

Topic 9: Case Study 2

Examination in National/Regional Phase -

JAPAN PATENT OFFICE

Part I

1. First action procedures at the national stage
2. Understanding ISRs/WOISAs
3. How to understand claimed inventions
4. How to evaluate the clarity of the claims
5. How to evaluate the unity of invention

Part II

6. How to evaluate XY citations in ISRs
7. Evaluating novelty and inventive step for claims in national stage with cited documents in ISR
8. How to conduct additional searches, when needed.
9. Summary and preview of Case Study 2

Part I

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- Outline of first action procedures at the national stage
 1. Understanding ISRs/WOISAs
 2. Understanding inventions
 3. Conducting prior art searches, if necessary
 4. Understanding prior art documents, etc.
 5. Examining requirements for patentability in terms of novelty, inventive step, etc.

Part I

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Let's start group work about understanding ISRs/WOISAs!

What can you learn about the invention based on the ISR and WOISA of PCT/JP2013/098765?

- ① International application number?
- ② International filing date?
- ③ Priority number?
- ④ Priority date?
- ⑤ Requirement of unity met?
- ⑥ Any claims which were found unsearchable?
- ⑦ Classification?
- ⑧ Electronic DB?
- ⑨ Number of claims?
- ⑩ Number of X/Y citations?
- ⑪ Publication number of each citation and category?
- ⑫ Assessment of patentability of each claim?

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Question 1

When conducting patent examination at the national stage, why do examiners need to correctly understand the claimed invention?

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When conducting patent examination at the national stage, why do examiners need to correctly understand the claimed invention?

Answers

- To evaluate X/Y citations (knowing that X/Y citations can be used for refusal)
- To decide whether to conduct additional prior art searches
- To conduct timely and high-quality examination

Question 2

- How do examiners correctly understand a claimed invention?

Question 2

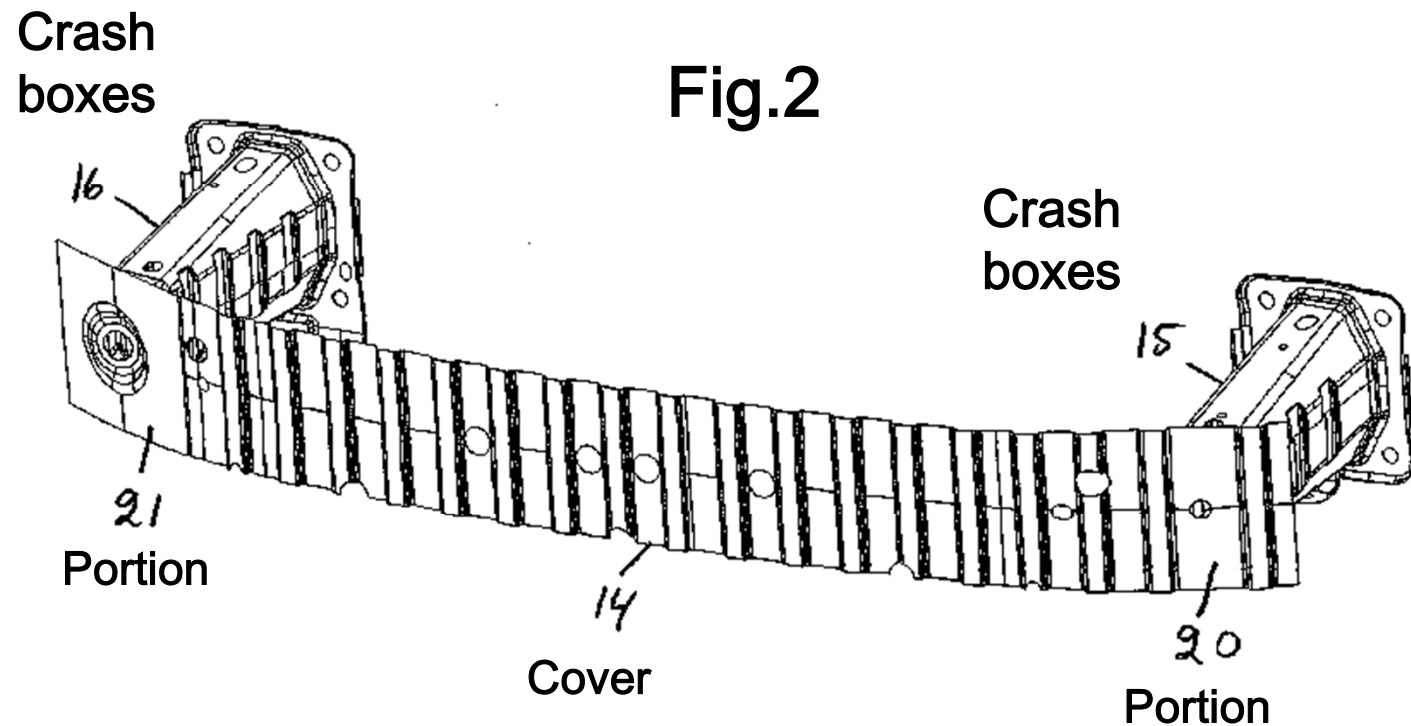
- How do examiners correctly understand a claimed invention?

