Topic 8: Case Study 1

- Examination in National/Regional Phase -

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Contents

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Part I

1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 4)
3. How to understand claimed inventions
   - Brief explanation
   - Group work
   - Discussion

Part II

4. How to evaluate XY citations in ISRs
   - Brief explanation
   - Group work
   - Discussion
5. Summary

Part I

Contents

1. **First action procedures at the national stage**
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   - Brief explanation
   - Group work
   - Discussion
4. How to evaluate XY citations in ISRs
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   - Discussion
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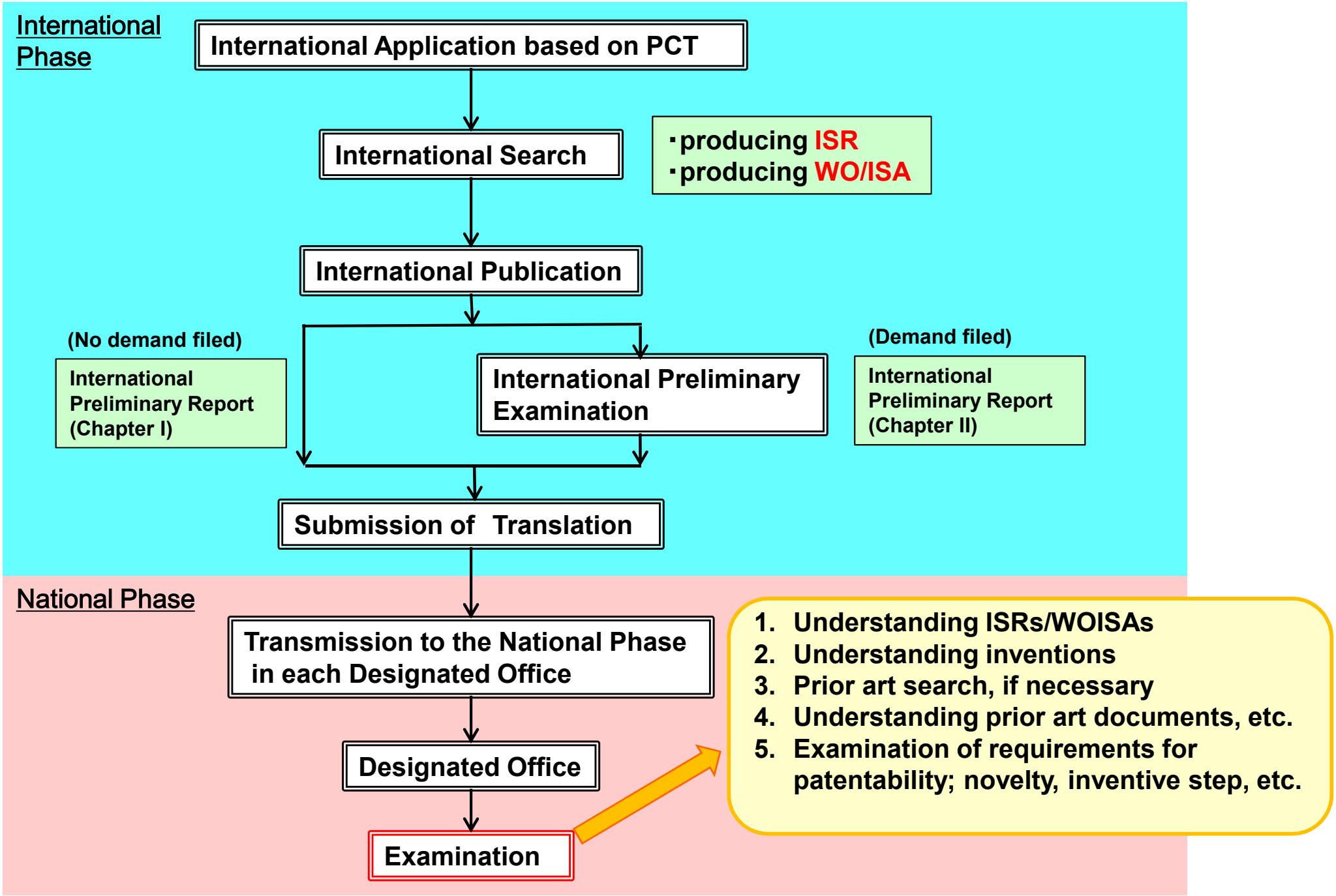
Flowchart of Typical International Application Processing



