

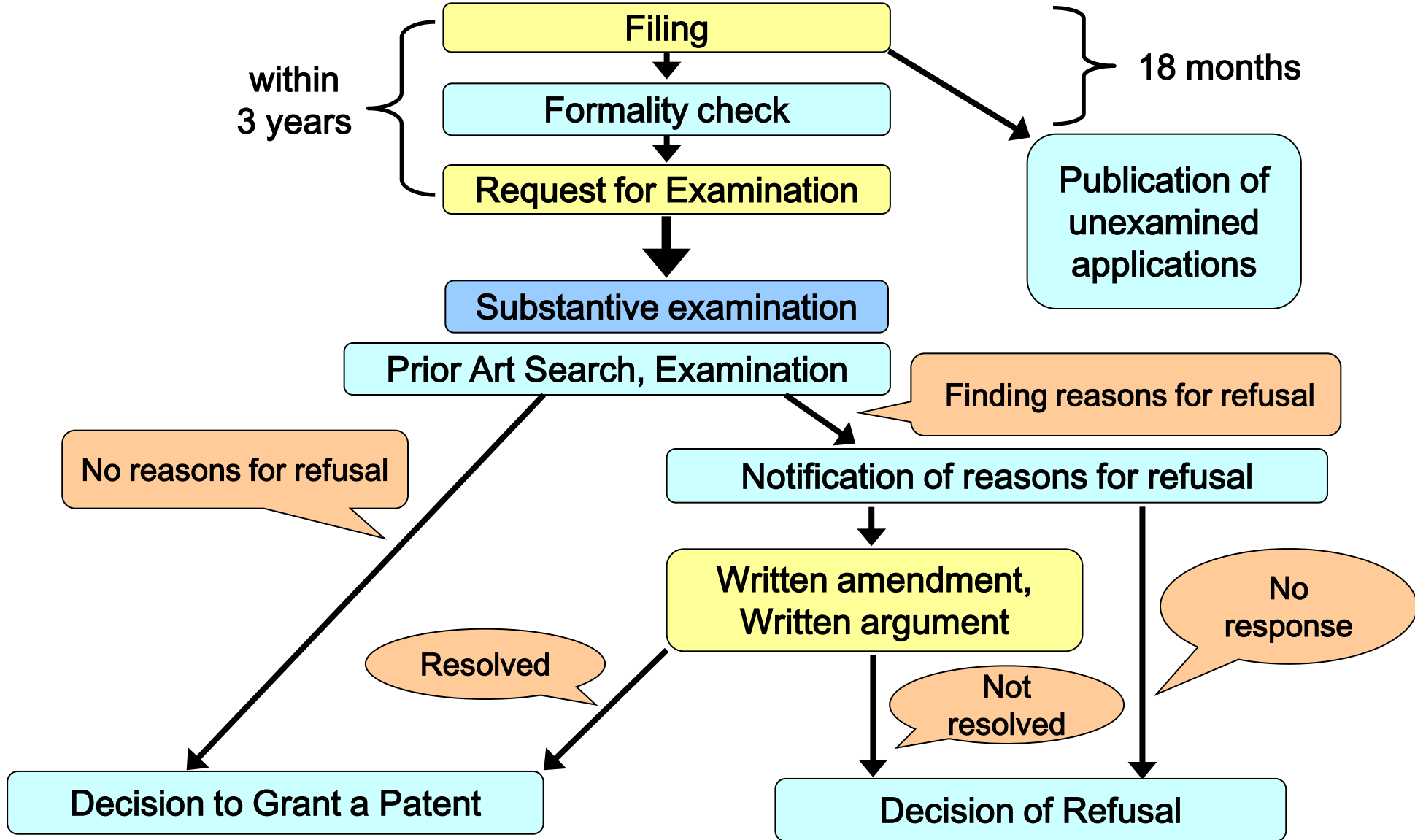
# *Japanese practice in prior art search*

