

# Understanding the Invention and Preparing Patent Applications (Chapter III.A)

Topic 4

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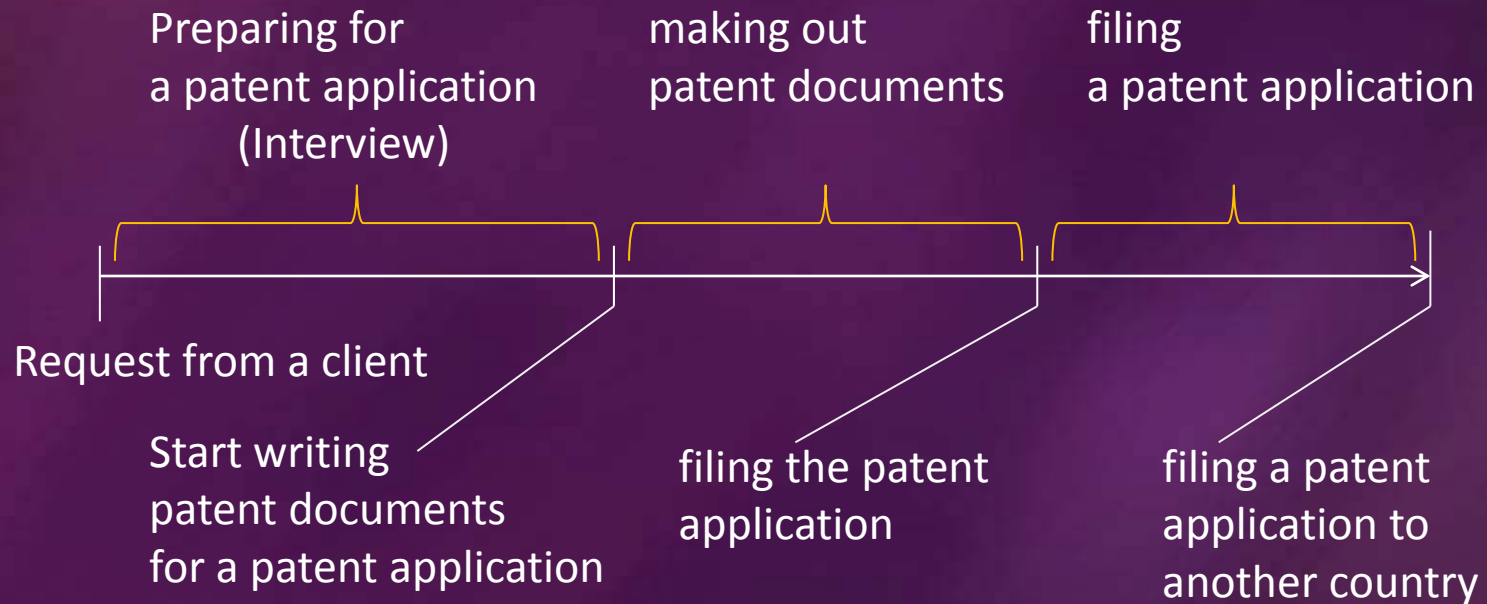
Japan Patent Attorneys Association (JPAA)

# Overview

1. Basic step  
of preparing a patent application
2. Intermediate step  
of preparing a patent application
3. Advanced step  
of preparing a patent application

# 1. Basic step of preparing a patent application

# 1. Basic step of preparing for a patent application



# 1. Basic step of preparing a patent application

- ✓ Intellectual property is intangible.
- ✓ A patent application is the means for making the property visible through patent documents.
- ✓ Patent documents are required to define a clear boundary of the right.

# 1. Basic step of preparing a patent application

- ✓ How can an inventor obtain a patent right ?
- ✓ Where is an invention ? Is it visible ?
- ✓ How do you transfer an invention to a patent documents? What are difficulties to transfer it ?
- ✓ Who read patent documents
- ✓ Where does satisfaction of an inventor exists?

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to do are:

- ✓ Obtaining information of an invention from an inventor for preparing for patent documents
- ✓ Making out patent documents of a patent application
- ✓ Filing the patent application

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing for patent documents of a patent application
  - A patent application documents generally includes:
    1. Request
    2. a specification,
    3. Claims,
    4. Drawings, and
    5. an abstract.
  - The specification is the document to explain the invention.
  - Claims will define the scope of a patent right.
  - Drawings helps the understanding of the invention.



# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - Understand the technical points of the invention. An interview is one of the best way to obtain information of the invention.
  - Obtain what an inventor wishes to describe about the invention and prepare patent documents to include all of those.
  - Understand general technology in the technical area regarding the invention.

# 1. Basic step of preparing a patent applications

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - A communication sheet between an inventor and a patent agent is convenient and effective to obtain information of the invention, e.g. Invention Disclosure Form (WIPO Patent Drafting Manual Appendix B).
    - why effective?

# 1. Basic step of preparing a patent applications

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - An inventor should fill out the form by him/herself at first.
  - A patent agent / attorney has to have a time to talk about the items in the form
  - A patent agent / attorney modify each item of the form through the discussion with the inventor.

# 1. Basic step of preparing a patent applications

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - A good patent document depends on the patent agent /attorney's effort in preparation, e.g. interview.
  - Make appropriate questions to an inventor for focusing on key points of an invention.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - “Invention” is a subjective term. All of the concepts that come out in an inventor’s brain are “invention.”
  - “Patentable invention” is the term complying with requirements ruled by a law. A patent agent/attorney has to derive “patentable invention” from “invention” of the inventor through the discussion.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - “Patentability” =
    - 1) Industrial applicability
    - 2) Novelty
    - 3) Inventive step
    - 4) Other requirements  
according to each jurisdiction

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - Industrial applicability

A patent has to contribute the development of the industry in each country. An invention to interfere an economic activity must not be patented.

