



Patenting your invention

Marina Moraiti Patent Examiner, Cluster Computers, EPO 2013 Athens, 27 November 2013 Heraklion, 28 November





Part II

- Introduction
- The grant procedure
- Filing a patent
- The search phase
- Substantive examination
- Post grant procedures
- The Unitary Patent
- Searching for prior art



Thorough and consistent procedures

Single procedure

 the European Patent Convention provides the legal framework for the granting of European patents

Systematic approach

each application is examined by a division of three technically qualified examiners

Review processes

- each opposition is examined by three technically qualified examiners, at least two of whom will not have been involved in the grant proceedings for the patent
- appeals heard by independent second-instance judiciary (Boards of Appeal)

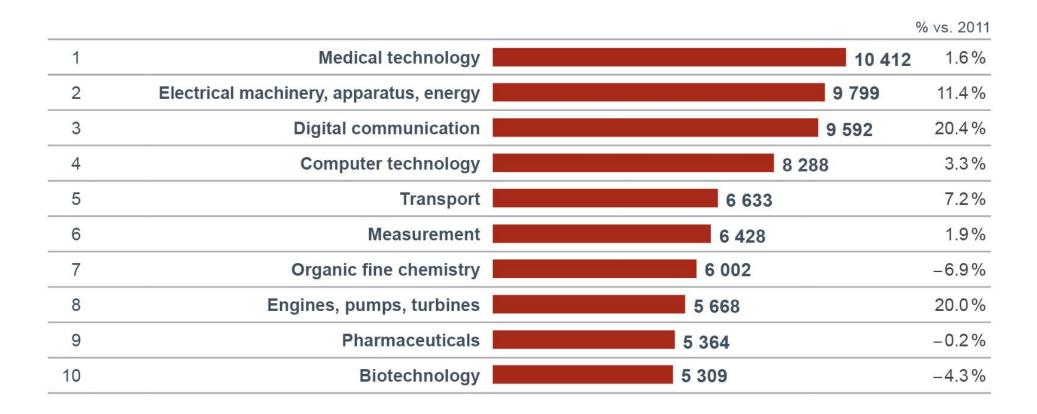


Comprehensive search documentation

- World's largest collection of patent and non-patent literature documents,
 containing more than 600 million records in over 120 databases and updated daily
- Online access to more than 7 000 journals via the EPO Virtual Library
- New tools and services such as machine translation to extend the range of easily accessible information
- Ongoing efforts to improve the scope and quality of our documentation



Technical fields¹ with the most applications (2012)²

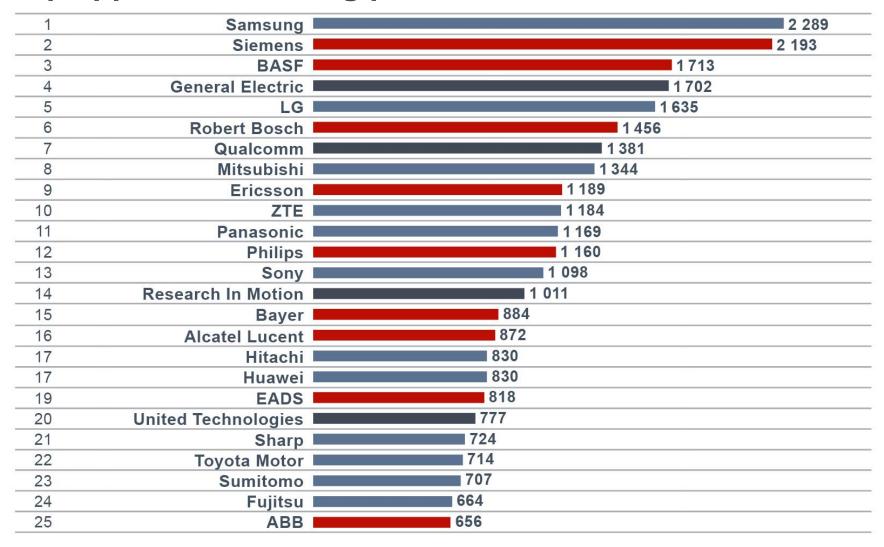


¹ Classified according to the IPC and technology concordance table compiled by the Fraunhofer ISI for WIPO

² Based on European patent applications filed with the EPO



Top applicants seeking protection with the EPO in 2012¹





Europe

North America

Asia

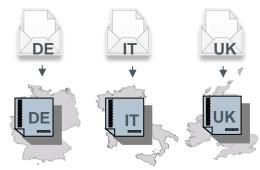


The options available

Routes towards patent protection in Europe

1. The national route

- separate procedure for each state
- procedures differ according to national law



3. via the international route - The PCT System

- > one application for 185 member states
- does not lead to patent until it has been
 "nationalised" through national offices or the EPO

2. The regional route - The European Patent Convention

- > one application filed at one office
- > **one** procedure
- > **one** European patent for up to **40** states
- results in a bundle of national patents



4. (The unitary patent, coming soon)

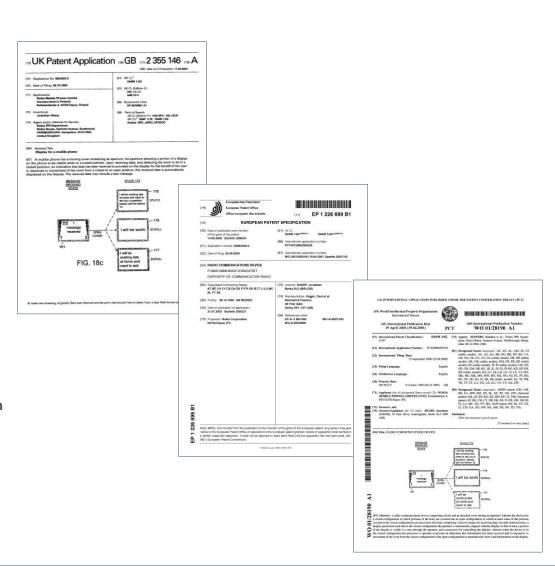


How to get a patent in Europe?

