

Patent Examination Practice in JPO

2015 JAUIP Summer IP Seminar

Tomoaki Hirase

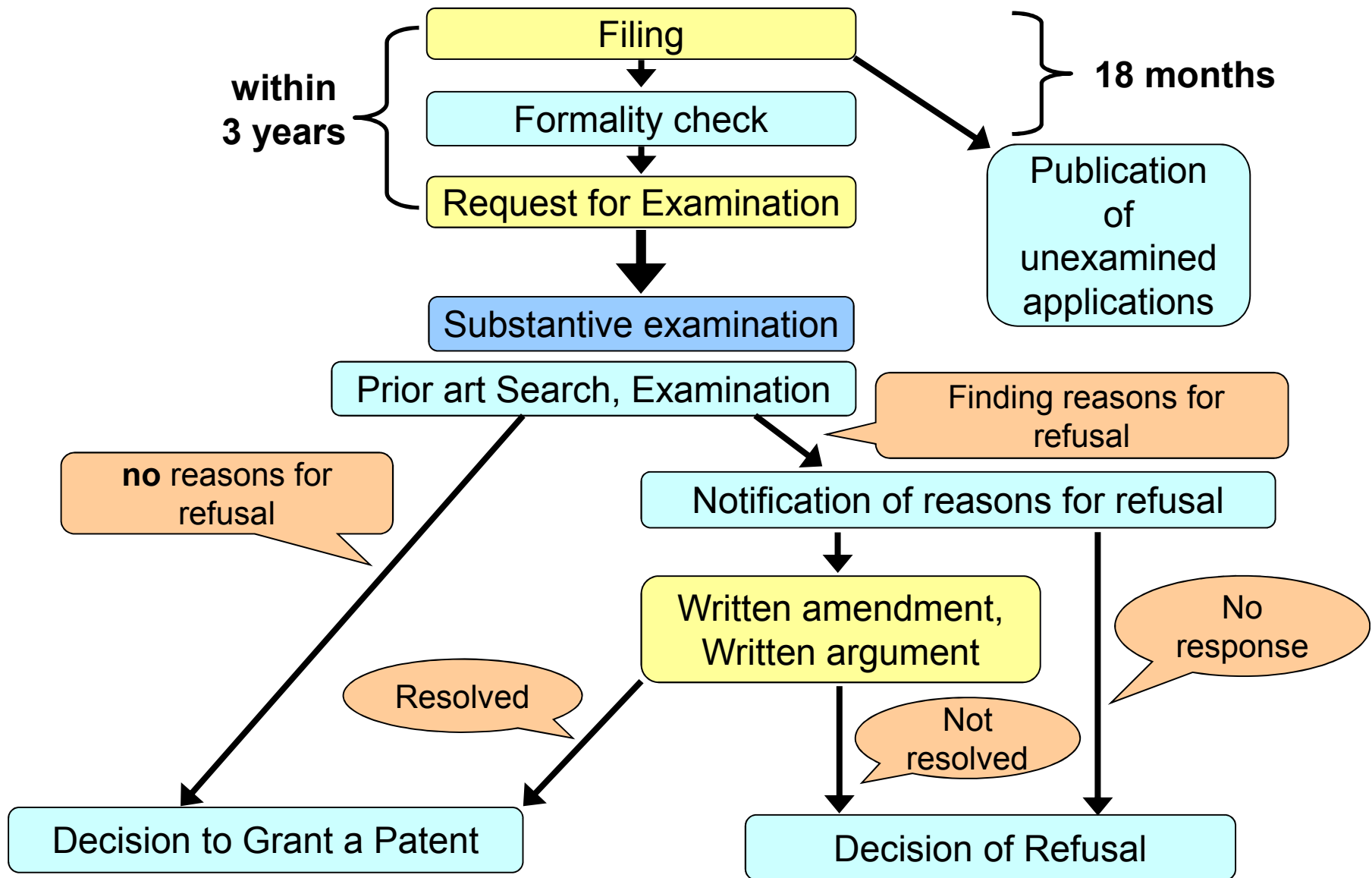
Contents

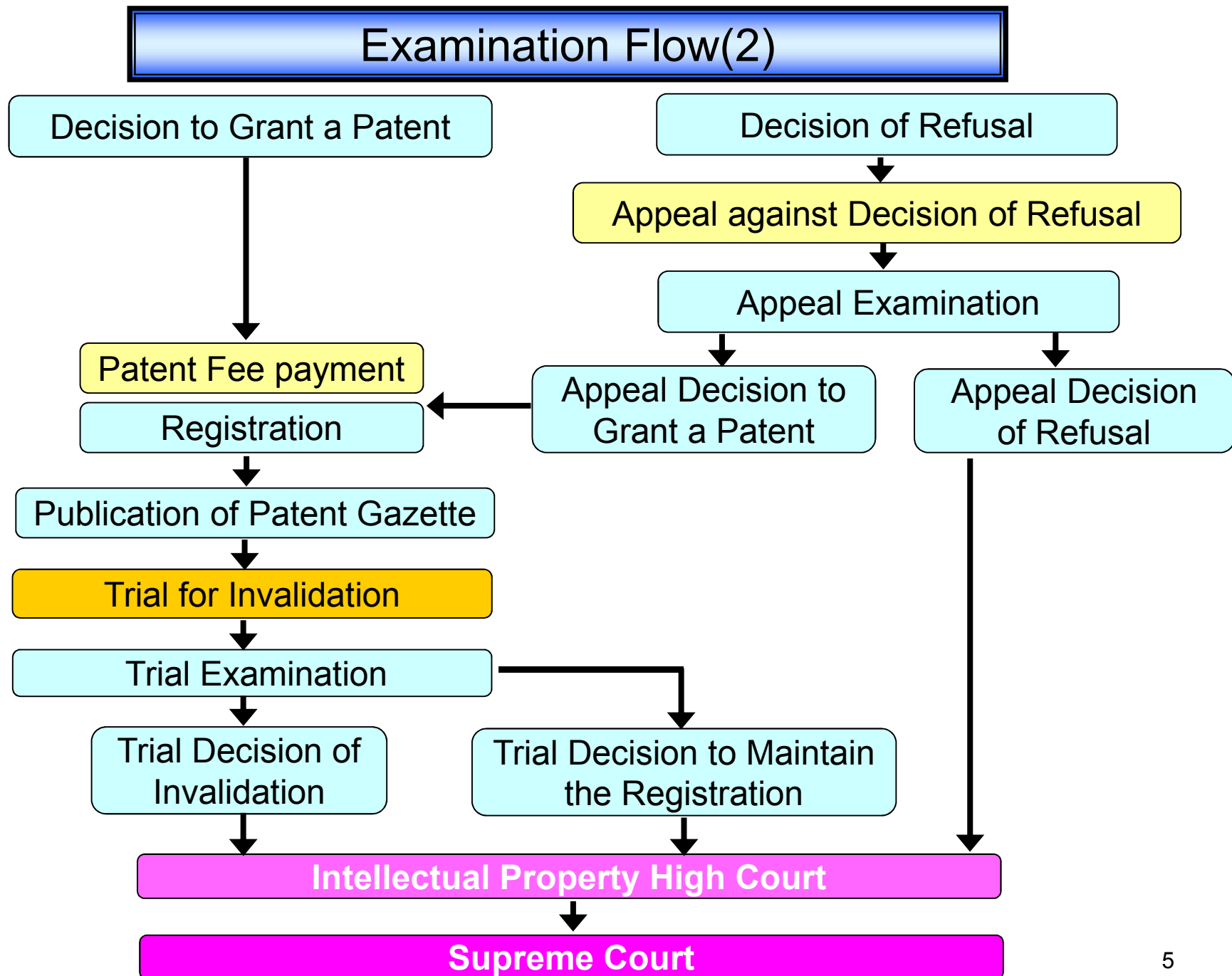
- Examination Flow
- Patentability Requirement
- Current situation of examination and JPO's efforts

Contents

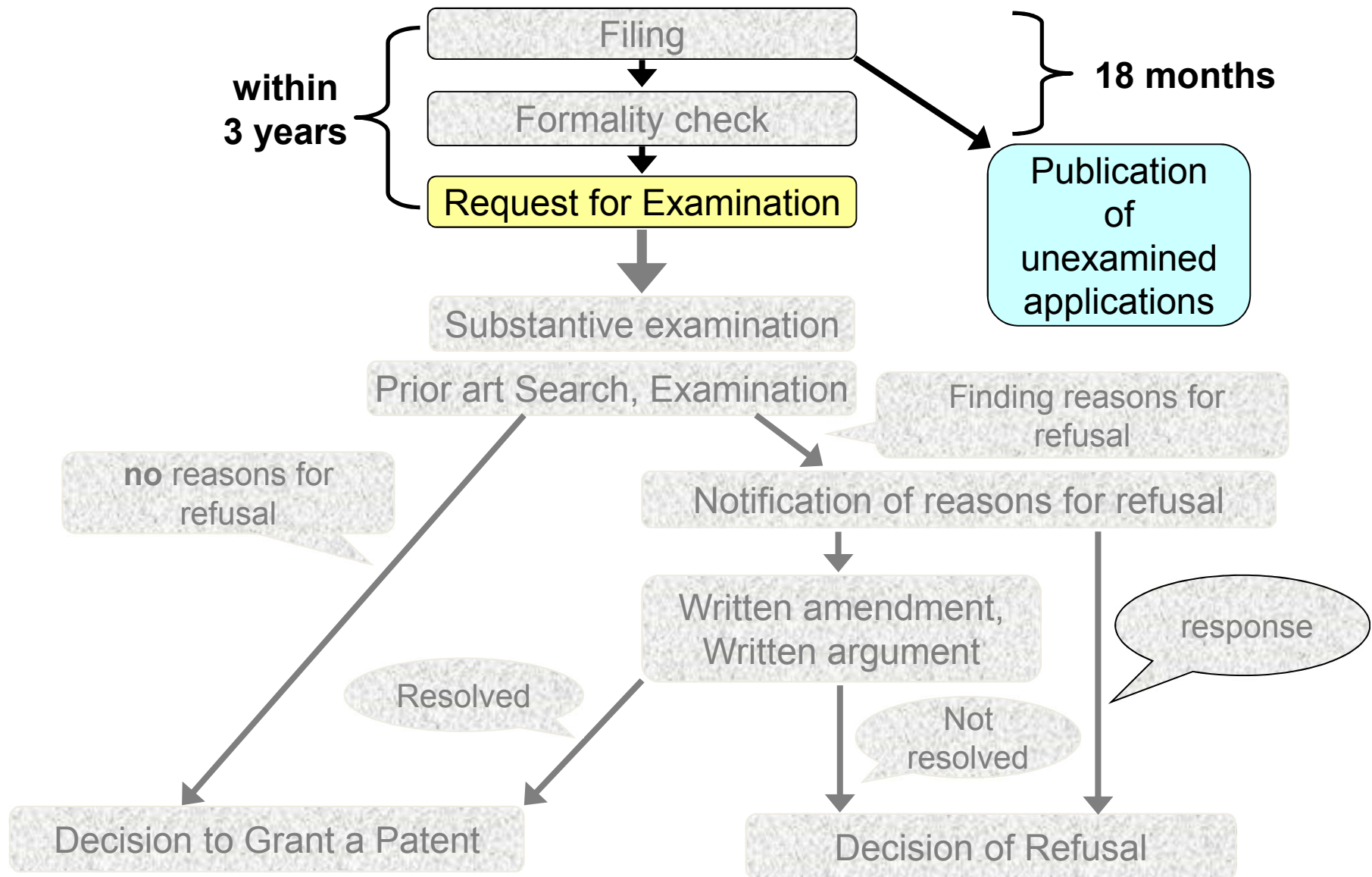
- Examination Flow
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Examination Flow (1)



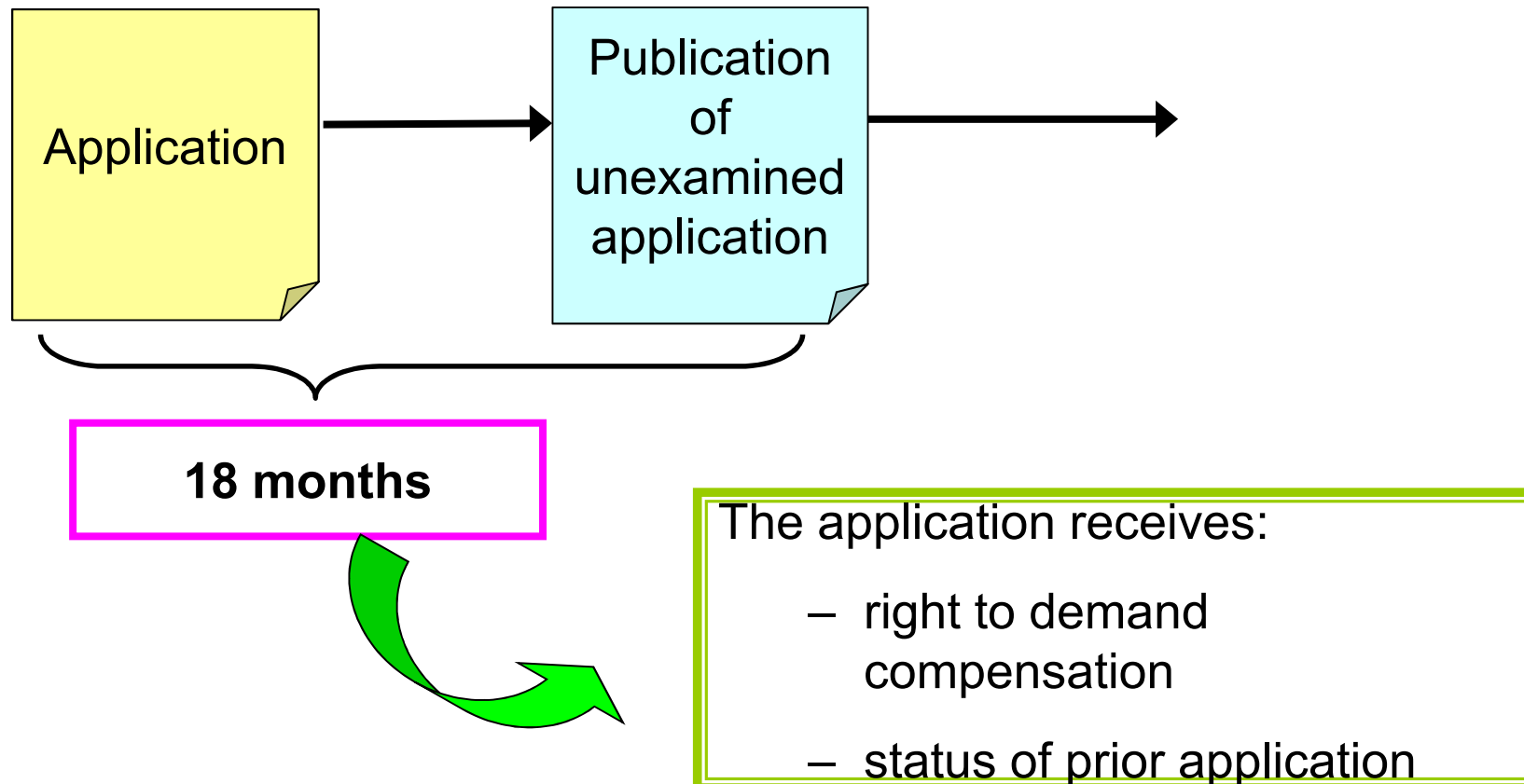


Examination Flow (1)