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3. How to understand claimed inventions
   - Brief explanation
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   - Group work
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Let's start group work on understanding ISRs/WOISAs

- ***Carefully reading the ISR and WOISA for PCT/JP2012/123456***

  (Reviewing what you learned in previous sessions, especially Topic 4)

- ***Check the following bibliographic items***

  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?

- ***Filling out Section 1 of Work Sheet 1***

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Question 1

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

Question 1

- 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, descriptions and drawings
- Color-highlighting and segmenting claims
- Color-highlighting items in descriptions and drawings with the claims

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Example of Color-highlighting and Segmenting

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
an image obtaining unit configured to obtain an image;
a server information storage unit configured to store plural items of superimposed data;
a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items;
a superimposing unit configured to superimpose the identified information on the obtained image and;
to present the image having the superimposed information.

2. The superimposition information presentation apparatus according to Claim 1, further comprising a local information storage unit configured to store local information related to a user of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the local information.
3. The superimposition information presentation apparatus according to Claim 2, further comprising a sensor unit configured to obtain sensor information related to position and time of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the sensor information.

Let's start group work about understanding claimed inventions!

- Discuss the invention:
  For example, the technical field, background art, problem the invention is to solve, means to solve the problems, etc.
- Next, color-highlight and segment each claim in a different color.
- Then, for descriptions and drawings that correspond to each item specified in the claims, color-highlight each description and drawing the same color to show that it corresponds to its counterpart item in the claims.
- Fill out Section 2 of the Work Sheet 1

3. How to understand claimed inventions: Discussion

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

Part II

Contents

1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   - Brief explanation
   - Group work
   - Discussion
4. **How to evaluate XY citations in ISRs**
   - Brief explanation
   - Group work
   - Discussion
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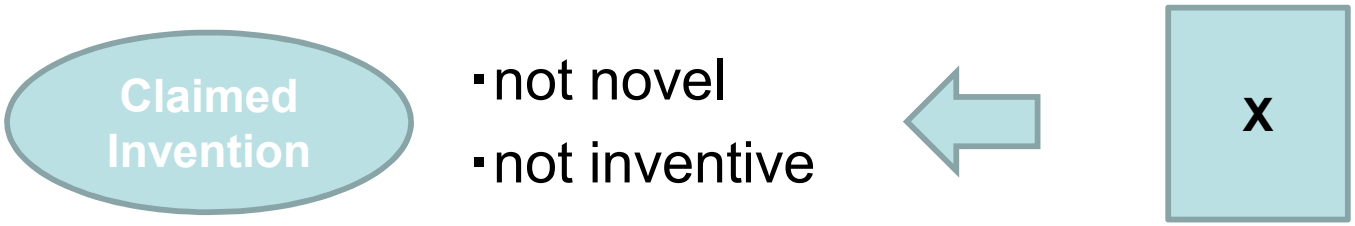
4. How to evaluate XY citations in ISRs : Brief Explanation

X document

Document of particular relevance:

The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone



Y document

Document of particular relevance:

The claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

Question 3

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

4. How to evaluate XY citations in ISRs : Brief Explanation

Question 3

- 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 4

- How do examiners evaluate all X/Y citations?

  (If necessary, please refer to Slide 8 of Topic 2.)

4. How to evaluate XY citations in ISRs : Brief Explanation

Question 4

- How do examiners evaluate all X/Y citations?
  (If necessary, please refer to Slide 8 in Topic 2.)

Answers

- Reading WO/ISA and understanding the reference points in all X/Y citations
- 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 understanding what is written in the WO/ISA!

- Fill out Section 1 of Work Sheet 2
- While referring to WO/ISA Box No. V, find technical features that are identical or similar with those specified in the claimed invention in X/Y citations, and complete Section 2 of Work Sheet 2.