Patent applications can be filed:

- separately via national patent offices
 national patent valid only in the country where it is granted
- with the EPO
 - => single examination procedure
 - => a European patent is equivalent to national patents in the countries for which it is granted

as an international (PCT) application
 just one application for up to 143 countries
 after the initial application phase, the international application leads to multiple national patent examination procedures



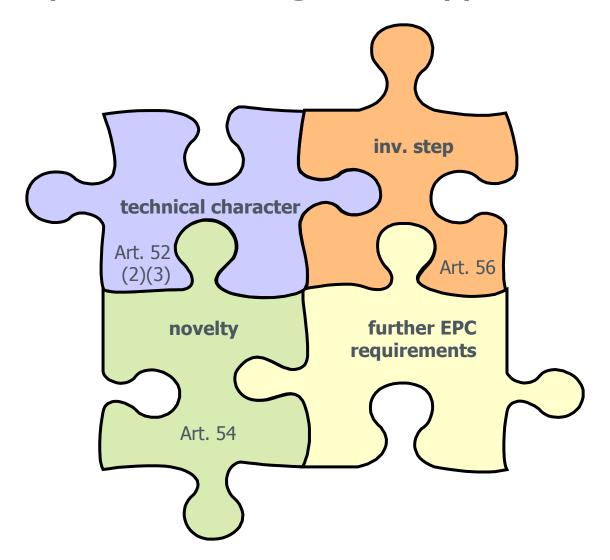


Contents

- Introduction
- The grant procedure
- Filing a patent
- The search phase
- Substantive examination
- Post grant procedures
- The unitary patent
- Searching for prior art

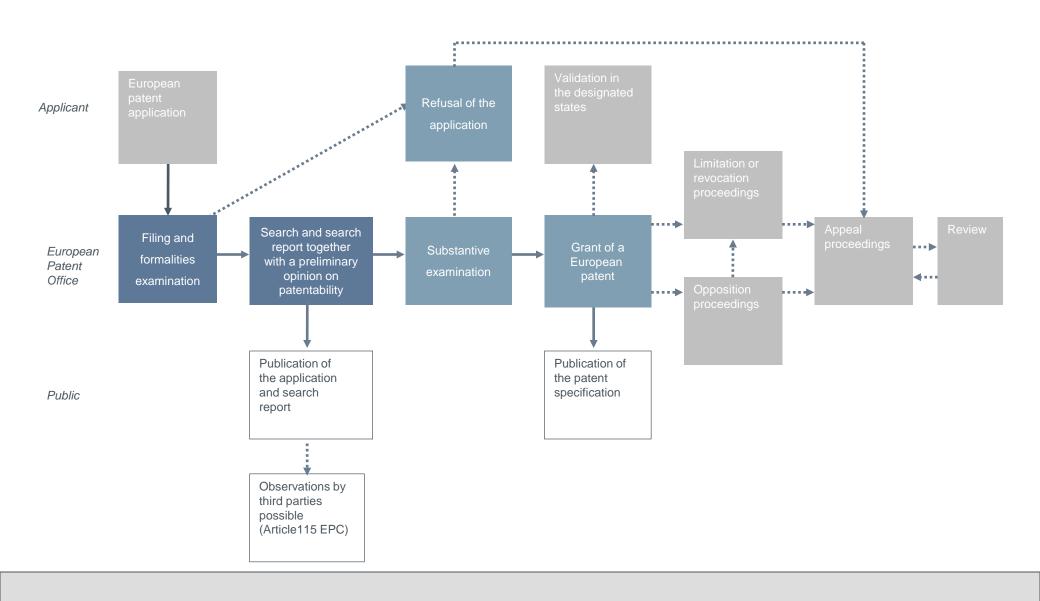


Basic components for the grant of applications





The grant procedure at a glance





Overview - grant procedure

The procedure begins when an application for a European patent is filed with the EPO. During this **filing phase**:

- a date of filing is assigned
- formal requirements are checked

Once the application complies with the filing requirements, it enters the **search phase**, where:

- a search for prior art is performed
- a search report and a written opinion are issued

In the **examination phase** all the substantive issues relating to the application are assessed and the contents of the application are shaped into a form in which the patent can be granted ... or the application refused.



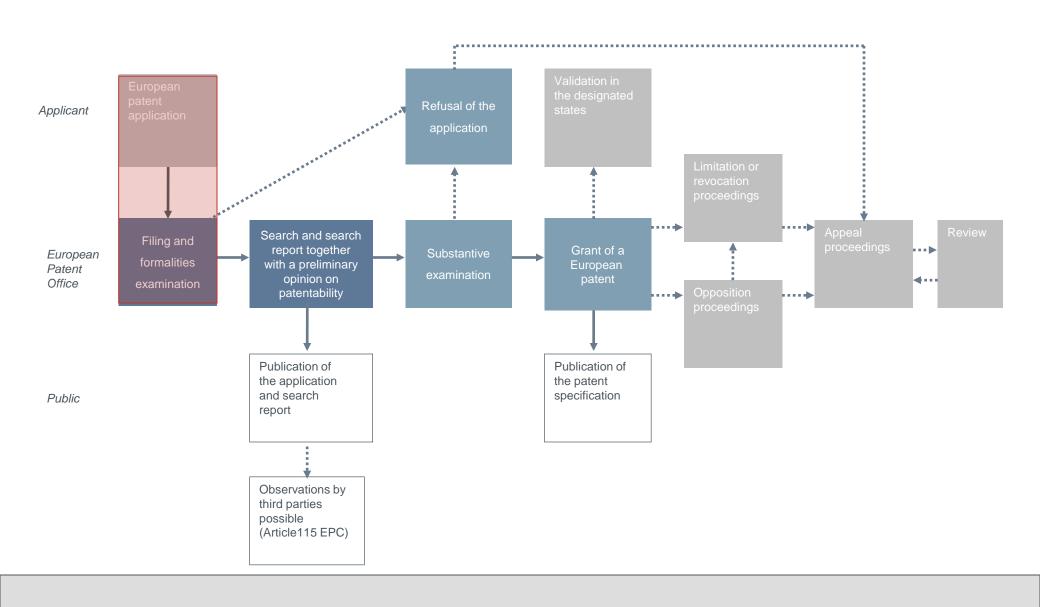
Overview – post-grant procedures

The post-grant procedures are:

- Opposition where third parties may contest a granted patent
- Revocation and limitation where patent proprietors may revoke their own patent or limit its scope
- Appeal every adverse decision is subject to appeal, to guarantee a twoinstance procedure



The grant procedure at a glance





Filing a patent application

- The first step is for the applicant to file a request for grant of a European patent.
- The application must be accompanied by the required documentation.
- Applications may be filed online.