Publication of unexamined applications

- Bibliographical items, specification, drawings etc. are open to the public 18 months after the filing.
- Purpose: To avoid double research or filings



Publication of unexamined applications

(19) 日本国特許庁 (J P)

(12) 公開特許公報 (A)

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(71) 出願人 000010098

アルプス電気株式会社

東京都大田区雪谷大塚町1番7号

(72) 発明者 田中 正宜

東京都大田区雪谷大塚町1番7号 アルプ

ス電気株式会社内

(72) 発明者 山下 龍彦

東京都大田区雪谷大塚町1番7号 アルプ

ス電気株式会社内

(74) 代理人 100078134

弁理士 武 嗣次郎 (外2名)

Fターム(参考) 5D046 CB02 CC04 CC05 CD05 FA01

HA05

5D076 AA01 AA02 BB01 CC01 CC01

(54) 【発明の名称】 ディスクドライブ装置

(57) 【要約】

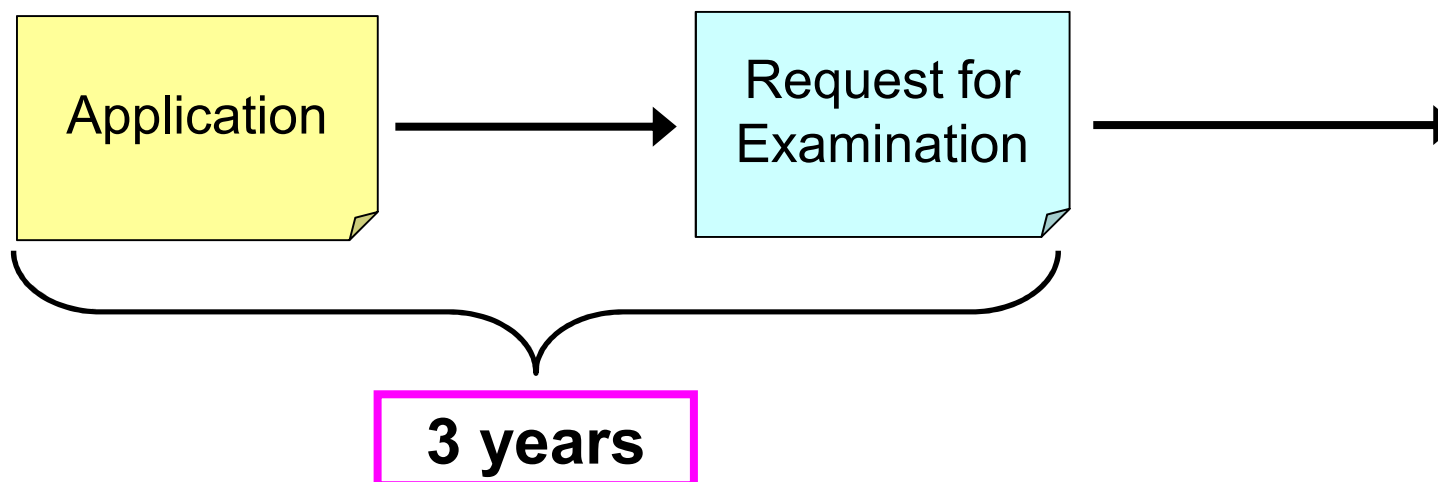
【課題】 構成が簡単で小型化、軽量化が可能で、使い
易く、コストの安価なディスクドライブ装置を提供す
る。

【図1】



Request for examination

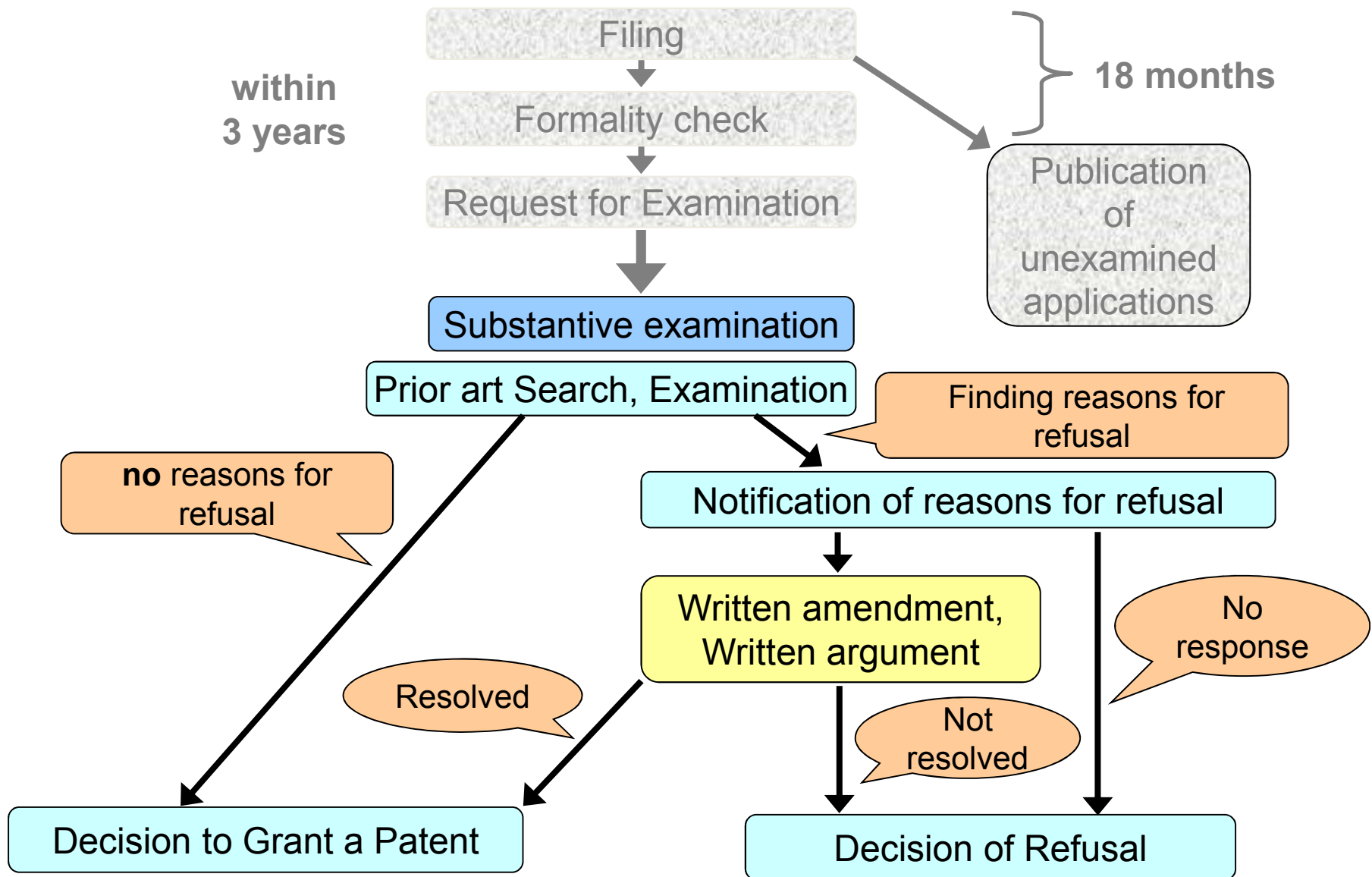
An applicant must request for examination within 3 years to receive substantive examination



It is economically beneficial to have second thoughts before requesting for examination

Third parties can also request for examination

Examination Flow (1)



Substantive Examination: Patentability requirement

The creation of technical ideas utilizing the laws of nature

Industrial applicability

Novelty

Inventive step

Prior application

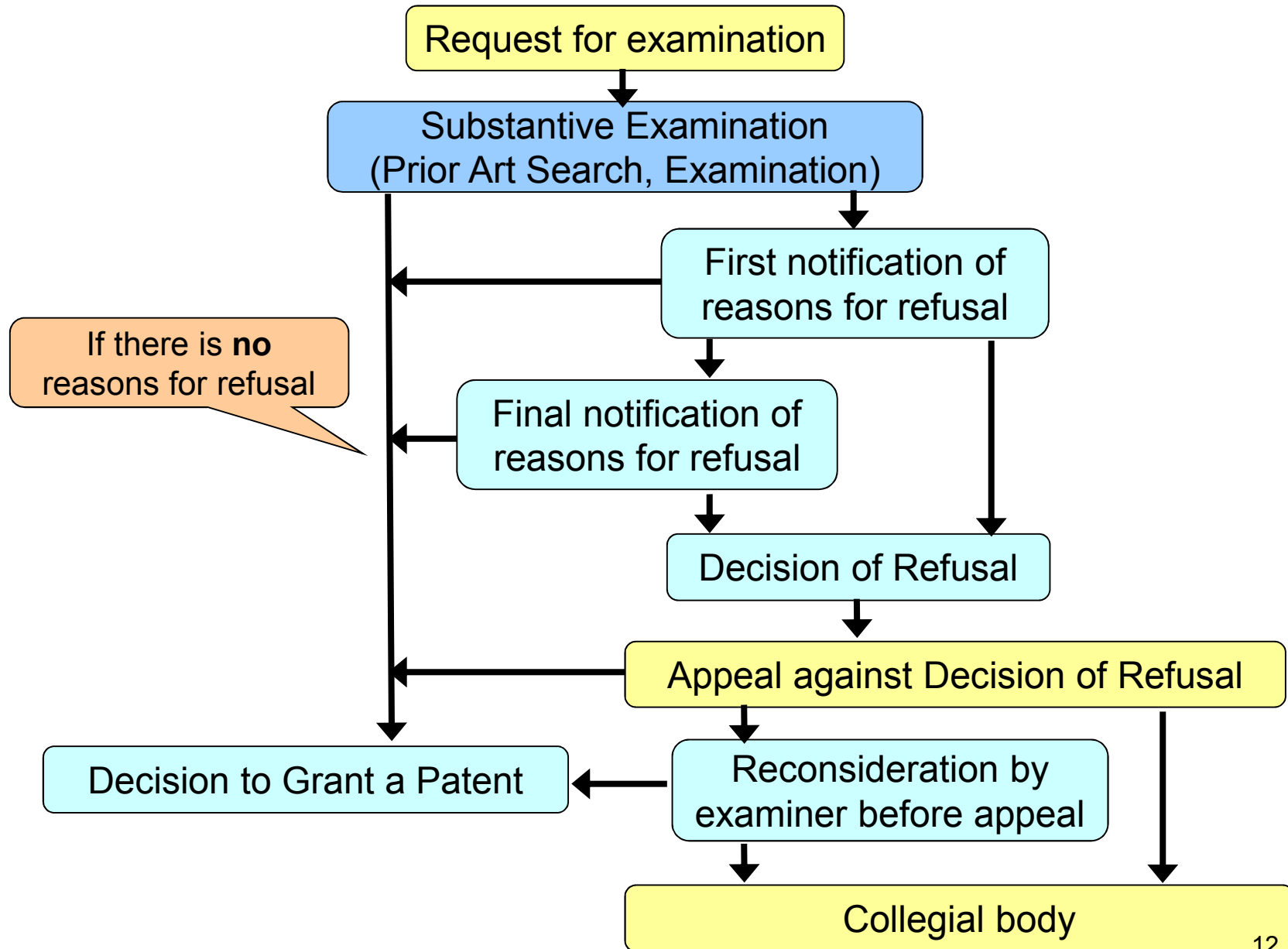
Unity

Description requirements

- Enablement requirement
- Support requirement
- Clarity

PATENT

Substantive Examination Flow

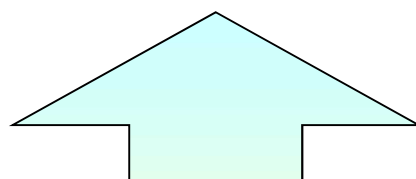


Substantive Examination : Notification, Final decision

1. Notification of Reasons for Refusal
2. Decision of Refusal
3. Decision to Grant a Patent

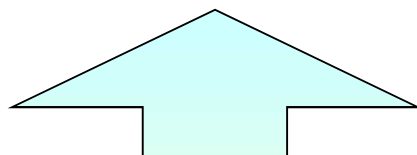
Substantive Examination : Notification of Reasons for Refusal

First (Non-final) notification of reasons for refusal



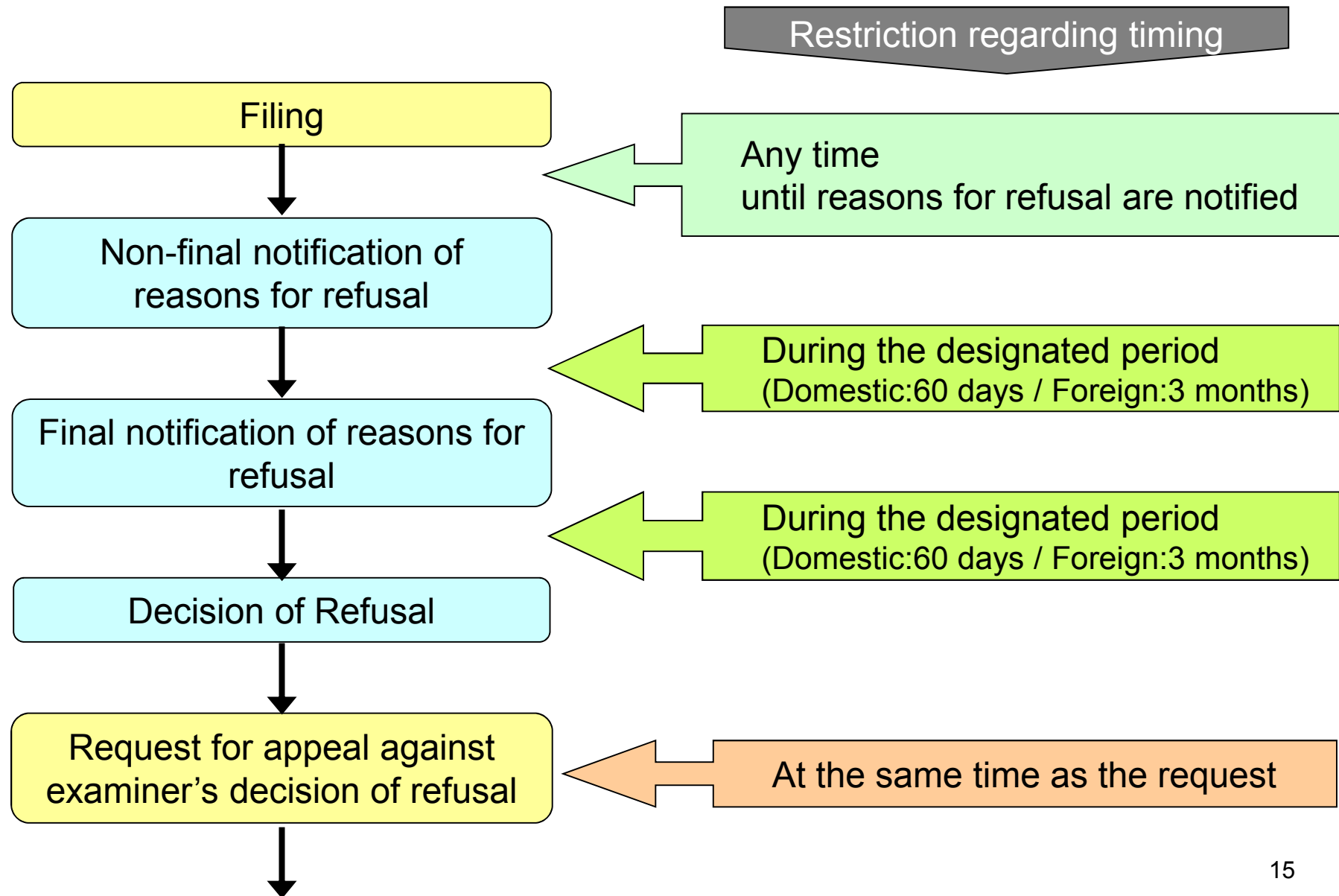
notifies the reasons for refusal
which are notified to an applicant **for the first time**