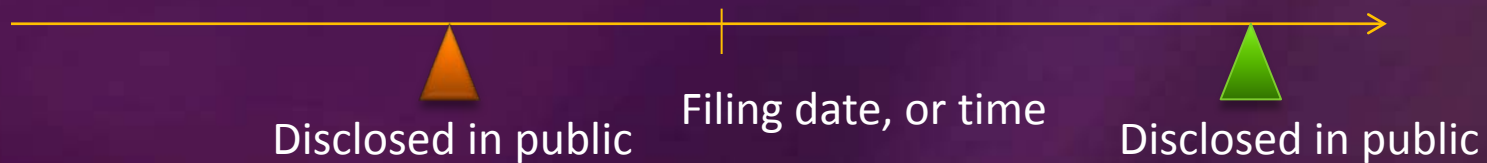
Subject matters not allowed in a jurisdiction are clearly listed up in general.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - Novelty

A technology that is the same as a past technology must not be patented.





# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - Novelty

Prior Art

Feature A

Feature B

Feature C

Invention

Feature A

Feature B

Feature C

⇒ Lack of Novelty

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - Inventive step

Prior Art

Feature A

Feature B

Feature C

NONE

Invention

Feature A

Feature B

NONE

Feature D

⇒ Novelty



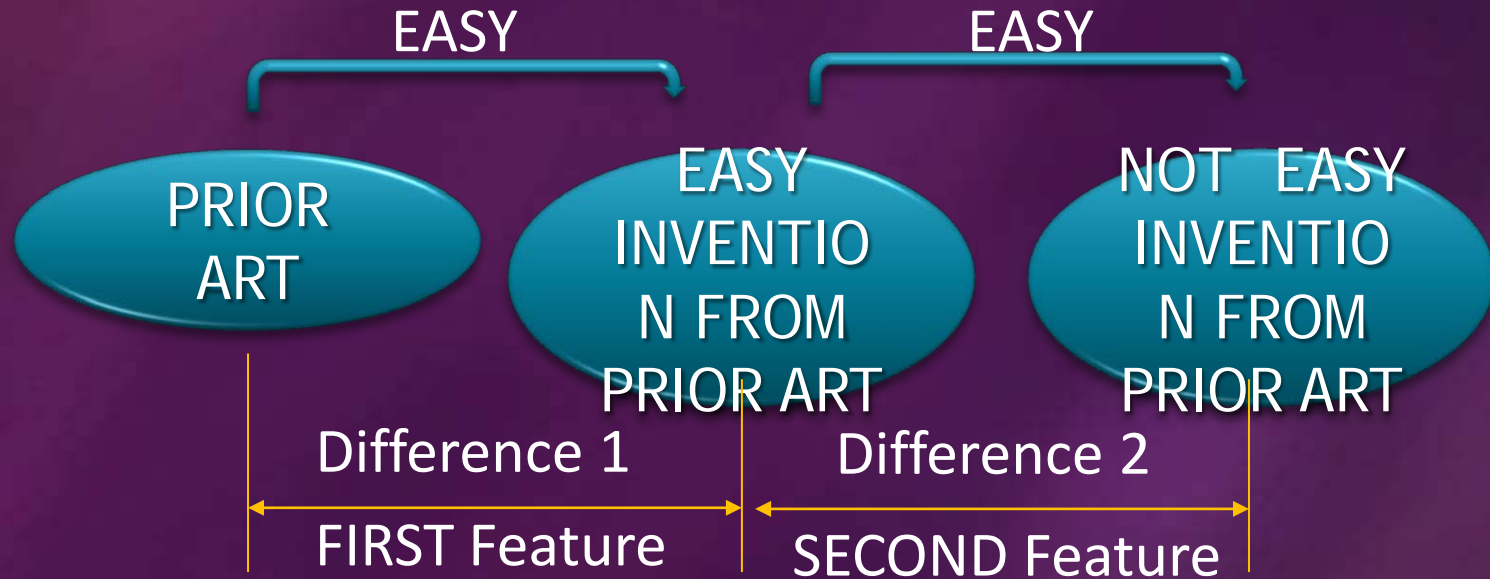
Replaceable? →

Easily Replaceable

Lack of inventiveness

# 1. Basic step of preparing a patent application

EASY OF EASY IS NOT EASY !



“FIRST feature” is to overcome the novelty requirement.

“SECOND feature” is to overcome the inventive step requirement.

Of course, if the application of “FIRST feature” to the prior art is difficult, it can overcome the inventive step by only one difference of the feature. In this case, you have to explain the difficulty.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to prepare are:

- ✓ Preparing patent documents of a patent application
  - “Patentability” of the patentable invention is not absolute but relative.
  - A patent agent/attorney has to help an inventor to correctly obtain prior arts to choose a patentable invention.

# 1. Basic step of preparing a patent applications

What a patent agent/attorney has to do are:

- ✓ Making out patent documents of a patent application
  - A patent agent/ attorney has to prepare the patent document and file a patent application as soon as possible.
  - If a client is going to disclose the invention in public, A patent agent/ attorney fundamentally file the patent application prior to the disclosure.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to do are:

- ✓ Making out patent documents of a patent application
  - Build a story of the specification. This is the preparation of making specification.
  - Choose best views for explaining the invention according to the story. This is the preparation of making drawings.

