION: You are still charged the full display fee for each answer.

ANS	Country	Patent No.	Published Appln. No.	Expiry Date	Expiry Comments	NOTE
1	Latvia	LV 10388	LV 92-581	20121230	SPC Granted	(1)
2	Ireland	IE 82784	IE 92-1240	20120416	SPC Granted	(2)
3	Slovakia	SK 282039	SK 93-1103	20120409	SPC Granted	(3)
4	Japan	JP 05117167			Extensions possible	
	Japan	JP 2527513		20120417		
5	Israel	IL 101537		20120409	Extensions possible	(4)
6	Australia	AU 648659	AU 92-14979	20140811	Extended	(5)
7	Australia	AU 595240	AU 86-63189	20090128	Extended	(6)

Comments provide detailed information on extension/expirations

Country Comments:

- (1) Latvian patent 10388 is a non-convention equivalent. A [supplementary protection certificate \(SPC\)](#) for the COSOPT formulation of dorzolamide hydrochloride with timolol maleate has been granted in Latvia citing Latvian patent 10388. [The SPC expires on 15 December 2014 and comes into force on expiry of the cited patent.](#)
- (2) A [supplementary protection certificate \(SPC\)](#) has been granted for dorzolamide, in particular dorzolamide hydrochloride, in combination with timolol, in particular timolol maleate, in Ireland citing Irish patent 82784. [The certificate expires on 5 March 2013 and comes into force on expiry of the cited patent.](#)
- (3) From 1 January 1993 Czechoslovakia ceased to exist and has been separated into two nations, the Czech Republic and the Slovak Republic. Where Czechoslovakia is designated in PCT applications filed prior to 1 January 1993 those applications will be recognised in both the Czech and Slovak Republics. Slovak Republic patent 282039 is based on WO 92/18124 designating Czechoslovakia. [A supplementary protection certificate \(SPC\) has been granted for the combination of dorzolamide hydrochloride and timolol maleate in the Slovak Republic citing Slovak Republic patent 282039. The SPC expires on 10 July 2015 and comes into force on expiry of the cited patent.](#)

Comments (cont)

- (4) [From 26 February 1998 the duration of patents covering pharmaceuticals in Israel may be extended by up to five years.](#)
- (5) Under the Intellectual Property Laws Amendment Act 1998, which came into force on 27 January 1999, Australian patents covering pharmaceutical substances are now eligible for patent term extensions. [The term of Australian patent 648659 has been extended. The new expiry date is 11 August 2014 from 16 April 2012.](#) The extension relates to the COSOPT formulation of dorzolamide hydrochloride with timolol maleate.
- (6) Under the Intellectual Property Laws Amendment Act 1998, which came into force on 27 January 1999, Australian patents covering pharmaceutical substances are now eligible for patent term extensions. [The term of Australian patent 595240 has been extended. The new expiry date is 28 January 2009 from 26 September 2006.](#) The extension relates to the TIMOPTOL XE formulation of timolol maleate with gellan gum.

e-Seminars


Summary

- Several files on STN cover expirations and extensions
 - Use IFI files for expiration and extension information for US Patents
 - Use INPADOC for US and additional authorities
 - Use IMSPATENTS for drug patents
- Consider additional files when information for specific countries is desired

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e-Seminars

Questions and answers...



Date & Time	Event
July 2006	
July 25, 2006 1:00 pm- 2:00 pm EDT	STN: Finding Regulatory Compliance Information in CHEMLIST®
August 2006	
August 29, 2006 1:00 pm- 2:00 pm EDT	STN®: Maximizing your STN Fixed Fee Plan
September 2006	
September 26, 2006 1:00 pm- 2:00 pm EDT	STN®: Creating Superior Document Sets for STN® AnaVist
October 2006	
October 12, 2006 9:00 am- 10:00 am EDT	STN®: Creating Superior Document Sets for STN® AnaVist

<http://casevents.webex.com>

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