

Outline of the Patent Examination Process at the JPO

April 2016
Japan Patent Office

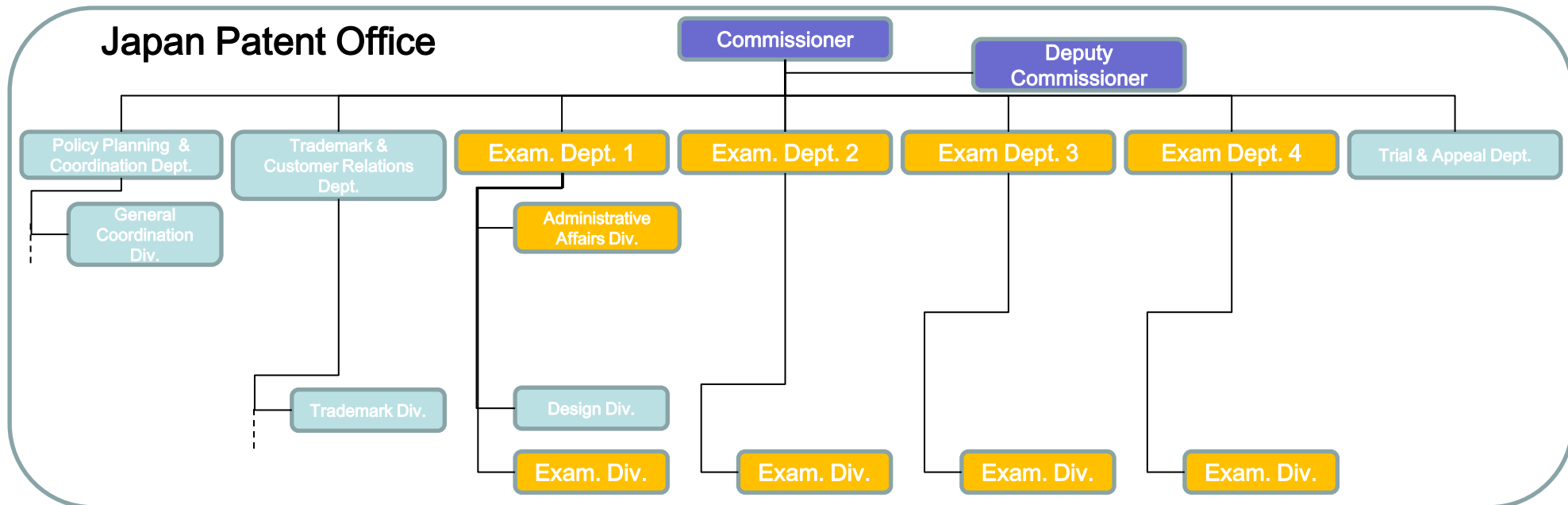
1. Organization of the JPO

2. Examination Procedures

3. Initiatives by the JPO

1. Organizational Chart of the JPO

- Under the leadership of the top management (Commissioner and Deputy Commissioner), around 1,700 patent examiners conduct patent examination.
- Patent Examination Departments consist of the First to the Fourth Departments.
 - Exam. Dep. 1 – Physics, Optics, Social Infrastructure and Design
 - Exam. Dep. 2 – Mechanical Technology
 - Exam. Dep. 3 – Chemistry, Life Science and Material Science
 - Exam. Dep. 4 – Electronic Technology
- There are 38 Examination Divisions based on technical fields. Around 130 directors are allocated for each Examination Division.



1. Layout of Examination Divisions

- The examination divisions are located in large rooms enabling examiners to consult with each other.

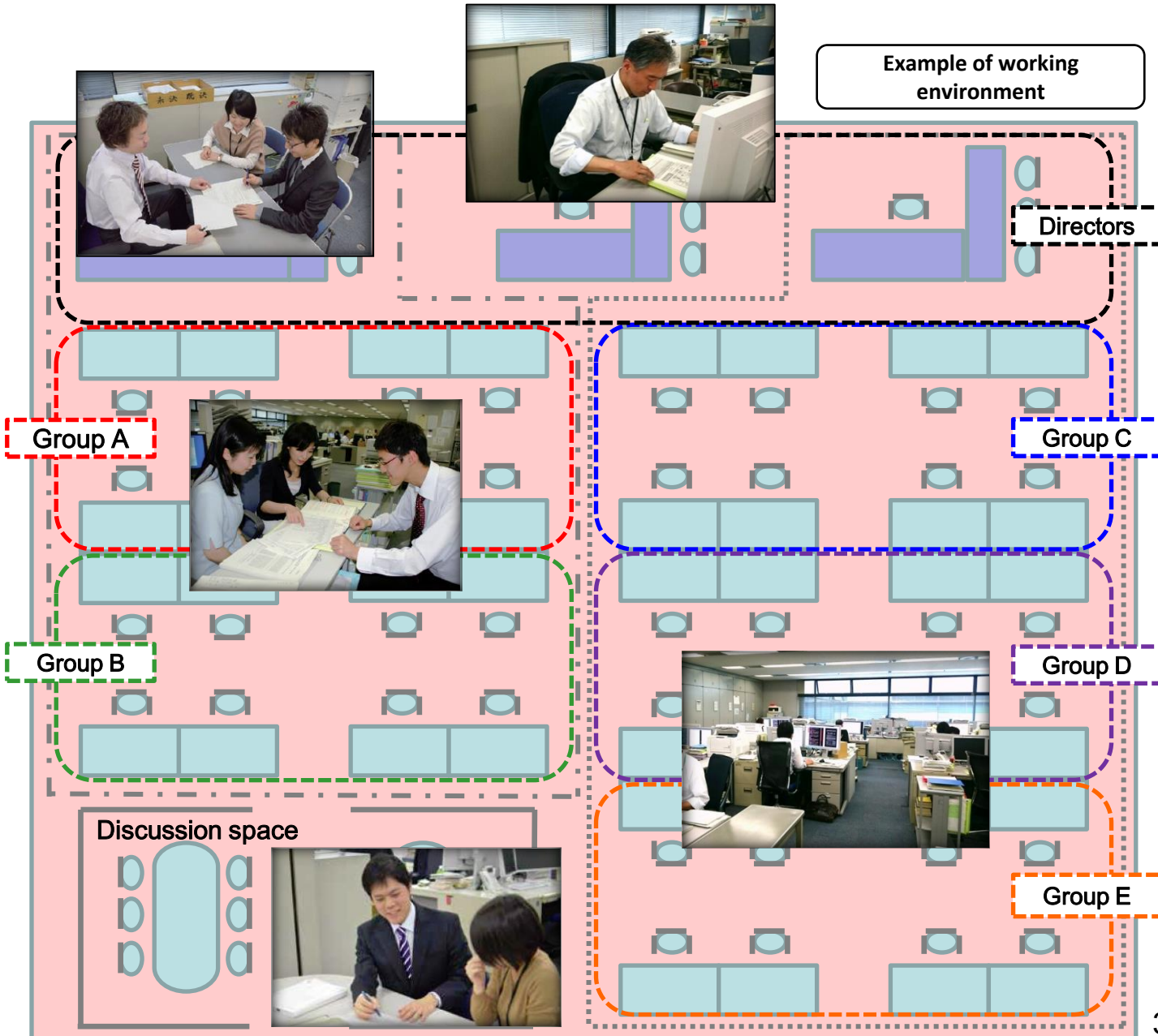
- 3 to 4 Directors are allocated to each examination division.

- The seating layout is arranged in groups of examiners in the division.

- Certain space is allocated in the office for group discussions.