**WIPO Patent Examiner Training Workshop**

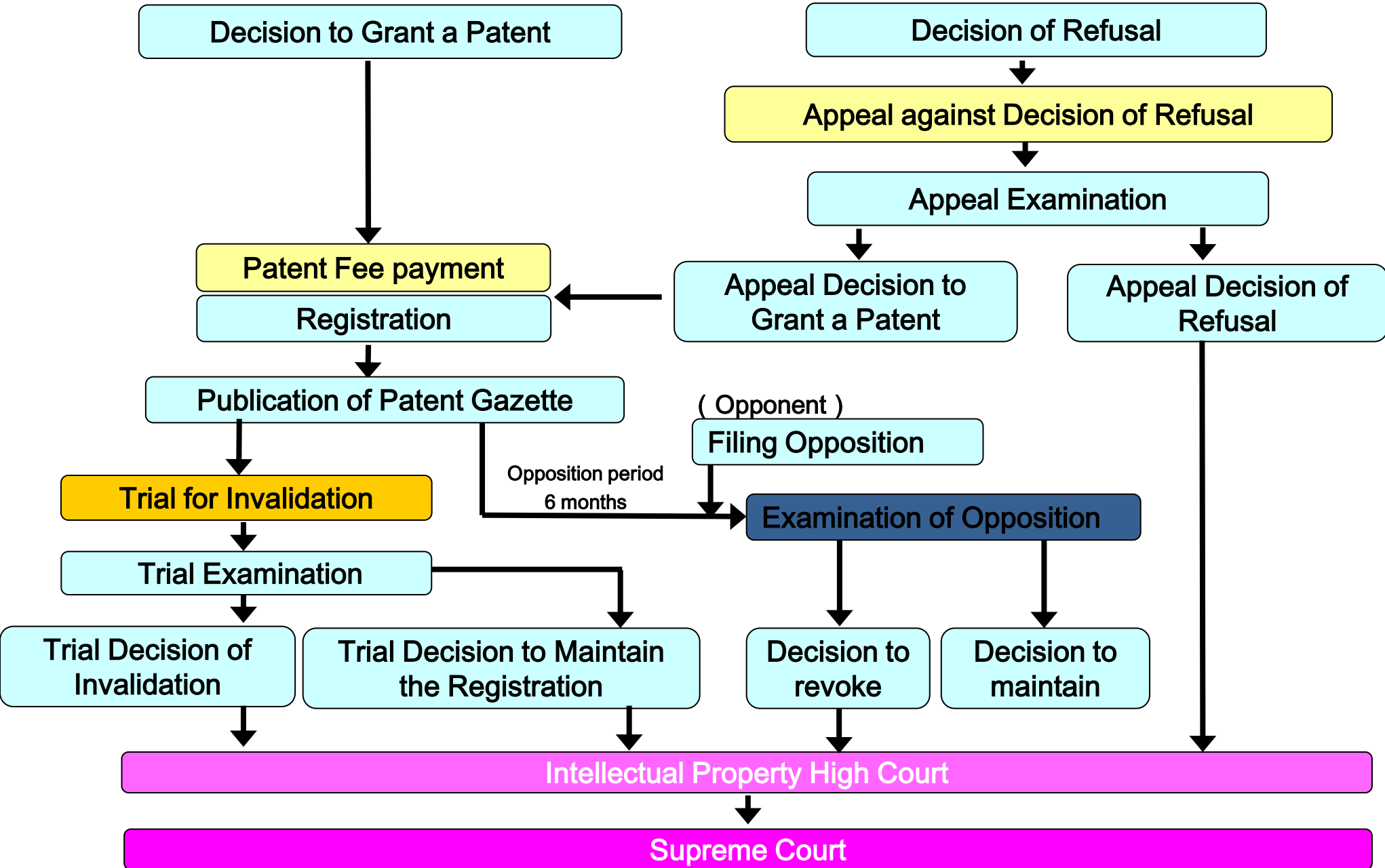
**March 2016**

**JAPAN PATENT OFFICE**

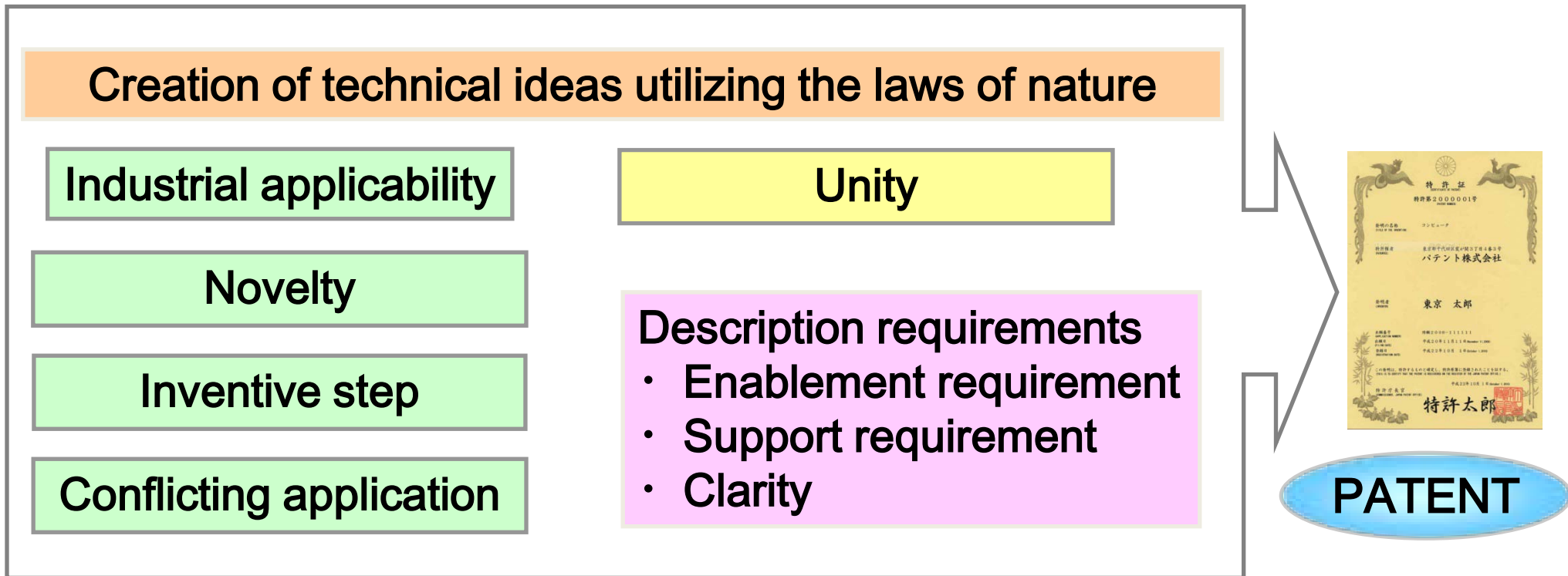
# 1.1 Japanese Patent Process Flow: Examination Stage



# 1.1 Japanese Patent Process Flow: Appeal Stage



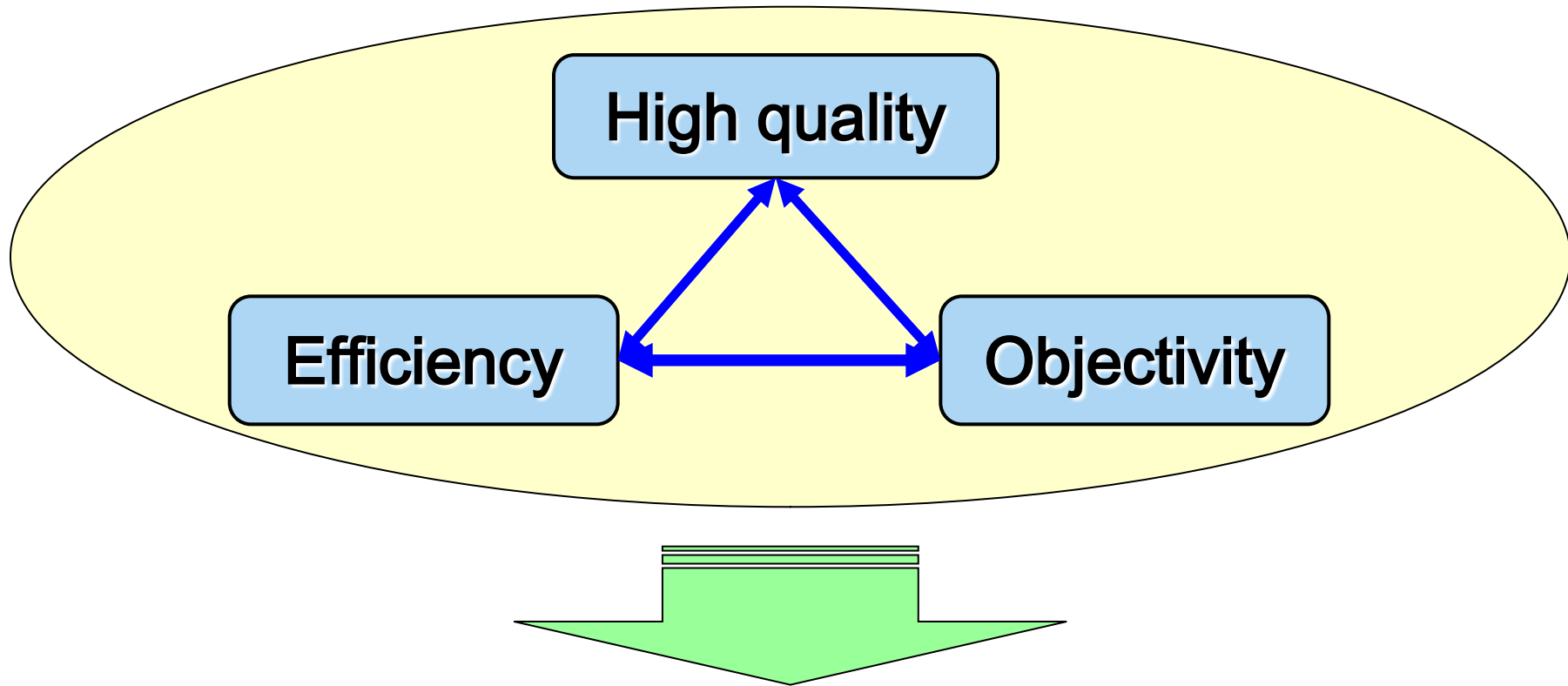
## 1.2 Substantive Examination: Patentability requirement