Request for grant of a European patent

	Antrag auf Erteilung eines europäischen Patents Request for grant of a European patent Requête en délivrance d'un brevet européen	
	Nachreichung von Form 1001 zu einer früher eingereichten Anmeidung nac Form 1001 flied further to a previous application under Rule 40(1) on Deptot du formulare 1001 pour une demande deposee anterierument au til Bestätigung einer bereits durch Fax eingereichten Anmeidung vom Confirmation of an application aiready flied by fax on Confirmation d'une demande deja déposee par teléfax le	
	Nur für amtilchen Gebrauch / For official use only / Cadre réservé à Padmini	stration
1	Anmeldenummer / Application No. / N* de la demande	EY
2	Tag des Eingangs (Regel 35 (2)) / Date of receptin (Rule 35(2)) / Date de reception (régle 35(2))	EC.
3	Tag des Eingangs beim EPA (Regel 35 (4)) / Date of reception at EPO (Rule 35(4)) / Date de reception at POEB (regle 35(4))	NA.
4	Anmeldetag / Date of filing / Date de depot	
5	Es wird de Erfeltung eines europtischen Patents und gemäß Artikel 94 Frödung von einem sesterager. Grant of a European patent, and examination of the application under Article 94, are hereby requested. Il est demande is delivrance d'un prevet europeen et, conformement à l'article 94, l'examen de la demande	EXAM4 Priffungsantrag in einer zugelassenen Nichtamissprache (siehe Merkbatt II, 6). /*Request für examination in an admissible non-EPC language betrack in an eine stelle eine eine eine eine eine eine eine
5.1	Der Anmelder verzichtet auf die Aufforderung nach Regel 70 (2), zu erklärer od die Anmeldung aufrechterhalten werd – nach der	MLESS
6	Zeichen des Anmeiders oder Vertreters (max. 15 Positionen) / Applicant's or representative's reference (max. 15 keystrokes) / Reference du demandeur ou du mandataire (max. 15 caractères ou espace	
	Anmelder / Applicant / Demandeur	APPR
7	Name / Nom	
8	Anschrift / Address / Adresse	
9	Zustellanschrift / Address for correspondence / Address pour la correspondance	
TR	AN	Zeichen des Anmelders / Applicant's reference / Reference du demandeur



Filing a patent application

■ Where? EPO (Munich, The Hague, Berlin) (Art. 75 (1)a) EPC)

National Patent Offices (Art. 75 (1) b) and 77 EPC)

PCT (Art. 150 et seq. EPC)

■ How? Post (R. 35 EPC)

Fax

EPO online services

■ Who? Inventor/applicant (<u>Art. 60 (1) und (3) EPC</u>)



Date of filing

- The date of filing is crucial because:
 - it determines the state of the art
 - it must be within the priority year if priority is claimed
 - many deadlines depend on this date
- For applicants it is therefore essential to acquire a date of filing.
- The requirements are laid out in R. 40 EPC.
 - indication that a European patent is sought
 - identification of the applicant
 - description or reference to a previously filed application
- For a date of filing to be accorded, the application may be filed in any language. No claims, fees or declaration of priority are necessary at this point
 - ... but they will be required later!



Date of filing

- The application as originally filed will define any amendments to come.
- The application as originally filed consists of the documentation present at the date of filing
- This has impact on subsequent phases: search and examination may be restricted to the original scope of protection sought.



Formalities examination

- Once the date of filing is accorded, the file must be complete.
- The following aspects are examined for compliance (R. 57 EPC):
 - Translation of the application (Art. 14)
 - Request for grant of a European (R. 41 EPC)
 - One or more claims (<u>Art. 78</u>)
 - An abstract (Art. 78)
 - Filing fee (additional fee for the 36th and subsequent pages) and the search fee paid (R. 17(2), 36(3), 38 EPC)
 - Designation of the inventor (R. 19(1))
 - Claim to priority (R. 52, 53 EPC)
 - Representation (<u>Art 133(2) EPC</u>)
 - Formal requirements (R. 46, 49 EPC)
 - Nucleotide or amino acid sequences



File constitution

- If all the information is present, a paper copy of the file is printed, containing at least:
 - a description
 - claims
 - drawings (where available)
- Different codes are assigned depending on whether the application
 - is a first filing, i.e. without any priority claim
 - claims priority from a previous application
 - is entering the European phase after the Patent Cooperation Treaty phase

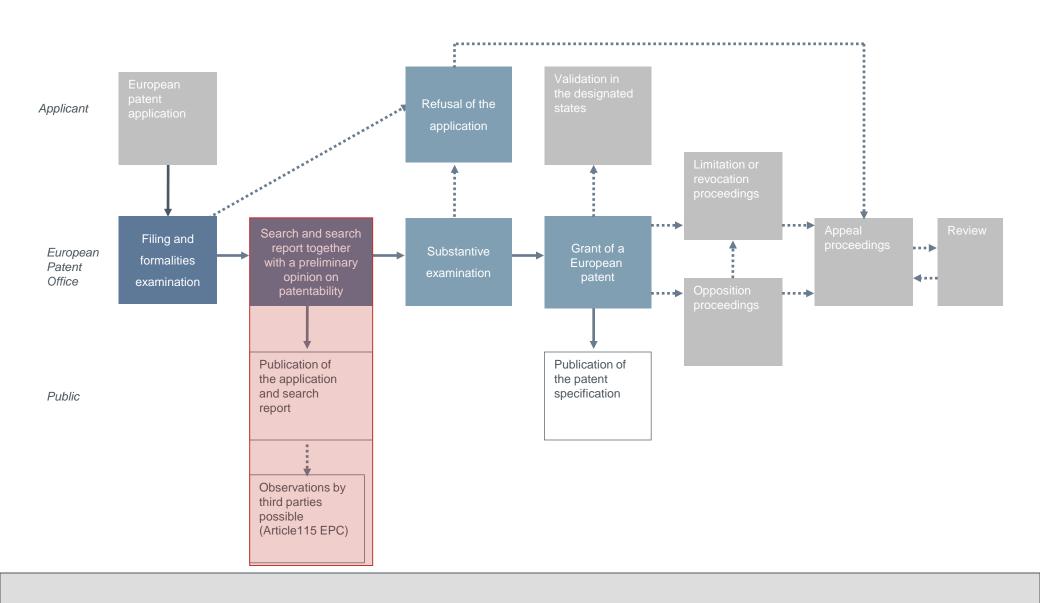


Contents

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The grant procedure at a glance





Search

Purpose of the search (Art. 92 EPC)

- To discover the state of the art at the relevant date.
- To prepare for substantive examination and to determine whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step.

Search documentation

- Internal and external documents
- Patent and non-patent literature



Search phase

- The outcome of the search phase is:
 - a search report listing the relevant prior art (<u>Art. 92, R. 61 EPC</u>) an opinion on whether the application and the invention to which it relates meet the requirements of the EPC (<u>R. 62(1) EPC</u>)
- The combination of these two documents is known as the extended European search report (R. 62 EPC).



European search report

The search report includes the citations of relevant documents.

Categories are assigned (X, Y, ...) to indicate the relevance and type of citation.

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Х	GB 1 203 328 A (TREVOR JOHN FRANKLIN) 26 August 1970 (1970-08-26) example 1	1,2,6-10
Х	WO 94 12184 A (SYNTEX INC) 9 June 1994 (1994-06-09) examples 1,2	1,10
Х	US 5 688 529 A (HEGDE SAYEE GOJANAN ET AL) 18 November 1997 (1997-11-18) abstract	1,7,10
Υ	WO 97 38689 A (HAEBERLIN BARBARA ;CIBA GEIGY AG (CH); MAK CHING PONG (CH); MEINZE) 23 October 1997 (1997-10-23) cited in the application example 1	1-10
	-/	

The opinion provides a written analysis of the patentability of the application, based on the cited documents.