4. How to evaluate XY citations in ISRs : Brief Explanation

- Let's check the answers.

  - WOISAs are useful for understanding what is disclosed in each citation.
  - Please note that all paragraphs that describe technical elements, which correspond to elements specified in the claims, are not always pointed out in the WOISA.

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

- Color-highlight identical or similar technical features the same color as the elements in the claimed invention
- Discuss whether each technical element in the claimed invention is disclosed in the citations
- Categorize the citations as X, Y, or A
- Fill out Section 3 of the Work Sheet 2

4. How to evaluate XY citations in ISRs : Discussion

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?

4. How to evaluate XY citations in ISRs : Disucussion

PCT/JP2012/123456 Claims 1-3	D1: US 2010/335934 A1	D2: JP 2009-198012 A
1. Selection superimposed information from plural items	X [0052] - [0058]	X [0021] - [0024]
2. Selection based on the local information (user information)	X [0052] - [0058]	
3. Selection based on the sensor information	Y [0043] – [0046]	Y [0025] - [0034]

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5. Summary

- It is very important to precisely understand the claimed invention. In order to do so:
  - Carefully read descriptions,
  - Color-highlight and Segment claims,
  - Color-highlight descriptions and drawings with the claims.
- It is also important to correctly evaluate all X/Y citations.

  In order to do so:
  - Carefully read each citation, focusing on the reference points suggested in ISRs;
  - Color-highlight identical or similar technical features the same color as the corresponding elements in the claimed invention.

Thank you!

(Reference) PCT/JP2012/123456: Overview of invention

Original Image

Image with superimposed info

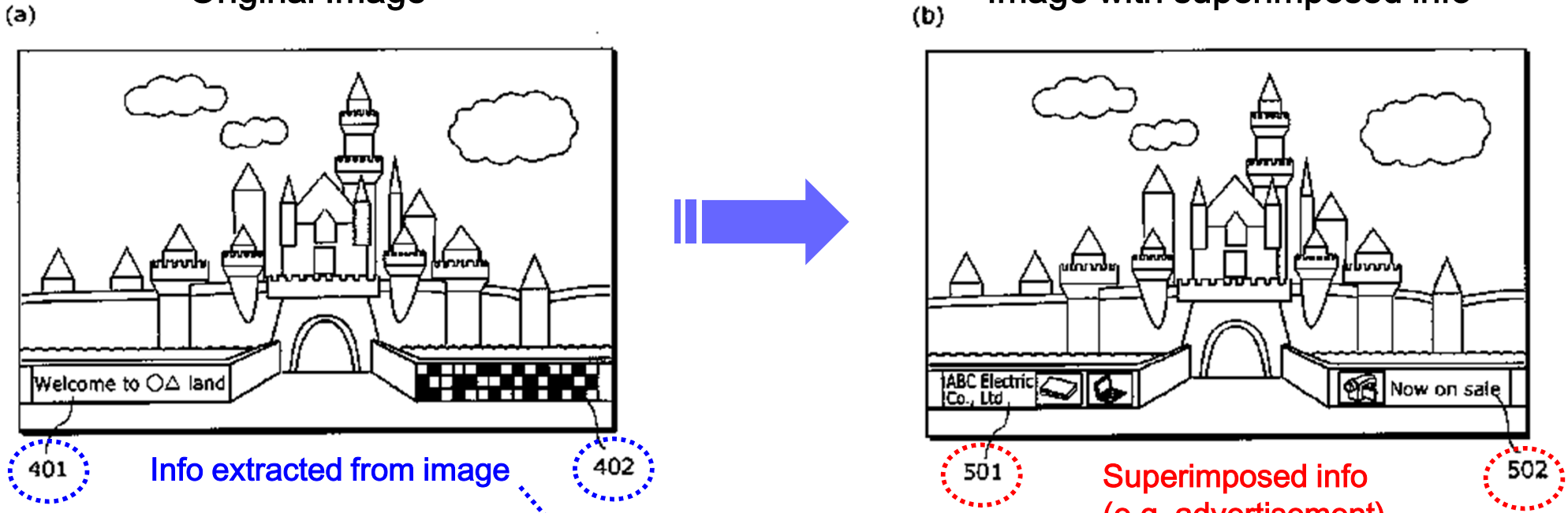
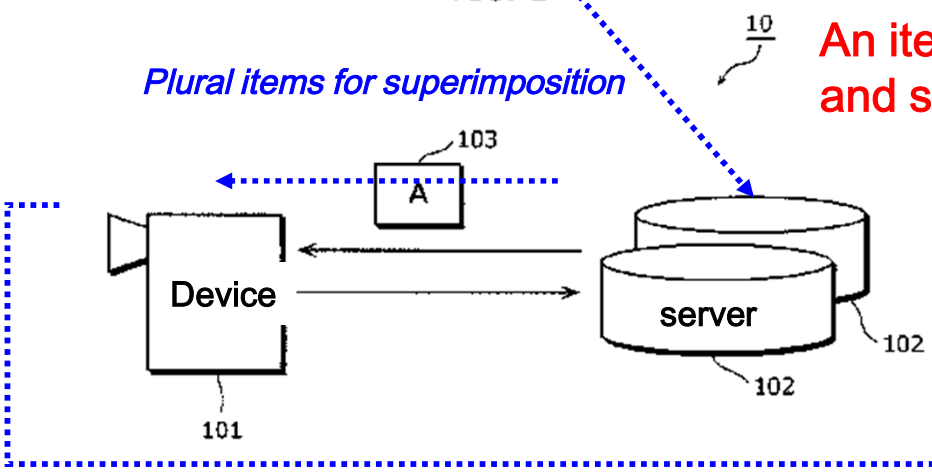