Requirements such as novelty, inventive step, and conflicting application are closely related to a prior-art document search.

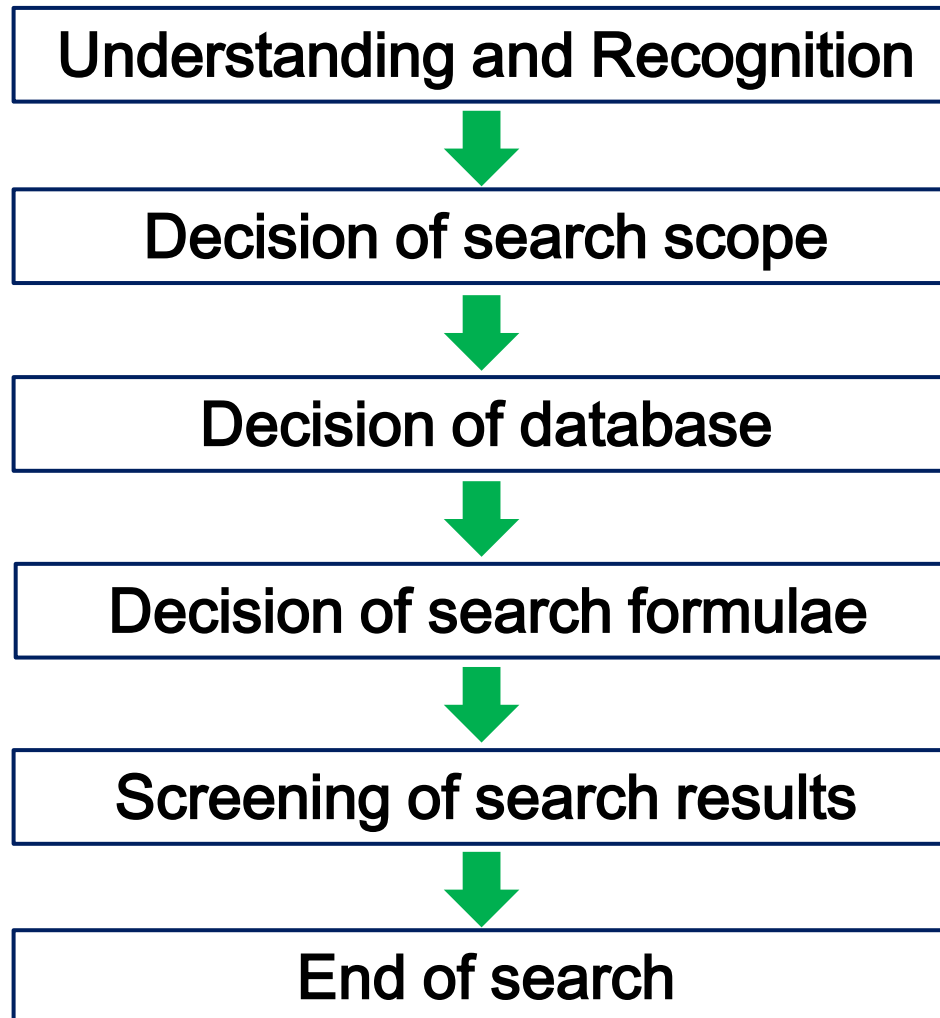
Examiners normally need to conduct a **prior-art-search** to identify that the examined patent applications are in conformity with those requirements.

### Three elements for an ideal search



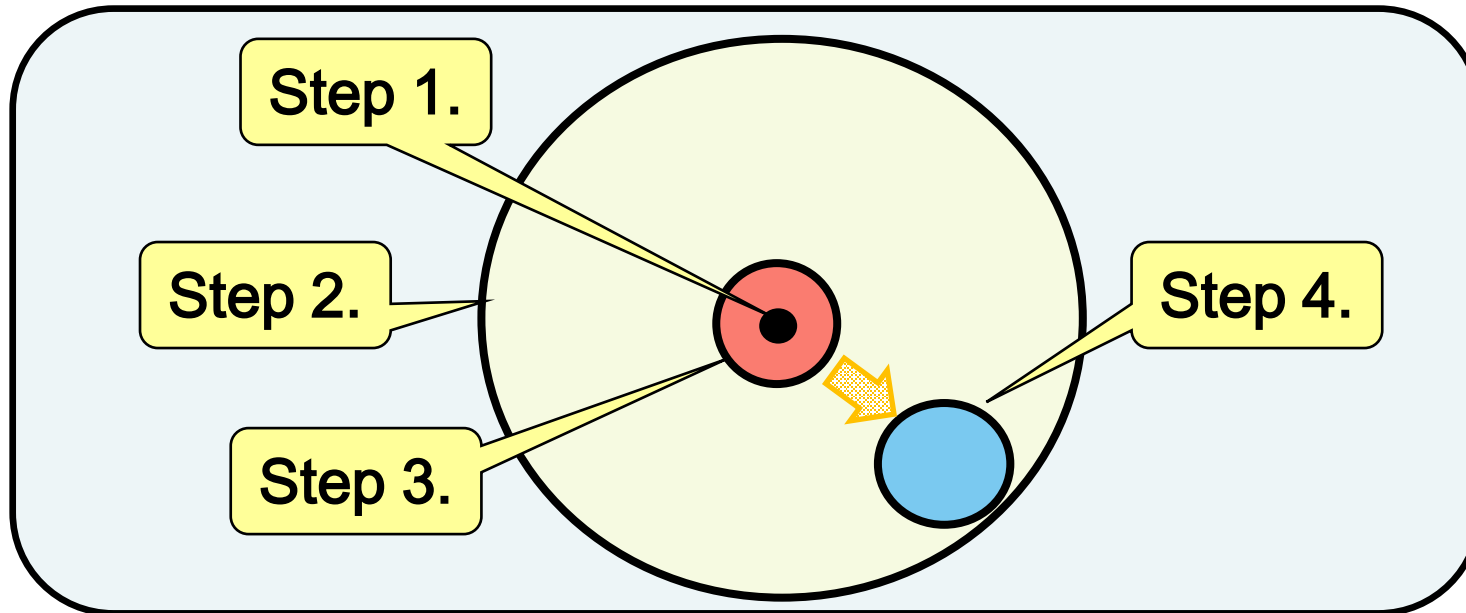
Establishing search strategy is necessary and significant