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to do are:

- ✓ For filing a patent application
  - Obtain filing particulars  
e.g. who is an inventor ? Any cooperator exists?  
Is it a co-inventor?
  - Obtain a power of attorney

# 1. Basic step of preparing a patent application

What a patent agent/attorney has to do are:

- ✓ For filing a patent application
  - If the client wishes to file an application to another country, a patent agent/ attorney has to choose a reliable associate to file the patent application in the country.
  - If you are chosen as an overseas associate to file an application to your country, you should make an effort to be a reliable agent.



# 1. Basic step of preparing a patent application

What a patent agent/attorney has to do are:

- ✓ For filing the patent application
  - If the client wishes to file an application to another country after a domestic filing, a patent agent/attorney has to file a patent application *within one year from the filing date of the filing date of the domestic filing based on a priority right of Paris Convention.*

2. Intermediate step of preparing a patent application

## 2. Intermediate step of preparing a patent application

To develop each process of the basic step

- ✓ Identify a patentable invention
- ✓ shape the invention to be protected
- ✓ achieve inventor's satisfaction

## 2. Intermediate step of preparing a patent application

To develop each process of the basic step

### ✓ Identify an invention

- An inventor does not tend to figure out his/her invention even though he/she made the invention.

- Find discrepancy between the inventor's understanding and the criteria for obtaining a patent. The discrepancy is a key point.

## 2. Intermediate step

### of preparing a patent application

### To develop each process of the basic step

- ✓ Identify an invention

- Identification of the invention is to :

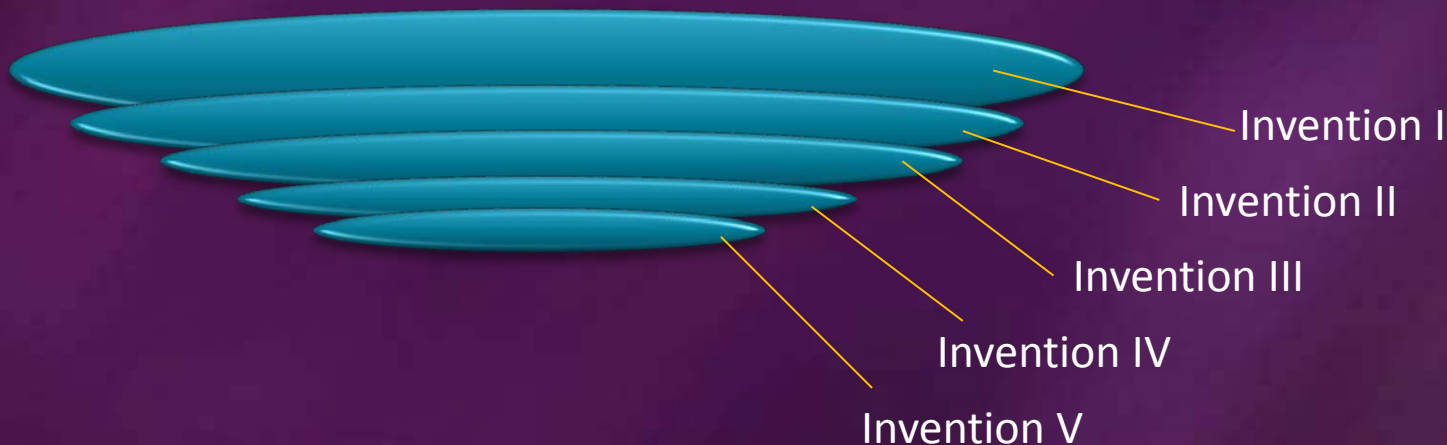
- 1) determine subject matter of a claim

- 2) determined essential features and non-essential features; and

- 3) determine the most meritorious feature to be focused on.

## 2. Intermediate step of preparing a patent application

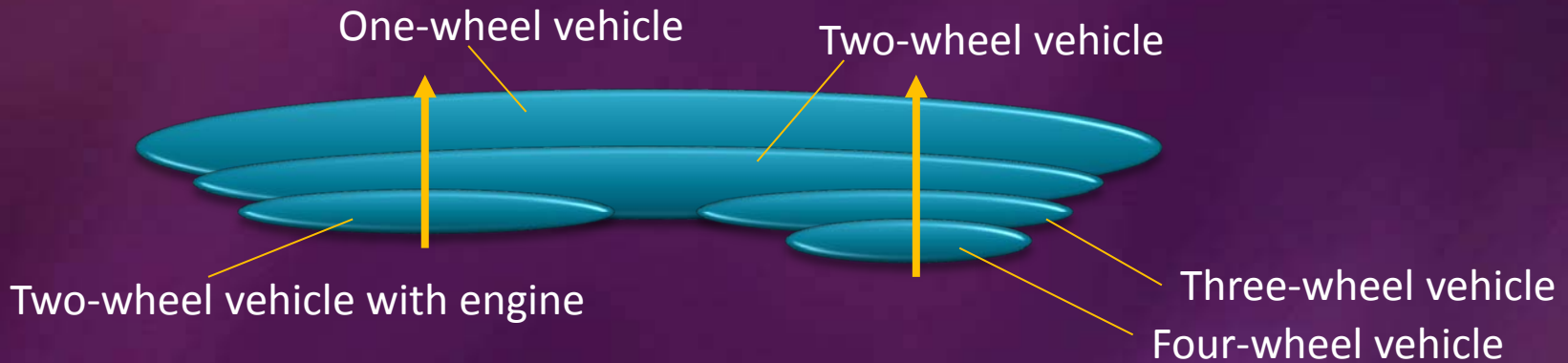
- ✓ A patent agent/ attorney has to Identify a patentable invention through the discussion with the inventor.
- An patentable invention is a multi-layer concept that seems like a mica crystal. A next layer unlimitedly come out even though a layer is peeled off.