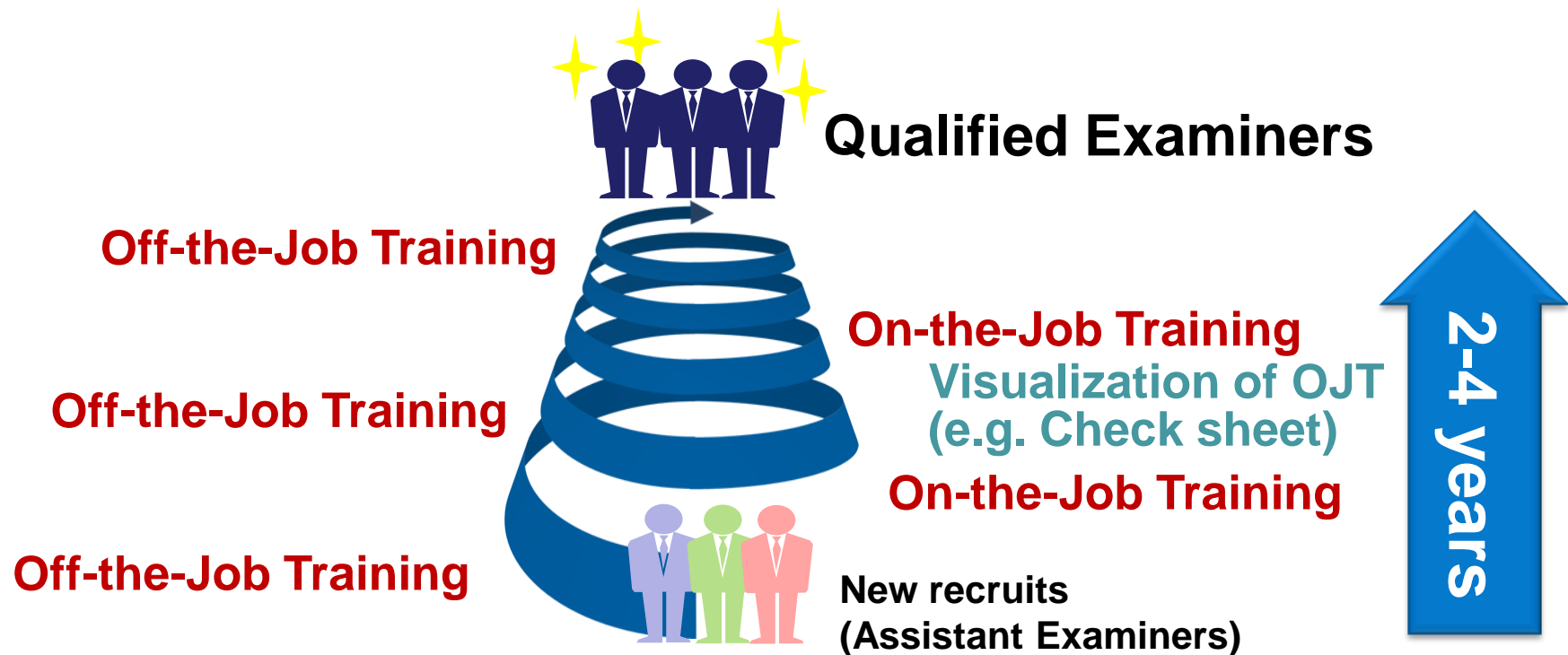


Achieving desirable work environment to encourage communications among examiners

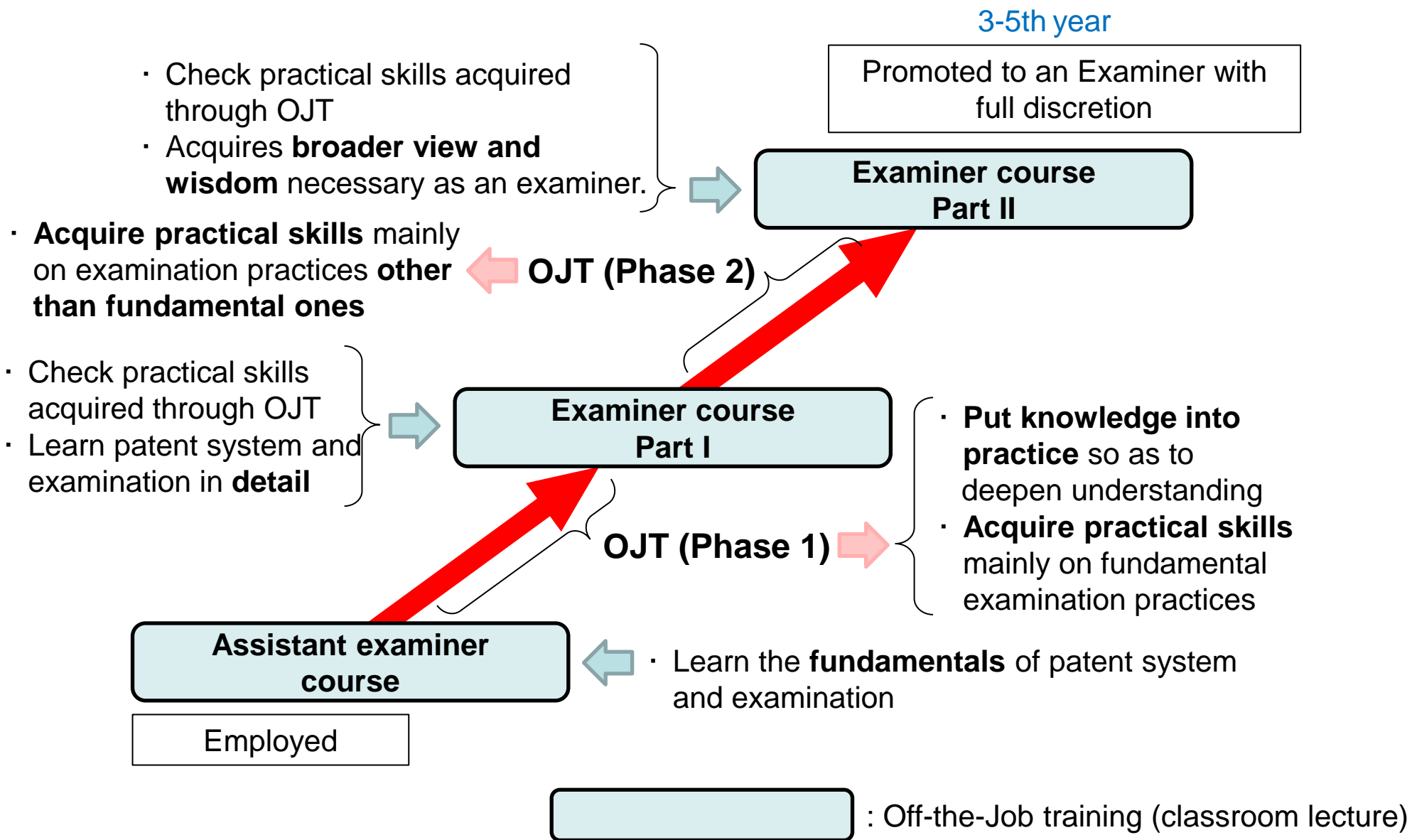


1. HRD-Related Experiences in the JPO

The JPO has broad experience in training new recruits with diverse backgrounds so as to enable them to become qualified examiners in 2-4 years through on- and off-the-job training.