### A. Search Flow



## B. Decision of search scope - 1/7

### Accessible Documents



Step 1. Recognize an invention

Step 2. Determine outer border of search scope

Step 3. Determine search scope

Step 4. Change search scope

## B. Decision of search scope - 2/7

~ Step 3. Determination of search scope ~

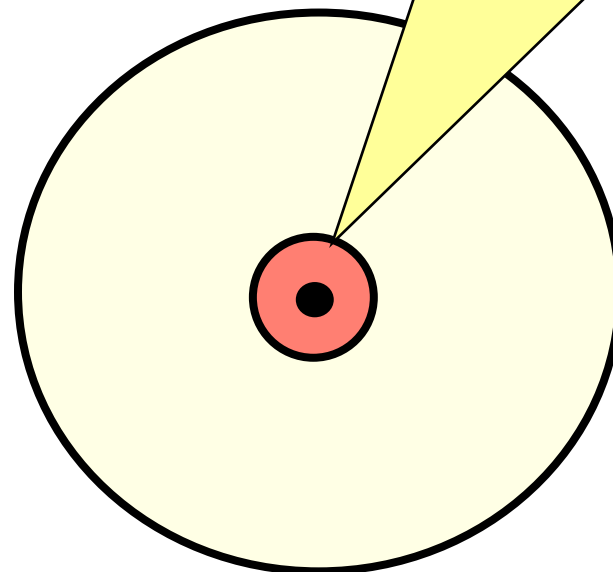
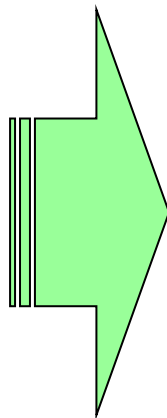
*Search scope having all the elements of the claimed invention*

~ Example ~

pen AND clip AND cap

### Claims

1. A pen having a clip and a cap



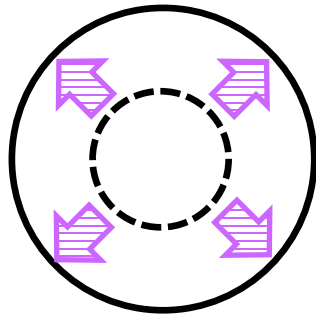


## B. Decision of search scope - 3/7

~ Step 4. Change of search scope ~

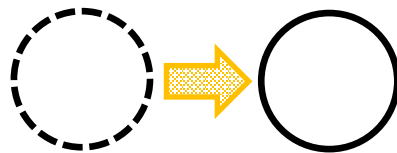
**Expansion or Shift of search scope**

Expansion



- ✓ Generalization of element(s)
- ✓ Deletion of element(s)

Shift

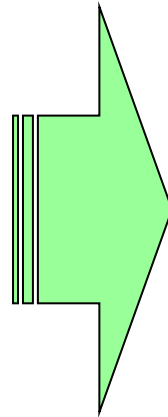


- ✓ Neighboring technical field(s)

## B. Decision of search scope - 4/7

### ~ Step 4. 1. Expansion of search scope ~

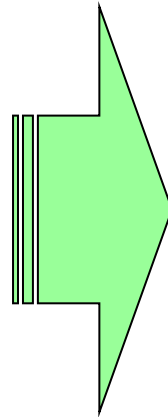
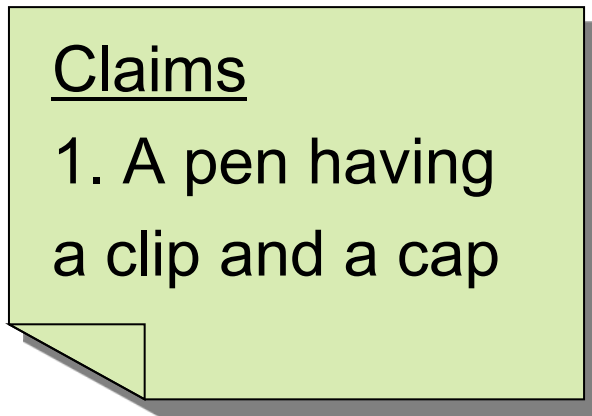
Claims  
1. A pen having  
a clip and a cap



- ✓ Generalization of element(s)
  - *A writing instrument*  
having a clip and a cap
- ✓ Deletion of element(s)
  - A pen *having a cap*
  - A pen *having a clip*

