

***Introduction of
“Handbook for PCT International Search
and Preliminary Examination
in the Japan Patent Office”***

January 2016

JAPAN PATENT OFFICE

- The JPO released a handbook titled “***Handbook for PCT International Search and Examination in the Japan Patent Office***” in both Japanese and English in October 2015. It is a comprehensive guideline showing details and illustrations on the practices and procedures for international applications under the PCT.
 - The overall outline of the PCT system and the practices and procedures followed by examiners with respect to international searches and preliminary examinations are explained in an easily understandable way through the use of flow charts, etc.
 - The information written by examiners in the boxes on the PCT forms and sent to an applicants is explained.

- ◆ The Handbook is available on the JPO's website:
http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pct_handbook_e.htm
(The English version is provided for reference only.)

- Chapter 1: Outline of the PCT System
- Chapter 2: International Search Work
- Chapter 3: International Preliminary Examination Work
- Chapter 4: Criteria for Substantive Requirements in the International Phase
- Chapter 5: Other Work in the International Work

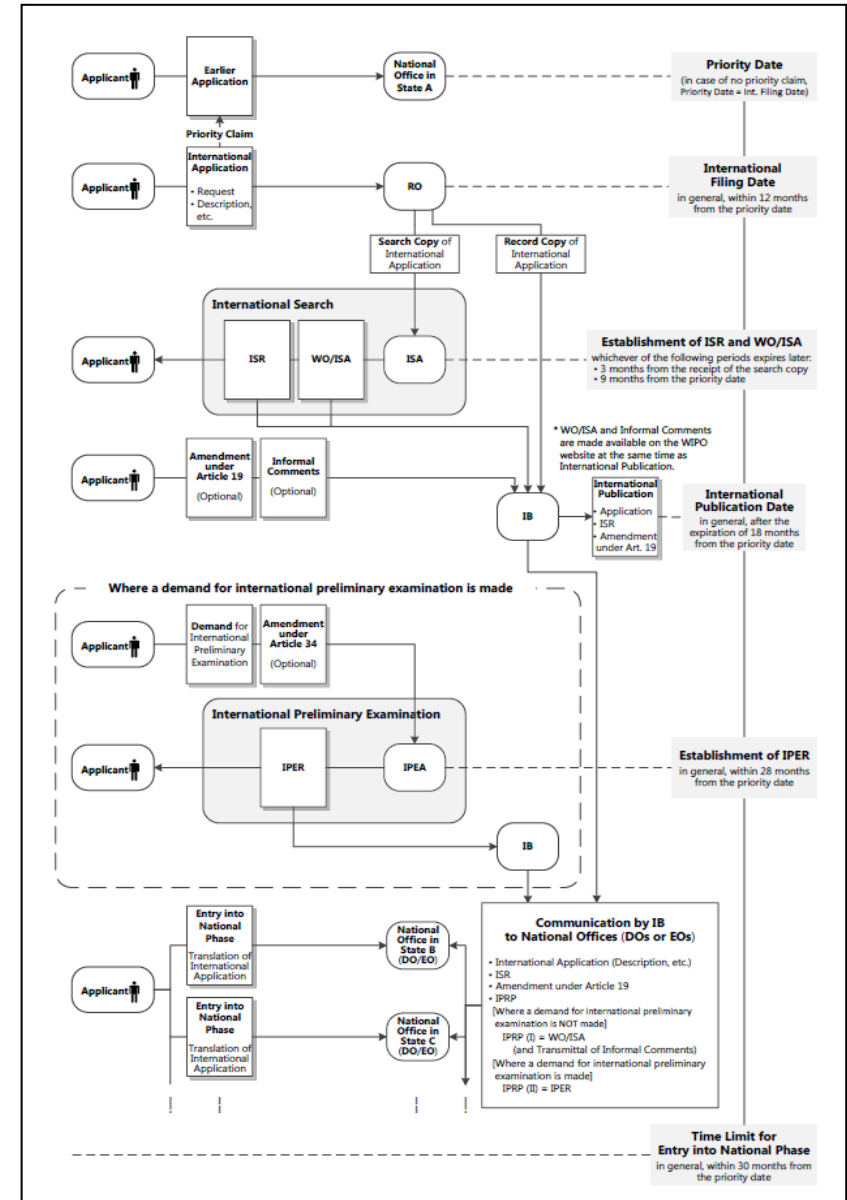
- Appendix A: Categories of Cited Documents
- Appendix B: Manner for Identification of Cited Documents
- Appendix C: Decision of the Basis of the International Preliminary Examination
in the Cases Where Amendments Have Been Made
- Appendix D: Case Examples of Annexes Attached to the IPER