Final notification of reasons for refusal



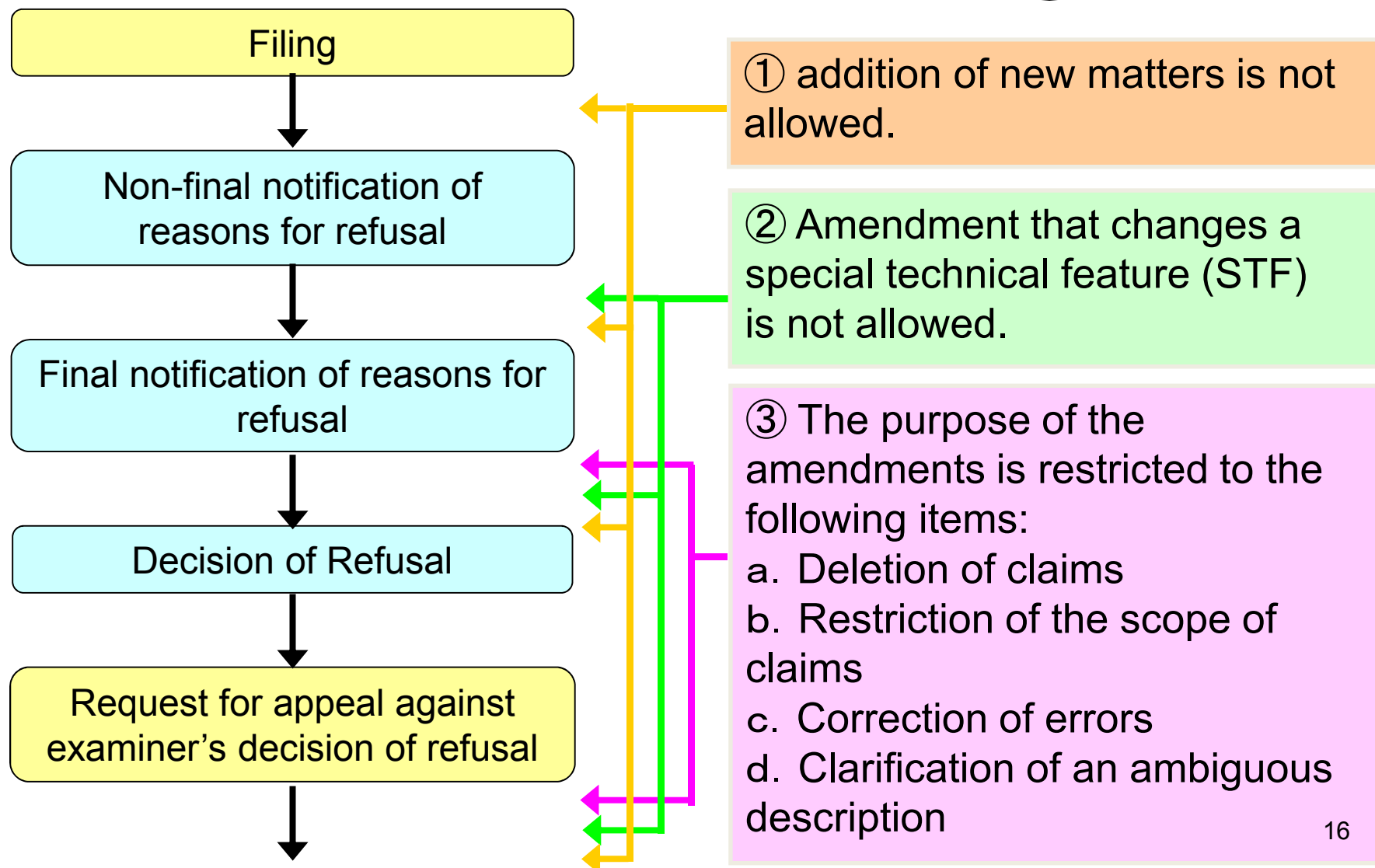
notified **only when the reasons for refusal are necessitated by amendments** made in response to a previous non-final notification of reasons for refusal

Substantive Examination : Restriction on amendments

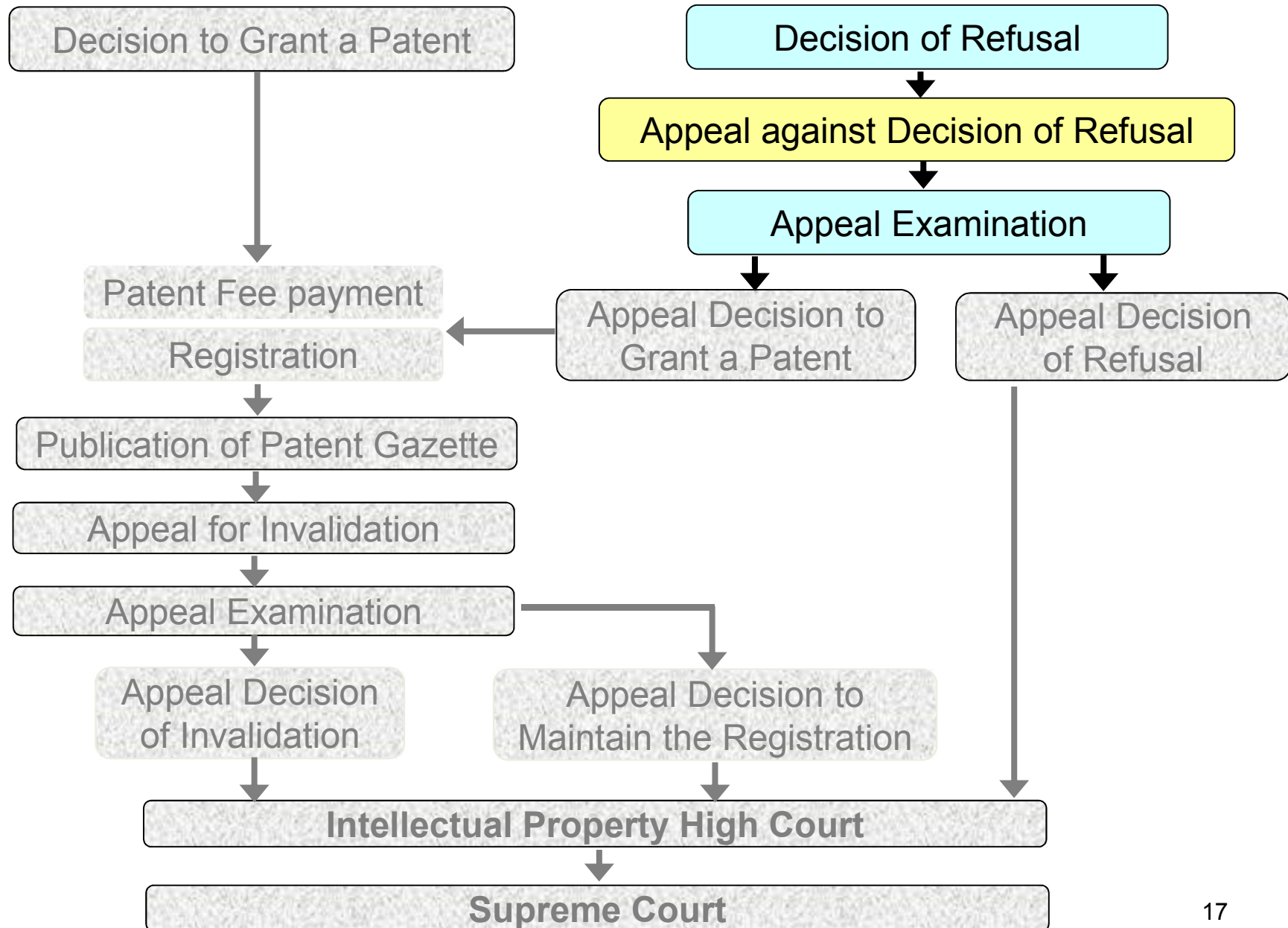


Substantive Examination : Restriction on amendments

Restriction regarding contents



Examination Flow(2)



Substantive Examination Appeal against Decision of Refusal

Appeal against examiner's decision of refusal

Requested by an applicant who is dissatisfied with the decision of refusal

Decision of refusal

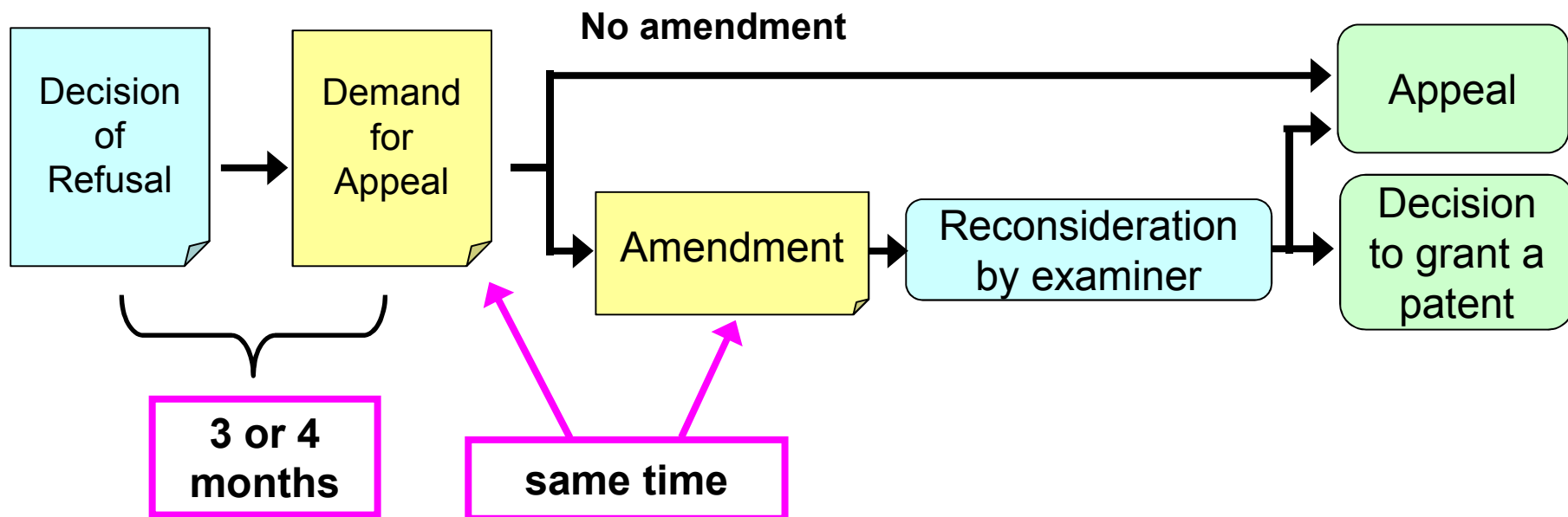
Demand for
Appeal
against
examiner's
decision of
refusal

**3 months (domestic application)
4 months (foreign application)**

Appeal Examination : Reconsideration by examiner

Reconsideration by examiner

when specification, claims or drawings are amended at the same time as demand of the appeal



Contents

- Examination Flow
- Patentability Requirement
- Current situation of examination and JPO's efforts

Substantive Examination: Patentability requirement

The creation of technical ideas utilizing the laws of nature

Industrial applicability

Unity

Novelty

Inventive step

Prior application

Description requirements

- Enablement requirement
- Support requirement
- Clarity

PATENT

Statutory invention

The first paragraph of Article 29(1) of the Patent Act

“An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention...”

➡ Invention must be “statutory”, “industrially applicable.

Article 2(1) of the Patent Act

statutory invention as “the highly advanced creation

of technical ideas utilizing the laws of nature”

➡ Examples are described in the Examination Guideline

Examples of Non-statutory inventions

(1) The laws of nature

e.g. law of conservation of energy

(2) Mere discoveries and not creations

e.g. discoveries of natural things (ore or natural phenomena)

(3) Those contrary to the laws of nature

e.g. perpetual motion

(4) Those not utilizing the laws of nature

- Laws other than natural laws (economic laws)
- Arbitrary arrangement (rules, schemes)
- Mathematical methods
- Mental activities of human
- Those utilizing only these laws (business methods)
e.g. business methods per se



New game

Not patentable

Examples of Non-statutory inventions

(5) Those not regarded as technical ideas

(a) Personal skills

e.g. a method of throwing a forkball performed by a human

(b) Mere presentation of information

e.g. manuals, audio CD or photographic image data

characterized only by contents.