The following documents are referred to in this communication:
D1: US 6 243 026 B1 (JUDGE KEVIN ET AL) 5 June 2001 (2001-06-05)

Clarity

2. The present application refers to a traffic signal priority system, although the wording of claim 1 is such that tries to encompass a generic entry/exit control system. This however is not in line with the description, page 3, lines 3-5, where is clearly state that the invention directs to a traffic signal priority system. As sucl will be the claimed invention understood in the following (Art. 84 EPC). The applicant is reminded that the full scope of the claims must be supported by the 1

- 3 Independent claims
- 3.1 The present application does not meet the criteria of Article 52(2) EPC because the subject-matter of claim 1 is not new in the sense of Article 54(1) and (2) EPC.

Document D1 discloses (the references in parenthesis applying to this document):

A mobile event triggering method, comprising detecting an entry of a vehicle into a defined event location (D1, col. 14, line 53) evaluating a vehicle status with respect to at least one entry criterion (col. 14, line 53)

conducting an event entry action when the vehicle status meets said at leas one entry criterion (D1, col. 14, line 55; lines 26-28)

evaluating the vehicle status with respect to at least one mobile event criterion corresponding to at least one mobile event

activating said at least one mobile event when the vehicle status meets said at least one mobile event criterion corresponding to said at least one mobile event



Publication

- Patent applications are published around 18 months from the date of filing or priority.
 - These documents are known as A publications (<u>Art. 93 EPC</u>).
- Publication makes the contents of the application available to the public. It also
 - provides provisional protection (<u>Art. 67 EPC</u>);
 - enables third parties to submit observations (<u>Art. 115 EPC</u>);
 - forms part of the state of the art (Art. 54(2)).



Publication of the application

- If it is ready, the European search report may be published together with the application.
- If it is not ready, the application is published without it, and the search report is published separately.
 - They can both be found in the <u>publication server</u>.
- The opinion is <u>not</u> published together with the search report (<u>R. 62 EPC</u>) but it is made available to the public as part of the written procedure via online file inspection.





Europäisches Patentamt European Patent Office

European Patent Office
Office européen des brevets



(11)

EP 0 797 950 A1

(12)

EUROPEAN PATENT APPLICATION

(43) Date of publication: 01.10.1997 Bulletin 1997/40 (51) Int CI.5: A61B 5/042

(21) Application number: 97400666.0

(22) Date of filing: 25.03.1997

(84) Designated Contracting States: BE DE FR GB IT NL SE

(30) Priority: 25,03,1996 JP 67653/96

(71) Applicant: TERUMO KABUSHIKI KAISHA Tokyo (JP)

(72) Inventor: Ouchi, Teruhiko Tokyo (JP)

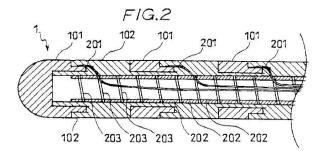
(74) Representative: Joly, Jean-Jacques et al Cabinet Beau de Loménie 158, rue de l'Université 75340 Paris Cédex 07 (FR)

(54) Electrode catheter

(57) The electrode catheter comprises a metal inner tube (202) with distal and proximal ends and an outer tube (102) formed of a synthetic resin so as to cover the outside surface of said inner tube (202). The inner tube (202) has a helical sili (203) formed from the distal end to a predetermined position. One or more insulated wires (201) are taid inside the inner tube (202) from the proximal end to the distal end option, and one or more electrodes (101) are disposed on the outer tube. The

wires (201) are brought out of the inner tube (202) through the slit (203) and are connected to the electrodes (101).

The electrode catheter has a high pushability and torque-transmission capability along with a high flaxibility and kink resistence. It can be easily inserted into a desired position of complexly branched thin blood vessels without kink or breakage of the wires caused by collapse of the lumen.



EP 0 797 950 A1

Printed by Jouve, 75001 PARIS (FR)

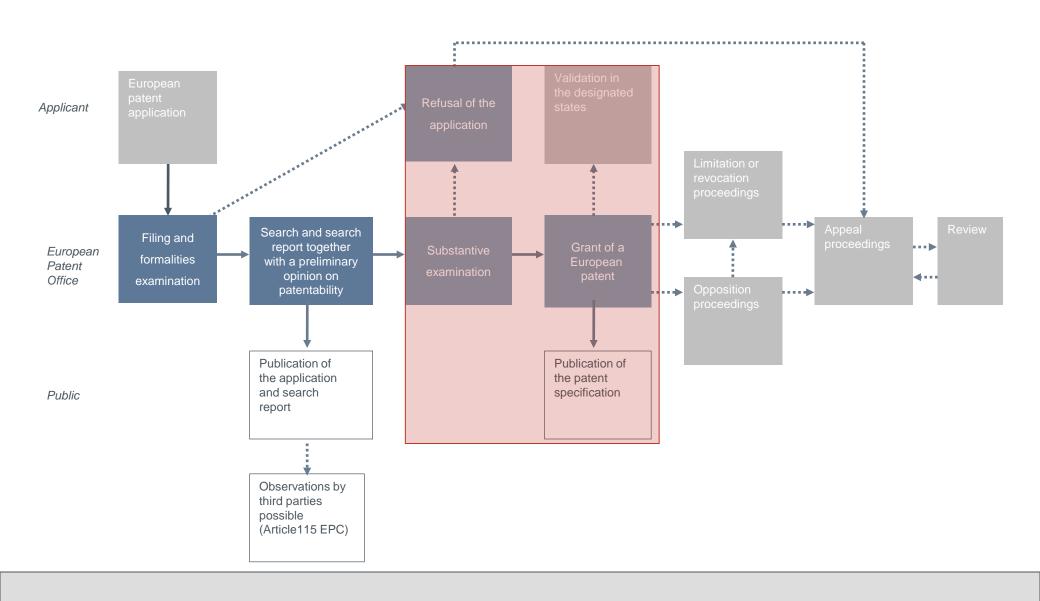


Contents

- Introduction
- The grant procedure
- Filing a patent
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- Substantive examination
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The grant procedure at a glance





- For an application to be granted, all the requirements of the EPC must be met (Art. 97 EPC).
- The applicant may request examination up to six months after the mention of publication of the search report (R. 70 EPC).