Invention I  $\supset$  Invention II  $\supset$  Invention III  $\supset$  Invention IV  $\supset$  Invention V

## 2. Intermediate step of preparing a patent application

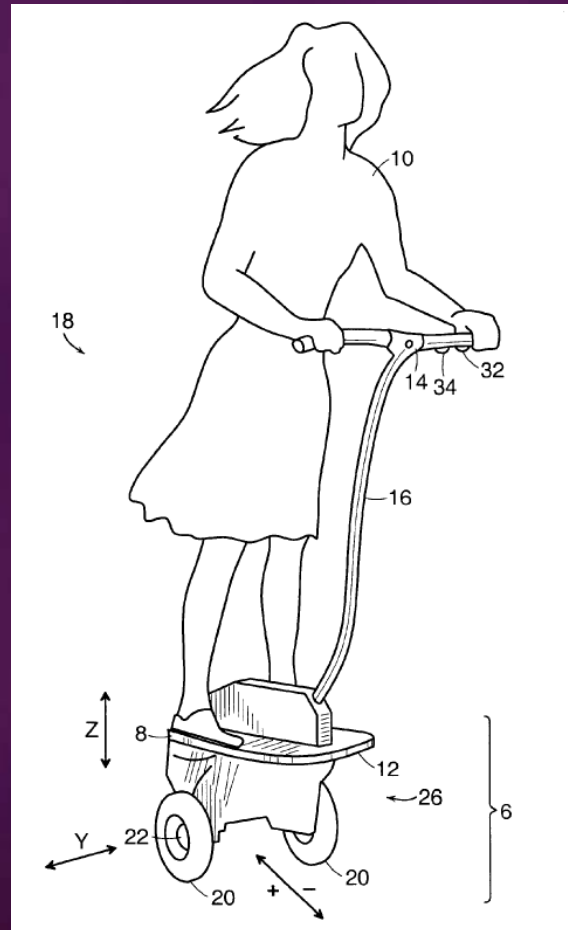
### - Example



- A patent agent/attorney has to derive a broader concept of which an inventor is not aware.
- When an inventor explains “three-wheel vehicle” as his invention, the invention may not be “three-wheel vehicle” but “two-wheel vehicle” or “one-wheel vehicle.”

## 2. Intermediate step of preparing a patent application

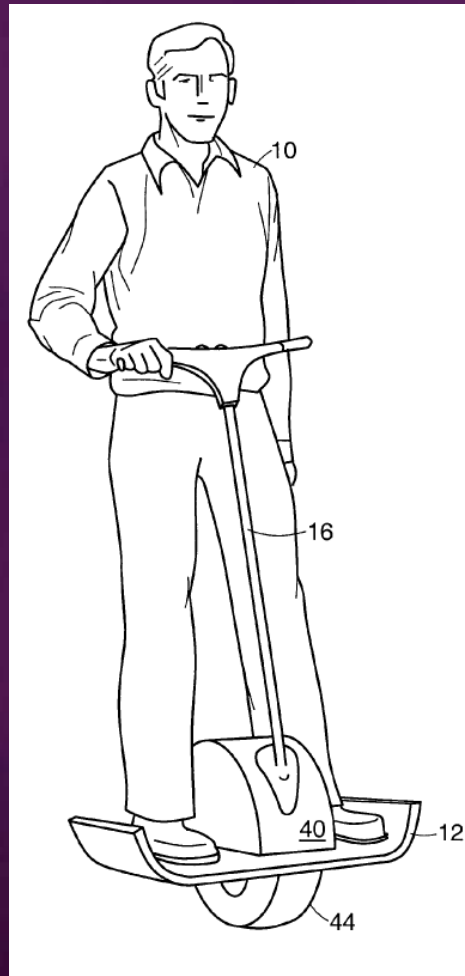
- Example (USP,6,302,230 Fig.1)





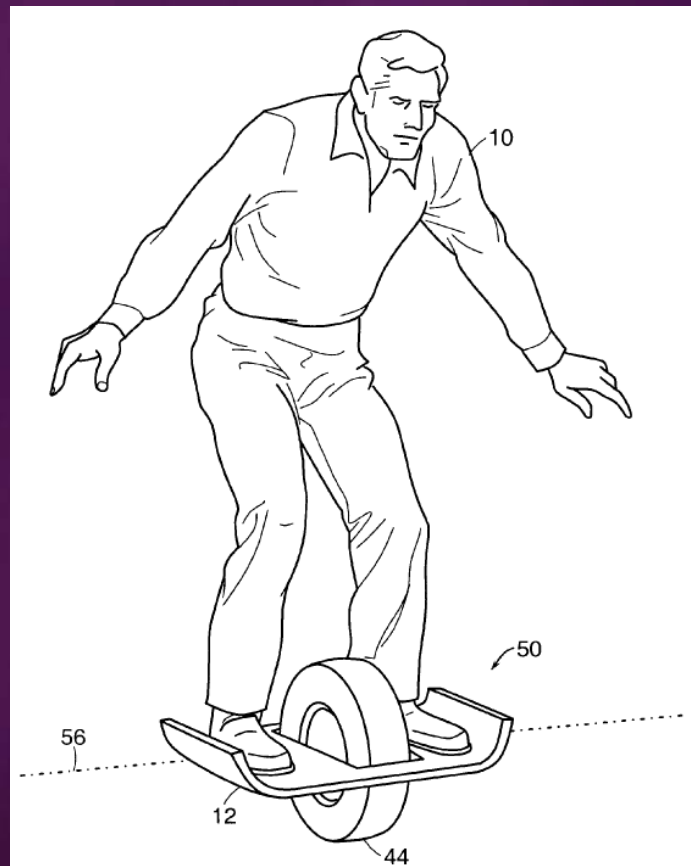
## 2. Intermediate step of preparing a patent application