1. Roadmap to Becoming a Competent Examiner in the JPO

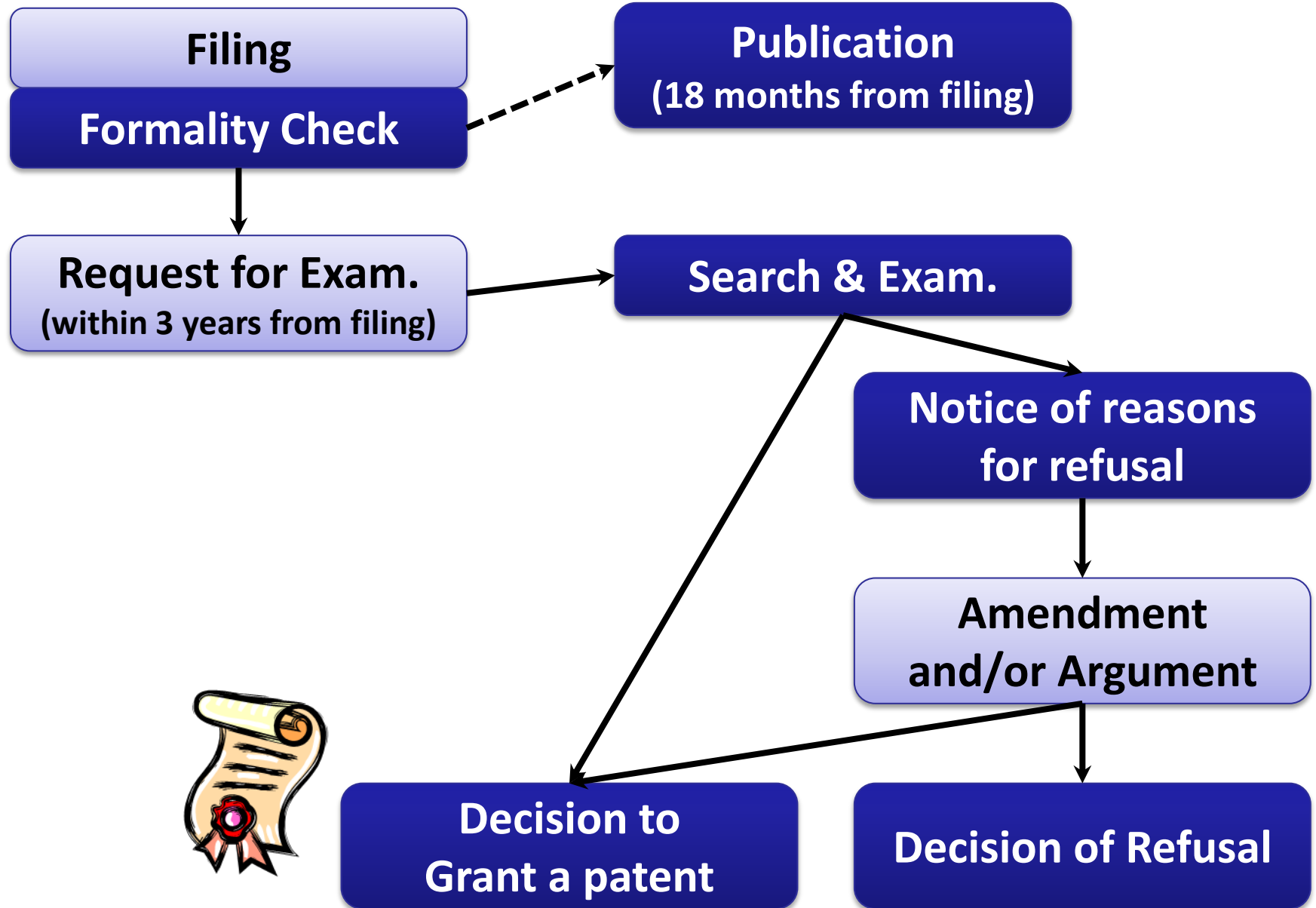


1. Organization of the JPO

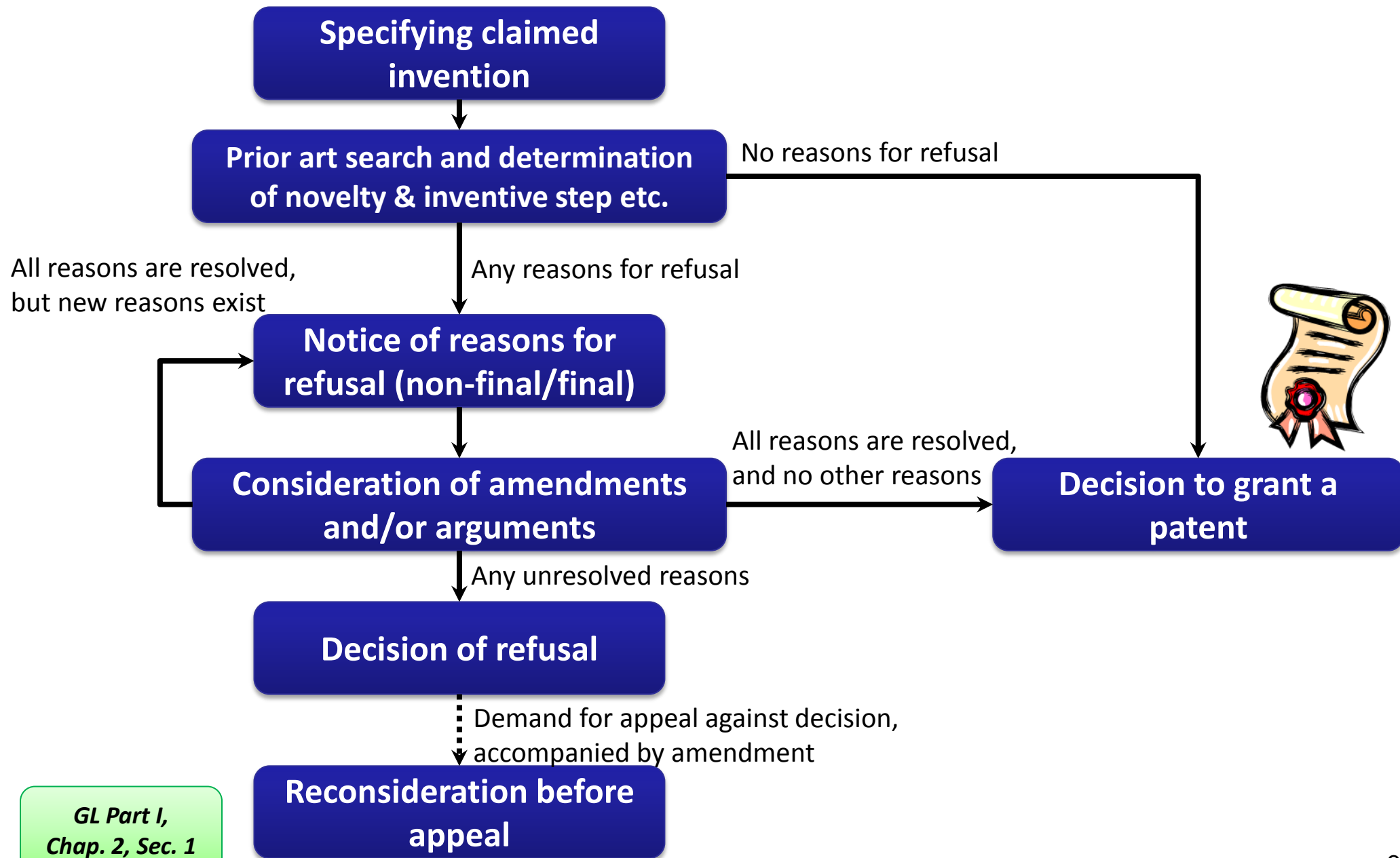
2. Examination Procedures

3. Initiatives by the JPO

2. Overview of Patent Examination Process



2. General Procedure of Substantive Examination



(1) Specifying claimed inventions

- Claimed inventions should be *specified based on statements in claims*.
- Examiners *take into consideration statements in the description and drawings, as well as the common general knowledge at the time of filing, in interpreting the meanings of terms* used in claims.
- Even though a claim is unclear, if the claim can be clearly identified by interpreting the terms in the claim based on the description etc., examiners should specify the claimed invention, taking into consideration that interpretation.
- When a claim is unclear, even if the description etc. are taken into account, the examiner does not specify a claimed invention. Such a claim may be excluded from the subject of prior art search.



(2) Prior art search and determination of novelty & inventive step



- Examiners should take into consideration ***working examples*** of a claimed invention which are shown in the description as the subject of prior art searches. Also, ***elements which are reasonably expected to be recited in amended claims*** should be taken into account.
- Inventions which may be excluded from the subject of prior art search are:
 - Inventions to which new technical matter is apparently added;
 - Subject matter which is apparently patent-ineligible; or
 - Inventions which cannot be identified, even when the description, etc. are taken into consideration.
- Points to note
 - Even when a claimed invention may be excluded, if it is reasonably expected, taking into account a possible amendment, that the invention can overcome the exclusion, the examiner ***conducts prior art searches based on a virtually amended claim***.

(2) Prior art search and determination of novelty & inventive step



- Examiners should ***retrieve all prior arts relevant to claimed inventions.***
- Examiners determine the scope of prior art searches based on their own knowledge and experience from the perspective of ***efficiency*** of the searches.
 - Examiners should, first, search the technical field where it is ***the most probable to retrieve relevant prior arts.*** Usually, such a technical field is the one most relevant to working examples shown in the description. Starting with such a technical field, examiner should gradually extend the scope of the search to less relevant fields.
 - Where examiners cannot retrieve enough prior arts for denying novelty or an inventive step, as per the relevant technical fields and they believe that it is probable to retrieve such prior arts from technical fields which are less relevant than those already searched, they extend the scope of the search to that end.

(2) Prior art search and determination of novelty & inventive step



- Examiners may stop the prior art searches when:
 - they have **retrieved enough relevant prior arts**;
 - there is **little expectation of retrieving more significantly relevant prior arts**; or
 - They have **retrieved a document which denies novelty or an inventive step of a claimed invention and its working examples, based on the document itself.** (Prior art search may be stopped with regard to the claim concerned.)

- Points to note
 - When, in the description, any prior art information is stated, examiners should consider the cited prior arts before searching for other prior arts.
 - When any search and/or examination results by foreign Offices or search results by outsourced prior art searches are available, the examiner should consider the results.

2. Substantive Examination Procedures

(2) Prior art search and determination of novelty & inventive step



- Examiners specify the claimed invention and the prior art, and then compare both in determining novelty and an inventive step. As a result of the comparison, they determine that the claimed invention lacks novelty when there is no difference. They determine whether there is an inventive step when there is a difference.