(c) Aesthetic creations

e.g. paintings or carvings



Carvings

Not patentable

(6) Those for which it is clearly impossible to solve the problem to be solved by any means presented in a claim

Examples of Industrially inapplicable inventions

(1) **Methods** for treatment of human body by surgery

e.g. **Methods** of surgical operation using scalpel



(2) **Methods** for treatment of human body by therapy

e.g. **Methods** of giving medicine to patient



(3) Diagnostic **methods**
practiced on human body

Not patentable

(4) Only for personal use

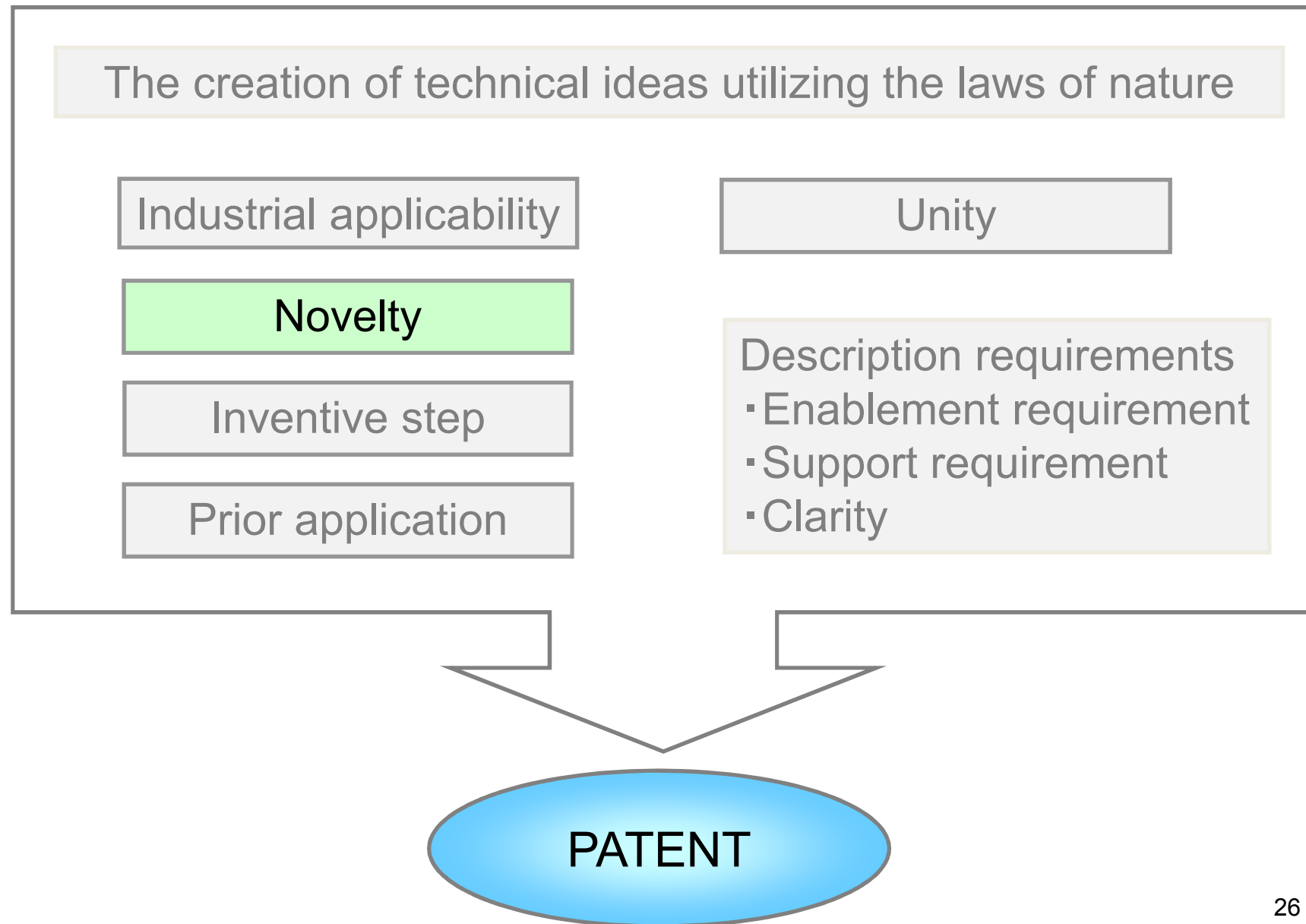
• **Method** of smoking



(5) Practically inapplicable inventions

e.g. Method for preventing increase in ultraviolet rays by covering whole earth's surface with ultraviolet ray-absorbing plastic film

Substantive Examination: Patentability requirement



Novelty

Article 29(1) of the Patent Act

An inventor of an invention ...may be entitled to obtain a patent for the said invention, except for the following:

- (i) inventions that were **publicly known** in Japan or a foreign country, prior to the filing of the patent application;*
- (ii) inventions that were **publicly worked** in Japan or a foreign country, prior to the filing of the patent application; or*
- (iii) inventions that were **described in a distributed publication**, or inventions that were made **publicly available through an electric telecommunication line** in Japan or a foreign country, prior to the filing of the patent application.*

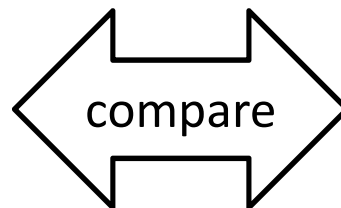
Non-novel inventions

Novelty

Method

1. Determining what is described in a claimed invention and a cited invention
2. Comparing of the claimed invention with a cited invention
3. Finding the identicalness and difference
4. Determining whether the claimed invention is novel

Matters defining
the claimed invention

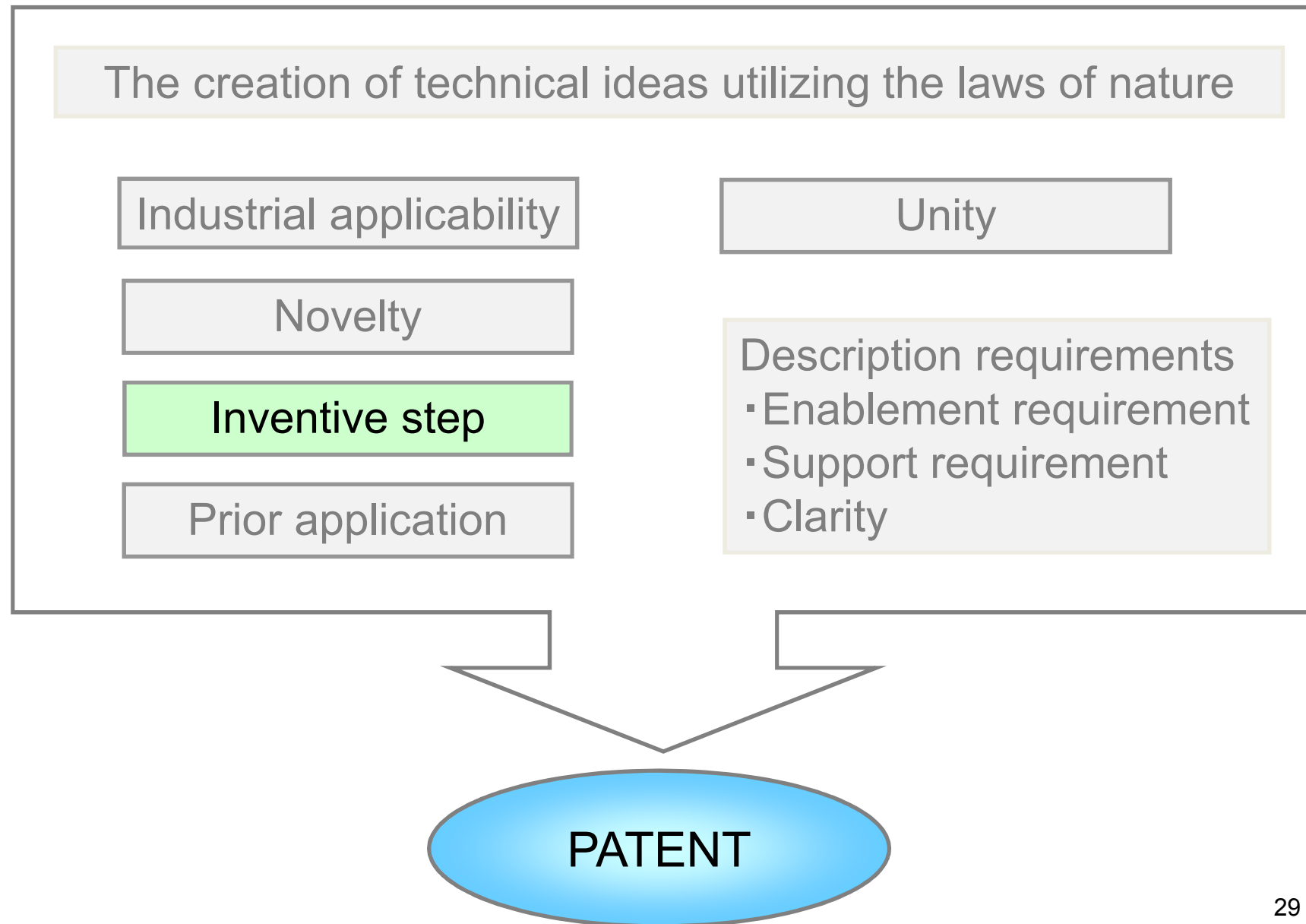


Matters defining
the cited invention

No difference found ➡ The claimed invention is not novel.

Difference found ➡ The claimed invention is novel.

Substantive Examination: Patentability requirement



Inventive Step

Article 29(2) of the Patent Act

Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

Purport of provision of Inventive Step

Not to grant a patent to such an invention, because granting a patent does not contribute to and even hampers progress of technology

Inventive Step

Method

1. Determining what is described in a claimed invention and one for more cited inventions
2. Comparing of the claimed invention with a cited invention
3. Clarifying the identicalness and difference in matters defining the inventions
4. Considering the reasoning for lacking an inventive step of the claimed invention on the basis of contents of the cited invention above and other cited inventions.

Difference found  The claimed invention is novel.


Determining an Inventive Step

Inventive Step

Specific Examples of Reasoning

1. Selection of an optimal material, workshop modification of design, mere juxtaposition of features
2. Motivation
3. Advantageous effects

Inventive Step

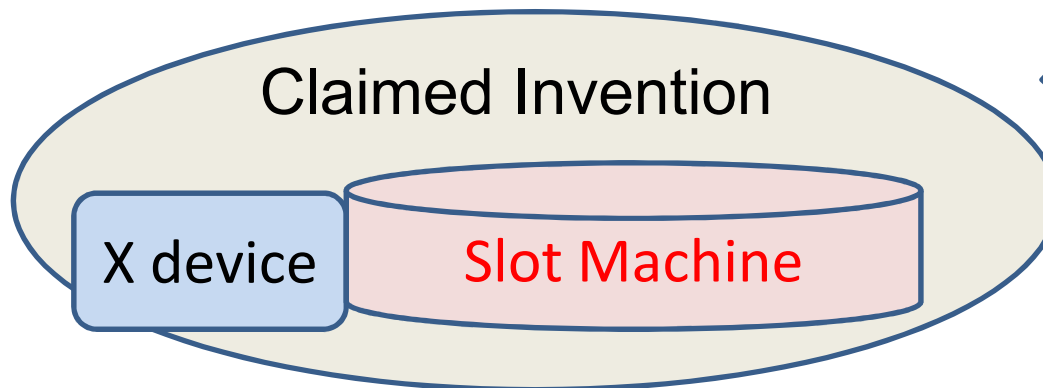
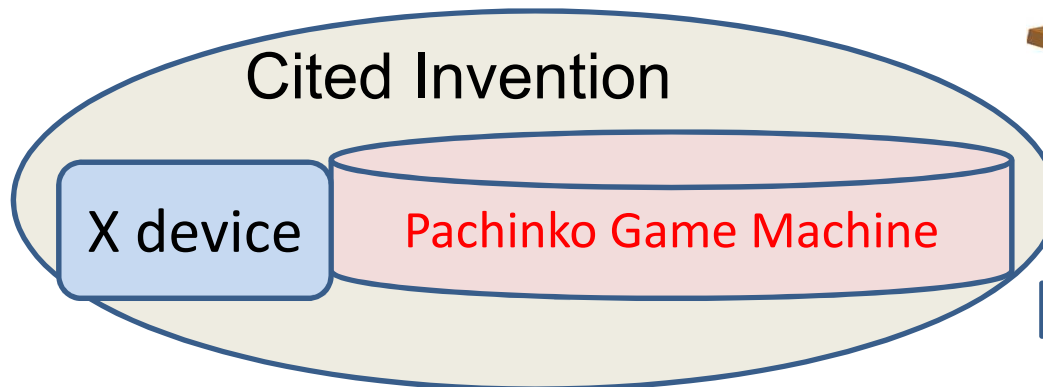
Motivation

1. Relation of technical fields
2. Similarity of a problem to be solved
3. Similarity of function, work or operation
4. Suggestions shown in the contents of cited inventions

Inventive Step

Relation of technical fields

Example



Applying a technical means in **Pachinko Game** to **Slot Machine** is a mere exercise of ordinary creativity



Inventive Step

Similarity of a problem to be solved

Example

Cited Invention 1

**A pet bottle coated
with silicon oxide film**



Claimed Invention

**A pet bottle coated
with hard carbon film**



Cited Invention 2

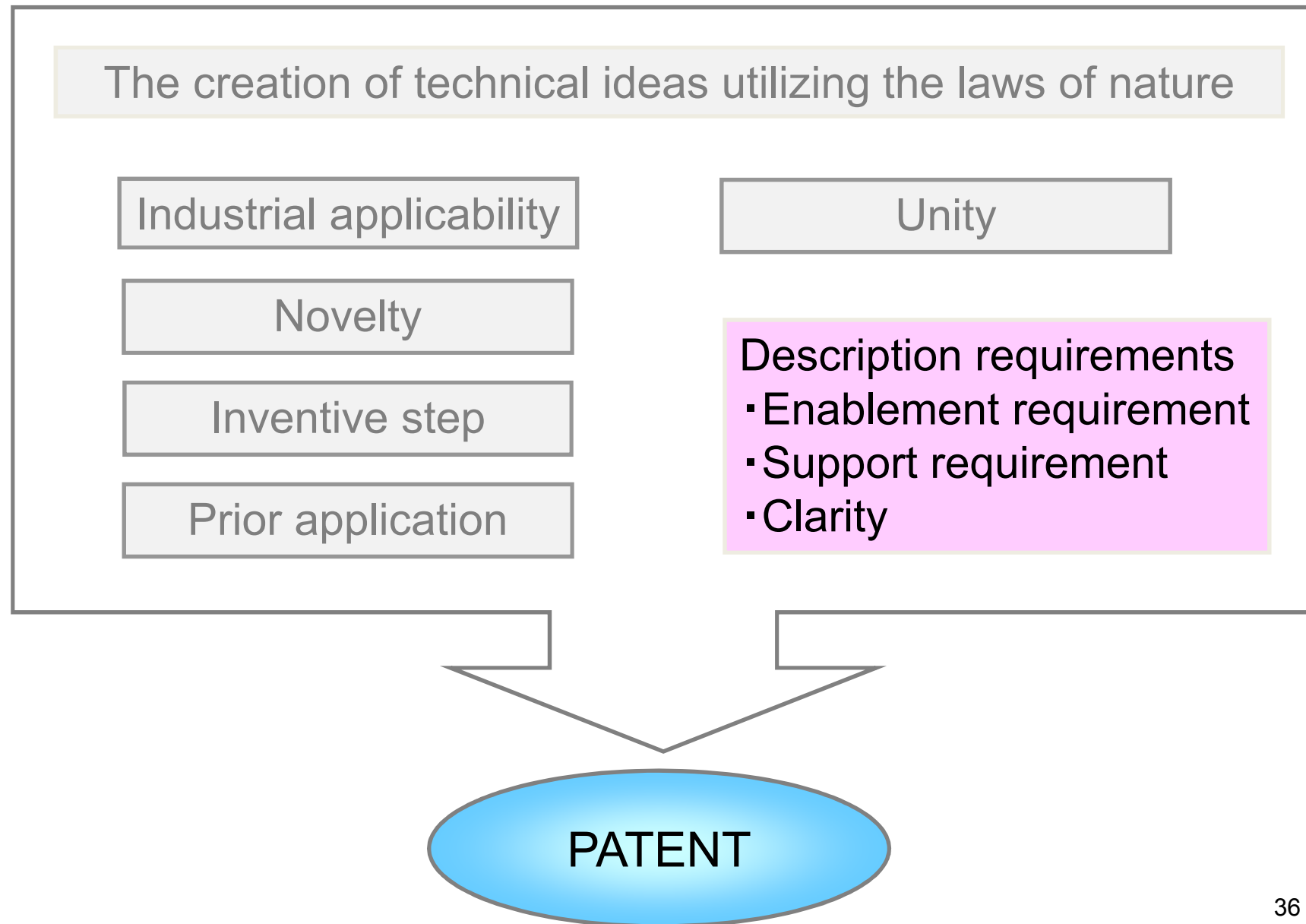
**A container coated
with hard carbon film**



Applying a technical means
of the cited invention 2 to
the cited invention 1 for
solving the problem is a
mere exercise of ordinary
creativity.