- Example (USP,6,302,230 Fig.8)



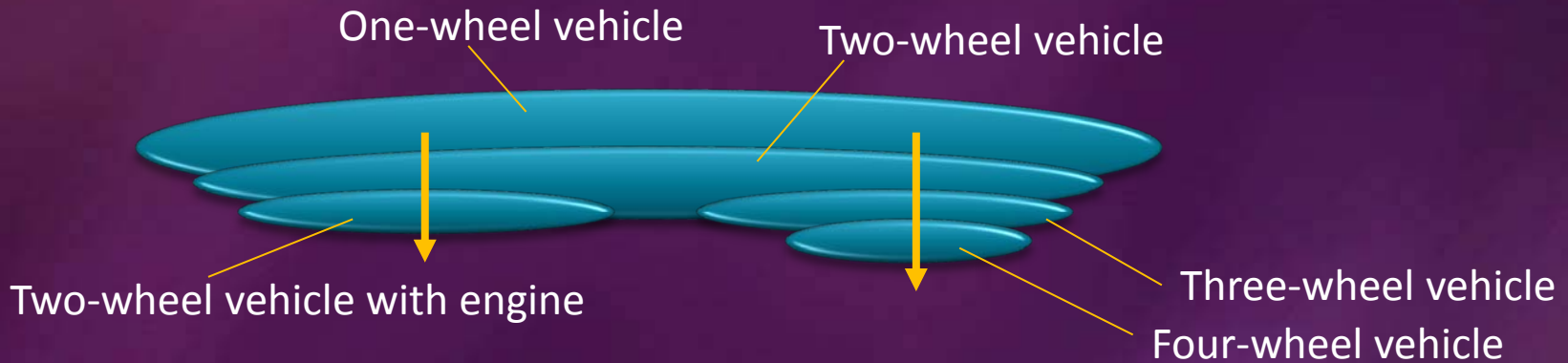
## 2. Intermediate step of preparing a patent application

- Example (USP,6,302,230 Fig.11)



## 2. Intermediate step of preparing a patent application

### - Example



- On the other hand, there is a case where a patent agent/attorney has to find a narrower concept.  
What is the case ?

## 2. Intermediate step of preparing a patent application

To develop each process of the basic step

✓ shape the invention to be protected

- Imagine a tentative claim in an interview.
- The process to look for appropriate claim words would help obtaining a patentable invention.
- Extract key points appropriate and important terms from an inventor through questions in the interview.

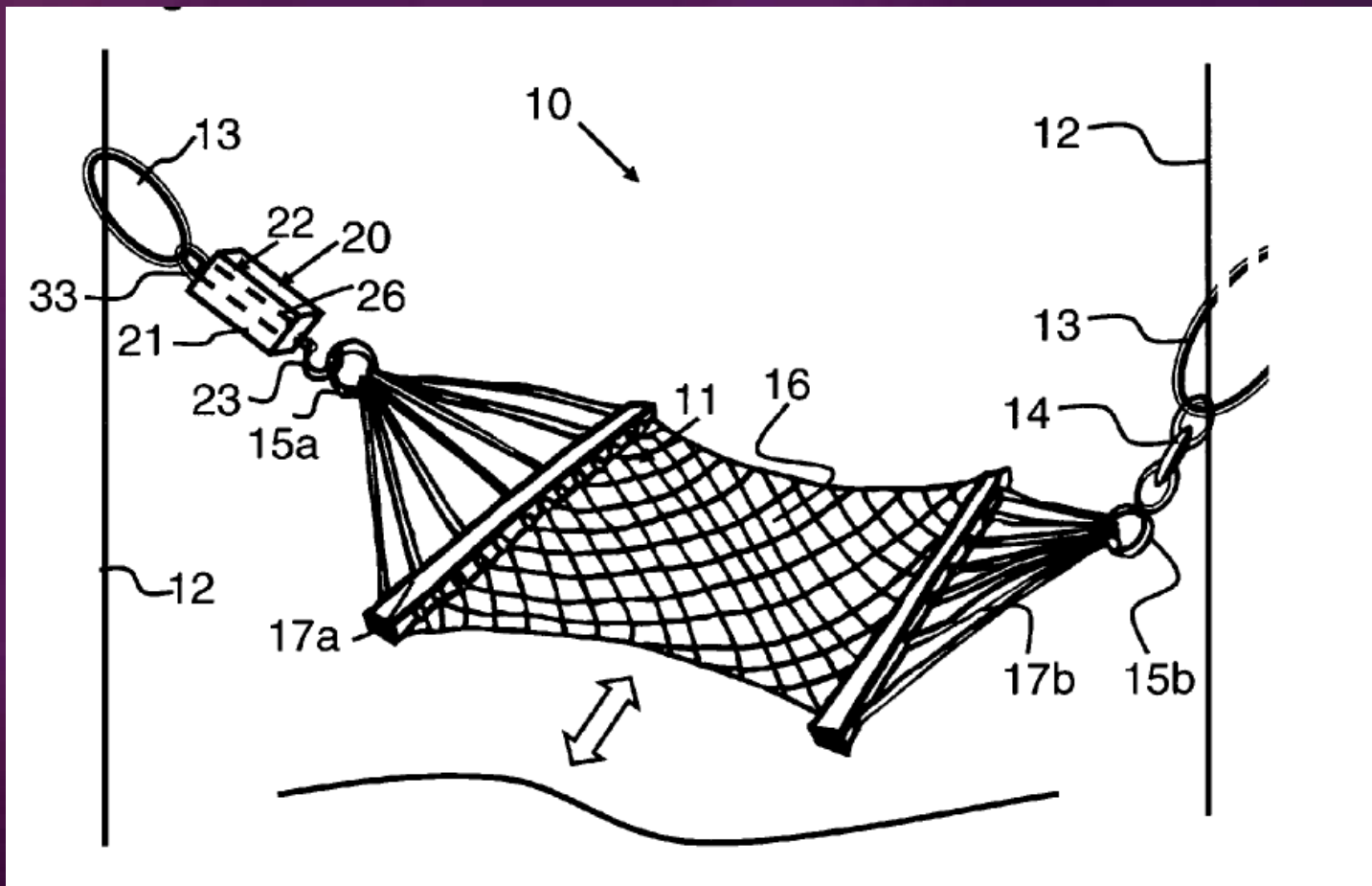
## 2. Intermediate step of preparing a patent application

