

National Workshop on the Patent Cooperation Treaty (PCT) System

Drafting IPRP Chapter II

November 29, 2016
Japan Patent Office

- I. Flow of International Preliminary Examination
- II. Drafting IPRP Chapter II

Applicant files demand with IPEA

WO/ISA treated as first WO/IPEA
(unless IPEA declares otherwise)

Applicant may file amendments under article 34
and/or arguments



IPEA examines IA, taking any
amendments and arguments into account

IPEA may establish further
written opinions and invite reply



IPEA establishes **IPRP (Chapter II)**
(=IPER)

Abbreviation:

IPEA International Preliminary Examining Authority

WO/ISA written opinion of the ISA

WO/IPEA written opinion of the IPEA

IA international application

IPRP international preliminary report on patentability

IPER international preliminary examination report

II. Drafting IPRP Chapter II

A. List of Sheets Constituting IPRP Chapter II

	IPRP Chapter II
	Cover Sheet
No.I	Basis of the report
No.II	Priority
No.III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
No.IV	Lack of unity of invention
No.V	Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
No.VI	Certain documents cited
No.VII	Certain defects in the international application
No.VIII	Certain observations on the international application
	Supplemental Box Relating to Sequence Listing

II. Drafting IPRP Chapter II

B. Cover Sheet (1/2)

PATENT COOPERATION TREATY PCT INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty) (PCT Article 36 and Rule 70)		
Applicant's or agent's file reference 123456AB	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/JP2015/123456	International filing date (<i>day/month/year</i>) 15.09.2015	Priority date (<i>day/month/year</i>) 15.09.2014
International Patent Classification (IPC) or national classification and IPC Int.Cl. G01N27/02 (2006.01) i		
Applicant PATENT CORPORATION		

Bibliographic
Information

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C. Basis of the report (1/2)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/JP2015/123456

Box No. I	Basis of the report
1.	With regard to the language , this report is based on: <input checked="" type="checkbox"/> the international application in the language in which it was filed. <input type="checkbox"/> a translation of the international application into _____ which is the language of a translation furnished for the purposes of: <input type="checkbox"/> international search (Rules 12.3(a) and 23.1(b)). <input type="checkbox"/> publication of the international application (Rule 12.4(a)). <input type="checkbox"/> international preliminary examination (Rules 55.2(a) and/or 55.3(a) and (b)).
2.	With regard to the elements of the international application, this report is based on (<i>replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report</i>): <input type="checkbox"/> the international application as originally filed/furnished, or <input checked="" type="checkbox"/> the description: pages 1-11, 13-18 as originally filed/furnished. pages* 12 received by this Authority on 28.09.2016 pages* _____ received by this Authority on _____ <input checked="" type="checkbox"/> the claims: Nos. 7-8 as originally filed/furnished. Nos.* _____ as amended (together with any statement) under Article 19 Nos.* 1-4, 6 received by this Authority on 28.09.2016 <input checked="" type="checkbox"/> the drawings: sheets/figs 2-12 as originally filed/furnished. sheets/figs* 1 received by this Authority on 28.09.2016 sheets/figs* _____ received by this Authority on _____ <input type="checkbox"/> a sequence listing - see Supplemental Box Relating to Sequence Listing.
3.	The amendments have resulted in the cancellation of: <input type="checkbox"/> the description, pages _____ <input checked="" type="checkbox"/> the claims, Nos. 5

Basis of the report

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C. Basis of the report (2/2)

4. This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since either they are considered to go beyond the disclosure as filed, or they were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in the Supplemental Box (Rules 70.2(c) and (c-bis)):

the description, pages _____

the claims, Nos. 7-8 _____

the drawings, sheets/figs _____

the sequence listing (*specify*): _____

5. This report has been established:

taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rules 66.1(d-bis) and 70.2(e)).

without taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rules 66.4bis and 70.2(e)).

6. With regard to top-up searches (Rules 66.1ter and 70.2(f)):

A top-up search was carried out by this Authority on 07.11.2016 _____

Additional relevant documents have been discovered during the top-up search. _____

No top-up search was carried out by this Authority because it would serve no useful purpose. _____

7. Supplementary international search report(s) from Authority(ies) _____

has/have been received and taken into account in establishing this report (Rule 45bis.8(b) and (c)).

* If item 4 applies, some or all of those sheets may be marked "superseded."

Portions where
the amendments are
unacceptable

Top-up search

D. Priority

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/JP2015/123456
Box No. II Priority	
<p>1. <input checked="" type="checkbox"/> This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:</p> <ul style="list-style-type: none"><input checked="" type="checkbox"/> copy of the earlier application whose priority has been claimed (Rule 66.7(a)).<input type="checkbox"/> translation of the earlier application whose priority has been claimed (Rule 66.7(b)). <p>2. <input type="checkbox"/> This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rule 64.1). Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.</p> <p>3. Additional observations, if necessary:</p>	

E. Non-establishment of opinion

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/JP2015/123456
Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	
The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:	
<input type="checkbox"/> the entire international application.	
<input type="checkbox"/> claims Nos. _____	
because:	
<input type="checkbox"/> the said international application, or the said claims Nos. _____ relate to the following subject matter which does not require an international preliminary examination (<i>specify</i>):	