Problem of both inventions is to **improve gas
barrier performance**

Substantive Examination: Patentability requirement

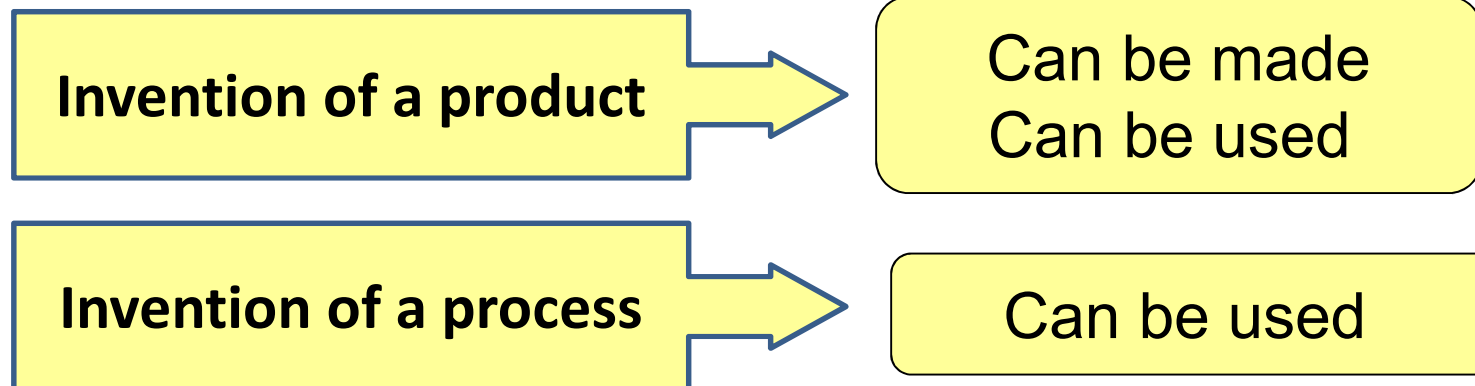


Description Requirement: Enablement Requirement

Article 36(4)(i) of the Patent Act

(4) The statement of the detailed explanation of the invention shall comply with each of the following items:

(i) the statement shall be clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention;



Description Requirement: Support Requirement

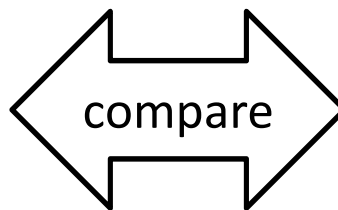
Article 36(6)(i) of the Patent Act

(6) The statement of the scope of claims shall comply with each of the following items:

*(i) the invention for which a patent is sought **is stated in the detailed explanation of the invention;***

Whether a statement in the claims complies with 36(6)(i) shall be determined as follows

A claimed invention



The matters disclosed in a detailed description of an invention

Description Requirement: Support Requirement

Example of violation of Article 36(6)(i)

Scope of claim “A hybrid car of which energy efficiency during running on electricity is a-b %, as measured by X test method.”

Scope of claim : EVERY hybrid car having characteristics that energy efficiency is a-b%.

Content disclosed in a detailed description : A hybrid car equipped with Y control means

a belt-type continuously-variable transmission



1. In technical field of hybrid car, energy efficiency is normally about X%, far lower than a%, and it is difficult to realize a higher energy efficiency such as a-b%. (Common knowledge as of the filing)
2. In light of the common knowledge, a hybrid car defined only by energy efficiency is NOT sufficiently specified from a technical perspective.

Description Requirement: Clarity

Article 36(6)(ii) of the Patent Act

(6) The statement of the scope of claims shall comply with each of the following items:

*(ii) the invention for which a patent is sought is **clear**;*

Examples of violation of Article 36(6)(ii)

(1) Claim includes inadequate statements as Japanese language expression

e.g. errors, an ambiguous statement

(2) Meaning of a term in claim is incomprehensible

(3) Claim states technically incorrect matters

e.g. “An alloy composed of 40-60wt% A, 30-50wt% B, and 20-30wt% C”

(4) Matters used to specify the invention are not related technically

e.g. “A road on which automobiles mounting a specific engine are traveling”

(5) Category of an invention is unclear

e.g. “A method and/or apparatus comprising...”

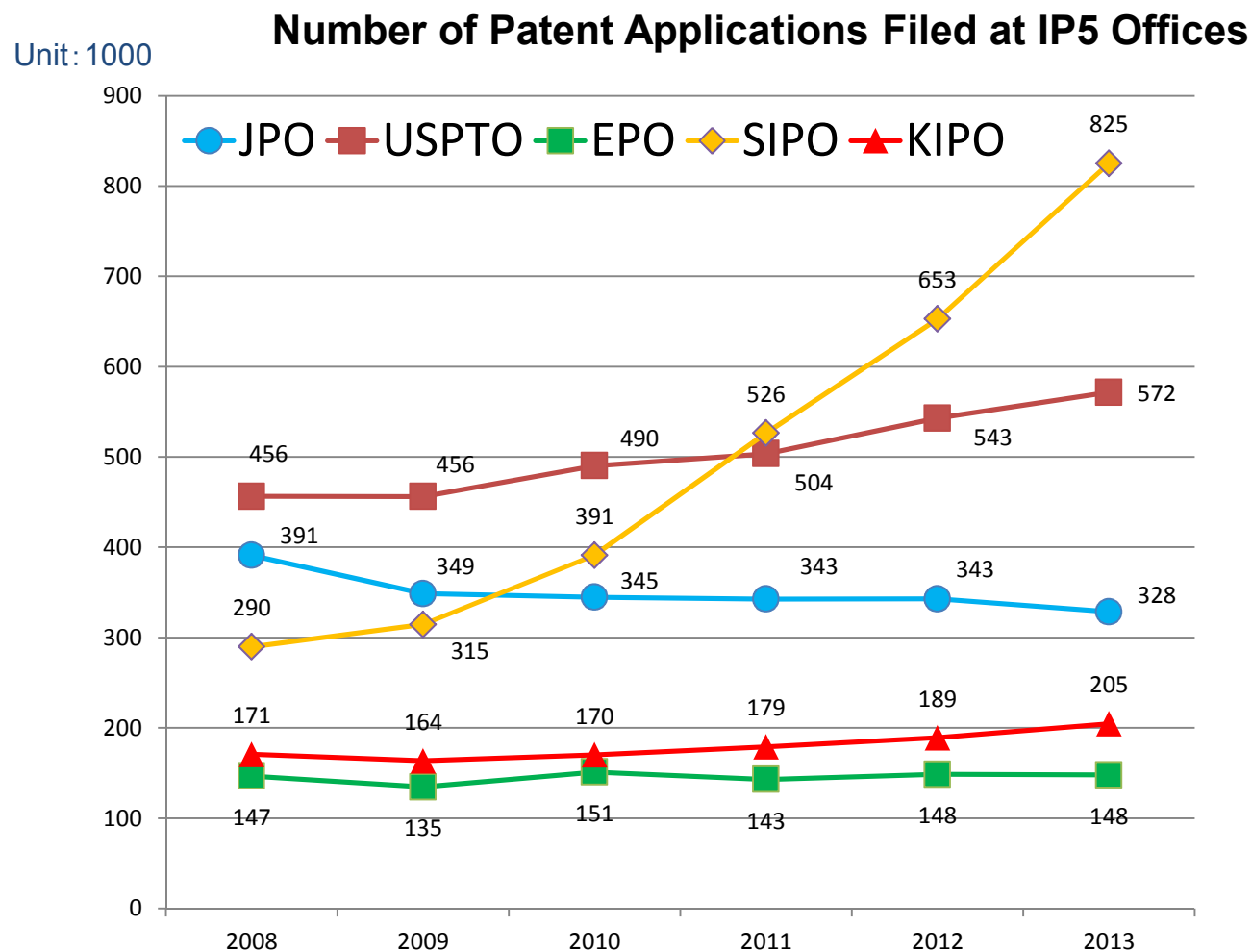
Contents

- Examination Flow
- Patentability Requirement
- Current situation of examination and JPO's efforts

Current situation of patent examination and JPO's efforts

Trends in Patent Applications

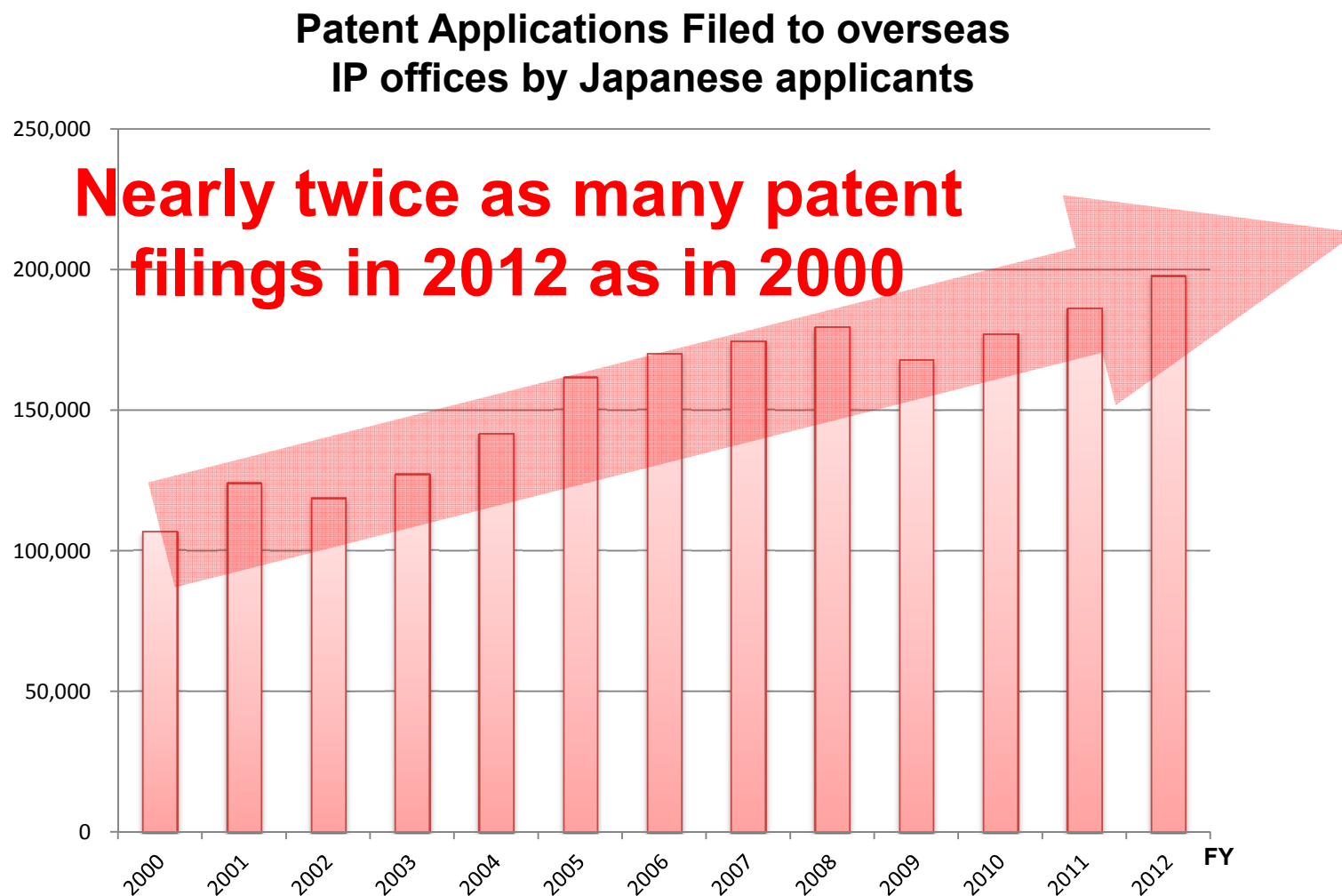
- The number of patent applications filed at the SIPO has grown significantly in recent years, exceeding that filed at the USPTO and ranking number one in the world in 2011.



Current situation of patent examination and JPO's efforts

Trends in International Applications by Japanese applicants

■ The number of patent applications filed to overseas IP offices has been increasing in accordance with their business activities.



Current situation of patent examination and JPO's efforts

JPO's efforts in Prompt Examination (1)

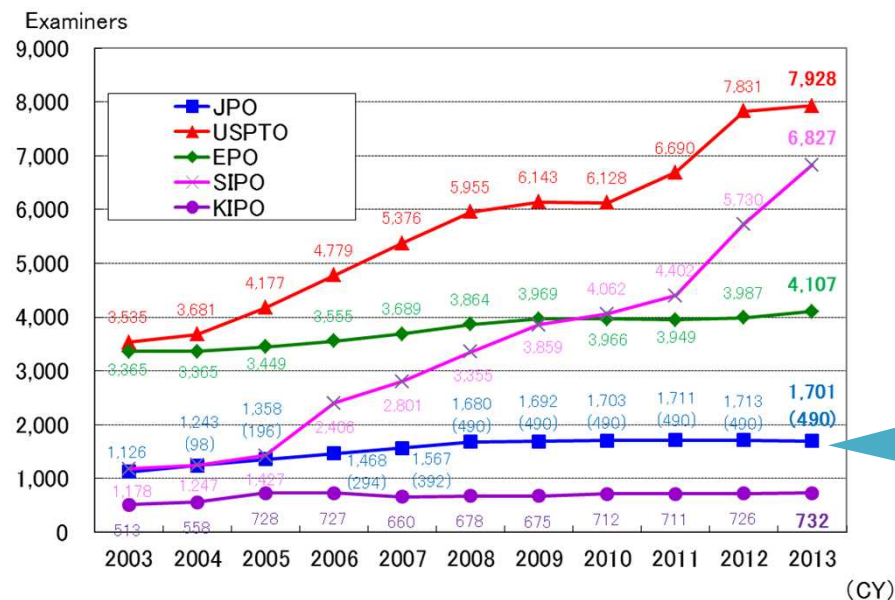
Long-term objective since 2004:

Making FA (First Action) pendency less than **11 months**
at the end of March 2014

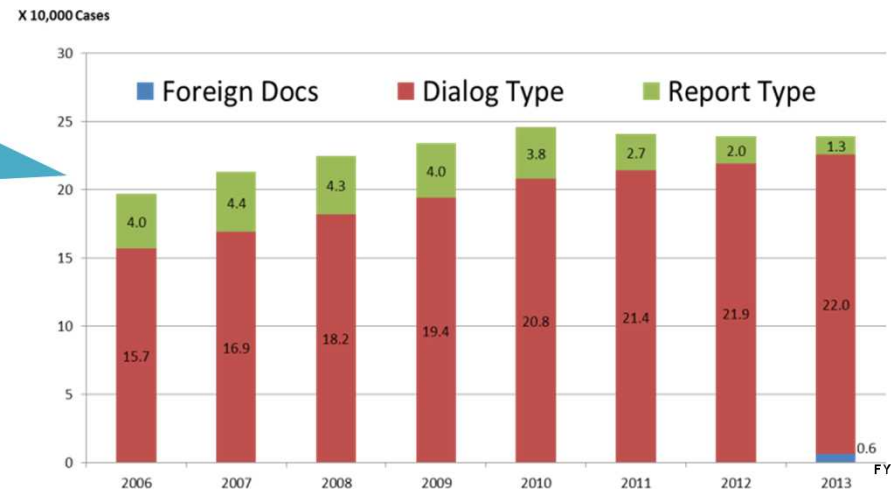
Outsourcing for preliminary prior art searches