To make a story outline of the specification

- ✓ shape the invention to be protected
  - An attorney/agent has to find discrepancy between the inventor's understanding and the criteria for obtaining a patent
  - Distinguish the invention from prior arts, an attorney/agent has to understand what a meritorious feature of the invention is.

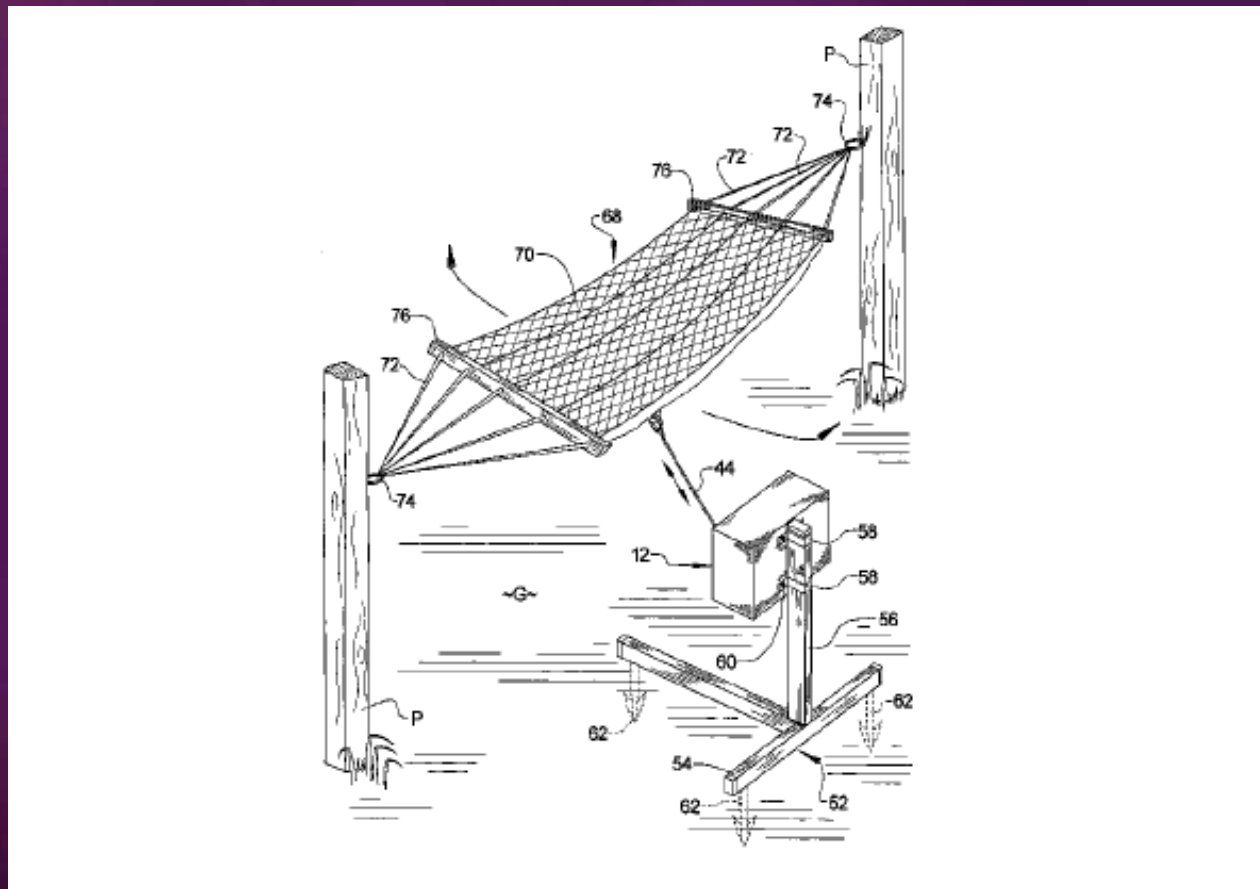
## 2. Intermediate step of preparing a patent application

