

REJECTION: REASONS FOR REJECTIONS AND PROPER DRAFTING OF REJECTION RULINGS

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Contents



1. Flow of examination
 2. Point of Notice of Reasons for refusal
 3. Specific examples of Reasoning concerning inventive step
-

Contents



1. Flow of examination

2. Point of Notice of Reasons for refusal

3. Specific examples of Reasoning concerning inventive step

PRINCIPAL OF EXAMINATION



□ Judgment as Experts

(1) High-quality examination

① Prior Art Search

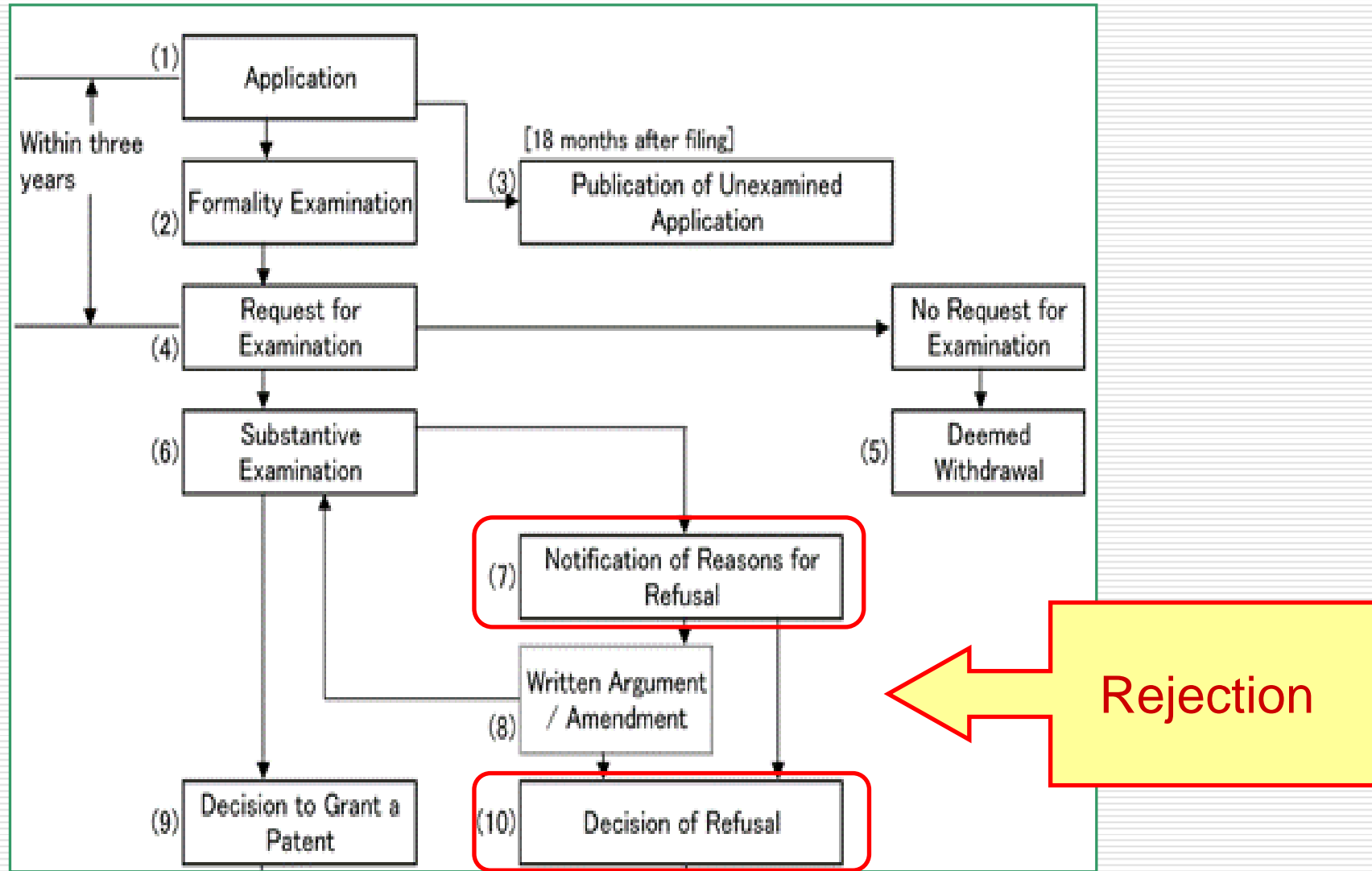
② Judgment on the Requirements for patentability