→ The JPO established an efficient
and effective examination system

Changes in the Number of Examiners at the JPO



The Number of Outsourced Prior Art Searches

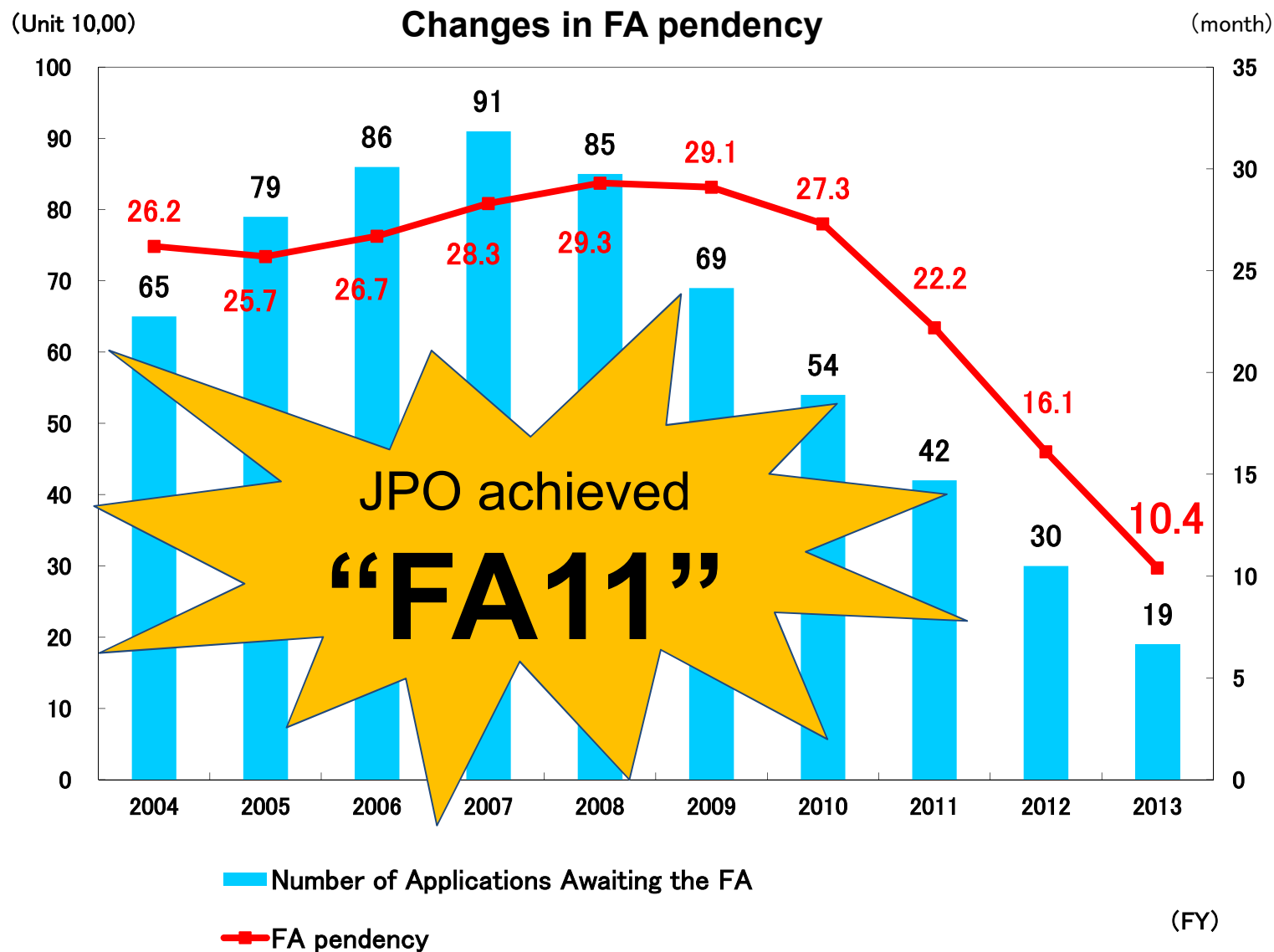


Increasing the number of fixed-term patent examiners

→ The JPO employed a total of approximately 500,
and reinforced the examination system

Current situation of patent examination and JPO's efforts

JPO's efforts in Prompt Examination (2)



Accelerating Examination

JPO's efforts in Prompt Examination (3)

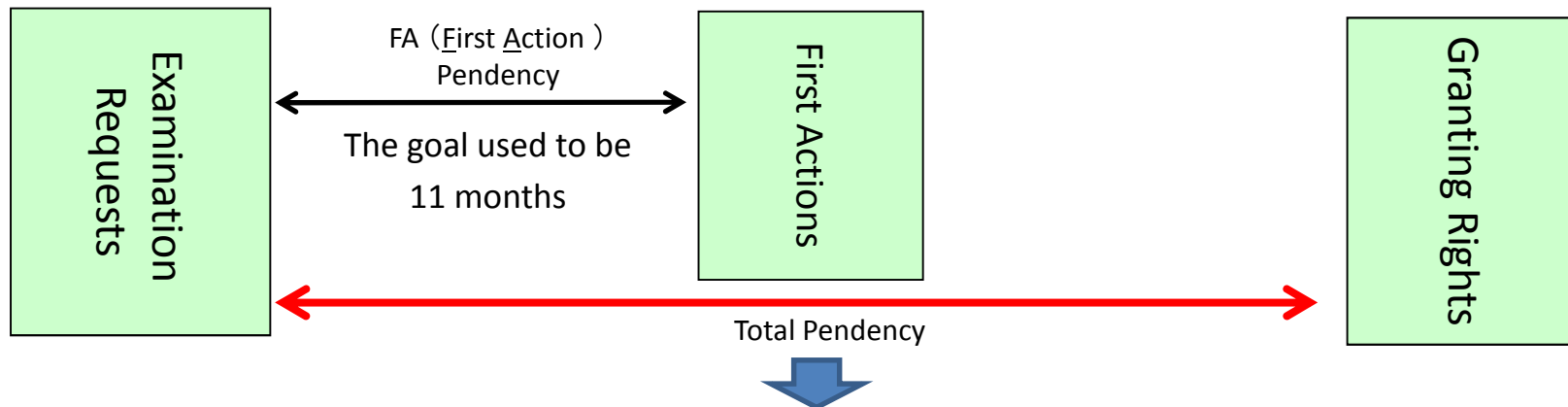
New Goal:

Making patent total pendency* less than **14 months** by FY2023

Making FA pendency less than **10 months** by FY2023

*"Total Pendency" excludes such cases where the JPO requests an applicant to respond to the second notification of reasons for refusal and others.

【Total Pendency and FA Pendency】



JPO	Less than 14 months (targeting by FY2023)
USPTO	20 months(targeting by 2017)
EPO	36.2 months
SIPO	22.6 months
KIPO	21.6 months

Current situation of patent examination and JPO's efforts

Accelerated Examination system (1)

① Meeting any of the requirements

The application is...

- (1) Applied for foreign countries
- (2) Related to Green Technology
- (3) Filed by the SMEs etc.



Applicants

② Following the necessary procedures

- (1) conduct prior art search
- (2) disclose prior arts
- (3) make a comparison between the claimed invention and prior arts

Request

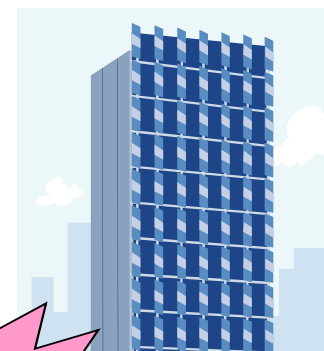
③ Accelerated examination

average period from request to FA

...**2months**

Free of charge

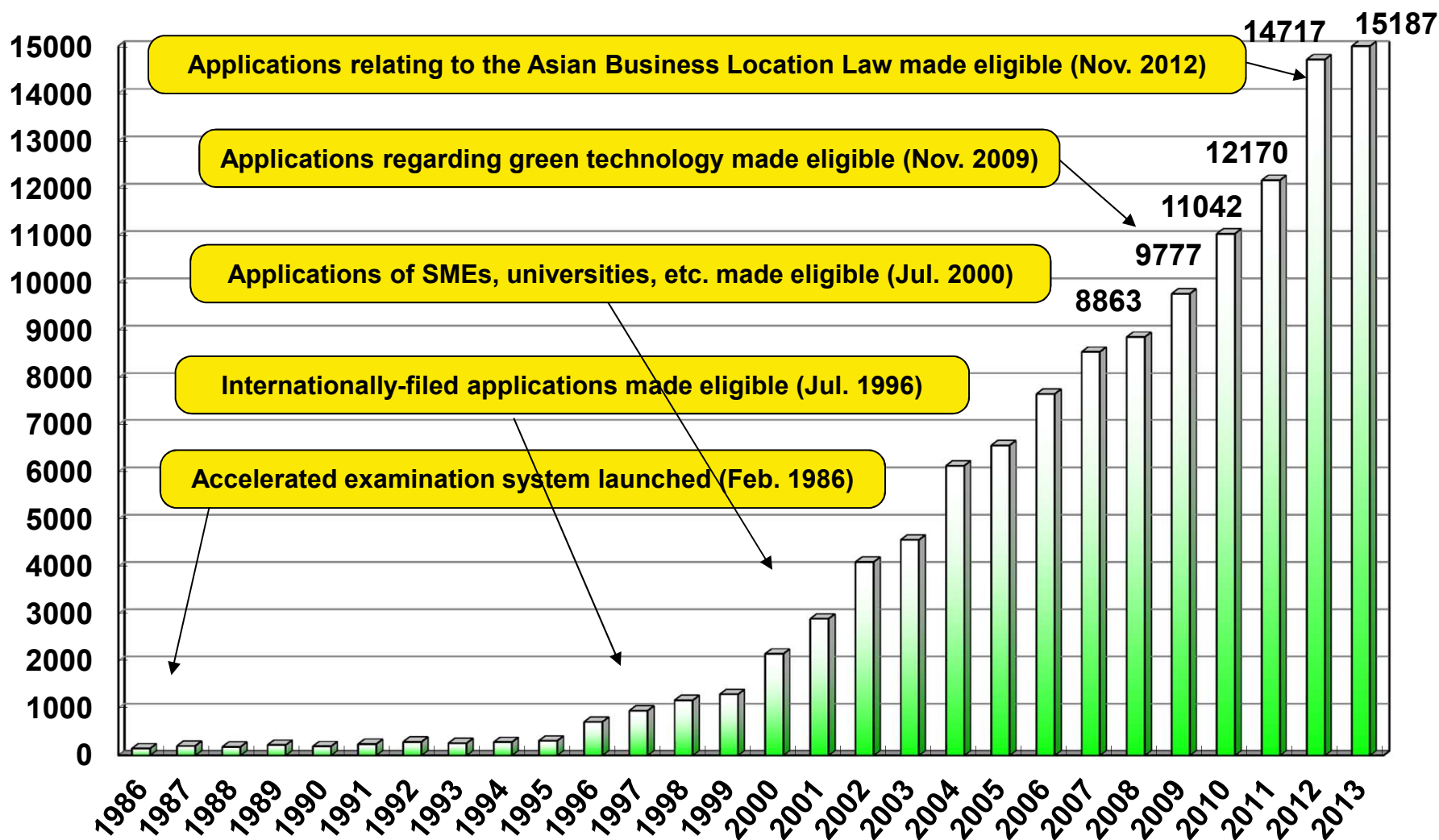
JPO



Current situation of patent examination and JPO's efforts

Accelerated Examination system (2)

Expanding Utilization of Accelerated Examination System



Current situation of patent examination and JPO's efforts

JPO's efforts in Improving Examination Quality (1)

- JPO released its “Quality Policy on Patent Examination” (the “Quality Policy”) in April 2014.
- Based on its Quality Policy, JPO is dedicated to maintain and even further improve the quality of patent examination, aiming to achieve patent examination of the fastest and utmost quality in the world.

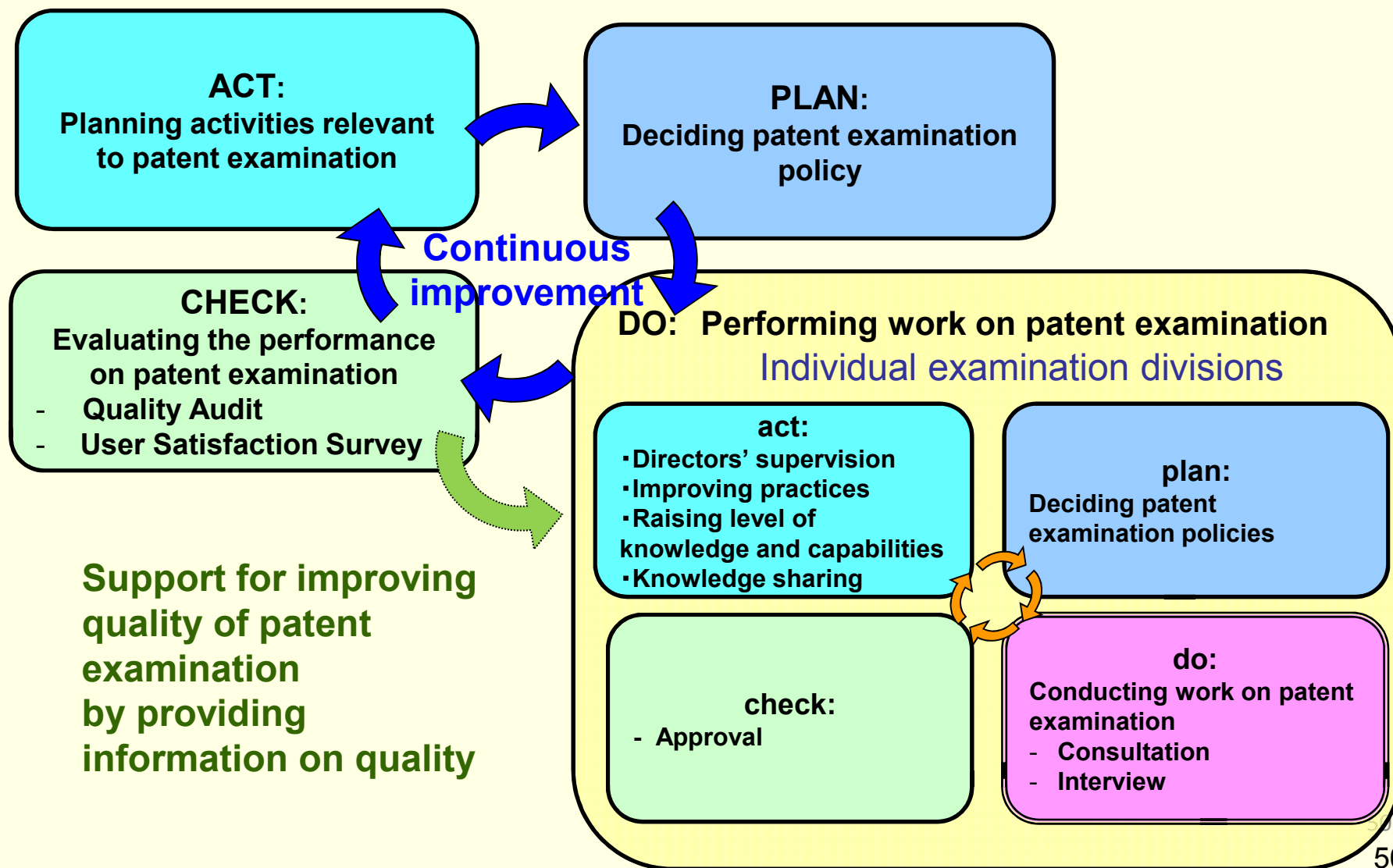
The Quality Policy sets forth the following fundamental principles:

- We grant robust, broad and valuable patents;
- We meet wide-ranging needs and expectations;
- We all dedicate ourselves to improving quality, cooperating with concerned persons and parties;
- We contribute to improving the quality of patent examination globally:
- We continually improve operations;
- We raise the knowledge and capabilities of our staff.