The examining division

- The examining division consists of three members (Art. 18 EPC).
- Each decision is the responsibility of the division as a whole.
- Examination is an ex-parte procedure in which only the applicant is involved.
 - Third parties may only submit observations





- Substantive examination mainly deals with how the invention is disclosed and defined:
 - Clear definition of the protection sought (<u>Art. 84 EPC</u>).
 - Sufficient disclosure of the invention (<u>Art. 83 EPC</u>).
 - Unity of invention (<u>Art. 82 EPC</u>).
- A patent may be granted for an invention which
 - is new (<u>Art. 54 EPC</u>),
 - involves an inventive step (<u>Art. 56 EPC</u>),
 - has industrial applicability (<u>Art. 57 EPC</u>),
 - ...and is not excluded from patentability (Art. <u>52-53</u> EPC).



- These requirements are examined using the cited prior art as documentation to back up the arguments.
- All objections raised must be reasoned and supported by evidence.
- Examination cannot therefore take place until after the search phase has been completed.



Applicants and examiners exchange written communications stating their objections, arguments and amendments.

■ The applicant must always be given the right to be heard (Art. 113 EPC). There can be no decision based on objections which have not been discussed.



Final outcome

- The application meets the requirements of the EPC:
 - + translation of the claims
 - + payment of grant and publishing fees
 - grant
 - Opposition period begins
 - Administration goes over to the national offices (+ "Validation")
- The application does <u>not</u> meet the requirements of the EPC:
 - refusal
 - Adverse decision may be appealed.



Publication of the European patent

- Granted European patents are published after the examination procedure.
 - These documents are known as B publications (Art. 98 EPC).
- Publication of the specification informs the public and
 - defines the granted exclusive right (<u>Art.</u> 64 EPC)
 - enables the opposition procedure (<u>Art.</u> 99 EPC)



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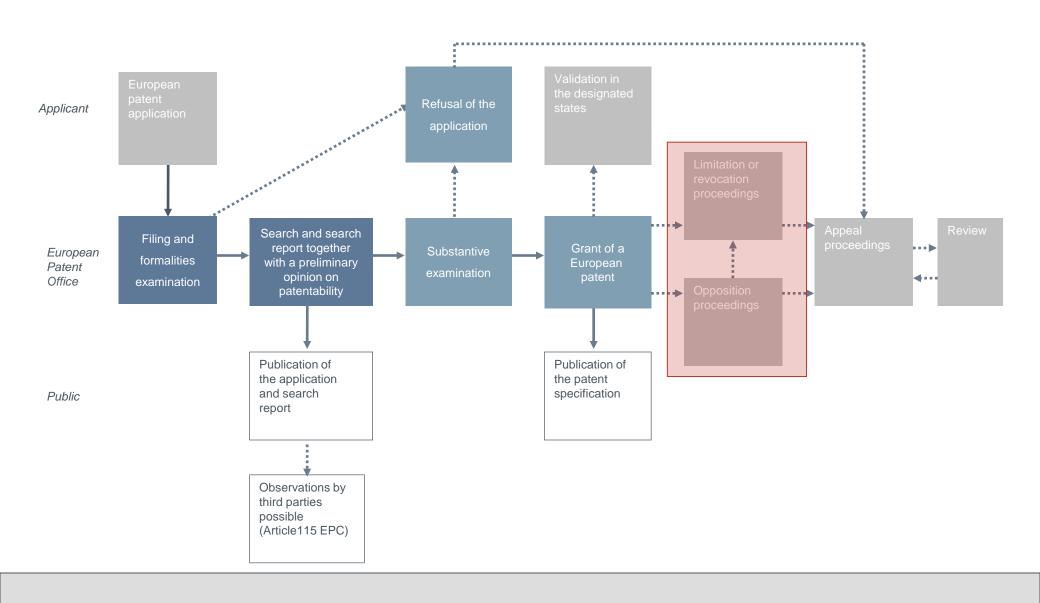


Contents

- Introduction
- The grant procedure
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- Substantive examination
- Post grant procedures
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The grant procedure at a glance





Post-grant procedures

- After a European patent has been granted, three procedures may be initiated:
 - opposition
 - limitation
 - revocation
- These procedures may affect the patent as granted.



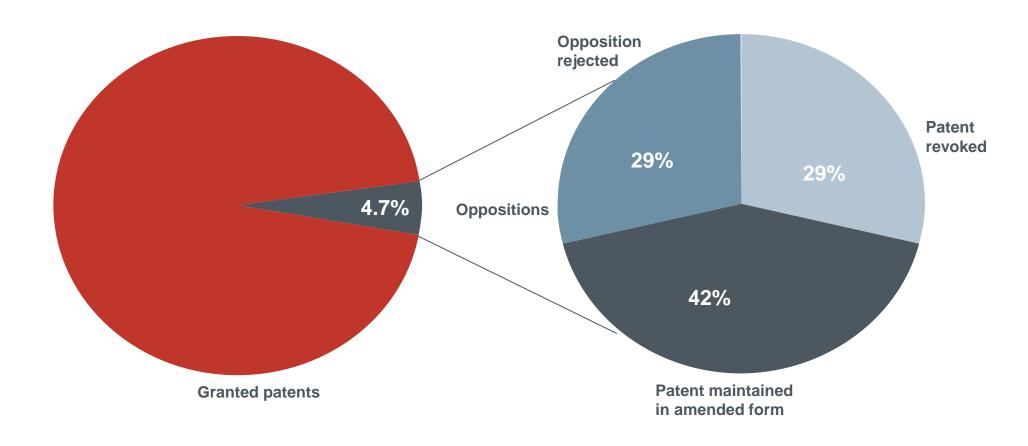
Opposition

- Any person may oppose a European patent within nine month of its publication.
- This procedure provides for a centralised possibility to rectify the grant of the patent.
- After the opposition period has expired, European patents may be only challenged in the individual countries in which they are valid.



Oppositions in 2012

Oppositions were filed against 4.7% of all granted European patents. Over one third of all opposed patents were revoked.





Limitation procedure (Art. 105 a-c EPC)

- At any time after the grant the patent proprietor may request limitation of the patent by filing a new set of claims.
- The decision to limit the European patent takes effect on the date on which it is published in the Bulletin.
- The effect of the decision to limit the patent is that the patent is limited *ab initio* in all contracting states.
- Opposition proceedings have precedence (R. 93 EPC).