- Technical Expertise
- Uniformity in line with laws and regulations, and guidelines
- Accuracy
- Fairness
- Transparency

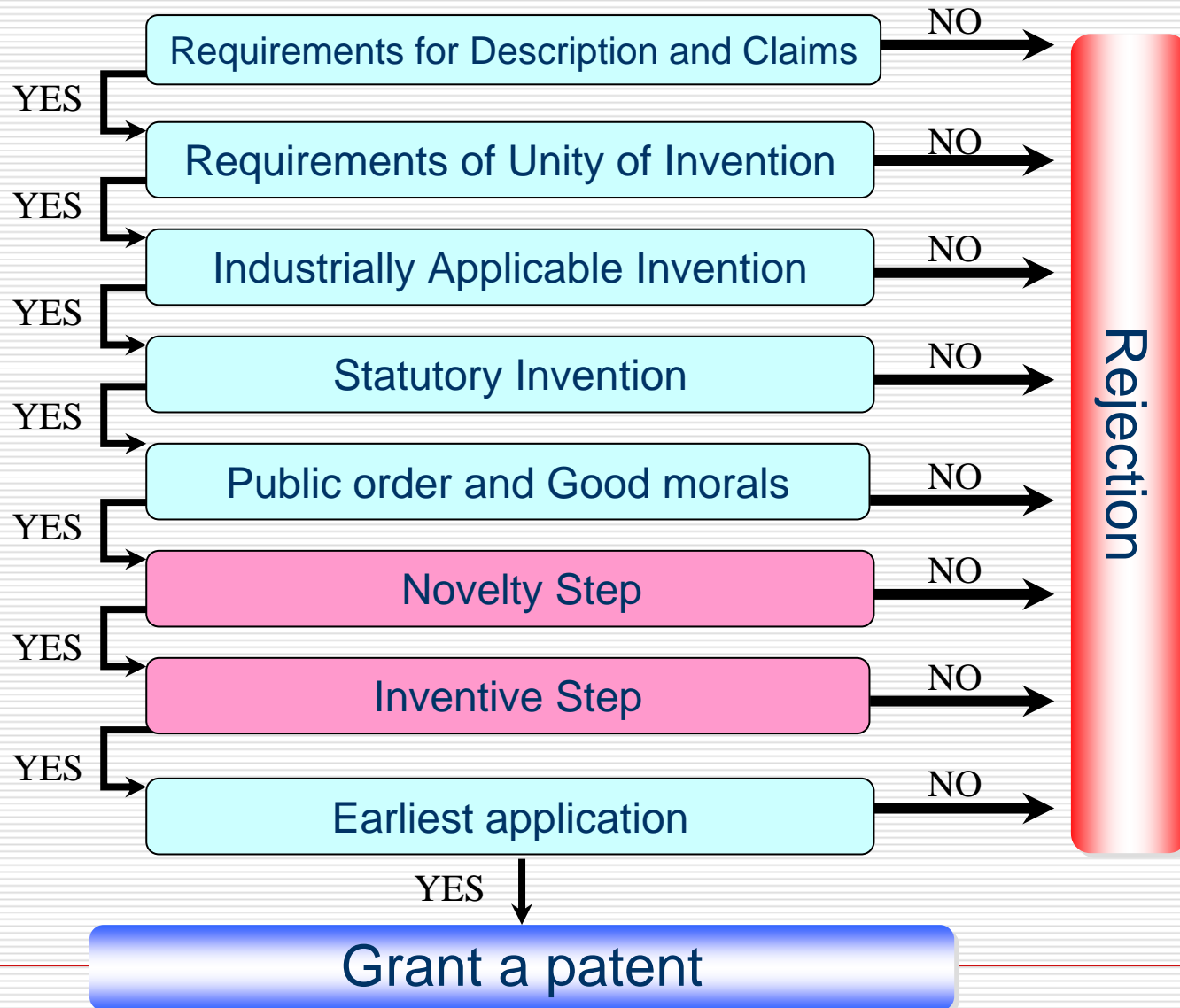
(2) Prompt Examination

(3) Efficient Examination in sufficiently communicating with applicants

Procedure for obtaining a Patent

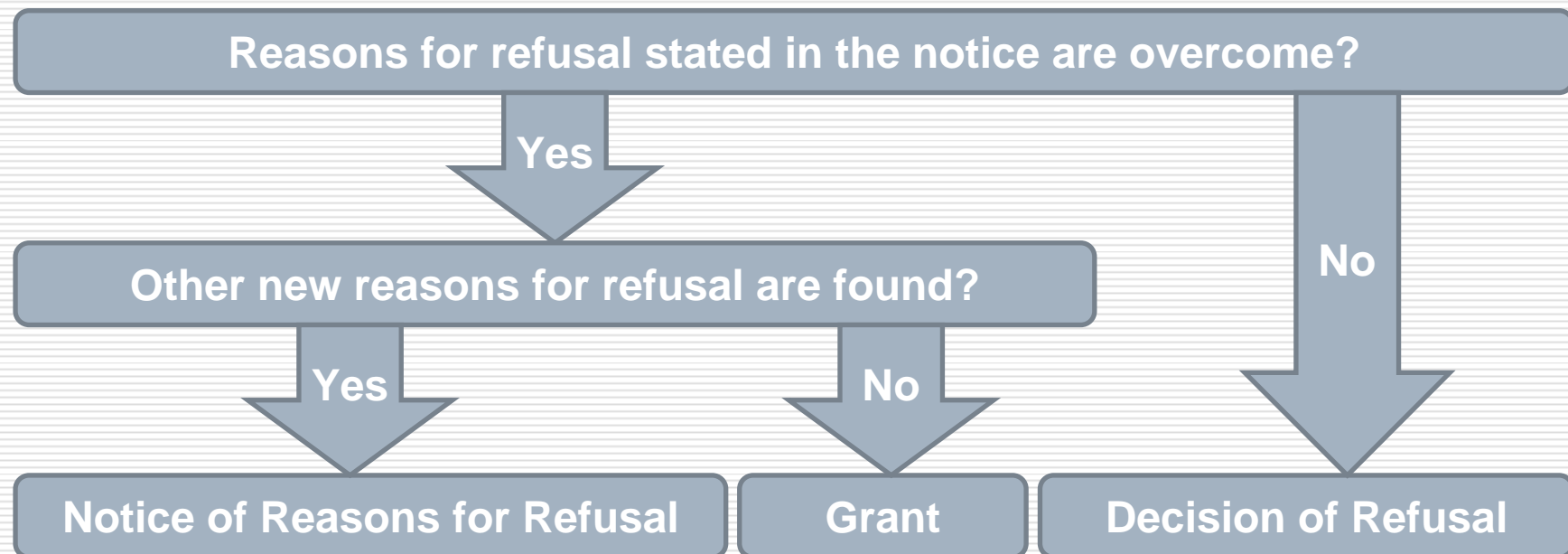


Grant a patent / Rejection



WHEN A WRITTEN OPINION OR A WRITTEN AMENDMENT ARE SUBMITTED

- Legality of the written amendment
 - ✓ New matters
 - ✓ Change a special technical features



FINAL DECISION

- No reasons for refusal
 - Decision to grant a patent

 - Notified reasons for refusal were deemed not to be resolved
 - Decision of refusal
 - All unresolved reasons for refusal
 - All claims for which the notified reasons for refusal were still unresolved.
 - For the issuable items in the written opinion, determination of the examiner on them should be clarified
 - Do not refer to any new prior art except for the well-known art or the commonly used art.
-