Current situation of patent examination and JPO's efforts

JPO's efforts in Improving Examination Quality (2)

- PDCA Cycle in the Quality Management System -



Current situation of patent examination and JPO's efforts

JPO's efforts in Improving Examination Quality (3)

- PDCA Cycle in the Quality Management System -

1. Quality Management at the Examination Division Level

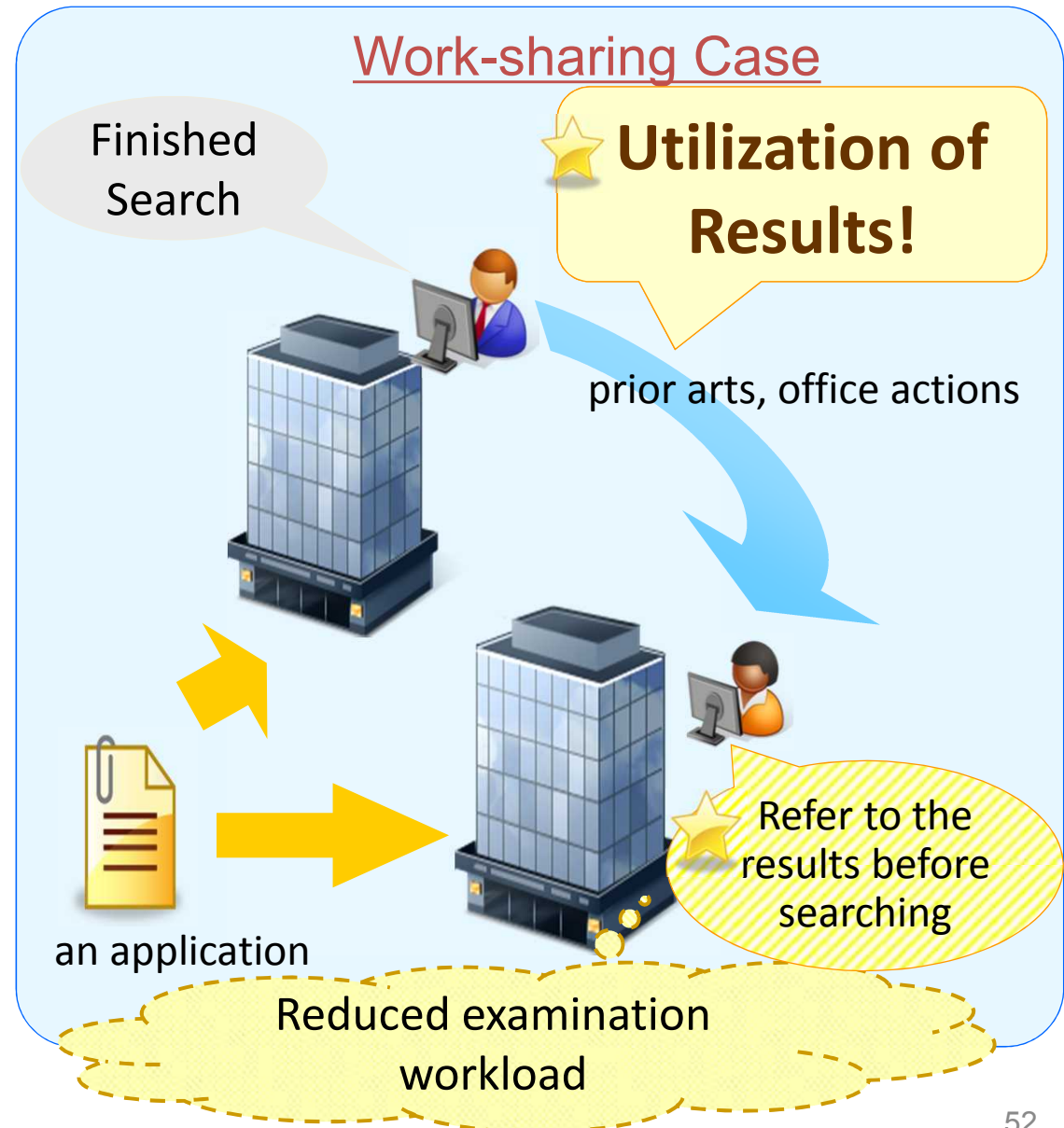
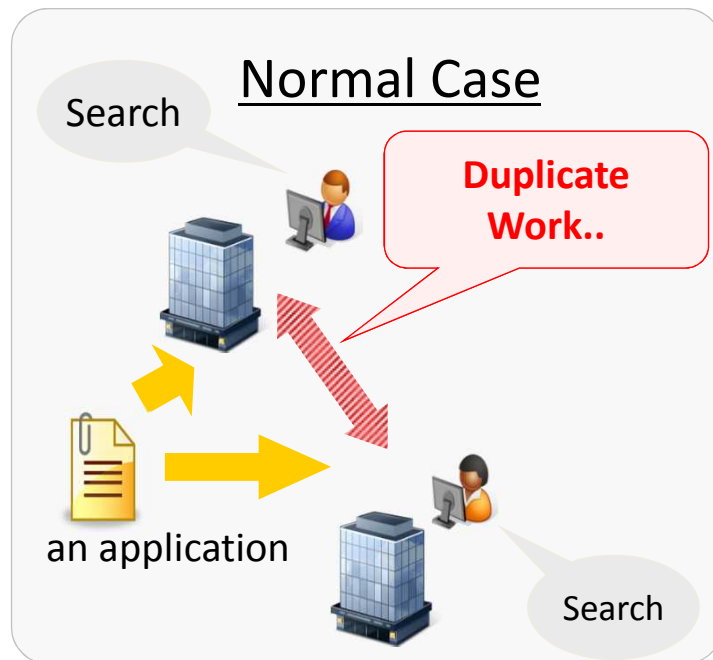
- i. Consultation – Have consultations with any other examiners whenever examiners need advice or have any questions
- ii. Approval – Directors' Check on examiners' outputs

2. Quality Management at the Examination Department Level

- i. Quality Audit
 1. Quality Audits on “PCT Applications” and “Decisions to Grant”
(Check the appropriateness of prior art searches by conducting additional searches)
 2. Quality Audits on “Reasons for Refusal” and “Decisions of Refusal”
(Check the appropriateness of reasoning, No additional searches)
 3. Checks on Formality Defects
- ii. User Satisfaction Survey –Collect user's needs

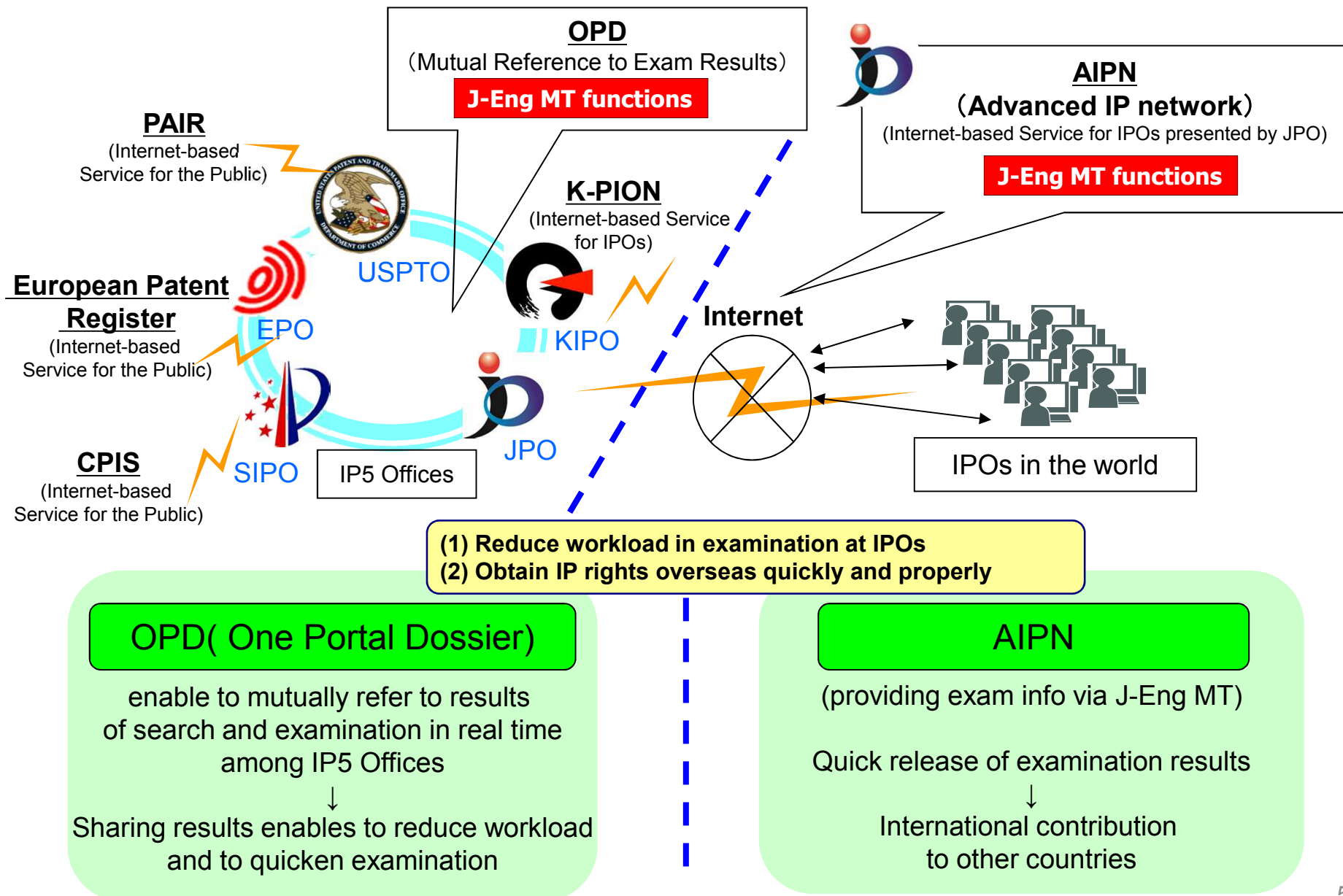
Actions for Work sharing and International Cooperation

Efficiency of Work sharing



3. Actions for Work sharing and International Cooperation

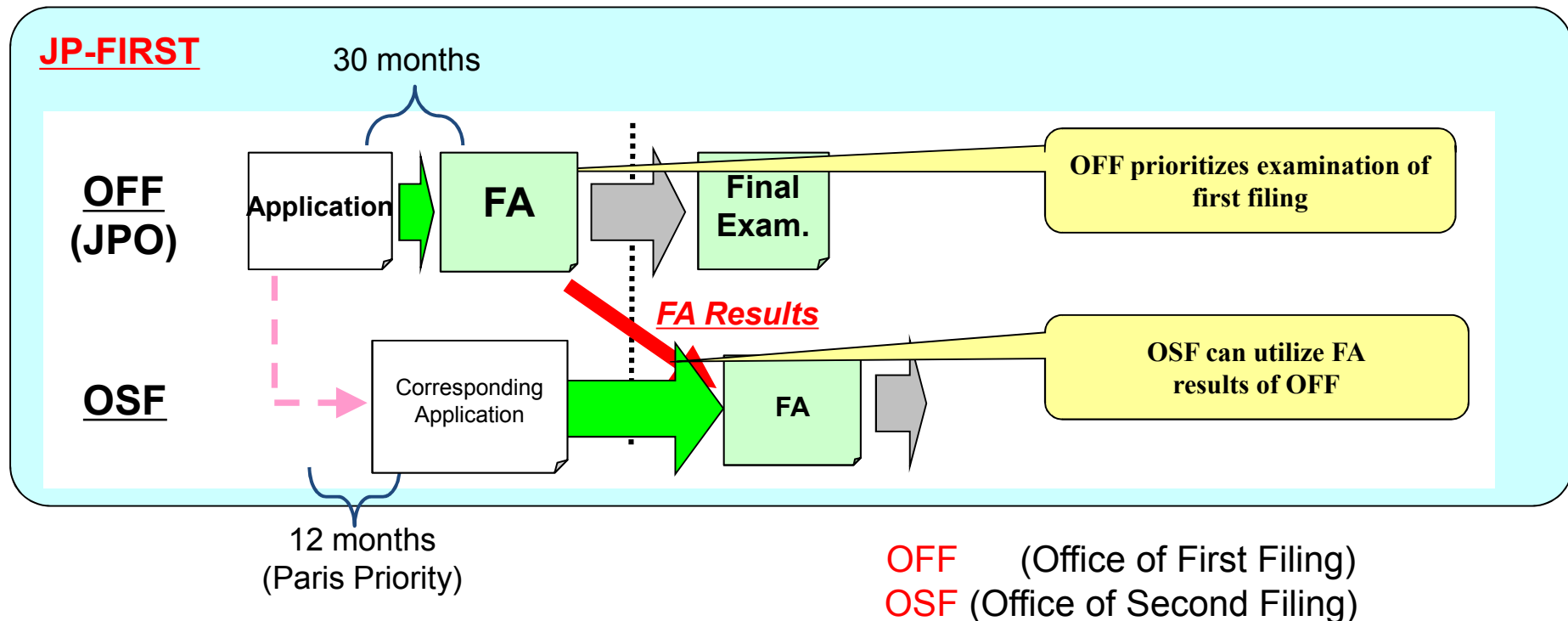
Mutual exploitation of search/examination results - Dossier Access System-



