

Roundtable 4:
Collections, Registers and Databases
relating to GR, TK and TCEs:
Issues and Practical Experiences

**WIPO Seminar on Intellectual Property and GR, TK and TCEs:
Regional and International Dimensions
Geneva, June 23 to 25, 2015**

JAPAN PATENT OFFICE
Yoshinari OYAMA

Activities of Patent Examiners

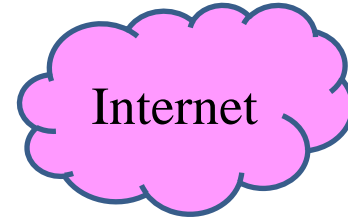
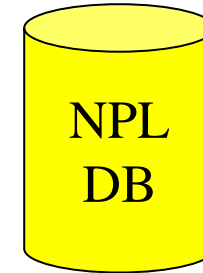
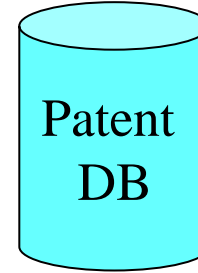
Understanding the claimed invention



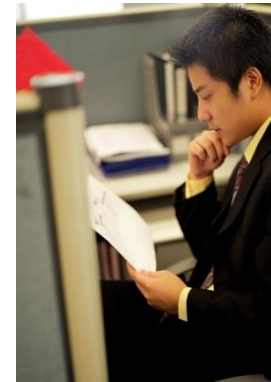
Searching for prior arts



Utilizing Databases and other sources



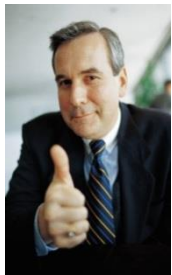
Judging patentability



Drafting an office action to the applicant



Directors' approval (quality check)



Send to the applicant



* High-speed screening (viewer):
Page-turning rate < 0.8 sec

The screenshot shows the 'スクリーニング' (Screening) software interface. On the left, there is a list of patent numbers (No. 文獻番号) and their corresponding dates. The main area displays a patent document for '特許2001-07721'. The document includes a title '無線送信機', an abstract, and several flowcharts (FIG. 1, FIG. 2, FIG. 3, FIG. 4) illustrating the device's operation. The interface includes a menu bar at the top and a toolbar with various icons for navigation and search.

This is a detailed view of a patent document page. It features a technical diagram (FIG. 1) showing a block diagram of a transmitter with various components like a processor, memory, and antenna. Below the diagram, there is Japanese text describing the invention. The page number '1/153' is visible in the top left corner. The interface includes a search bar and navigation controls.



This screenshot shows the text of the patent document with a search tool overlay. The search tool includes a search bar, a list of search results, and a list of keywords. The text is highlighted in yellow, and the search tool is used to find specific terms within the document. The interface includes a search bar, a list of search results, and a list of keywords.

“Examination Guidelines for Patent and Utility Model in Japan” Outline of Examination Procedures

Understanding of the invention

- ✓ The examination starts by understanding the claimed invention for the application concerned.
- ✓ The examiner should understand the claimed invention based on the writing of the claims.

Understanding of the invention

When examining patent applications related to GR

- The examiner works to understand the claimed invention based on the wording of the claim including the effect, if any, of GR on the invention.

Prior art search

- ✓ The examiner shall conduct a prior art search targeting the claimed inventions, which are the subjects of the search, in terms of novelty, inventive step and seniority of applications.

Prior art Search

Typically, the examiner

- Searches for prior patent documents by doing text searches with IPC, FI and F-term.
- Searches for non-patent literature by utilizing commercial databases.
- Searches documents with chemical structures or sequences.
- Utilizes information on the Internet or printed in books such as dictionaries.
- Also utilizes machine/human translation.

Examination of requirements for patentability in terms of novelty, inventive step, etc.

- ✓ Novelty, inventive step, etc. of the claimed invention should be examined, based on the search results.

Judgment

For example,

- When the medicinal use of the claimed invention is only expressed as a newly found working mechanism in place of the medicinal use of the cited invention and both uses cannot be substantially distinguished from each other, the novelty of the claimed medicinal invention is denied.
- (i) Selection from optimum materials from publicly known materials, (ii) optimally or preferably modified numerical ranges, (iii) materials replaced by equivalents, or (iv) designs modified along specific application of techniques to solve certain problems are regarded to be arts derived from the ordinary creativity of a person skilled in the art.