### B. Decision of search scope - 5/7

~ Step 4. 2. Shift of search scope ~



✓ Neighboring technical field

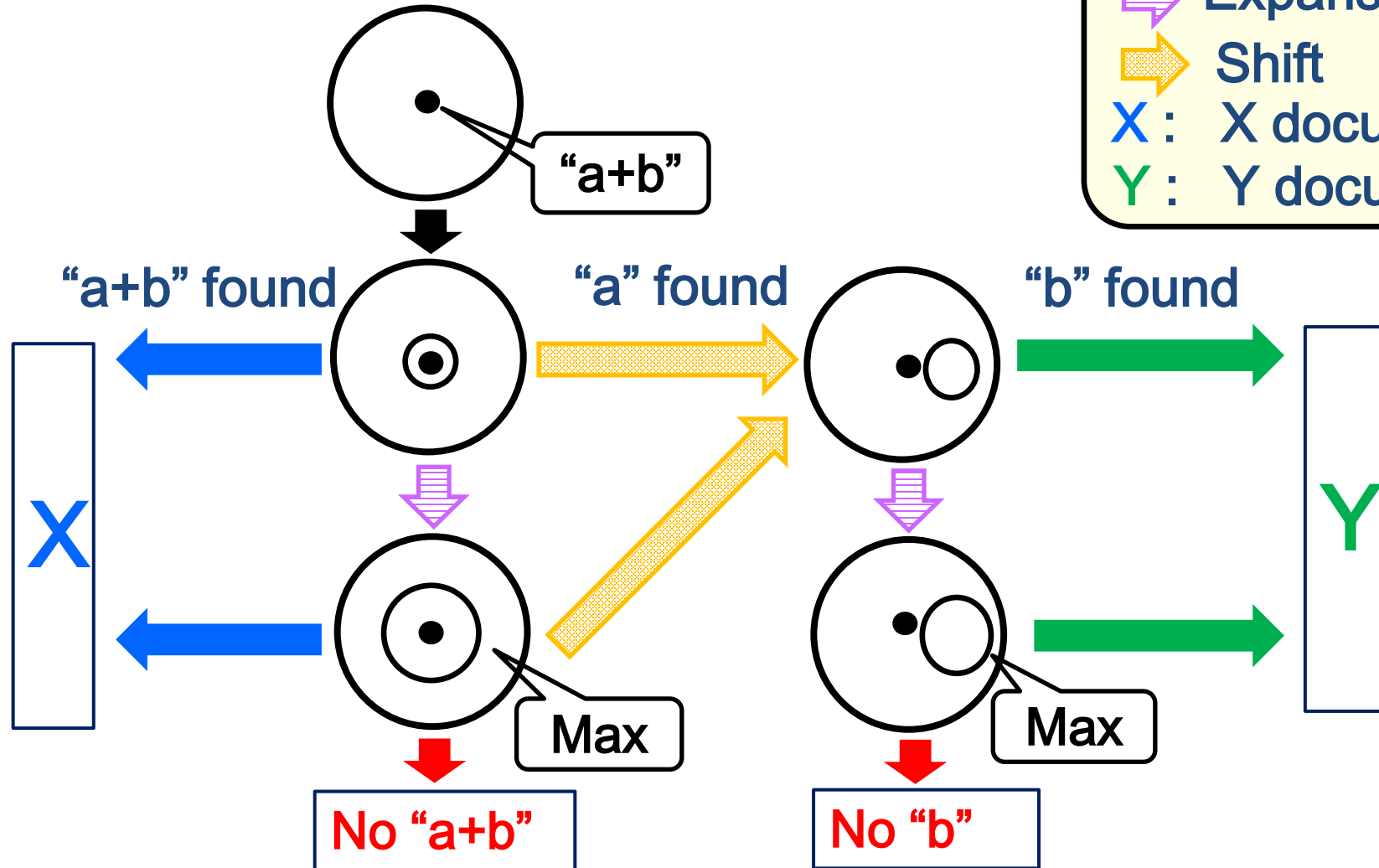
- *An electronic stylus* having a clip and a cap



## B. Decision of search scope - 6/7

~ Change of search scope ~

Expansion  
Shift  
X : X documents  
Y : Y documents



## B. Decision of search scope - 7/7

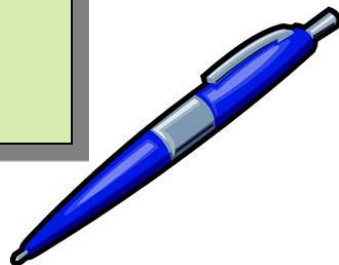
~ Tips for more efficient search ~

### Claims

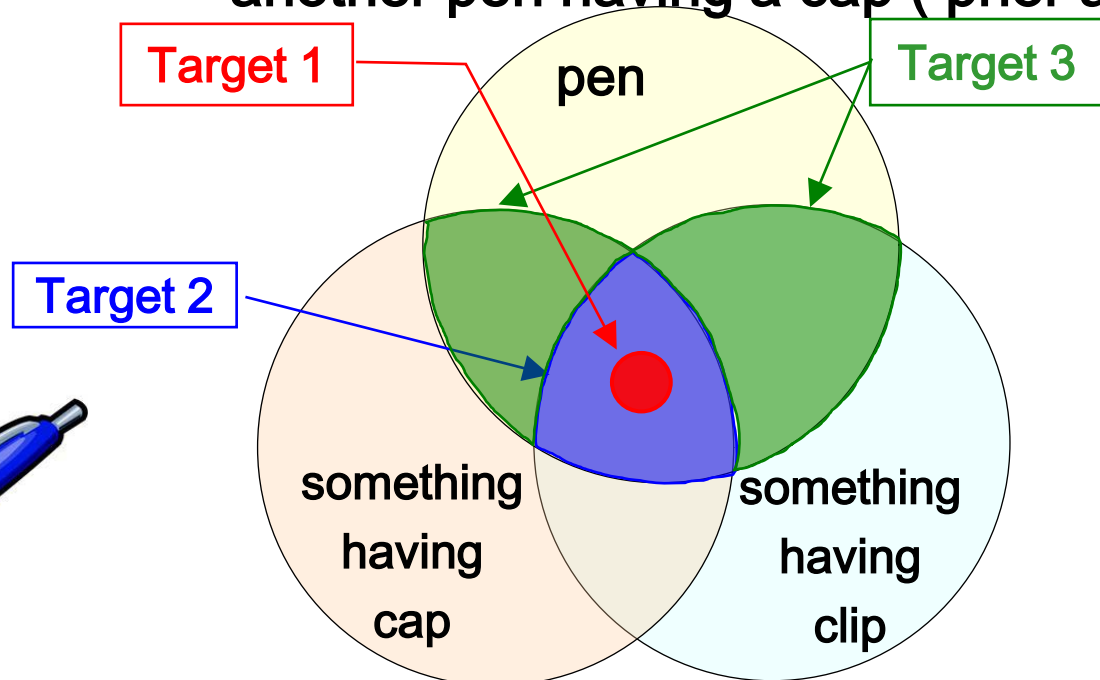
1. A pen having a clip and a cap.

### Embodiment

A *ball-point* pen having a clip and a cap

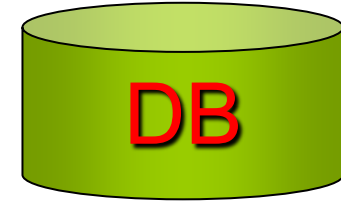


- Target 1:** A *ball-point* pen having a clip and a cap
- Target 2:** A pen having a clip and a cap
- Target 3:** A pen having a clip ( prior art 1) and another pen having a cap ( prior art 2)



### C. Decision of database

*~ How to select database ? ~*



- Basic inventions and academic inventions of element(s)
  - Patent Gazette
  - Papers by using Commercial DB and the Internet
- The fields where specific search tools have been established
  - CAS for compounds
  - ICIREPAT for metal alloys
- Improvement invention
  - Patent Gazette