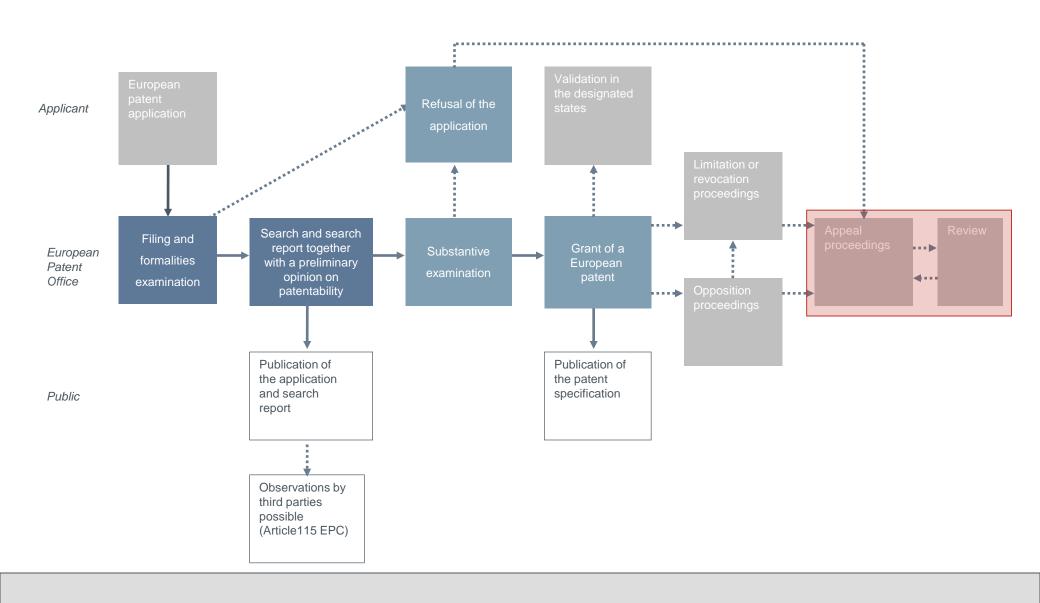


Revocation procedure (Art. 105 a-c EPC)

- The patent proprietor may request revocation of the patent at any time after grant.
- The revocation applies *ab initio* to all contracting states in respect of which the patent was granted.



The grant procedure at a glance





Appeals

- Any adverse decision made by the EPO is subject to a two-instance procedure.
- The department of the first instance for example, the Receiving Section, the examining division or the opposition division may refuse an application or a request.
- The party adversely affected may appeal in the second instance.



Appeal procedure

The boards of appeal

• The EPO's legal boards of appeal and technical boards of appeal give independent final rulings on appeals against decisions taken during grant and opposition proceedings. They can exercise any power within the competence of the department responsible of the decision appealed or remit the case to that department for further prosecution (<u>Art. 106-111</u> <u>EPC</u>).



Grant procedure summary

The procedure starts with the filing of the documents that form the European application. Once this has occurred:

- a search is carried out
- an examination is conducted
- and a decision is taken.

This decision may later be

- opposed
- limited
- revoked
- appealed



Contents

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Key facts about the unitary patent

Basic principles

- a European patent granted under the EPC
- unitary effect for the territories of the 25 EU member states currently participating, at the applicant's request
- co-existence with the existing European patent and national patents
- validated in one single administrative step by the EPO for all the participating states in the language in which it was granted
- language regime being finalised; transition measures foreseen

Objective

European Council Presidency and EU Commission intend to have the first unitary patent granted in 2014





Advantages

For inventors

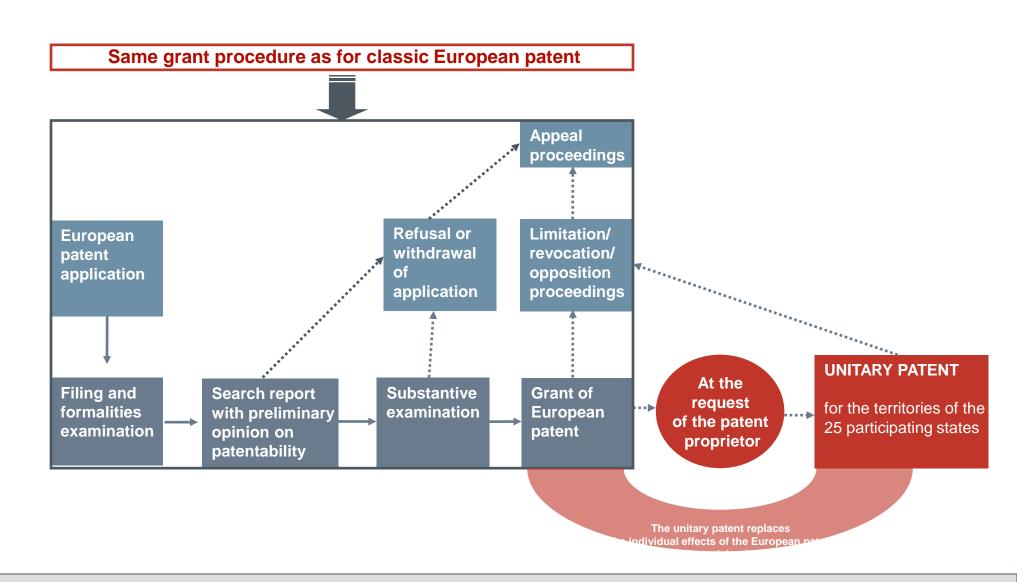
- protection in one single step for the 25 states currently participating
- significant cost savings (translation, validation, administration)
- simplified validation procedure (instead of up to 25 different procedures)
- simplified and more cost-efficient renewal procedure
- increased legal certainty due to uniform litigation system

For Europe

- optimal protection in the participating states as a whole
- better framework conditions for innovative companies and organisations
- simplified European protection mechanism for companies from outside Europe
- improved competitiveness of the European patent system



The unitary patent as a European patent





Contents

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- Post grant procedures
- The unitary patent
- Searching for prior art

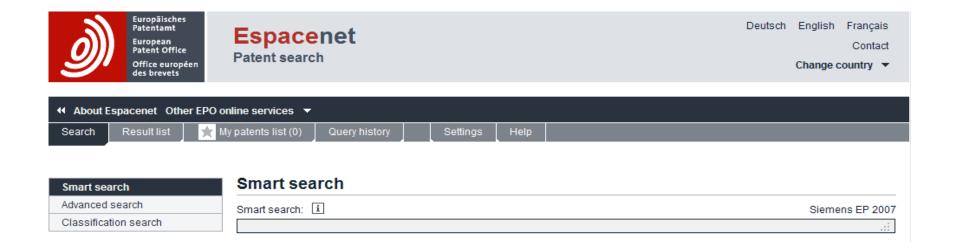


Espacenet

- User friendly access to patent documents
- More than 80 million documents
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- International
- Multilingual
- Online tutorials