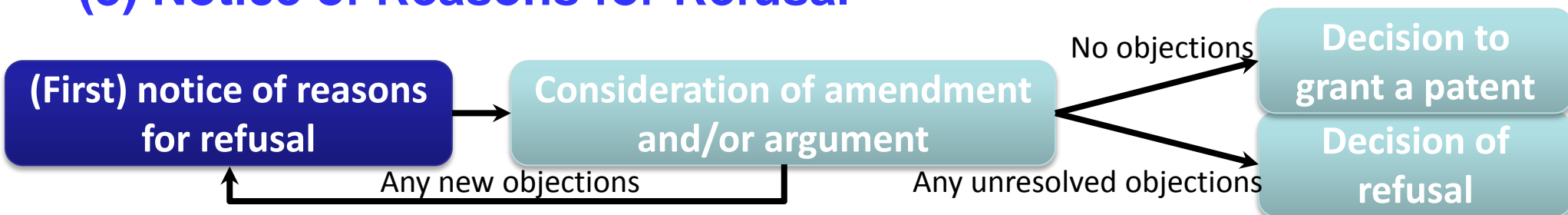
Determine any identical features and differences

When there is a difference, the claimed invention is **novel**.

Then, determine **Inventive Step**

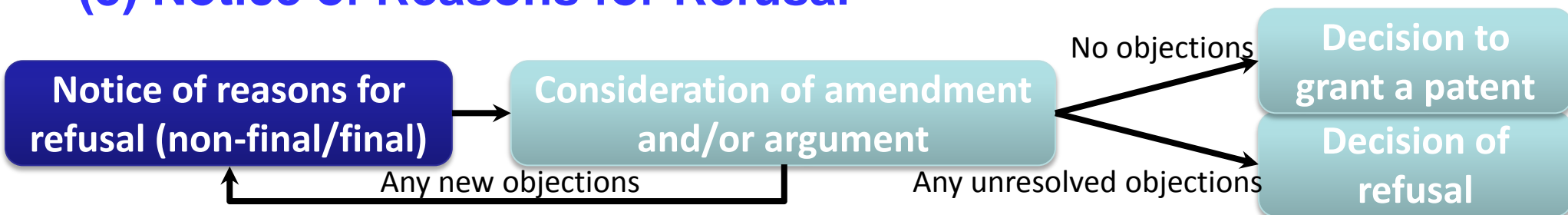
Consider the factors in support of existence/nonexistence of an inventive step based on the contents of the prior arts

(3) Notice of Reasons for Refusal



- Examiners shall ***notify the applicants reasons for refusal*** and ***give the said applicants an opportunity to submit a written argument*** before they render a decision of refusal. (Article 50 of the Patent Act)
- Types of notices
 - ***Non-final*** notice of reasons for refusal
 - A first-time notice about the reasons raised in examination. Thus, the one given for the first time is always “non-final.” Note that, even for the second time or more, notices including the reasons which should have been raised (but not) in the “first” notice are, in principle, “non-final.”
 - ***Final*** notice of reasons for refusal
 - A notice about the reasons which are brought by amendments filed in response to a “non-final” notices. Whether notices are “non-final” or “final” depends on the reasons raised therein. (The determination of “non-final” and “final” is not based on the number of notices sent.)

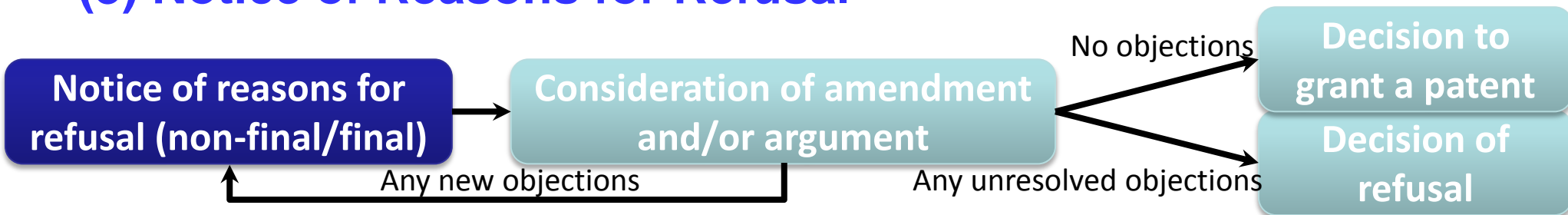
(3) Notice of Reasons for Refusal



■ Points to note

- Examiners should prepare notifications of reasons for refusal that are **clear and sufficient so that applicants can easily understand** and response to the notices. Each reason should be accompanied with the claims concerned.
- With regard to reasons denying an inventive step, the examiner needs to **clarify the differences between the claimed invention and elements specifying prior arts**, and specifically **describe the reason that a person skilled in the art would easily arrive at the claimed invention**, based on the prior art.
- When examiners notify “final” reasons for refusal, they need to **explicitly indicate that the notice is “final” and the reason for such**. If the notice lacks the indication and/or the reason, the examiner cannot regard such a notice as “final.”

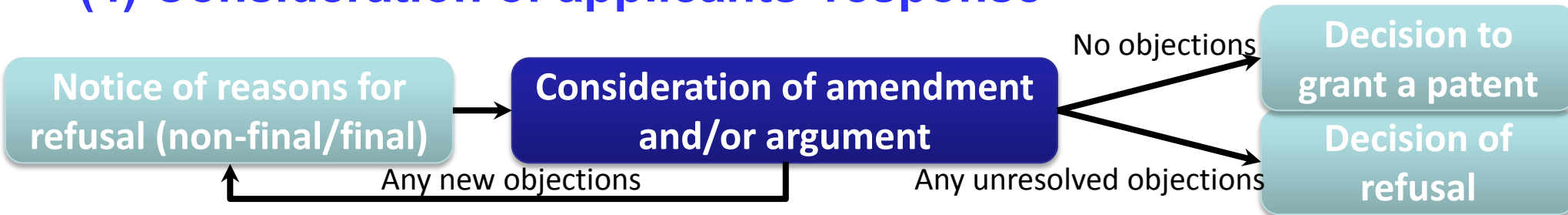
(3) Notice of Reasons for Refusal



■ Record of search

- When examiners notify reasons for refusal after conducting first-time prior art searches, they should indicate in the notification, the technical fields that they searched. Technical fields should be indicated by International Patent Classifications (IPCs).
- If there are prior arts which do not constitute the grounds for the reasons for refusal, but may serve as useful references for the applicant, examiners may identify those prior arts in the notification.

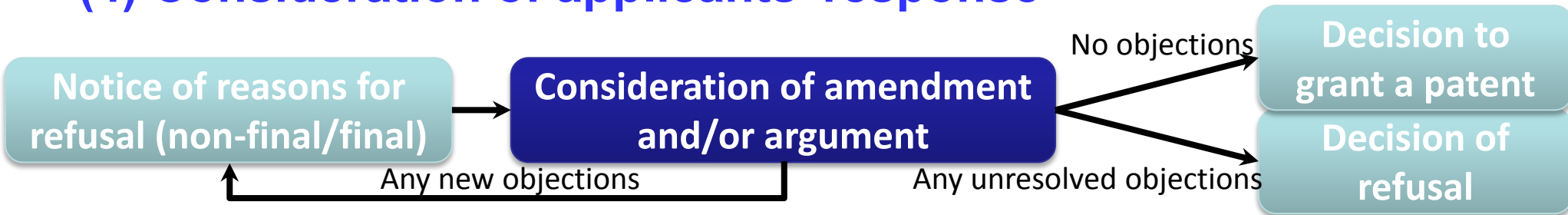
(4) Consideration of applicants' response



- Applicants can make amendments and/or submit written arguments within the period designated in the notification.
- When an amendment and/or an argument is made as a response to a notice of reasons for refusal, ***the examiner determines (i) whether the reasons raised in the notice are resolved, and (ii) whether any other reasons should be raised.***
- Prior art search after amendments and/or arguments are filed
 - When amendments and/or arguments are filed in response to notices and, because of them, the examiners believe that the searches which have been conducted are insufficient, they should re-search. Examiner are not required to conduct additional searches when they can advance examinations without additional searches.