### D. Decision of search formulae - 1/3

- Search formulae are created based on search scope and database
- **Search scope** determines the contents of search formulae.
  - When search scope is “*pen* AND *clip* AND *cap*”, search formulae can be “*(pen\*clip\*cap)/tx*”.
- **Database** determines the description methods of search formulae.
  - When classification(IPC) is assigned to documents in the database, search formulae whose search scope is “*pen* AND *clip* AND *cap*” can be “*B43K9/00 \* clip/tx*” (B43K9/00 : Cap for pen)

### D. Decision of search formulae - 2/3

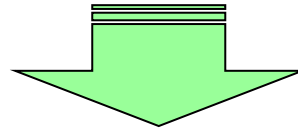
~ *Tips for keyword search* ~

#### Claims

1. A pen having a clip and a cap



Search formulae : *(pen\*clip\*cap)/tx*



#### ■ Synonym

➤ *(pen\*[clip+pin]\*cap)/tx*

(“pin” is a synonym of “clip”)

#### ■ Proximity

➤ *{pen,clip,cap},10n/tx*

(“pen” and “clip” and “cap” are within 10 words)



### D. Decision of search formulae - 3/3

#### ~ Tips for classification search ~

#### Claims

1. A pen having  
a clip and a cap



- When classification is not available...

- *(pen\*clip\*cap)/tx*

- When IPC is available...

- *B43K9/00\*clip/tx*

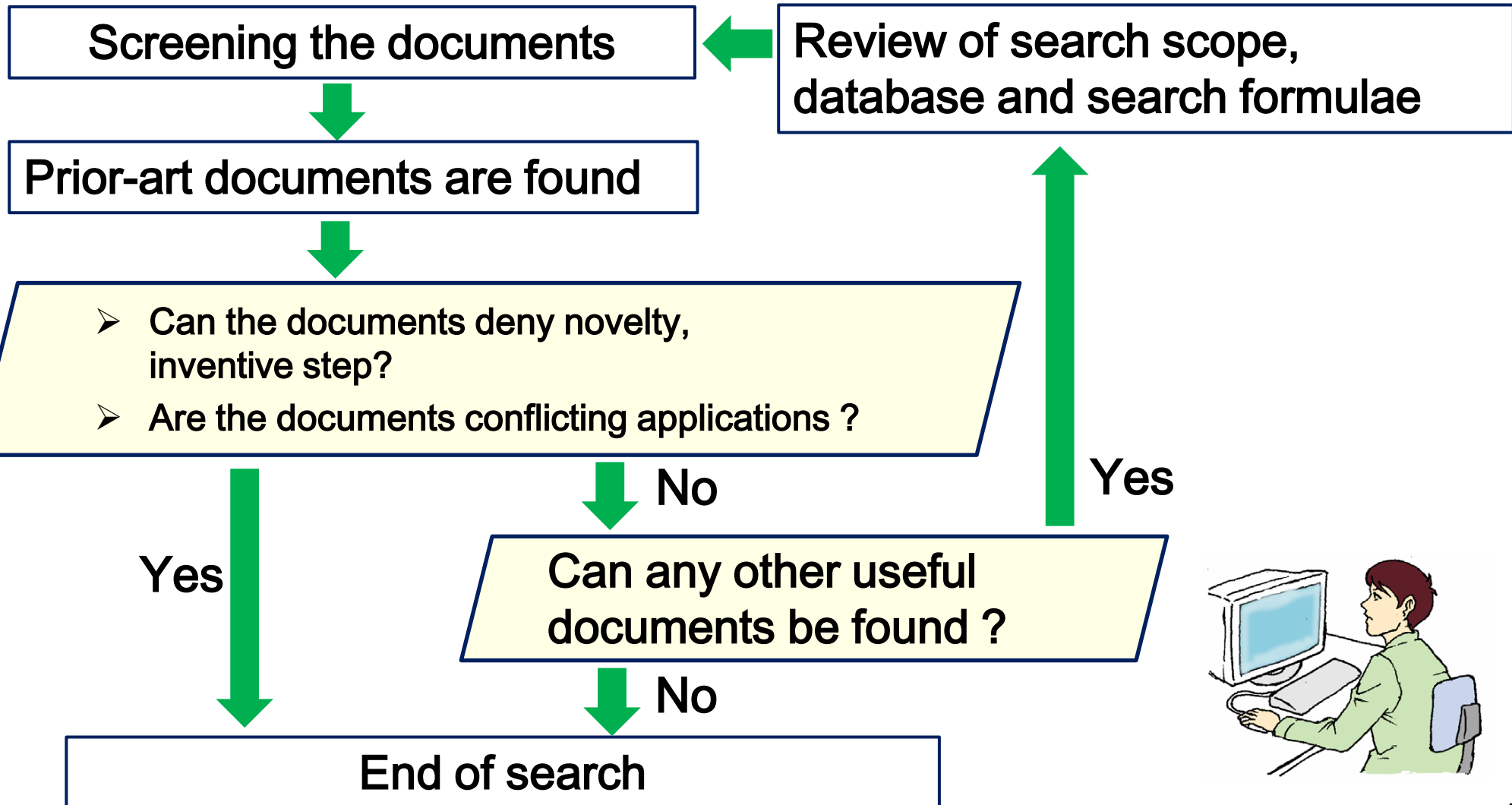
(IPC B43K9/00 : Cap for pen)

- When FI is available...

- *B43K9/00@F*

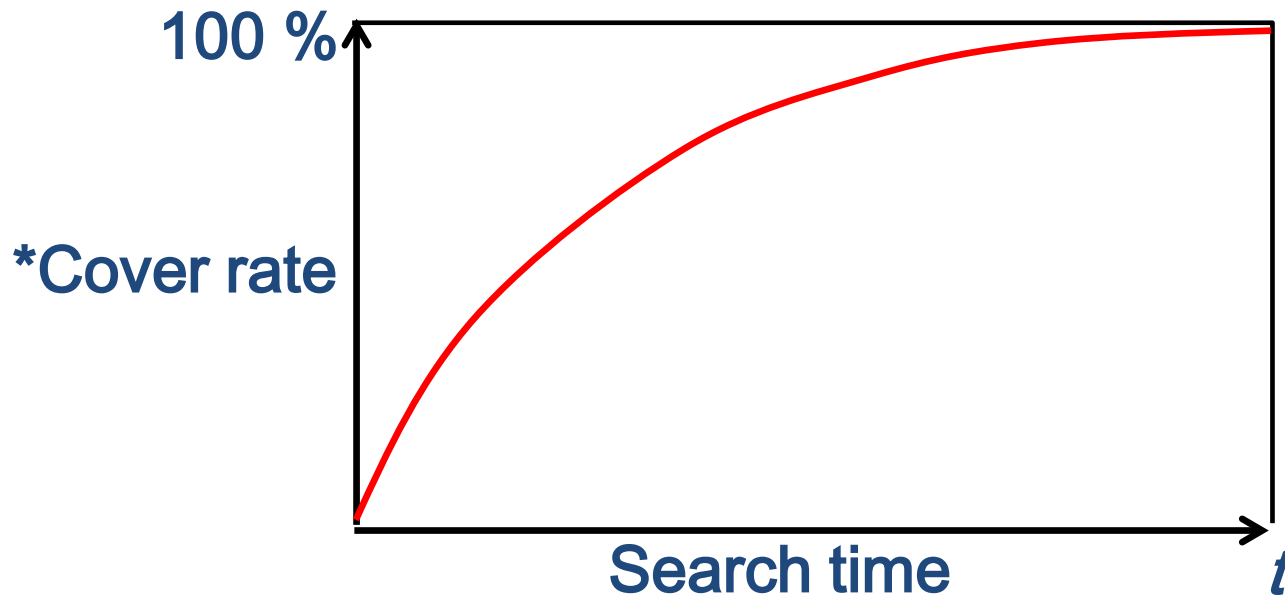
(FI B43K9/00@F : Cap and clip for pen)