Answers

- Carefully reading claims, specifications and drawings
- Color-highlighting and segmenting claims
- Color-highlighting items in specifications and drawings with the claims

3. How to understand claimed inventions

Fig.2



A crown

Flanges portion

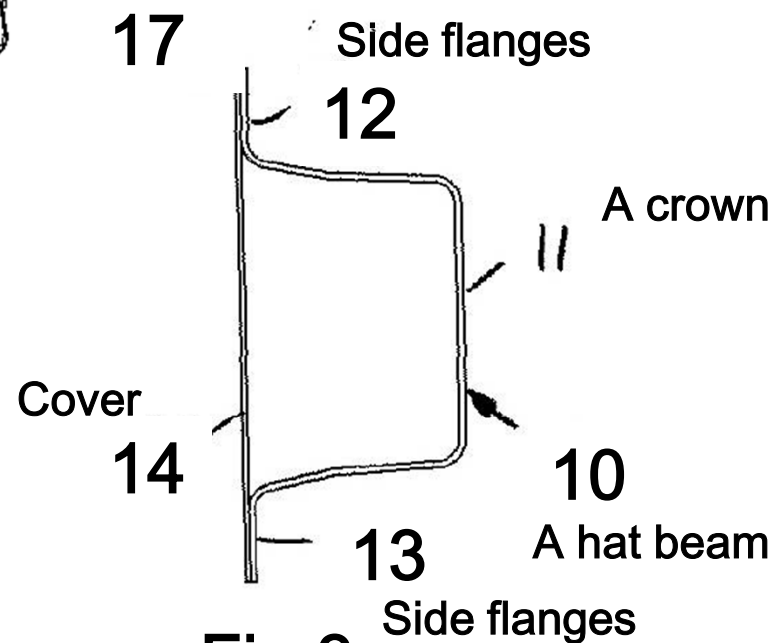


Fig.3

Example of Color-highlighting and Segmenting

1. A bumper beam for a vehicle comprising a hat beam (10) with a crown (11) and side flanges (12,13), and a cover (14) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle, characterised in that the cover (14) extends past at least one of the side flanges (12,13) and has transverse stiffening means.
2. A bumper beam according to claim 1, characterised in that the transverse stiffening means comprise transverse corrugation of the cover (14).
3. A method of adapting a bumper beam to various vehicle models built on the same platform when the ground clearance is not the same for all the models, characterised in that a hat beam is used which is mounted to the platform with its crown and a cover wider than the hat beam is fastened to the side flanges of the hat beam and in that one adaptes the bumper beam to the various ground clearances of the various vehicle models by fastening the cover with different extension past at least one of the flanges for different models.

Let's start group work about understanding claimed inventions!

- **Discussing the invention:**
For example, technical field, background art, problem the invention is to solve, means to solve the problems, etc.
- **Color-highlighting and segmenting claims**
- Color-highlighting items in specifications and drawings with the claims (if possible)
- **Filling out Section 1 of the work sheet**

Let's compare our results and discuss them!