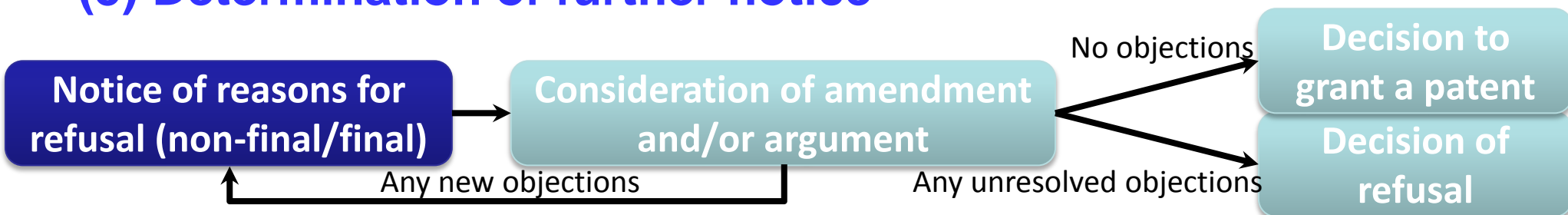
2. Substantive Examination Procedures

(4) Consideration of applicants' response



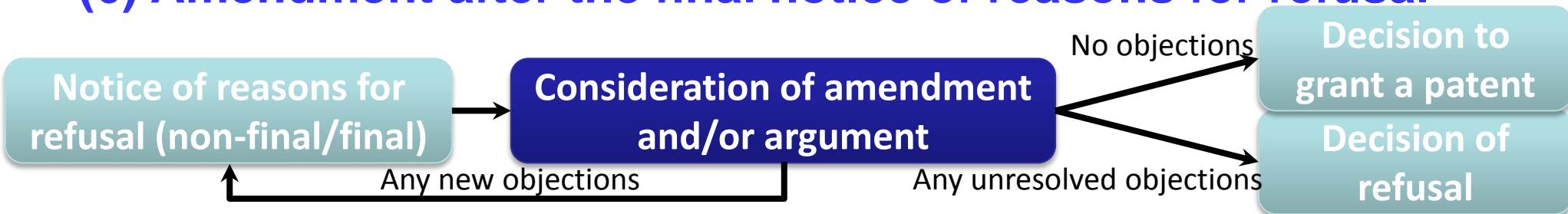
- If all reasons raised are resolved and there are no more reasons, the examiner renders a decision to grant a patent.
- If any reason raised is not resolved, examiners render decisions of refusal, in principle. However, when examiners can ***indicate to the applicants a possible response to resolve the reason***, and it is expected that the applicant will respond accordingly, the examiners notify the “final” reasons for refusal.

(5) Determination of further notice



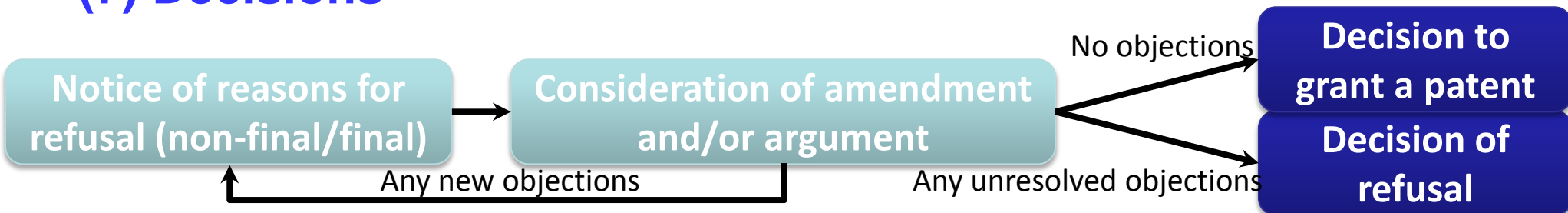
- When, although all reasons notified are resolved, the examiner finds ***other reasons for refusal***, they send a further notice.
- Criteria for determining whether the further notice is “non-final” or “final”
 - Where a new reason is ***raised because of an amendment*** made as a response to the last notice, the further notice should be “final.” On the other hand, where a new reason ***should have been raised in the last notice (but not raised)***, the further notice should be “non-final.”

(6) Amendment after the final notice of reasons for refusal



- After the final notice of reasons for refusal, the applicant may amend the claims for limited purposes as follows (Japanese Patent Act Art. 17bis(5)):
 - deleting claims;
 - restricting the scope of claimed inventions in a limited way;
 - correcting errors; or
 - clarifying ambiguous statements on which an objection that the statements are unclear was raised.
- This restriction is provided for the **efficiency of examinations** and **violating it does not constitute the grounds for invalidation**. In applying the provision, the examiner should ensure, giving due consideration to the objective thereof, that it should **not be applied more strictly than necessary**, especially when the examiner believes that the results of the examination already performed can be used effectively to complete the examination process promptly even if an amendment does not comply with the restriction.

(7) Decisions



■ Points to note

- When examiners issue decisions of refusal, they need to determine (i) whether the reasons notified are resolved or not, and (ii) whether the reasons notified are appropriate or not.
- In the decision of refusal, all reasons which are not resolved should be described. Each reason should be clearly described and be accompanied with the claims concerned. Also, examiners should ***describe their determination on issues raised in written arguments.***

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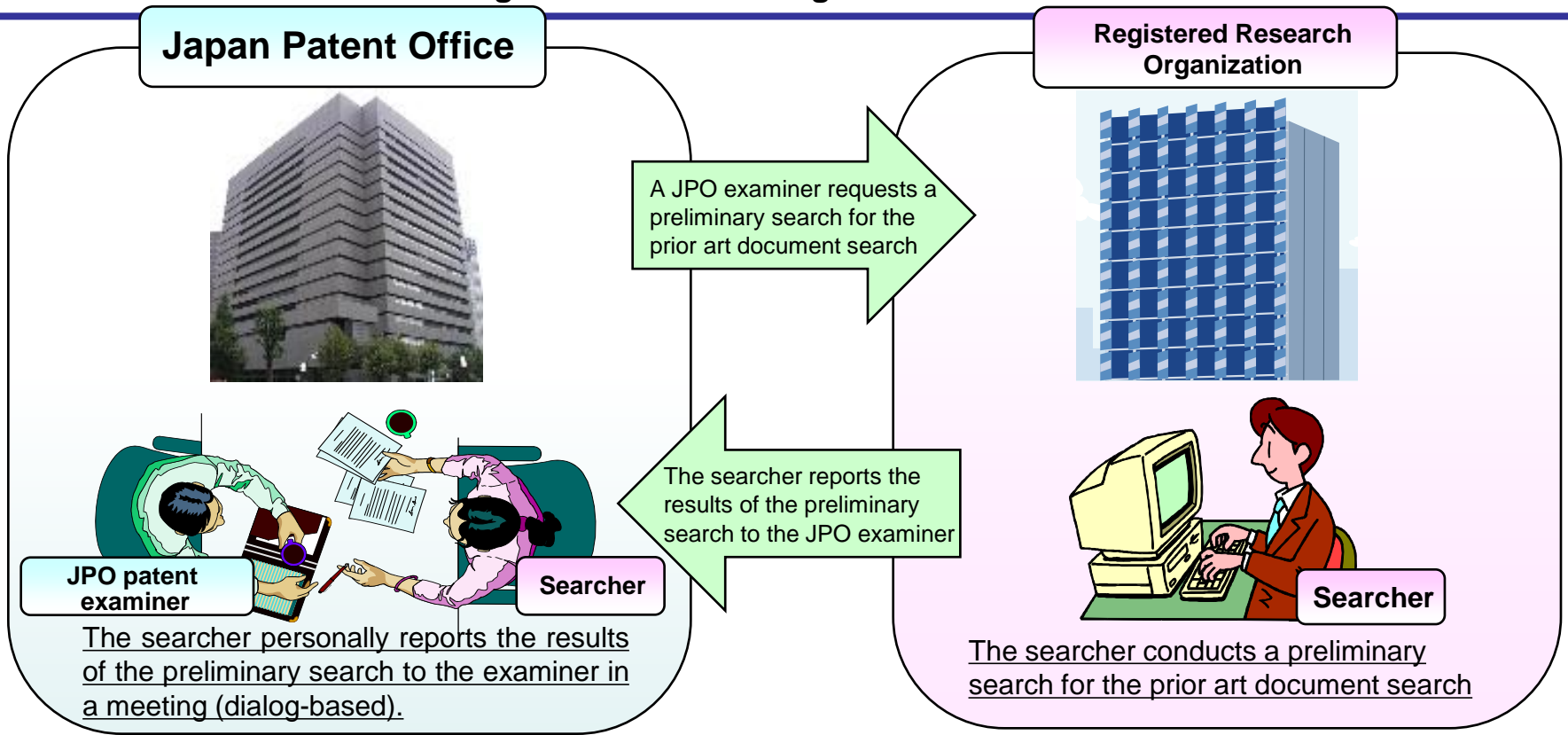
Outsourced Prior Art Searches

Examination by Interview

Cooperation with foreign offices

3. Outsourced Prior Art Searches

- JPO patent examiners outsource prior art document searches to registered research organizations (preliminary searches), with the aim of improving the efficiency of the examination process (search outsourcing).
- The search outsourcing is implemented mainly through personal meetings (dialog-based) between the examiner and the searcher in the registered research organization to reduce the **workload of examiners**.