Contents



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POINT OF NOTICE OF REASON FOR REFUSAL



- Notify an applicant of a notice of reasons for refusal when reasons for refusal are found

 - Reasons for refusal should be stated
 - Clearly
 - Simply but Concretely
 - Claim/Reason basis
- so as to make applicants understand easily

Example of Notification of Reasons for Refusal (1)



Notification of Reasons for Refusal

Bibliographic data

Application number: The application for patent 2008-203715
Date of Drafting: Heisei 20(2008) December 19
Patent examiner: UEJIMA, Hiroki 3364 5M00
Representative/Applicant: INOUE, Manabu
Applied Provisions: Patent Law Section 29(2)

3364:Examiner Code
5M:Division Code

Conclusion / Time Limit of Response

This application should refuse for the following Reason. If there is an opinion about this, please submit Written Argument within **60 days** after a day of dispatch of this notice.

Time Limit of Response

Reason

The claimed invention(s) in the each claim listed below of this patent application should not be granted a patent under the provision of Patent Law **Section 29 (2)** for the reason that the claimed invention(s) could have easily been made by persons who have common knowledge in the technical field to which the claimed invention(s) pertains, on the basis of the invention(s) described in the distributed publication(s) listed below in Japan or other foreign countries prior to the filing of the patent application.

Article 29(2)
Non-Inventive Step

Example of Notification of Reasons for Refusal (2)

Account

Account

(Please refer to "The list of cited documents etc." for cited documents etc.)

- Claim: 4
- Cited documents 1 and 2
- Remarks:

Cited Parts

[Cited documents 1 (refer to [0040]-[0048] and [0051])] Picture image data is inputted from a video camera, characteristic quantity of each frame of inputted picture image data is computed, characteristic quantity of each frame and characteristic quantity of a previous frame are measured, and storing a video section of a frame group which fulfills predetermined conditions as a dynamic image file is indicated.

Contents of Document 1

[Cited documents 2 (refer to [0013]-[0015])] A picture picturized with a television camera etc. is inputted, an inputted picture is memorized, characteristic quantity is extracted from an object in a picture, extracted characteristic quantity is memorized and matching an object of a previous frame and a present frame with characteristic quantity of an object of each frame is indicated.

Contents of Document 2

Allowable claims

<Claim(s) which has been found no reason for refusal>
At present for an invention concerning Claims 1-3, no reason for refusal is found. Any subsequently identified reasons for rejection will be notified accordingly.

Example of Notification of Reasons for Refusal (3)



List of Cited Documents

The list of cited documents etc.

1. JP,H6-266774,A
2. JP,H8-315150,A

Documents of category "X" or "Y"

Record of the Result of Prior Art Search

A Record of the result of prior art search

- Technical fields to be searched
IPC G06F17/30H04N 5/765/80-5/9079/04-9/11
DB name JSTPlus (JDream2)
- Prior art documents
JP,H9-44639,A
- JP,H7-46517,A

Documents of category "A"

REMARKS FOR NOTICE OF REASONS FOR REFUSAL (1)



- (1) Clearly distinct between claims which have reasons for refusal and the claims which do not have reasons for refusal
- (2) Indicate claim by claim basis
 - Note: An explanation can be referred to more than two claims in the case they are common
- (3) In the case no examination has been conducted to particular claims or whole claims (ex. violation of the requirement of unity, amendment), indicate only the relevant reason and clearly state that no examination has been conducted other than those

REMARKS FOR NOTICE OF REASONS FOR REFUSAL (2)



- (4) No examination may be conducted in the following case (in JPO)
 - ① Invention to which new matters have been clearly added
 - ② Invention directed to a category of unpatentable invention
 - ③ Invention clearly contrary to law of nature or not industrially applicable
 - ④ In case where the description of claims are so ambiguous that the invention cannot be conceived
 - ⑤ Invention, the detailed description of which is too unclear or insufficient for a person skilled in the art to carry out the claimed invention
 - ⑥ In case where the claimed invention is beyond the scope of description in the detailed description of the invention within which a person skilled in the art can recognize that the problem of the invention can be solved, the parts that “beyond the scope of description”