FIG. 1



An item is selected from among multiple items and superimposed onto the original image.

(Reference) PCT/JP2012/123456: Features of invention

Selection of an item for superimposition

Superimposition data management information

Superimposition data ID	Genre	Manufacturer	Target gender	Target age	Weather	Season	Location	…
1	Character	A	Male	10	—	—	Tokyo	…
2	Life	B	Female	40	Fine	Spring	Kobe	…
3	Character	A	Female	10	—	—	Tokyo	…
6	Sightseeing	C	Female	20	Rain	Autumn	Osaka	…
7	Food	D	Male	30	Fine	Summer	Kyoto	…
⋮	⋮	⋮	⋮	⋮	⋮	⋮	⋮	

matching

Local information

1. User information

User identification	User registration information				Device Unique information		
	Gender	Age	Favorite genre	…	Manufacturer code	Key word	…
User 1	Male	28	Food/Sightseeing	…	D	—	…
User 2	Female	26	Character	…	D	—	…
⋮	⋮	⋮	⋮	⋮	⋮	⋮	⋮

2. Sensor information

- position
- time

Claims 1-3

1. Selection of an item for superimposition
2. Local information (user information)
3. Sensor information (position and time)

(Reference) PCT/JP2012/123456: Claims

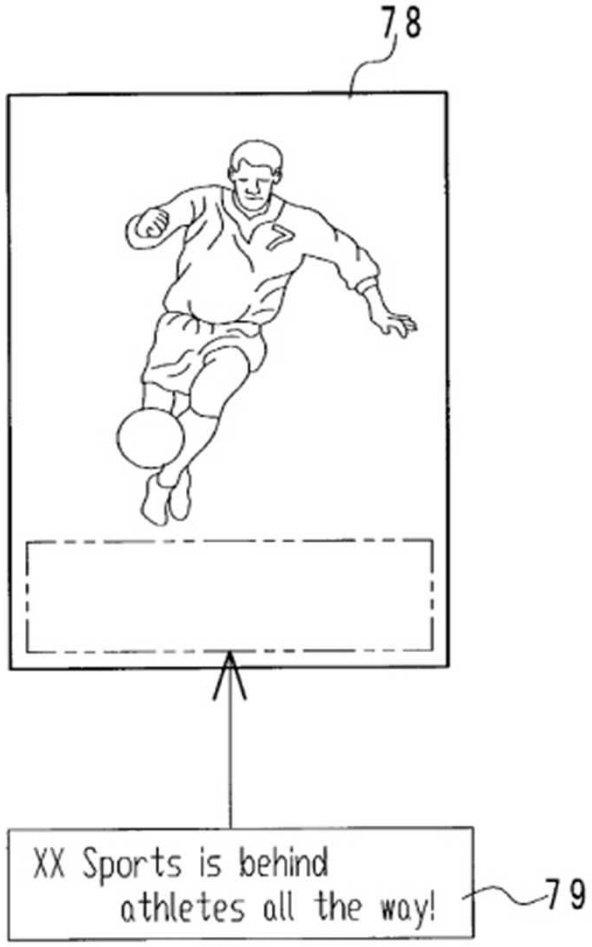
1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
an image obtaining unit configured to obtain an image;
a superimposed information storage unit configured to store plural items of superimposed data;
a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items;
a superimposing unit configured to superimpose the identified information on the obtained image and;
to present the image having the superimposed information.