- Example (US 7,234,177, Fig.1a)



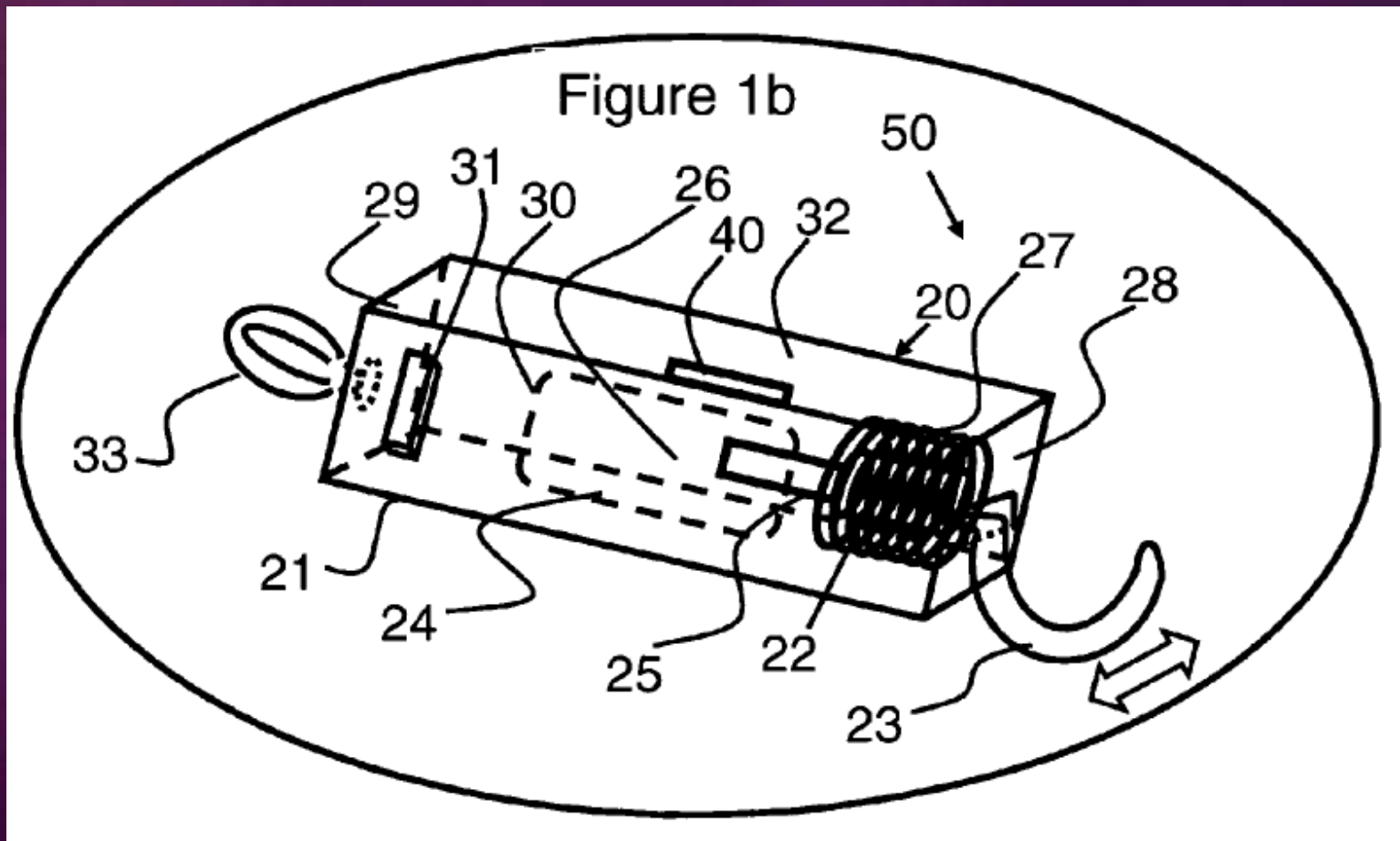
## 2. Intermediate step of preparing a patent application

- Example (US 7,159,254, Fig.3)



## 2. Intermediate step of preparing a patent application

- Example (US 7,234, 177, Fig.1a)





## 2. Intermediate step of preparing a patent application

To make a story outline of the specification

✓ Achieve inventor's satisfaction

- Provide a chance to imagine upper concept of the invention to the inventor to extract the invention