REMARKS FOR NOTICE OF REASONS FOR REFUSAL (3)



- (5) In the case descriptive requirements are not satisfied, indicate the deficient parts and the reasons for deficiency concretely
 - (6) For citation of prior art documents, the following matters should be noted;
 - ① Cited documents and the cited parts required for comparison with the claimed invention and judgment should be specified
 - ② The technical contents found in the cited documents etc. should be clarified
 - ③ Necessary and sufficient documents for constituting the reasons for refusal should be cited and too many documents should not be cited unnecessarily
-

REMARKS FOR NOTICE OF REASONS FOR REFUSAL (4)



- (7) In principle, all of the reasons for refusal which have been found should be notified

- (8) Notify the reasons for refusal for which amendments are required
(Do not stick to trivial matters)

Contents



1. Flow of examination
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-

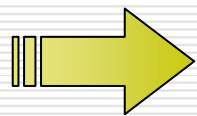
Specific Examples of Reasoning

□ The reasoning can be made from various and extensive aspects.

(1) Section of an optimal material, workshop modification of design, mere juxtaposition of features

① Selection of an optimal material, workshop modification of design, etc.

- selection of an optimal material from publicly known materials which achieve a specific object
- optimization of a numerical value range
- a replacement with equivalents
- a workshop modification of design in applying specific technology



it is usually considered that a person skilled in the art could have easily arrived at it

Specific Examples of Reasoning



- ① Selection of an optimal material, workshop modification of design, etc.

Example

Sending or receiving with infrared waves of approximately 0.8-1.0 μ m of infrared energy wavelength range is recognized as well-known art. Then, since there is no special circumstances which prevent to apply the technology to an apparatus for communicating their position of emergency vehicles, it is acknowledged that a person skilled in the art could have been easily arrived at the claimed invention by applying the technology for the communication of their positions of the cited invention 1.

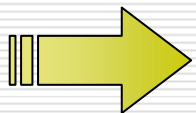
(Reference: Hei 9 (Gyo Ke) 86, Example easy to apply unless there is no obstructive factors)

Specific Examples of Reasoning

(1) Section of an optimal material, workshop modification of design, mere juxtaposition of features

② Mere juxtaposition of features

- matters defining an invention are not linked each other functionally or operationally
- the invention is a combination of each matter (mere juxtaposition of features)



the invention is deemed as a mere exercise of ordinary creativity of a person skilled in the art

② Mere juxtaposition of features

Example

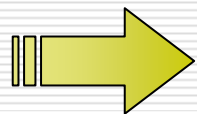
The remarkable working-effect which the plaintiffs assert is not deemed to be anything but a mere combination of expected effects of each publicly known art. Thus, the effect is not deemed to be a specific remarkable working-effect of the claimed invention.

(Reference: Sho 44 (Gyo Ke) 7)

(2) Probable cause or motivation

① Close relation of technical fields

- An attempt to apply a technical means in a related technical field in order to solve a problem



a mere exercise of ordinary creativity of a person skilled in the art

Specific Examples of Reasoning



① Close relation of technical fields

Example

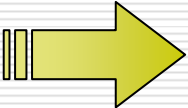
A camera and an automatic strobe light are always used together and are closely related. Therefore, applying the incidence control element of a photometric circuit for the camera to a photometric circuit for the automatic strobe light would have been easily made by a person skilled in the art, unless an outstanding structure is utilized in terms of the application.

(Reference: Sho 55 (Gyo Ke) 177)

(2) Probable cause or motivation

② Close similarity of a problem to be solved

- A close similarity of a problem to be solved

 can be a strong ground for the reasoning that a person skilled in the art would be led to a claimed invention by applying or combining cited inventions

Specific Examples of Reasoning



② Close similarity of a problem to be solved

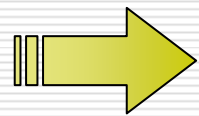
Example

The two inventions of cited documents 1 and 2 have the common problem to be solved in that a carrying sheet weakly attached with labels stops at a prescribed position. A person skilled in the art could have easily conceived the idea of applying the label feeding control means disclosed in the cited document 2 to the cited invention 1 for solving the technical problem.