- Problems that the invention is to solve
- Features of the invention (means to solve the problems)
- Color-highlighting and segmenting

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Question 1

- How do examiners evaluate the clarity of the claims ?

Question 1

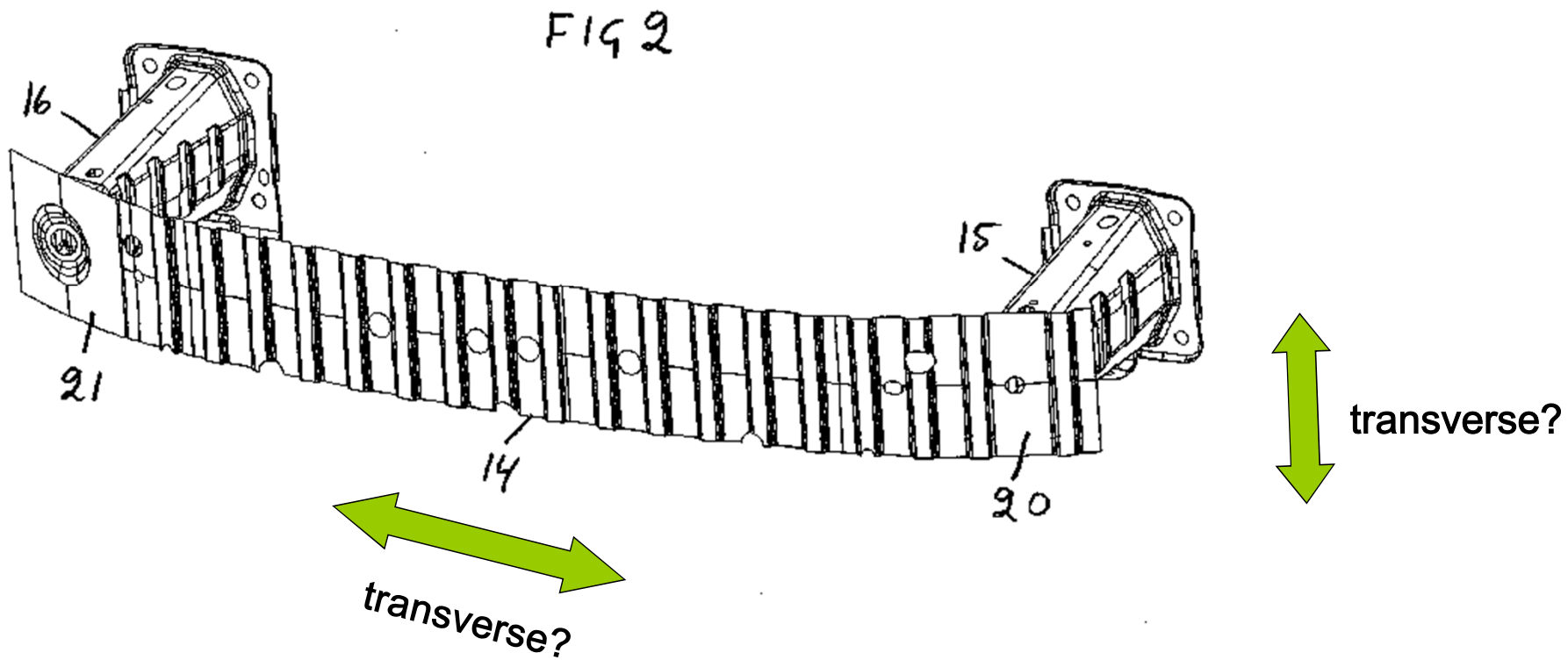
- How do examiners evaluate the clarity of the claims ?

Answers

- Clarity of the claim's language must be analyzed in terms of the content of the particular application disclosed, the teachings of the prior art, and the interpretation of the claim, which would be given by a person skilled in the art at the time the invention was made.
- A claim that includes vague or equivocal forms of wording that leave the reader in doubt as to the scope of a feature should be objected to for lack of clarity.

4. How to evaluate the clarity of the claims

Bumper beam



4. How to evaluate the clarity of the claims

Let's compare our results and discuss them!

➤ The clarity of the claims

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Question 1

- How do examiners evaluate the unity of invention ?