## E. Screening of search results - 1/3



### E. Screening of search results - 2/3

*~ When do you finish prior art search ? ~*



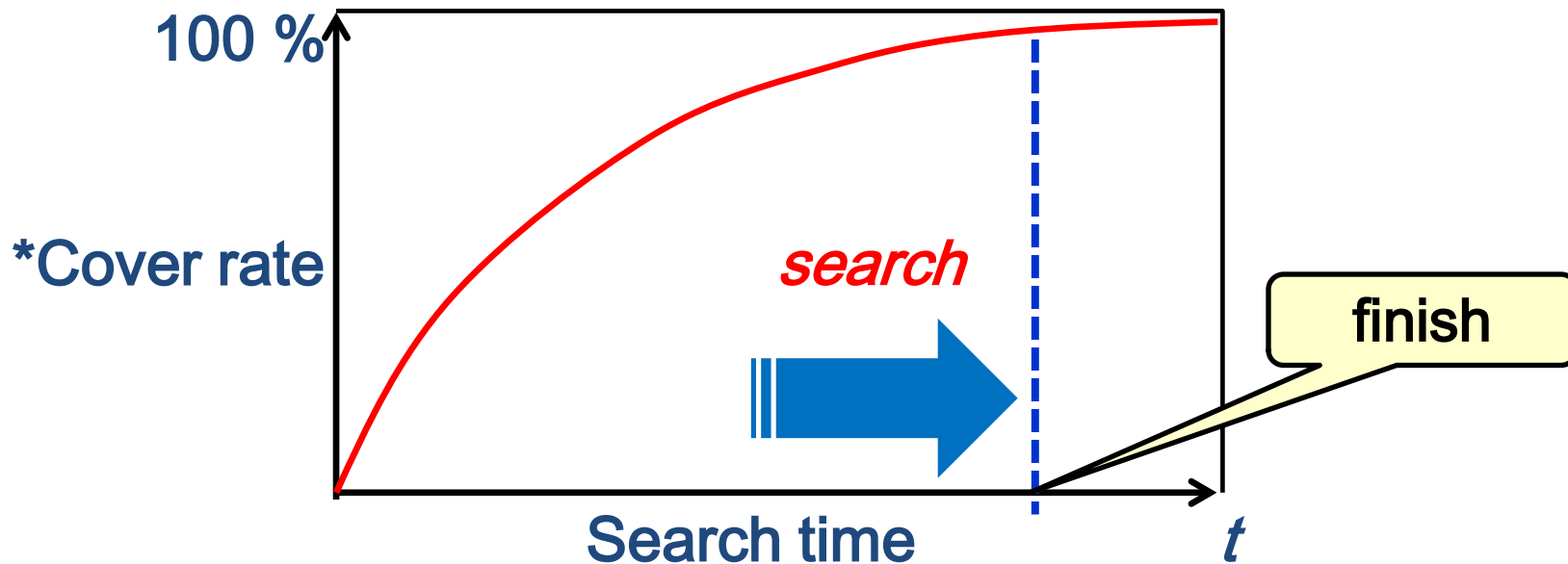
Cover ratio approaches 100 % as search time increases.  
However, search time is limited for examiners...



\*The percentage of documents you have searched within the outer border of the search scope

### E. Screening of search results - 3/3

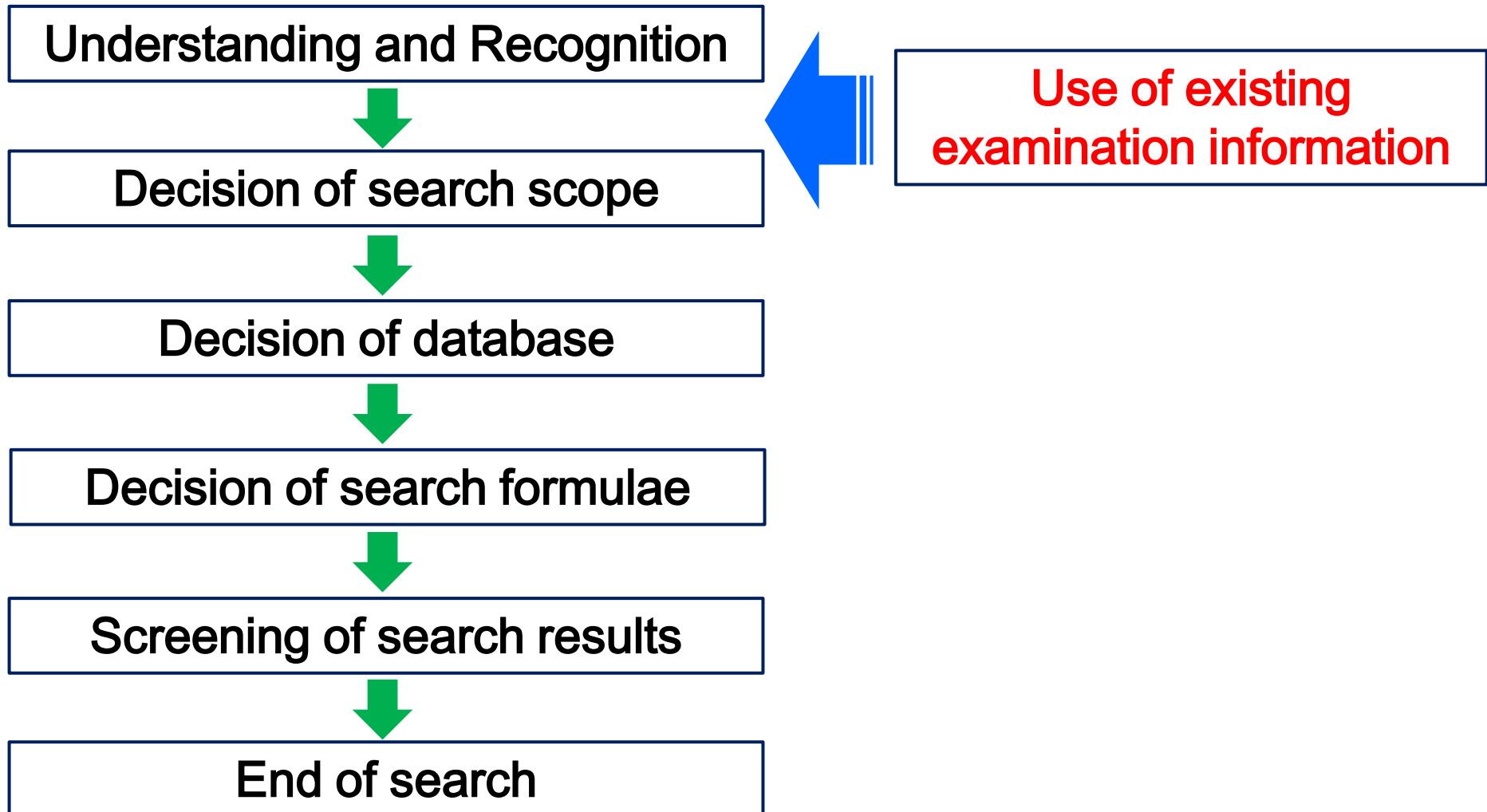
~ *When do you finish prior art search ?* ~