(Reference: Hei 2 (Gyo Ke) 182)

② Close similarity of a problem to be solved

- When a cited invention does not intend a similar problem to be solved to that of a claimed invention



further examination based on the state of the art should be conducted whether a problem to be solved is evident or whether it would have been easily conceived

Specific Examples of Reasoning



② Close similarity of a problem to be solved

Example

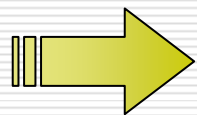
A cited invention 4 clearly indicates that "light-weighted" is one of the important properties required for a golf club shaft, and suggests the needs or the advantages of lightening a golf club shaft in relation to drive of golf balls. Thus, it is acknowledged that a problem of the claimed device to lighten a golf club shaft is the matter which a person skilled in the art can predict as a matter of course.

(Reference Hei 7 (Gyo Ke) 152)

Specific Examples of Reasoning

② Close similarity of a problem to be solved

- the reasoning can properly be made that a person skilled in the art could have easily arrived at the matters defining the claimed invention in a different way of thinking from the problem-solution of the claimed invention.



the inventive step of the claimed invention can be denied regardless of the difference in problems

Specific Examples of Reasoning



② Close similarity of a problem to be solved

Example

The claimed invention is a carbon disk brake with grooves to drain water on its face. The cited document 1 discloses a carbon disk brake. The cited document 2 discloses a metal disk brake with grooves to remove dust on its face.

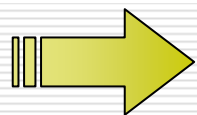
In this case, it is clear that dust on the face prevents the brake even for the carbon disk brake disclosed in the cited document 1 in the light of the general function of the brake. To provide a carbon disk brake with grooves to solve the problem suggested in the cited document 2 is a technical improvement which a person skilled in the art could have easily arrived at. Consequently, the same structure as the claimed invention is obtained, so that the claimed invention involves no inventive step.

Specific Examples of Reasoning

(2) Probable cause or motivation

③ Close similarity of function, work or operation

- a close similarity in function, work or operation exists between a claimed invention and a cited invention or between cited inventions



there can be a well-founded reasoning that a person skilled in the art would have been led to the claimed invention by applying and combining the cited inventions

Specific Examples of Reasoning



③ Close similarity of function, work or operation

Example

Both the cited invention 1 and the cited invention 2 are common in respect of washing cylinders of the printing machine by pressing a cloth on it. There is no difference between the cam structure of the cited invention 1 and the expansion structure of the cited invention 2, in respect of that the cloth is placed for attaching to or detaching from the cylinder. Then, it could be said that there is a background of conversion of the expansion structure of the cited invention 2 in place of the cam structure of the cited invention 1 as a pressure means.

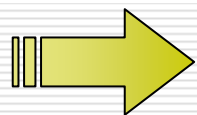
(Reference Hei 8 (Gyo Ke) 262)

Specific Examples of Reasoning

(2) Probable cause or motivation

④ Suggestions shown in the contents of cited inventions

- Suggestions shown in the contents of cited inventions relevant to a claimed invention



can be a strong ground for the reasoning that a person skilled in the art would have been led to the claimed invention

Specific Examples of Reasoning



④ Suggestions shown in the contents of cited inventions

Example

The 3-chlorocompound of the claimed invention merely differs in the substitution position in the chemical formula from the 2-chlorocompound and 4-chlorocompound in the cited document. And there is no notation in the cited document that the chemical compound should restrict the substitution position to the specific positions in order to be used as a color brightener, the 3-chlorocompound can be considered as being suggested in the cited document in the light of the above. Thus, the brightener can be easily predicted by a person skilled in the art.

(Reference: Sho 51 (Gyo Ke) 19)

Thank you!