Question 1

- How do examiners evaluate the unity of invention ?

Answers

- If there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are linked so as to form a single general inventive concept .
- Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

Question 2

- How do examiners evaluate the unity of combinations of different categories of claims?

Question 2

- How do examiners evaluate the unity of combinations of different categories of claims?

Answers

- An independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process

Apparatus Claims

1. A bumper beam for a vehicle comprising a hat beam (10) with a crown (11) and side flanges (12,13), and a cover (14) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle, characterised in that the cover (14) extends past at least one of the side flanges (12,13) and has transverse stiffening means.
2. A bumper beam according to claim 1, **characterised** in that the transverse stiffening means comprise transverse corrugation of the cover (14).

Process Claims

3. A method of adapting a bumper beam to various vehicle models built on the same platform when the ground clearance is not the same for all the models,
characterised in that a hat beam is used which is mounted to the platform with its crown and a cover wider than the hat beam is fastened to the side flanges of the hat beam and in that one adaptes the bumper beam to the various ground clearances of the various vehicle models by fastening the cover with different extension past at least one of the flanges for different models.

Let's compare our results and discuss them!

➤ The unity of the claims

Part II

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Question 1

- Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?

Question 1

▪ Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?

Answers

- To confirm whether each citation can be used as an X/Y citation
- To decide whether additional searches should be conducted

(Reference) excerption of Chapter 21 of PCT ISPE Guidelines

21.01 International Searching Authorities and International Preliminary Examining Authorities are entrusted to apply and observe all the common rules of international search and examination. Although applicants can generally expect the International Searching and Examining Authorities to act in accordance with the Guidelines, due to the involvement of several States in the international search and examination process and to the multitude of personnel within the various Authorities, **some variability is inherent to the international search and examination process.** At the same time, it is recognized that minimizing inconsistencies between or within the International Searching and Examining Authorities is crucial to the unqualified acceptance of an Authority's work product by the States.

Question 2

- How do examiners evaluate all X/Y citations?

Question 2

How do examiners evaluate all X/Y citations?

Answers

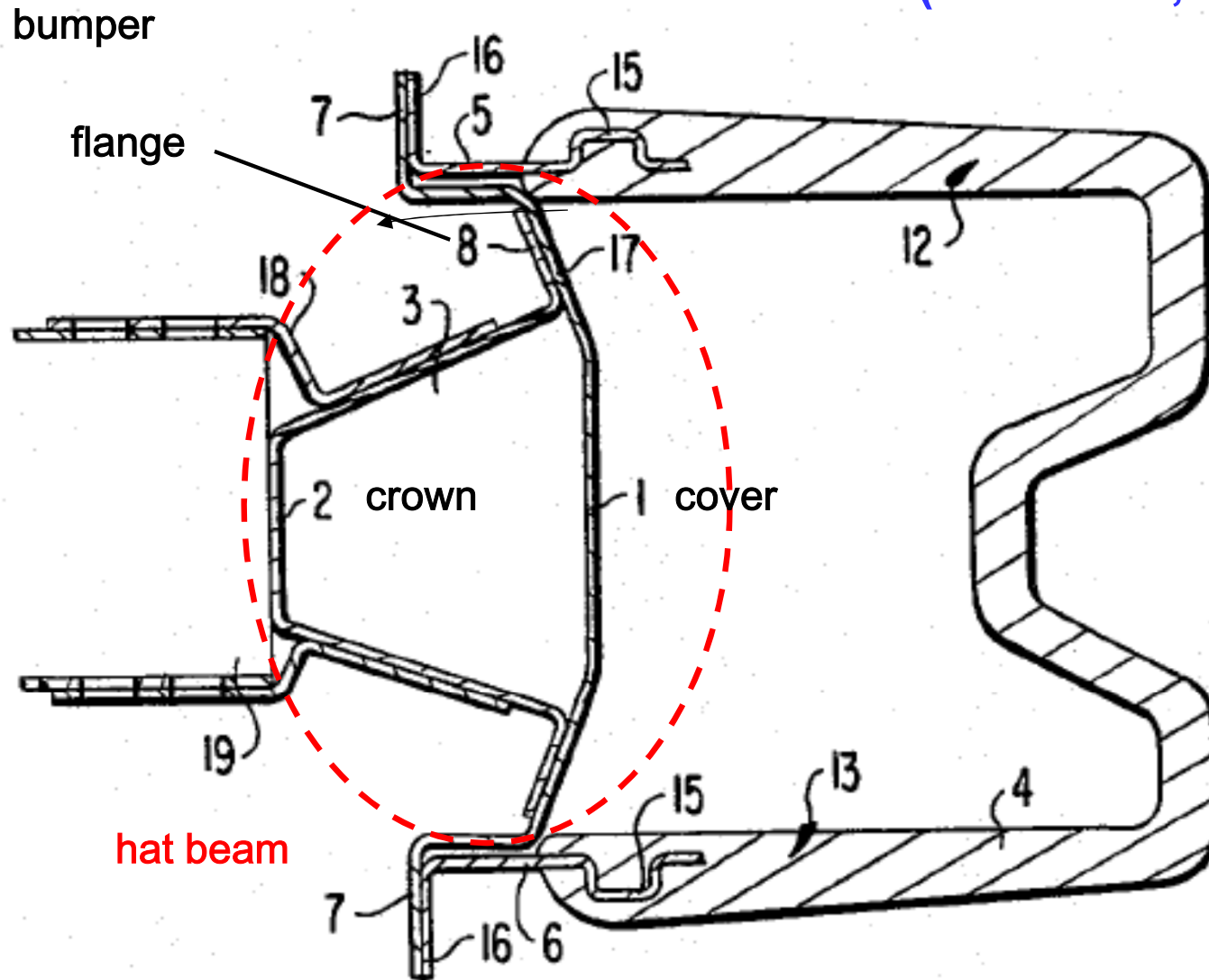
- Carefully reading all X/Y citations
- Color-highlighting identical or similar technical features the same color as the corresponding elements in the claimed invention
- Comparing prior art to the claimed invention from the following view points:
 - Whether the technical field is the same
 - Whether each technical element of the claimed invention has been disclosed