⋮

<input type="checkbox"/> no international search report has been established for said claims Nos. _____	<input type="checkbox"/>
<input type="checkbox"/> a meaningful opinion could not be formed without the sequence listing; the applicant did not, within the prescribed time limit:	<input type="checkbox"/>

⋮

Claims for which no ISR has been established

F. Lack of unity of invention

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/JP2015/123456
Box No. IV	Lack of unity of invention	
1.	<input type="checkbox"/> In response to the invitation to restrict or pay additional fees the applicant has, within the applicable time limit: <ul style="list-style-type: none"><input type="checkbox"/> restricted the claims.<input type="checkbox"/> paid additional fees.<input type="checkbox"/> paid additional fees under protest and, where applicable, the protest fee.<input type="checkbox"/> paid additional fees under protest but the applicable protest fee was not paid.<input type="checkbox"/> neither restricted the claims nor paid additional fees.	
2.	<input checked="" type="checkbox"/> This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.	
3.	This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is: <ul style="list-style-type: none"><input type="checkbox"/> complied with.<input checked="" type="checkbox"/> not complied with for the following reasons:	

“the applicant has ...
restricted the claims”

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G. Reasoned statement under Article 35(2) (1/3)

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	1-4, 6-8	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1-4, 6-8	NO
Industrial applicability (IA)	Claims	1-4, 6-8	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
D1: JP 2010-123456 A (TOKYO CORPORATION) 2010.04.01, [0010]-[0020], Fig.3 & EP 123456 A1, [0020]-[0030], Fig.3			
D2: WO 2008/123456 A1 (OSAKA CORPORATION) 2008.01.01, [0100]-[0121], Fig.1 (Family: none)			
The subject matter of claim 1 does not involve an inventive step over document D1 in view of document D2. ...			
The statement shall be explained in light of the applicant's arguments. <Guideline 17.73>			

Statement

- Novelty
- Inventive step
- Industrial applicability

Citations and explanations

G. Reasoned statement under Article 35(2) (2/3)

- Each such statement must be accompanied by relevant citations, explanations and observations. <Guideline 17.42>
- Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions... <Guideline 17.43>
- If the applicant submits arguments in response to the written opinion, the examiner should comment on the applicant's relevant arguments... <Guideline 17.73>

G. Reasoned statement under Article 35(2) (3/3)

D1: JP 2010-123456 A (TOKYO CORPORATION)

2010.04.01, [0010]-[0020], Fig.3

& EP 123456 A1, [0020]-[0030], Fig.3

D2: WO 2008/123456 A1 (OSAKA CORPORATION)

2008.01.01, [0100]-[0121], Fig.1 (Family: none)

The subject matter of claim 1 does not involve an inventive step over document D1 in view of document D2.

D1 describes a machine for

Comparing the subject matter of claim 1 and the machine described in D1, there is a difference in

With regard to the difference stated above, D2 discloses that

Both D1 and D2 address the same problem of Therefore a person skilled in the art would easily conceive the idea of ... disclosed in D2 to the machine disclosed in D1.

The applicant argues that However

Citations

- Publication number
- Applicant's name
- Publication date
- Relevant passages
- Number of Family

Reasons supporting the conclusions

Comment on the applicant's arguments

An example of "Citations and explanations"

H. Certain documents cited

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/JP2015/123456	
Box No. VI Certain documents cited			
1. Certain published documents (Rule 70.10)			
<u>Application No. Patent No.</u>	<u>Publication date (day/month/year)</u>	<u>Filing date (day/month/year)</u>	<u>Priority date (valid claim) (day/month/year)</u>
EP 4567890 A1 [E, A]	01.04.2016	01.10.2014	
2. Non-written disclosures (Rule 70.9)			
Date of written disclosure			

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I. Certain defects in the international application

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/JP2015/123456
Box No. VII Certain defects in the international application	
The following defects in the form or contents of the international application have been noted:	

J. Certain observations on the international application

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/JP2015/123456
Box No. VIII Certain observations on the international application	
The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:	

K. Supplemental Box Relating to Sequence Listing

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/JP2015/123456
Supplemental Box Relating to Sequence Listing	
<p>Continuation of Box No. I, item 2:</p> <p>1. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this report was established on the basis of a sequence listing:</p> <p>a. <input type="checkbox"/> forming part of the international application as filed:</p> <ul style="list-style-type: none"><input type="checkbox"/> in the form of an Annex C/ST.25 text file.<input type="checkbox"/> on paper or in the form of an image file. <p>b. <input type="checkbox"/> furnished together with the international application under PCT Rule 13ter.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file.</p> <p>c. <input type="checkbox"/> furnished subsequent to the international filing date for the purposes of international search and/or examination:</p> <ul style="list-style-type: none"><input type="checkbox"/> in the form of an Annex C/ST.25 text file (Rule 13ter.1(a)).<input type="checkbox"/> on paper or in the form of an image file (Rule 13ter.1(b) and Administrative Instructions, Section 713). <p>d. <input type="checkbox"/> furnished to this Authority as an amendment* under PCT Article 34 on _____</p> <ul style="list-style-type: none"><input type="checkbox"/> in the form of an Annex C/ST.25 text file, and preferably identified as “Amended” at the first line of text.<input type="checkbox"/> on paper or in the form of an image file. <p>2. <input type="checkbox"/> In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.</p>	