2. The superimposition information presentation apparatus according to Claim 1,
further comprising a local information storage unit configured to store local information related to a user of said superimposition information presentation apparatus,
wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the local information.

3. The superimposition information presentation apparatus according to Claim 2,
further comprising a sensor unit configured to obtain sensor information related to position and time of said superimposition information presentation apparatus,
wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the sensor information.

(Reference) D1: US 2010/335934 A1 Overview of invention

Overlaying of an additional image



Information about additional images

41

	TYPE OF THE IMAGE	COLOR/TONE	MOTIF	SEASON	FITTING FRAME NUMBER	FITTING FRAME SHAPE	USAGE NUMBER
ADDITIONAL IMAGE A1	DECORATIVE IMAGE	WARM COLOR	FLOWER	SPRING	—		3
ADDITIONAL IMAGE A2	DECORATIVE IMAGE	WARM COLOR	ANIMAL	ALL	—		4
ADDITIONAL IMAGE A3	DECORATIVE IMAGE	WARM COLOR	LANDSCAPE (MOUTAIN)	AUTUMN	—		1
ADDITIONAL IMAGE A4	DECORATIVE IMAGE	WARM COLOR	LANDSCAPE (JUNGLE)	SUMMER	—		4
ADDITIONAL IMAGE B1	MARK IMAGE	BROWN	CONSTELLATION (CAPRICORN)	WINTER	—		4
ADDITIONAL IMAGE B2	MARK IMAGE	WHITE	CONSTELLATION (AQUARIUS)	WINTER	—		3
ADDITIONAL IMAGE C1	TEMPLATE IMAGE	WARM COLOR	EGG	ALL	1	ROUND	2
ADDITIONAL IMAGE C2	TEMPLATE IMAGE	PLANE WHITE	—	ALL	4	SQUARE	1

1. User profile information

42

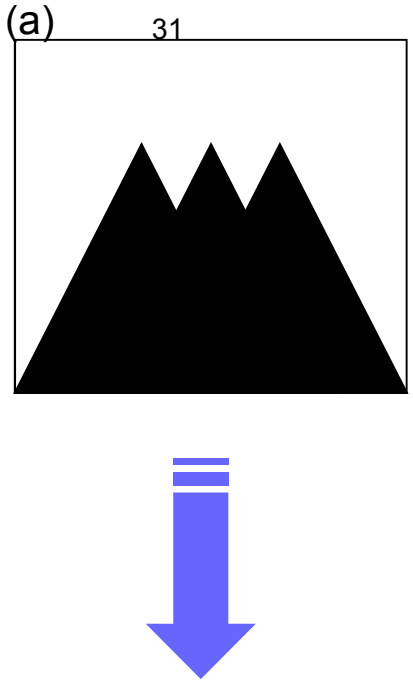
CUSTOMER No.	NAME	SEXUALITY	BIRTHDAY	HOBBY	FAVORITE SPORTS	FAVORITE COLOR	FAVORITE TONE	FAVORITE TASTE
1	JOHN WILLIAMS	MALE	JUL.27/1950	MOUNTAIN CLIMBING	SOCCER	BLUE	COOL COLOR	CONSERVATIVE
2	DAVID JOHNSON	MALE	JUL.01/1955	WATCHING MOVIE	BASEBALL	YELLOW	WARM COLOR	CONSERVATIVE
3	MICHEL SMITH	MALE	JAN.01/1960	FISHING	SWIMMING	GREEN	WARM COLOR	VIVID
4	LISA JONES	FEMALE	APR.20/1965	FLOWER ARRANGEMENT	MARATHON	RED	WARM COLOR	VIVID
5	A SOCCER CLUB	—	—	—	—	—	—	—