Let's start group work on evaluating XY citations in ISRs!

- Discussing whether each technical element in the claimed invention is disclosed in the citations
- Color-highlighting identical or similar technical features the same color as the elements in the claimed invention
- Categorizing the citations as X, Y, or A
- Filling out Section 2 of the work sheet

6. How to evaluate XY citations in ISRs

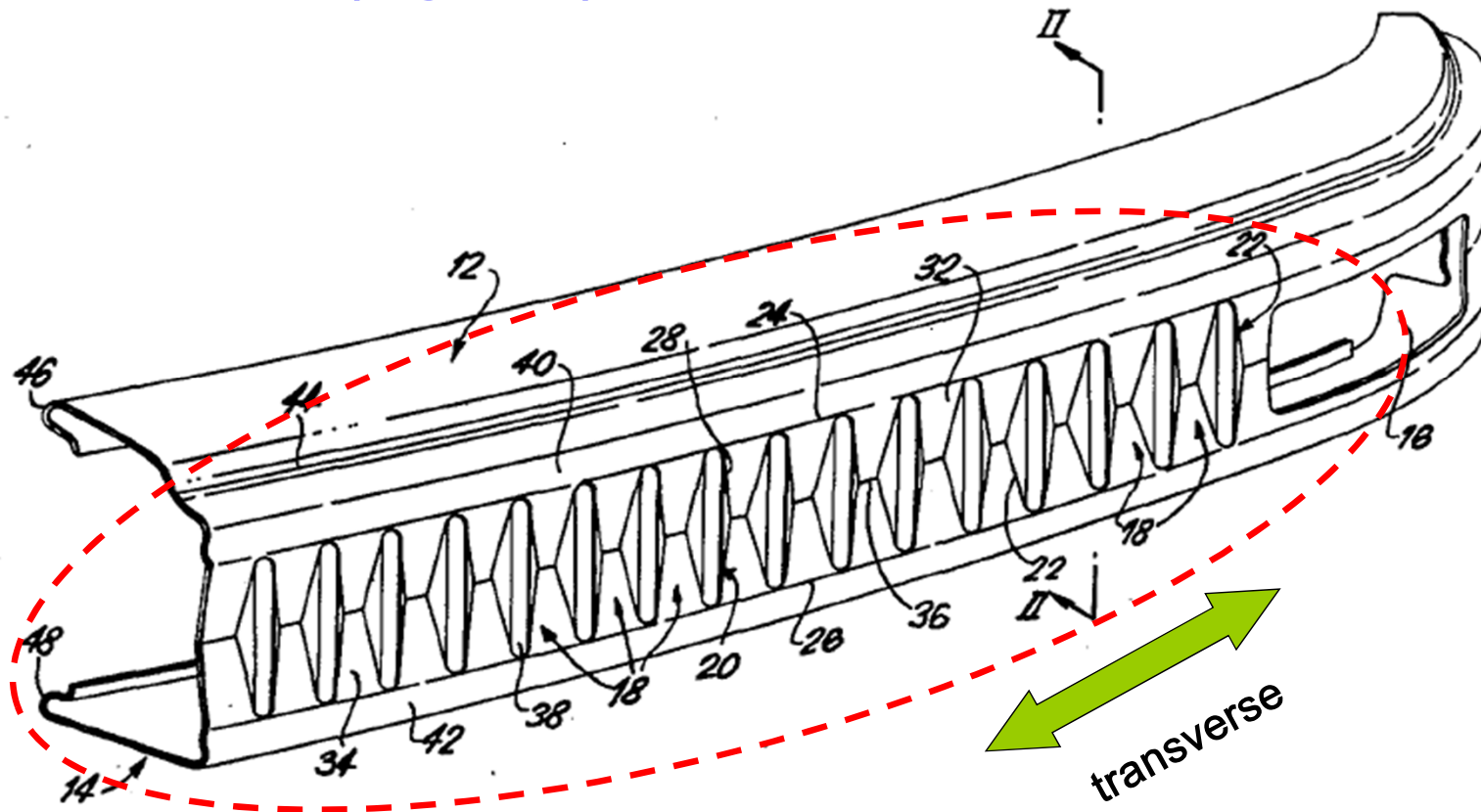
D1: US 4088357 A (Column 4, Line 20 – 37, Figure 2)



Disclosed “A bumper beam for a vehicle comprising a hat beam (3) with a crown (2) and side flanges (8), and a cover (1) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle”

6. How to evaluate XY citations in ISRs

D2: US 4116480 A (Figure 1)



Disclosed “the cover (12) extends past at least one of the side flanges and has transverse stiffening means.” and “the transverse stiffening means comprise transverse corrugation of the cover ”

Let's compare our results and discuss them!

- How did you evaluate D1?
 - Same technical field?
 - Are all technical elements in each claimed invention disclosed?
 - X, Y, or A for Claim 1?
 - X, Y, or A for Claim 2?
 - X, Y, or A for Claim 3?
- How did you evaluate D2?
 - Same technical field?
 - Are all technical elements in each claimed invention disclosed?
 - X, Y, or A for Claim 1?
 - X, Y, or A for Claim 2?
 - X, Y, or A for Claim 3?

6. How to evaluate XY citations in ISRs

PCT/JP2013/098756 Claims 1-3	D1: US 4088357 A	D2: US4116480 A
1. A hat beam(3) with a crown(2) and side flanges	Y Column4 ,line20- line37,Figure.2	
2. Transverse stiffening means		Y figure1
3. A method of adapting a bumper beam to various vehicle models	A	A

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PCT/JP2013/098765: Claims

1. A bumper beam for a vehicle comprising a hat beam (10) with a crown (11) and side flanges (12,13), and a cover (14) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle, **characterised** in that the cover (14) extends past at least one of the side flanges (12,13) and has transverse stiffening means.
2. A bumper beam according to claim 1, **characterised** in that the transverse stiffening means comprise transverse corrugation of the cover (14).
3. A method of adapting a bumper beam to various vehicle models built on the same platform when the ground clearance is not the same for all the models, **characterised** in that a hat beam is used which is mounted to the platform with its crown and a cover wider than the hat beam is fastened to the side flanges of the hat beam and in that one adaptes the bumper beam to the various ground clearances of the various vehicle models by fastening the cover with different extension past at least one of the flanges for different models.