Actions for Work sharing and International Cooperation

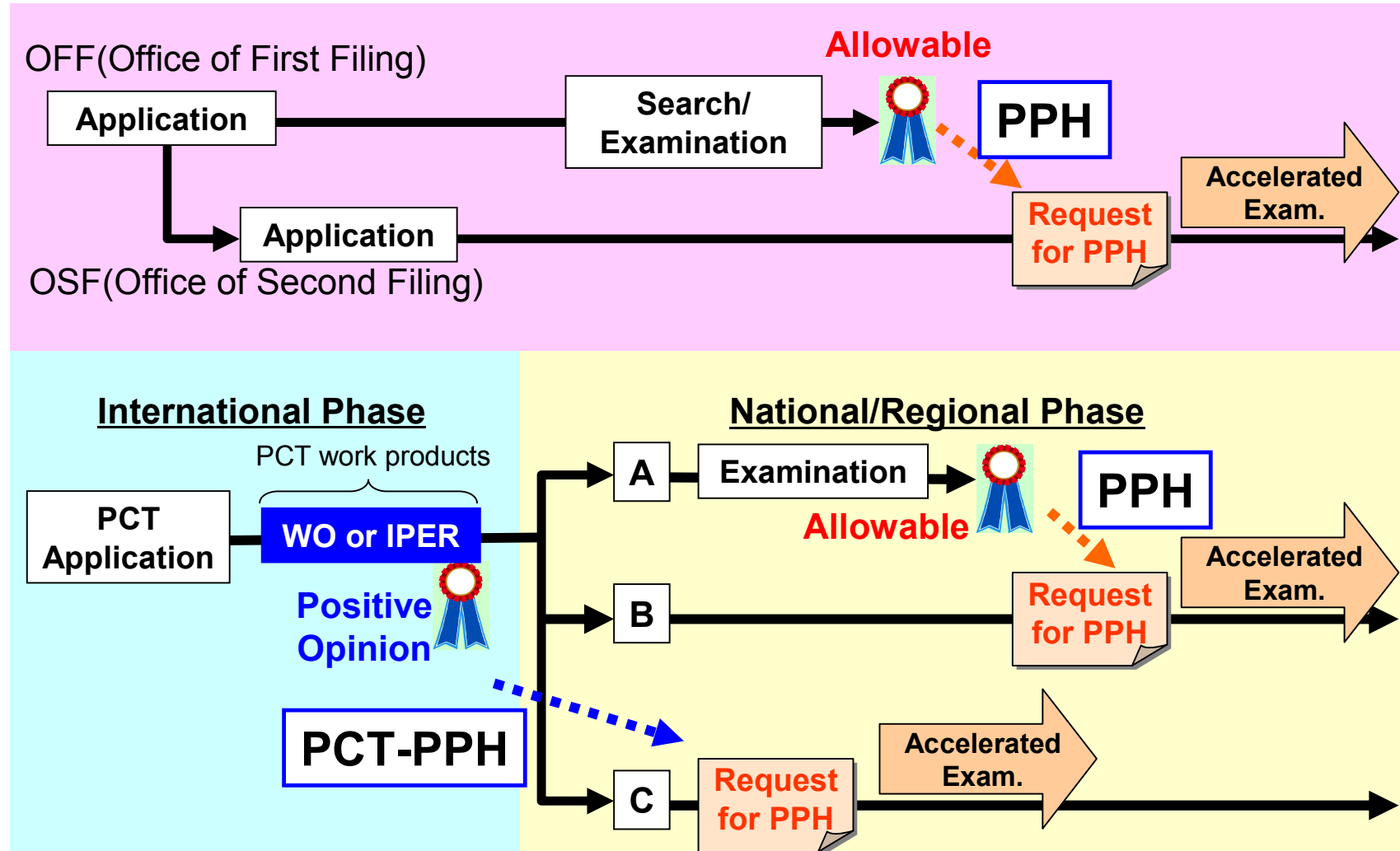
JP-FIRST (JP-Fast Information Release Strategy)

- The JPO prioritizes examination of applications satisfying both (i) & (ii)
 - (i) First filed at the JPO (and then filed via the Paris route with OSF)
 - (ii) Examination of application is requested within 2 years from the JPO filing date
- The JPO provides examination results (First office Actions; FA) to applicants within 30 months from the JPO filing date
- A considerable quantity of JPO FA results can be provided to the OSF before OSF examinations



3. Actions for Work sharing and International Cooperation

PPH (Patent Prosecution Highway)

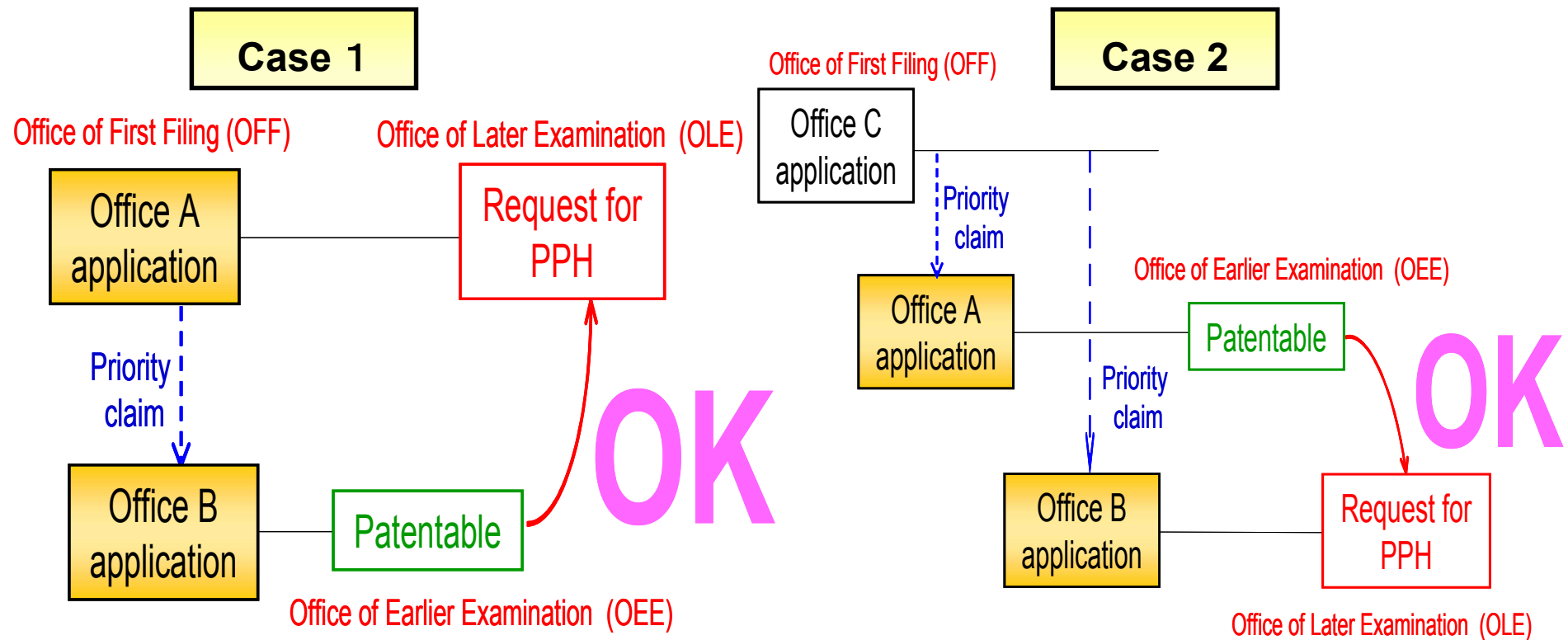


Actions for Work sharing and International Cooperation

PPH MOTTAINAI Pilot Program ~Easing of PPH requirements~

Under this pilot program, request is eligible, whether or not the office which provides the examination results is the Office of First Filing (OFF).

The newly eligible examples under the PPH MOTTAINAI Pilot Program

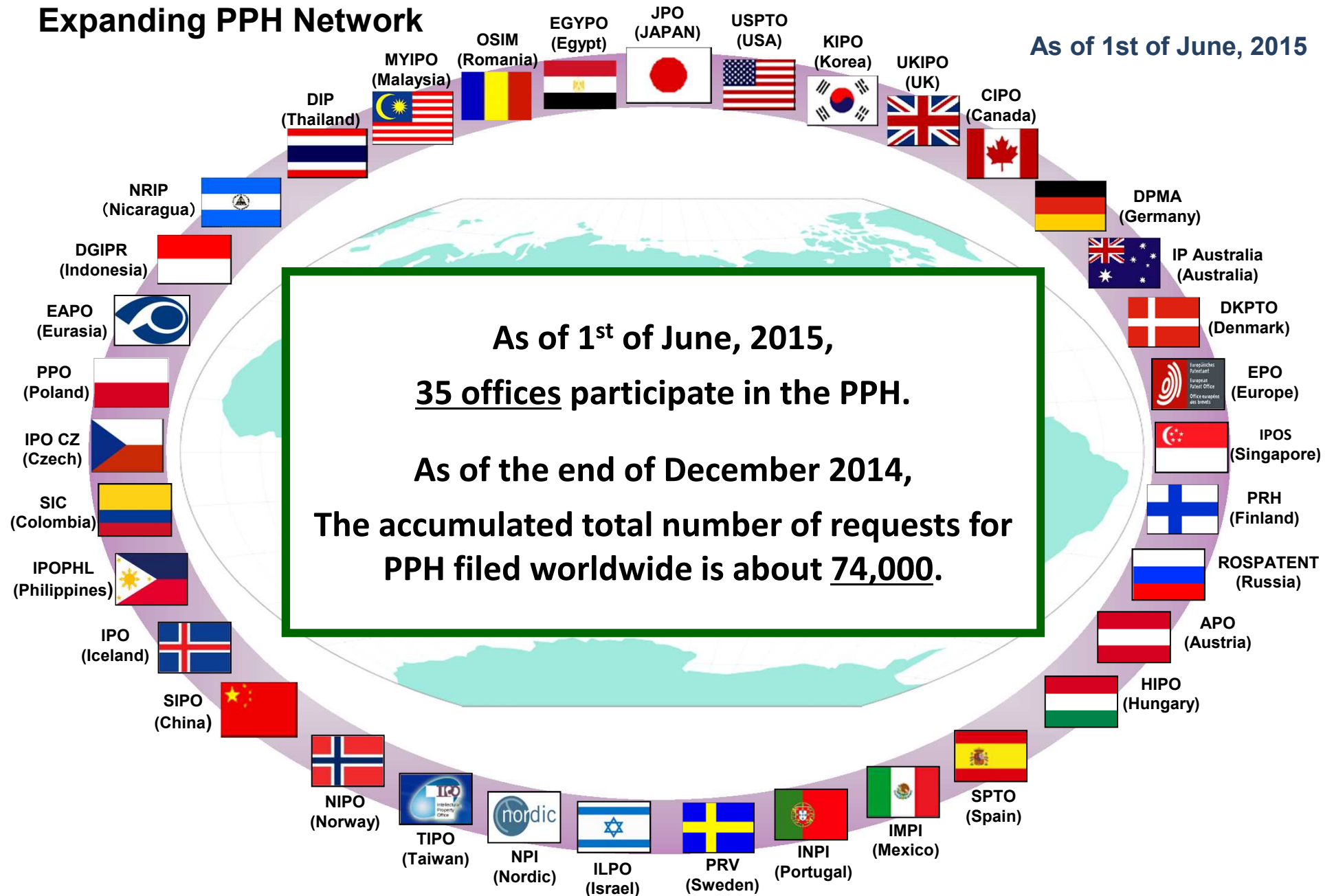


※ ...the participating Office for this Pilot Program

Actions for Work sharing and International Cooperation

Expanding PPH Network

As of 1st of June, 2015

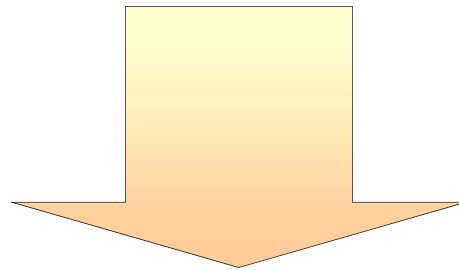


Actions for Work sharing and International Cooperation

Examiner Exchange (1)

➤ Purposes

1. Mutual understanding of the other offices' examination practices
2. Learning useful tools for examiners themselves
3. Fostering mutual confidence on “work results” of the other offices

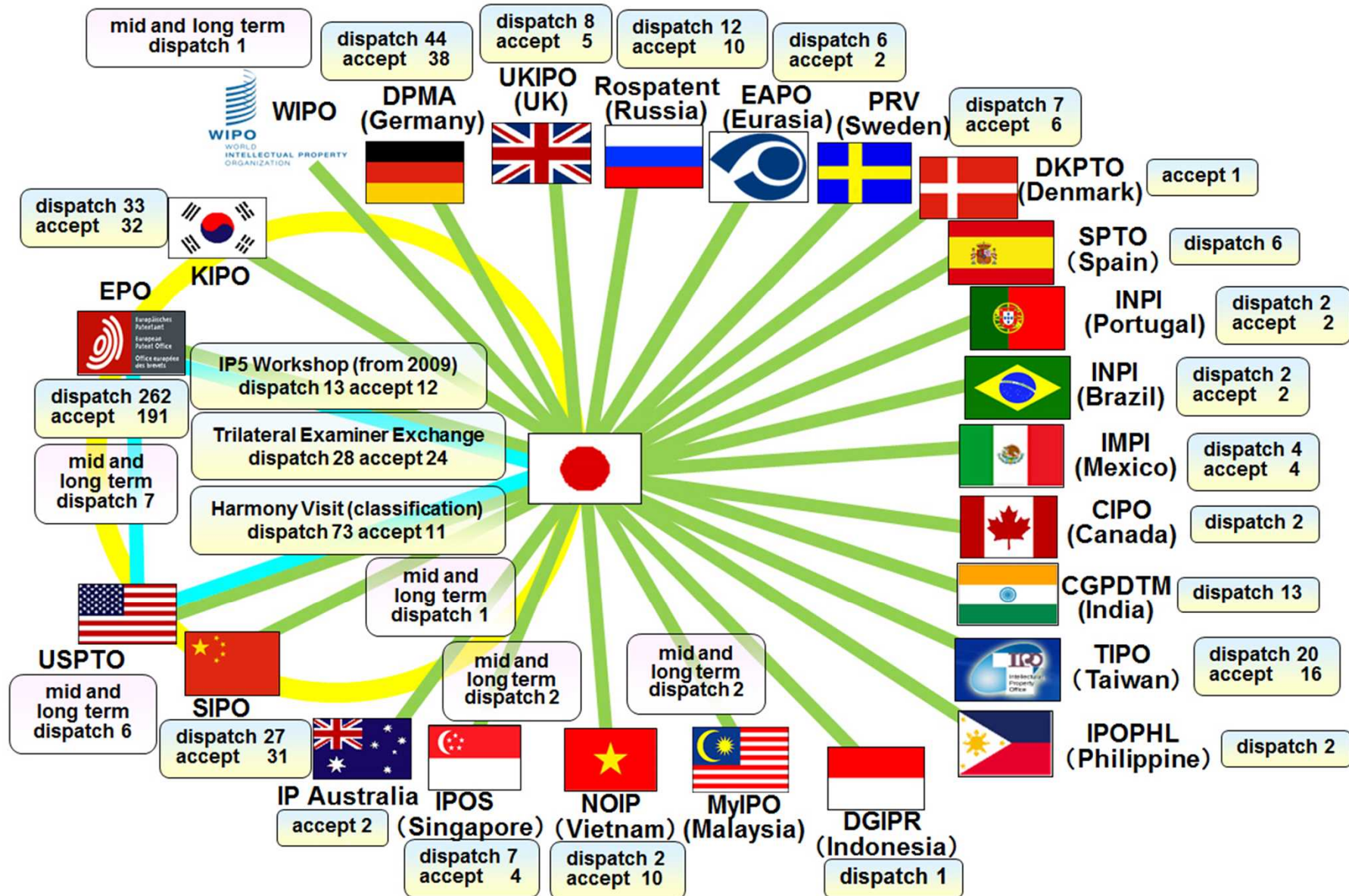


Maximize mutual exploitation of search/examination results among the offices

Actions for Work sharing and International Cooperation

Examiner Exchange (2)

➤ As of end of May, 2015



Thank you for your attention