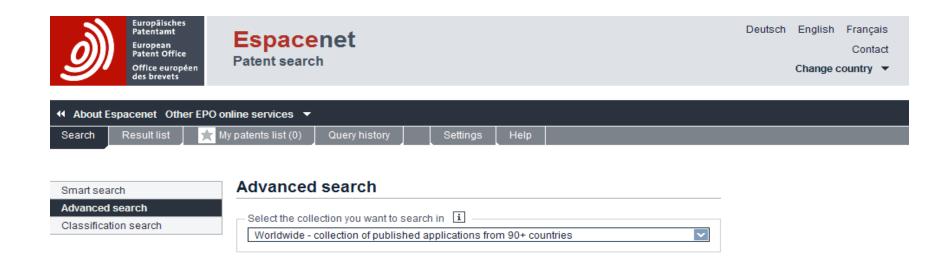


Smart search





Advanced search



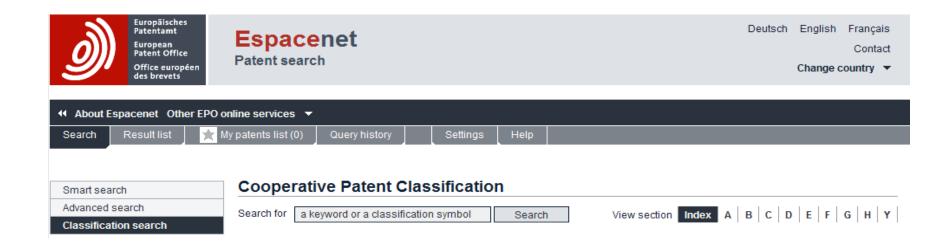


Advanced search

Enter keywords in English————————————————————————————————————	
Title: i	plastic and bicycle
	.::
Title or abstract: i	hair
	.::
Enter numbers with or without country code	
Publication number: i	WO2008014520
	.::
Application number: i	DE19971031696
	.::
Priority number: i	WO1995US15925
	.::
Enter one or more dates or date ranges	
Publication date: i	yyyymmdd
	.::
Enter name of one or more persons/organisations	
Applicant(s): i	Institut Pasteur
	.::
Inventor(s): i	Smith
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Enter one or more classification symbols	
CPC i	
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IPC i	H03M1/12
	Clear Search

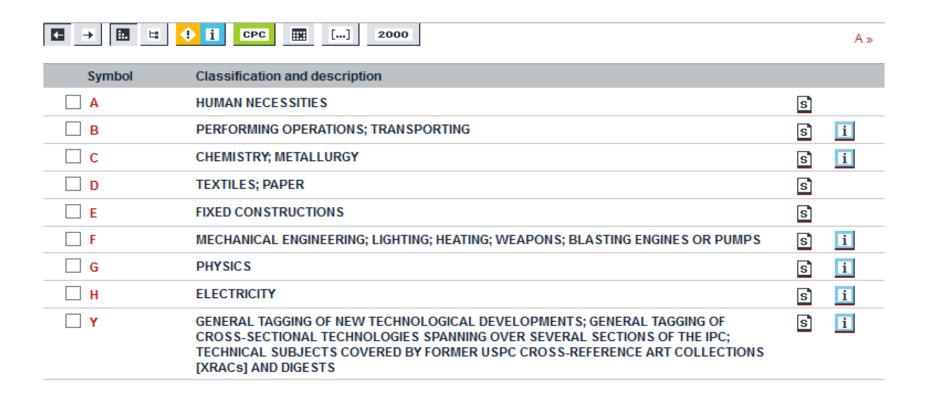


Classification search





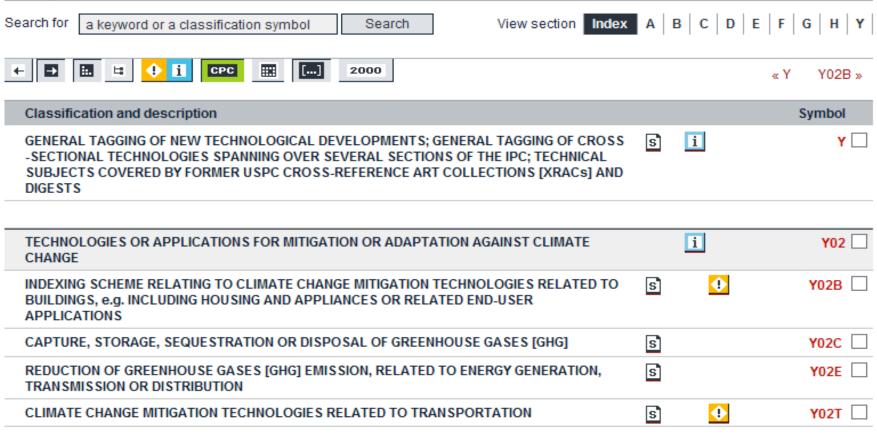
Classification search





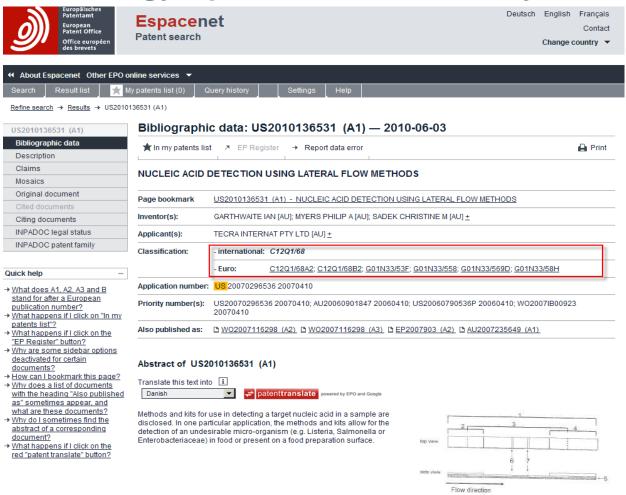
Y02

Cooperative Patent Classification





Technology Specific - Biochemistry





Technology Specific - Transport

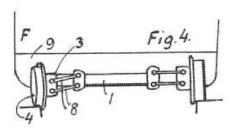
Bibliographic data: GB2085383 (A) — 1982-04-28



Abstract of GB2085383 (A)



The vehicle body (F), is tilted in a curve by raising its side (9) facing away from the centre of curvature while the side of the body facing towards the centre of curvature remains substantially unaffected and at a predetermined level. The vehicle can thereby be provided with small wheels (4) and the constructional height of the body be reduced. The tilting, which is performed by hydraulic cylinders, may be in conjunction with radial displacement of the wheel axles. The vehicle, which may be an articulated street vehicle, may be propelled by wheel-associated hydraulic motors.