PCT/JP2013/098765: Claims (Review)

1. A bumper beam for a vehicle comprising a hat beam (10) with a crown (11) and side flanges (12,13), and a cover (14) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle, **characterised** in that the cover (14) extends past at least one of the side flanges (12,13) and has transverse stiffening means.
2. A bumper beam according to claim 1, **characterised** in that the transverse stiffening means comprise transverse corrugation of the cover (14).

3. A method of adapting a bumper beam to various vehicle models built on the same platform when the ground clearance is not the same for all the models, **characterised** in that a hat beam is used which is mounted to the platform with its crown and a cover wider than the hat beam is fastened to the side flanges of the hat beam and in that one adaptes the bumper beam to the various ground clearances of the various vehicle models by fastening the cover with different extension past at least one of the flanges for different models.

	Yes	No
Novelty	1-3	
Inventive step	3	1, 2
Industrial applicability	1-3	

Unclear claims

PCT/JP2013/098765: Claims (Amended)

1. A bumper beam for a vehicle comprising a hat beam (10) with a crown (11) and side flanges (12,13), and a cover (14) fastened to the side flanges, wherein the crown faces the vehicle and is fastened to the vehicle, characterized in that the cover (14) extends past at least one of the side flanges (12,13) and has transverse stiffening means.

Cancelled

2. A bumper beam according to claim 1, characterized in that the transverse stiffening means comprise transverse corrugation of the cover (14).

Cancelled

3. A method of adapting a bumper beam to various vehicle models built on the same platform when the ground clearance is not the same for all the models, characterized in that a hat beam is used which is mounted to the platform with its crown and a cover wider than the hat beam is fastened to the side flanges of the hat beam and in that one adaptes the bumper beam to the various ground clearances of the various vehicle models by fastening the cover with different extension past at least one of the flanges for different models.

	Yes	No
Novelty	3	
Inventive step	3	
Industrial applicability	3	

Unclear claims

Resolved

Question 1

- What to do first to efficiently evaluate novelty and inventive step for amended claims?

Question 1

- What to do first to efficiently evaluate novelty and inventive step for amended claims?

Answer 1

- Evaluate novelty and inventive step for amended claims based on cited documents in ISRs

Question 2

- When novelty or inventive step is not denied based on cited documents in ISRs, what to do next?

Question 2

- When novelty or inventive step is not denied based on cited documents in ISRs, what to do next?

Answer 2

Confirm what kind of additional documents are needed and conduct additional searches.

Group work

Evaluate novelty and inventive step for amended claims based on cited documents in ISRs.

- Filling out the work sheet for case study 2

- Let's compare our results and discuss them.
 - Claim 3
 - Are all technical elements in each claimed invention disclosed ?
 - If there are any points that are not disclosed, what are the points?

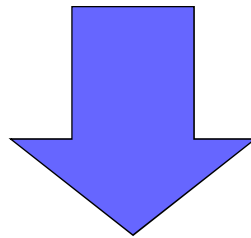
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Confirm technical points which are not disclosed in cited documents in ISRs



Additional searches should be done for the technical points

Question 1

What point do you have to keep in mind when you conduct additional searches?

Question 1

What point do you have to keep in mind when you conduct additional searches?

Answer 1

Additional documents must be “Y” documents

→ They have to be combined with D1 or D2

- Are technical fields between D1 (or D2)

and additional documents the same?

Group work

- What are **the technical points** that are not disclosed in cited documents in ISRs?

- What kind of documents should you search to deny **an inventive step** ?

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9. **Summary of Case Study 2**

- ① **Clarify X,Y category** with cited documents in ISRs
- ② **Understanding inventions**
Color-highlighting and segmenting claims and figures
- ③ **If novelty or inventive step are not denied,**
confirm what kind of additional documents are needed
and **conduct additional searches.**
- ④ After doing additional searches, and you don't find any documents to deny the claim, you can determine novelty and inventive step of the claims.
- ⑤ Finally, you will **grant a patent.**

Thank you!