Number of registered research organizations

2004
One organization



2014
Eleven organizations

3. Outsourced Prior Art Searches

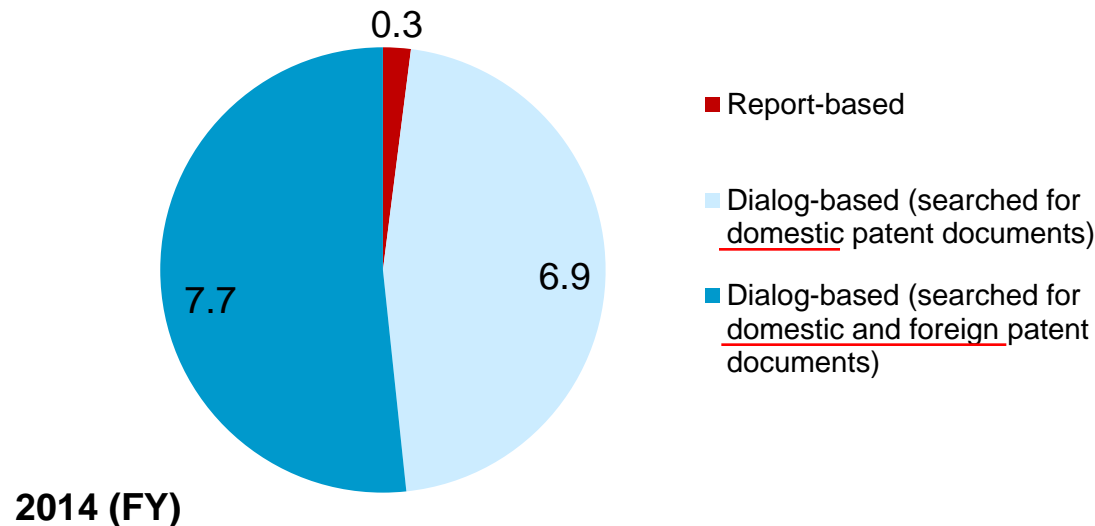
■ There are two ways of delivering the results of prior art document searches:

- Dialog-based: The searcher meets the examiner and personally reports the results of the prior art document search to the examiner
 - Report-based: Delivery of a report of the prior art document search results
- About 98% of all outsourced searches were dialog-based (in FY2014).

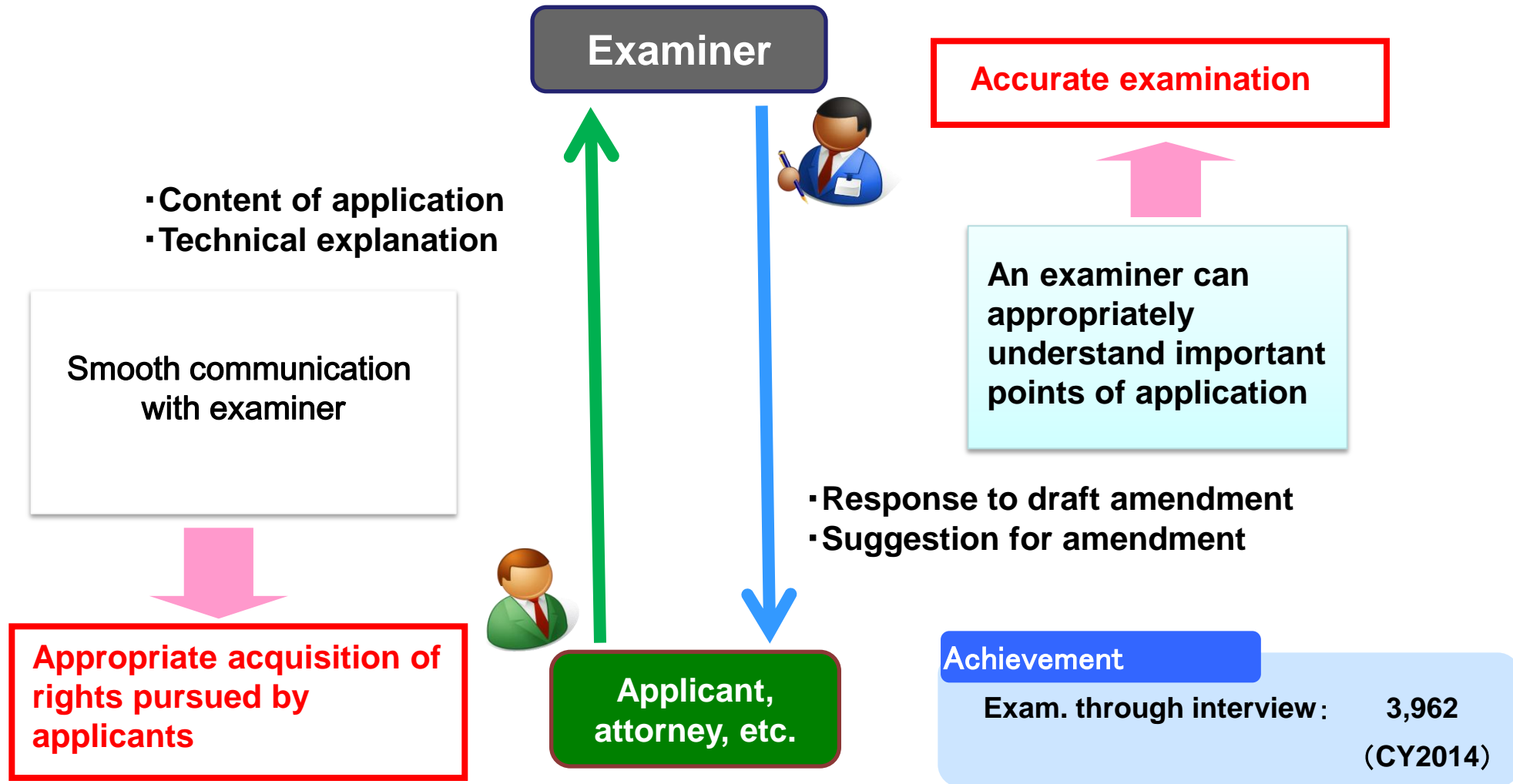
■ To further improve the quality, **searches of patent documents in foreign languages** are also outsourced to registered research organizations.

→ About 52% of all outsourced searches were searches of foreign patent documents (in FY2014).

Type of Outsourced Prior Art Searches (units:10,000)



Implementation of Exam. through interview



3. Requirements for an Interview

Requesting an interview

- If an examiner is already assigned to the application, the applicant requests an interview with that examiner.

Accepting an interview

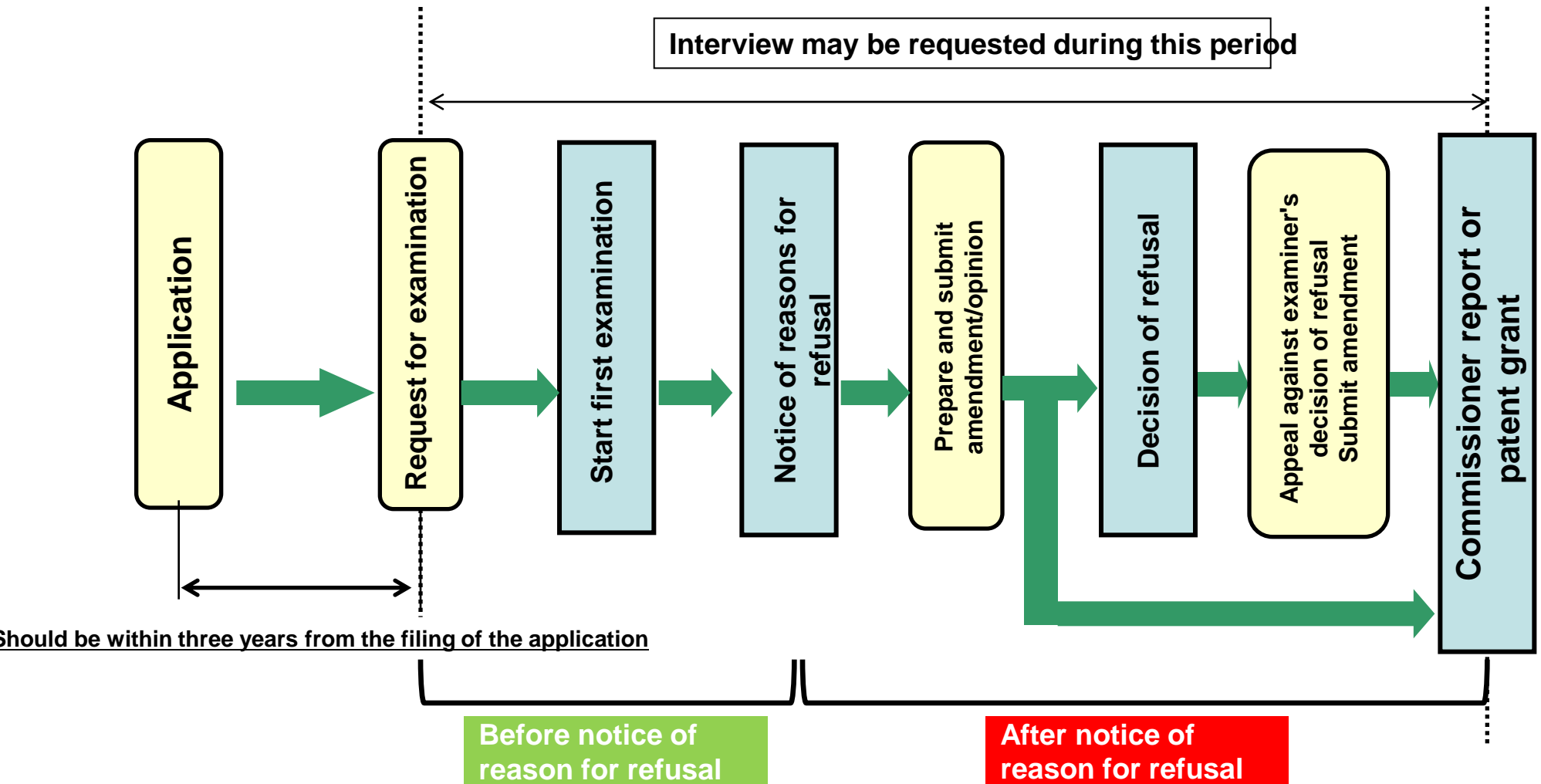
- If an applicant or an attorney of the applicant requests an interview, the examiner accepts at least one interview, in principle.