2. Feature information (analyzing images)

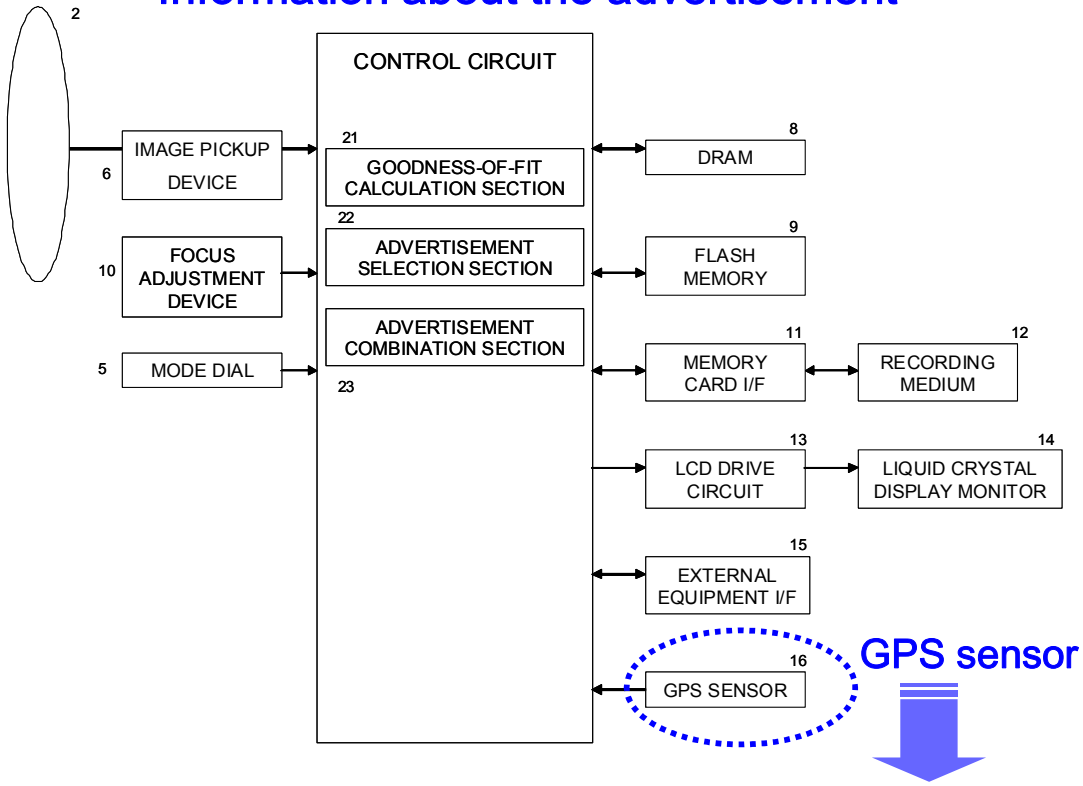
- tone
- main subject
- color

(Reference) D2: JP 2009-198012 A Overview of invention

Overlaying of an advertisement



Information about the advertisement



	MODEL RANK	DATE AND TIME OF SHOOTING	SHOOTING MODE	SHOOTING LOCATION
ADVERTISEMENT A	0	70	20	10
ADVERTISEMENT B	80	0	20	0
ADVERTISEMENT C	0	80	20	0
ADVERTISEMENT D	40	10	0	50
ADVERTISEMENT E	10	10	40	40
ADVERTISEMENT F	10	10	50	30