- explain what you are going to do

### 3. Advanced Step of preparing a patent application

# 3. Advanced Step of preparing a patent application

## Short Summary

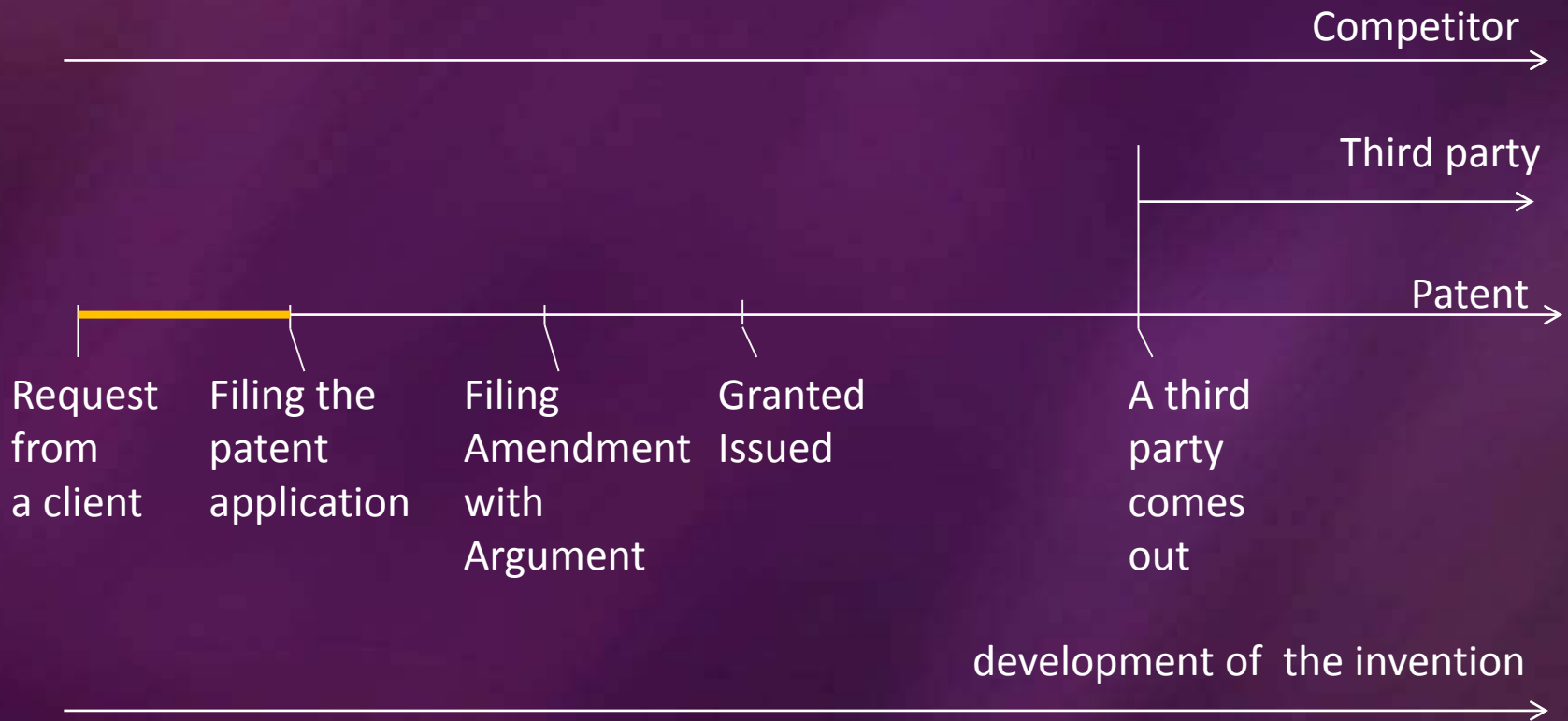
- ✓ Only patent documents are offensive means for a patent applicant/ owner to claim his/her right.
- ✓ Only patent documents are defensive means for a patent applicant/ owner to claim his/her right.
- ✓ Only patent documents are offensive means for a third party to attack a patent right.
- ✓ Only patent documents are defensive means for a third party to attach a patent right

### 3. Advanced Step of preparing a patent application

#### Short Summary

- ✓ There is no reader to give a benefit of the doubt to a patent applicant/owner including an agent.
- ✓ An inventor/ applicant gives no benefit of the doubt in the patent document to an agent.

# 3. Advanced Step of preparing a patent application



### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ Should or should not disclose the invention
- ✓ Existence of any other related invention
- ✓ Improvement /development schedule of the invention
- ✓ Give awareness of the invention to an inventor
- ✓ Business schedule related to the invention
- ✓ A place to obtain a patent
- ✓ Existence of a competitor on the present
- ✓ How would a third party circumvent the invention ?

### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ Should or should not disclose the invention
  - Leakage of the invention by a reverse engineering
    - Is the technology obtainable or not, from sold products?
    - Should it be kept as know-how without disclosing the invention?

### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

✓ Existence of Any other related invention

- Prevent the self-collision of an application

All information of related inventions should be incorporated into one patent document, or filed on the same day.



### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ Improvement/development schedule of the invention
  - prevent the self-collision of an application
    - If improvement/development of the invention is scheduled, it should not be in the specification.

### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ Give awareness of the invention to an inventor
  - An inventor has a seed of new invention or improvement/development of the invention, but he/she does not tend to be aware of it.

### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ Business schedule related to the invention
  - When a client is going to bring products into the market ?
  - When a client is going to disclose patent-related products in public?

### 3. Advanced Step of preparing a patent application

#### To build a patent strategy of the invention

- ✓ A place to obtain a patent
  - Where are products manufactured?
  - Where are products sold ?
  - Where does counterfeits come out ?
  - How do counterfeits moves ?

### 3. Advanced Step of preparing a patent application

To build a patent strategy of the invention

- ✓ Existence of a competitor on the present
  - Is there a competitor ?  
Does the competitor have a similar products ?

### 3. Advanced Step of preparing a patent application

To build a patent strategy of the invention

- ✓ Foresee a unknown third party's action
  - What would a third party circumvent the invention?  
How take an initiative in the invention

# *Summary*

1. 90% Preparation 10% Writing
2. Derive underlying key points from an inventor
3. Find meritorious differences of an invention from prior arts
4. Build a strategy to reduce the risk in the future events

*Thank you for your attention.*

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