Requirements for Interviewee

- If an applicant appoints an attorney, the interview will be conducted between the attorney and the examiner. The applicant or any other person who is authorized to take responsible actions, such as a staff member from the IP department of the applicant company, may also attend the interview and personally communicate with the examiner.
- If an applicant does not appoint an attorney, the interview will be conducted between the applicant and the examiner, in principle.

3. Requirements for Interview (Interview Period)

- The examination by interview may be held from the date a request for examination is filed to the date a patent right is granted.
- During the period when an applicant may file an appeal against an examiner's decision of refusal, if the applicant requests an examination by interview before filing the appeal, the applicant must present a concrete reason for the appeal and a draft of an amendment.



3. Purpose of Interview

(1) Interview to explain technological characteristics of the invention

Mainly before notice of reason for refusal

- The technological fields, the problem to be solved by the invention, the method to solve the problem, advantageous effect compared with conventional art, etc. are explained to the examiner.

(2) Interview to compare the invention with the prior art

Mainly after notice of reason for refusal

- Comparison between the invention and the prior art (cited by the applicant or cited by the examiner in the notice of reason for refusal) is explained to the examiner.
- Differences of the invention from the prior art and patentability of the invention based on those differences and other arguments are also organized and explained to the examiner.
- Technical aspects of the invention are explained based on the patent descriptions. Supplemental materials may also be used as necessary.

(3) Interview to explain a draft of amendment of patent descriptions or any other document

Mainly after notice of reason for refusal

- Before filing an amendment or any other document with the JPO, a draft of the document is presented and explained to the examiner in advance.
- The examiner may give advice to ensure that the amendment is appropriate.

3. Purpose of Interview (from examiner's viewpoint)

(1) Interview to explain technological characteristics of the invention

Mainly before notice of reason for refusal

- Must understand the technological characteristics of the invention, such as which constituents are important and what effects can be obtained.
- Must understand for which portion of the detailed description of the invention the applicant seeks a patent right.

Get information useful for determining the examination policy before starting the examination, such as how the prior art searches should be performed.

(2) Interview to compare the invention with the prior art

(3) Interview to explain a draft of amendment of patent descriptions or any other document

Mainly after notice of reason for refusal

- Examiners need to confirm that they correctly understand the technological aspect of the prior art cited in the invention or cited in their notice of reason for refusal.
- Confirm in which part of the detailed description of the invention the constituents indicated in the amendment are included.
- Confirm what the technological difference is between the invention indicated in the draft of the amendment and the prior art cited in the notice of reason for refusal.

Confirm whether the matter indicated in the amendment draft can eliminate the reason for refusal.

3. Milestones in JPO's 20 Years of Support

- 5,137 short & midterm trainees from 75 countries / 5 regions
- 569 experts (short term / long term) to 36 countries / 1 region

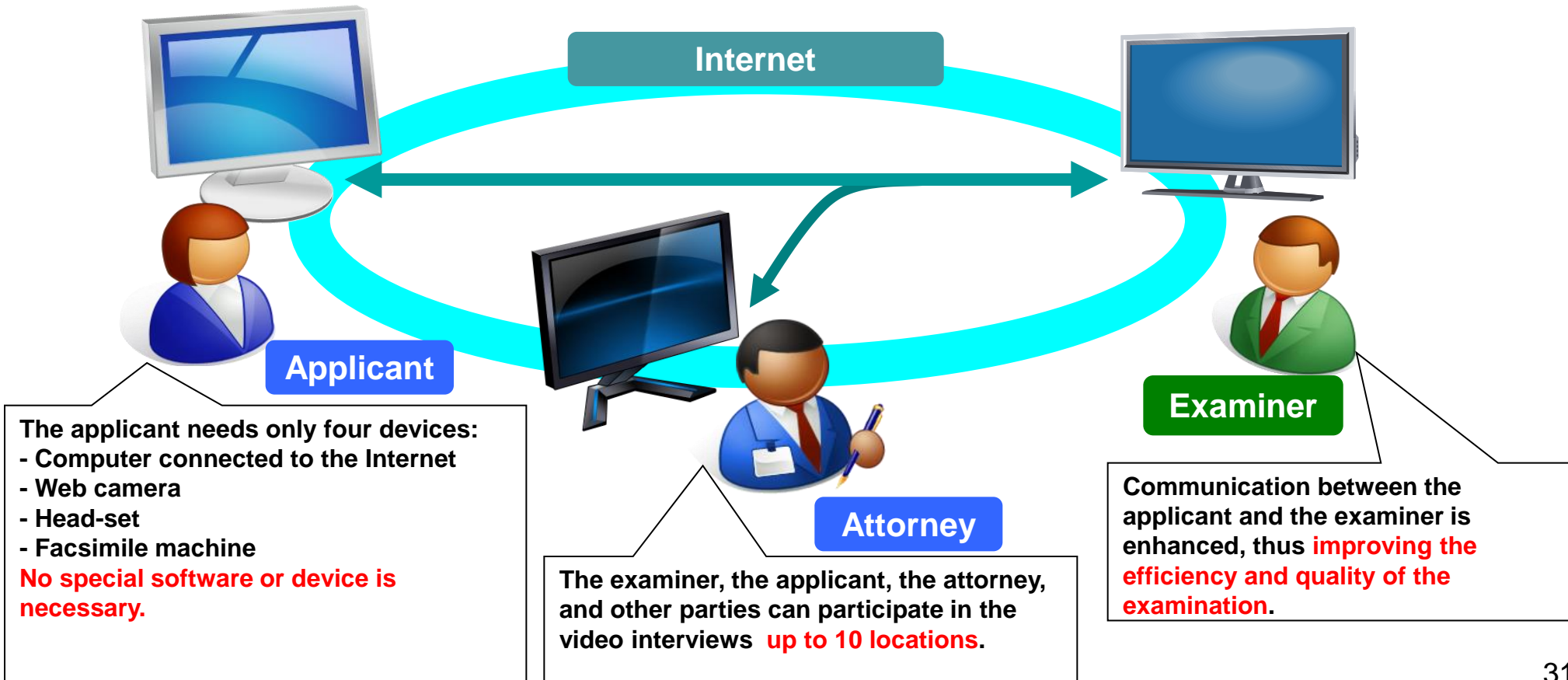
**Total number of trainees
invited/experts sent
between FY 1996 and FY 2015**



Country	Welcomed trainees	sent experts/speakers
Afghanistan	4	0
Bangladesh	38	1
Bhutan	23	2
Brunei	26	2
Cambodia	117	11
India	281	14
Indonesia	701	111
Laos	94	11
Malaysia	463	39
Maldives	3	1
Myanmar	108	6
Nepal	28	0
Pakistan	72	3
Philippines	477	52
Singapore	34	19
Sri Lanka	54	12
Thailand	597	89
Viet Nam	574	90
Other	1443	126
Total	5137	589