Technology Specific - ICT

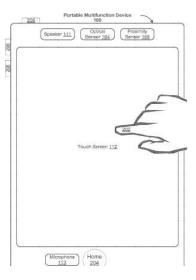
Bibliographic data: EP2387215 (A1) - 2011-11-16

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Incoming teleph	one call mana	gement for a portab	le multifunction device		
Page bookmark	EP2387215 (A	1) - Incoming telephone of	all management for a portable	multifunction device	
Inventor(s):	COFFMAN PATRICK [US]; LEMAY STEPHEN O [US]; JOBS STEVEN P [US]; FORSTALL SCOTT [US]; CHRISTIE GREG [US]; NOVICK GREGORY [US]; VAN OS MARCEL [US]; CHAUDHRI IMRAN [US] ±				
Applicant(s):	APPLE INC [US] ±				
Classification:	- international:	G06F3/048; H04M1/274	5; H04M1/57; H04M1/725		
	- Euro:	G06F3/0481H; G06F3/04 H04M1/725F1M4; H04M1		P1; H04M1/725F1; H04M1/725F1	<u>M</u> ;
Application number:	EP 201101764	80 20070831			
Priority number(s):			4769P 20060906; US2007088 US20070769695 20070627	33783P 20070106; US20070879	253P
Also published as:		63 (A1)	78 (A1) 🗅 EP2060096 (A1)	D DE212007000039 (U1) D	

Abstract of EP2387215 (A1)

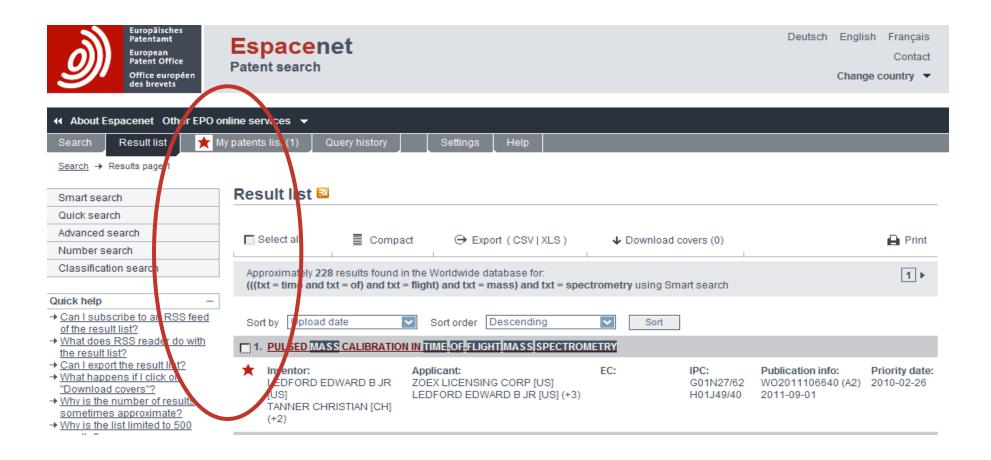


At a portable electronic device (100) with a touch screen display (112), a list of items (2800B) comprising missed telephone calls is displayed (5002). Upon detecting (5014) user selection of an item (2803) in the list (2800B), contact information (2800C) is displayed (5016) for a respective caller corresponding to the user selected item (2803). The displayed contact information (2800C) includes a plurality of contact objects that include a first contact object (2816), comprising a telephone number object having a first telephone number associated with the missed telephone call, and a second contact object (2818,2820,2822). Upon detecting (5018) user selection of the second contact object (2818,2820,2822), a communication with the respective caller is initiated via a modality corresponding to the second contact object (2818,2820,2822).



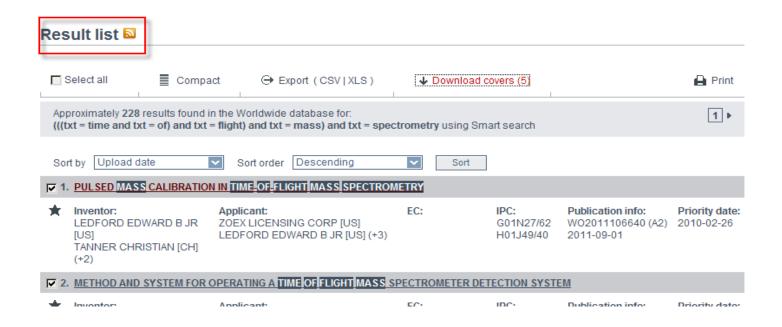


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01 September 2011, 00:00:00 | LEDFORD EDWARD B JR [US]; TANNER CHRISTIAN [CH] (2)

METHOD AND SYSTEM FOR OPERATING A TIME OF FLIGHT MASS SPECTROMETER DETECTION SYSTEM

11 August 2011, 00:00:00 | LOBODA ALEXANDRE [CA] ->

Disease Diagnosis Method, Marker Screening Method and Marker Using TOF-SIMS

28 April 2011, 00:00:00 | LEE TAE GEOL [KR]; MOON DAE WON [KR] (2) 🥎

METHOD OF ANALYZING ORGANIC MOLECULE ON SURFACE OF METAL NANOPARTICULATE

24 March 2011, 01:00:00 | INAGA TAKASHI; SHIBAMOTO KOHEI (1)

METHOD FOR DIAGNOSIS OF ABNORMAL IRON METABOLISM USING ACTIVE HEPCIDIN AS INDICATOR

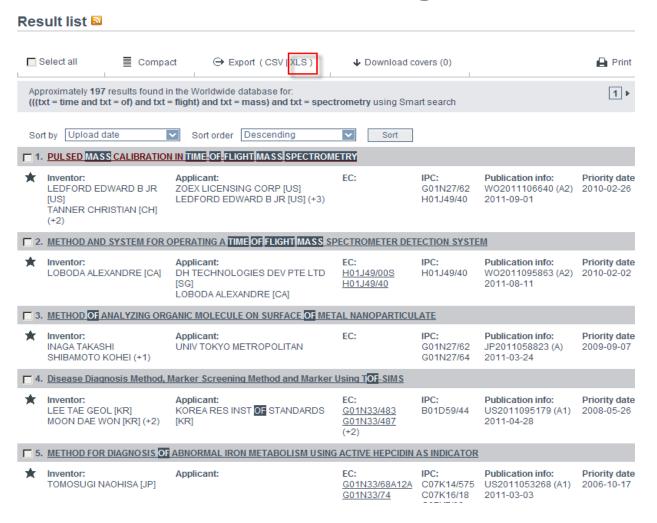
03 March 2011, 01:00:00 | TOMOSUGI NAOHISA [JP] ->

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METHOD AND SYSTEM FOR OPERATING A TIME OF FLIGHT MASS SPECTROMETER DETECTION SYSTEM	WO2011095863 (A2)	2011-08-					
METHOD OF ANALYZING ORGANIC MOLECULE ON SURFACE OF METAL NANOPARTICULATE	JP2011058823 (A)	2011-03-					
Disease Diagnosis Method, Marker Screening Method and Marker Using TOF-SIMS	US2011095179 (A1)	2011-04-:					
METHOD FOR DIAGNOSIS OF ABNORMAL IRON METABOLISM USING ACTIVE HEPCIDIN AS INDICATOR	US2011053268 (A1)	2011-03-					

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