- Finish prior art search when an examiner judges that no more useful documents can be found.
  - ✓ The judgment is made based on the examiners' knowledge and experience.
  - ✓ Young examiners are recommended to consult with experienced examiners.

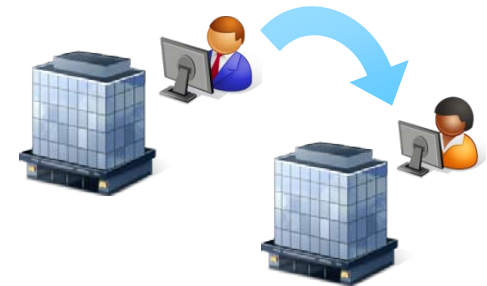
\*The percentage of documents you have searched within the outer border of the search scope

### F. Use of existing examination information - 1/3

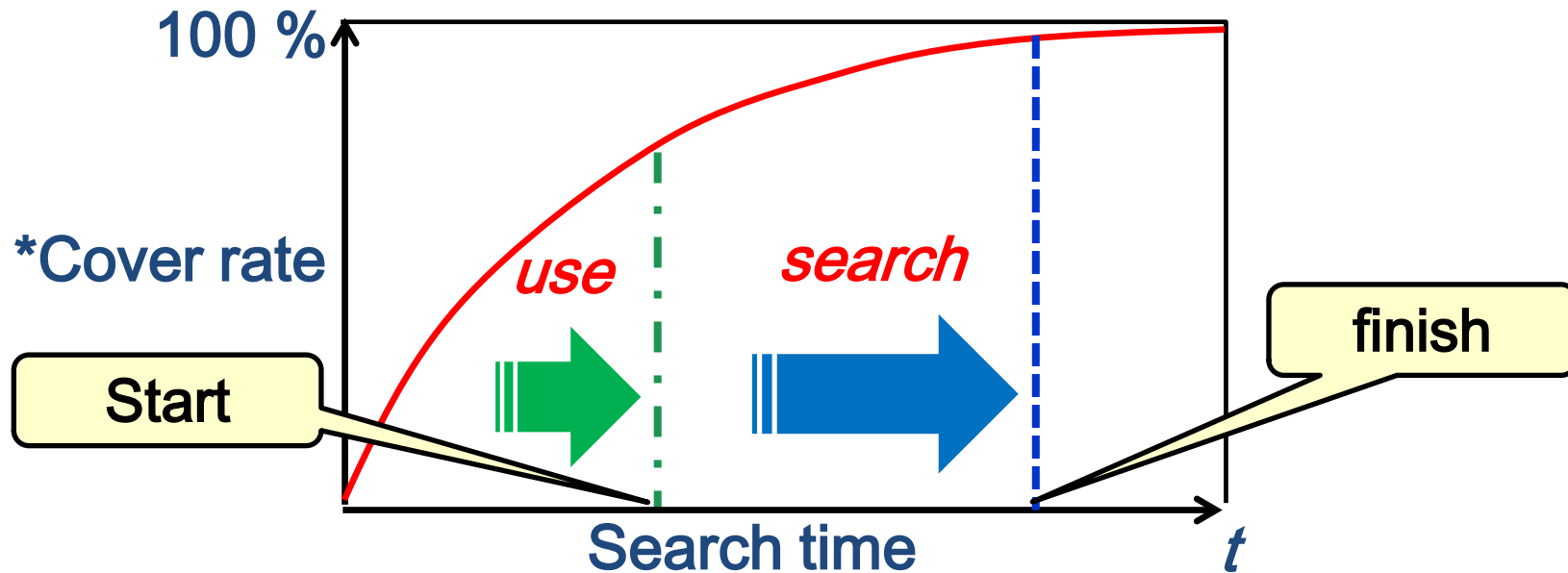


### F. Use of existing examination information - 2/3

- Search and Examination results of other patent offices
  - ISR, IPER, Written Opinion in PCT
  - Search and Examination results of IP5 Offices and WIPO-CASE Participating Offices, etc.
  
- Examination results of related applications
  - Domestic divisional applications
  - Filing of the same inventors or applicants



## F. Use of existing examination information - 3/3



- Utilization of existing examination information can reduce search time

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***Thank you !***  
**ご清聴ありがとうございました。**



## **Patentability: Major Articles in the Japanese Patent Acts**

29(1)	Statutory subject matter / Industrial applicability
29(1)(iii)	Novelty
29(2)	Inventive step
29bis	Secret prior art
39	Double patenting
36(6)(ii)	Clarity of claims
36(6)(i)	Requirement of support in description
36(4)(i)	Enablement requirement
37	Unity of invention
17bis(iii)	New matter in amendment

Globally reliable patents of high quality are important for supporting smooth business expansion worldwide and promoting innovation.

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\*Patent examination means examination of inventions (including international searches and international preliminary examinations)and establishment of Reports of Utility Model Technical Opinion.

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March2014  
Japan Patent Office