3. Video Interview

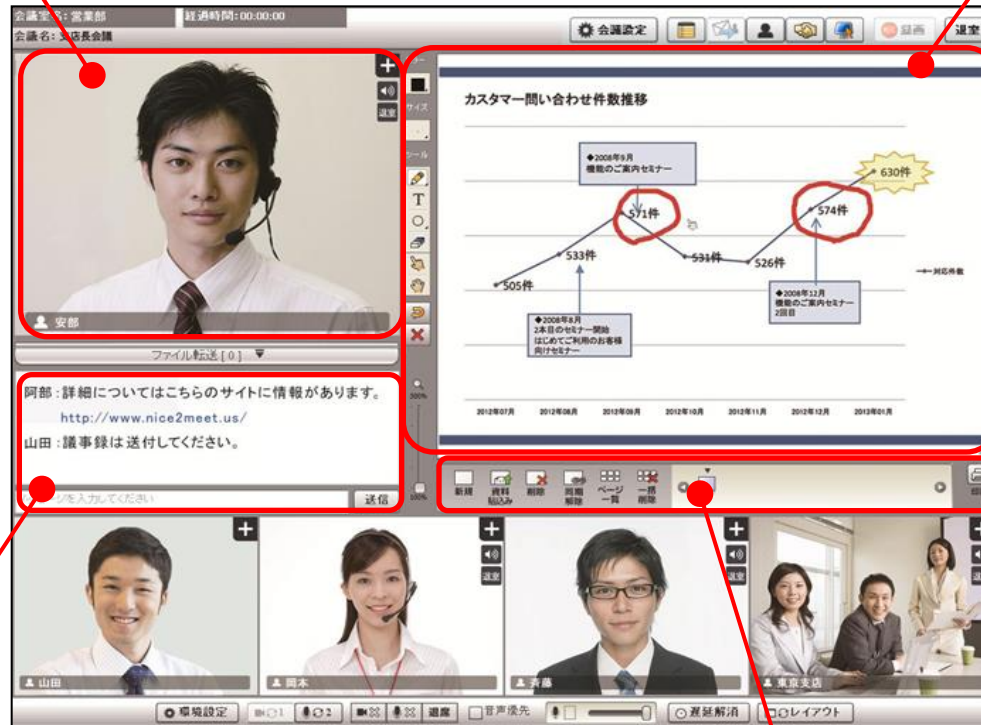
- Examination by interview between the examiner and the applicant/attorney is a very efficient way to improve the accuracy of examination.
- In April 2013, the JPO introduced an option to conduct examination by interviews, by using videoconferencing through the Internet to increase the opportunity for applicants to have interview examinations.
- **It has become easier for applicants who are far from the JPO office to conduct interview examinations by using their computers. Decisions on patent rights can be made based on more accurate information through interactive communication between the applicant and the examiner.**



3. Video Interview System

Video images of all participants are displayed.

This is a whiteboard. Uploaded documents can be displayed here. The tool bar enables participants to write drawings and text on the whiteboard. The pointer tool can be used to point to an object displayed on the board.



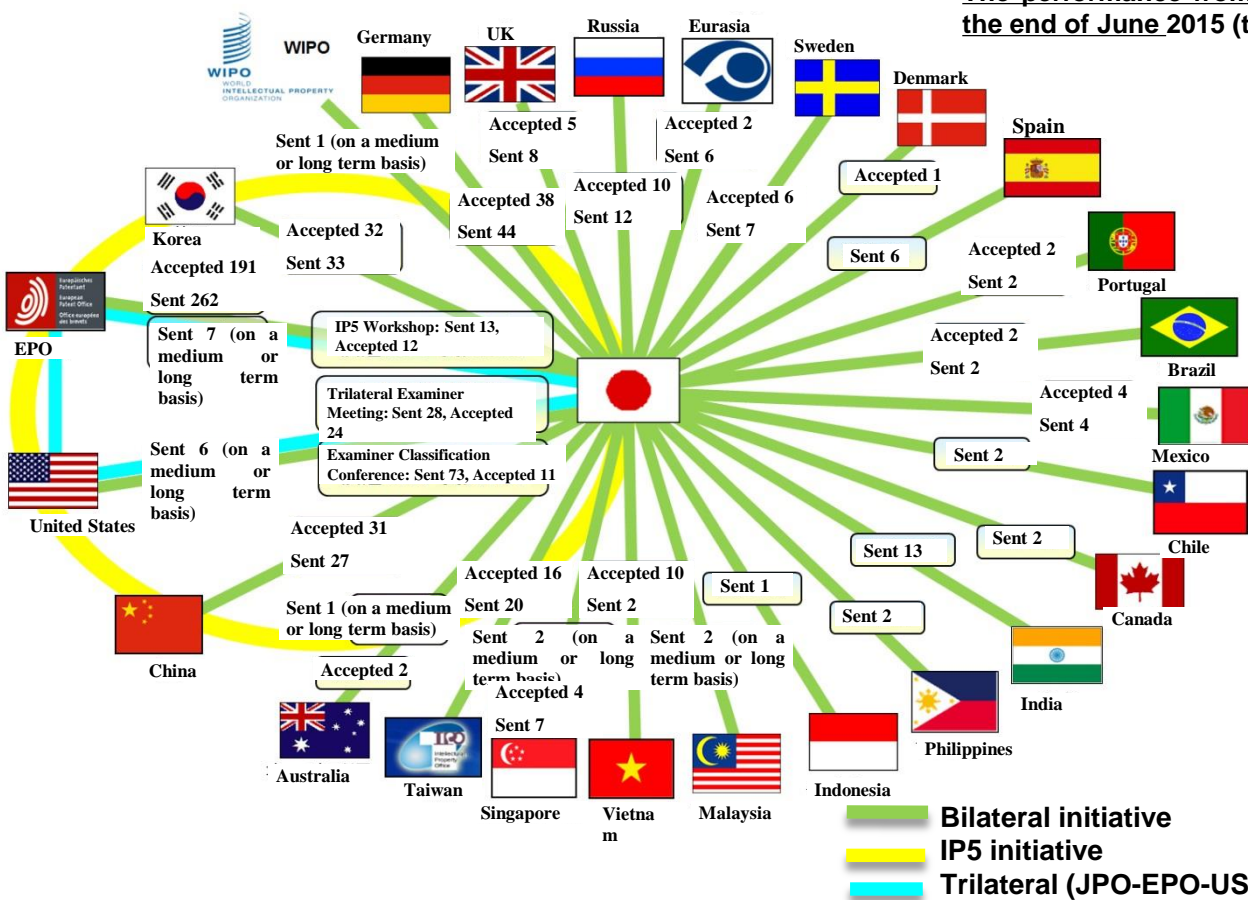
The text chat function enables a participant to send text messages or URL links to other participants.

In this section, the whiteboard can be used to upload materials and switch between pages. (Documents in Word, Excel, PowerPoint, and PDF formats can be uploaded.)

3. Sending and Accepting Patent Examiners

- Under the International Examiner Exchange Program, examiners are sent and welcomes between the JPO and other offices to enable them to gain a deeper understanding about examination procedures and standards for making judgments; learn about the requirements for patents in other countries through discussions using actual applications; and promote harmonization of patent practices, measures, and initiatives.
- In order to support the development of IP systems in emerging countries in Asia and other regions, the JPO supports Japanese companies by sending and accepting experts such as patent examiners and by expanding the Japanese IP system and examination practices and providing support for computerization.

The performance from April 2000 to the end of June 2015 (total number)



<The Fundamentals of Patent Examination>

- ❑ The JPO has prepared a training material for patent examiners in emerging countries

<Other cases of sending and accepting examiners>

- ❑ The JPO sent examiners as senior examiners to the Intellectual Property Office of Singapore.
- ❑ The JPO sent examiners as JICA long-term experts to Myanmar to support the establishment of IP laws and IP Office.
- ❑ The JPO provided trainings with the aim of improving the capabilities of examiners for emerging countries.
- ❑ The JPO sent experts to Asian countries for computerization such as computerization of documents and introduction of examination system.

Thank you
for your attention!

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<p>【請求項1】</p> <p>電話回線を用いて相互通信を行うファクシミリ端末等によるパラメータを通知し、通信時の端末パラメータを識別する含む制御信号の送信側端末は該制御信号のファクシミリフィールドに分離し、各サブフィールドの情報を分離するデータ中には現れない特定の識別コードを挿入してファクシミリフィールドの識別コードを検出し、該ファクシミリ情報フィールドの端末パラメータの内容を検出することを特徴とする方式。</p> <p>【請求項2】</p> <p>請求項1の装置を用いる方法……………。</p> <p>【発明の詳細な説明】</p> <p>【技術分野】</p> <p>【0001】</p> <p>本発明は簡単にして、装置機能のパラメータの拡張が容易なファクシミリ識別方式に関するものである。</p>																																																									