■ Briefly introduces the PCT system

➤ Basics of the PCT system:

- History;
- Characteristics;
- Competence of ROs, ISAs, and IPEAs;
- Relevant treaties and national laws.

➤ Outline of procedural flows



■ Explains common works conducted by examiners during the international search stage.

- Examiners' workflow during the international search stage
- Instructions for preparing ISRs, WO/ISAs, etc.

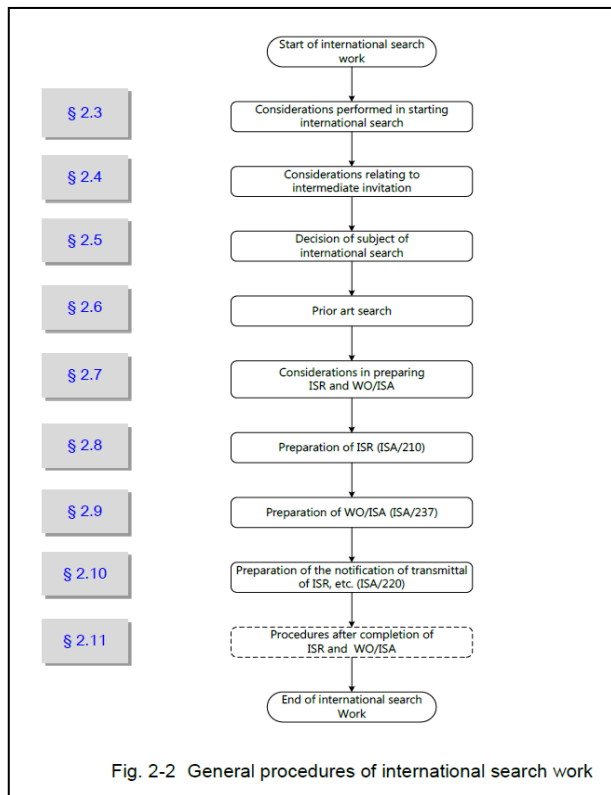


Fig. 2-2 General procedures of international search work

The image shows a sample International Search Report (ISR) form with several annotations explaining the checkboxes and boxes. The form is titled 'INTERNATIONAL SEARCH REPORT' and includes fields for 'International application No.' (PCT/JP2015/999999) and 'International classification' (IPC Class. (Int. Cl.)).

Annotations:

- Box No. II:** Check the appropriate box, if specified claims are excluded (→ § 2.7.1 (1)). In addition, state the following (i) and (ii).
 - (i) No. of the excluded claim (*2)
 - (ii) Specific reason(s) for exclusion
- Box No. III:** State the following (i) to (iii). Use the extra sheet, if more space is necessary.
 - (i) Number of inventions covered by the claims
 - (ii) Nos. of claims divided into individual inventions
 - (iii) Reason(s) why it is decided that the requirement of unity of invention is not met.
- Box No. I:** Check the appropriate box among box 1., 3. and 4., if payment of additional fees was invited under ISA/206 at the time of interim instruction. In the case of 3. or 4., state number of the claim subject to international search (→ § 2.5) (*3)
- Box No. IV:** Check the appropriate box, depending on whether there is a protest against additional fees (→ § 5.2.3), if box 1. of Box No. III is checked. Do not check 2nd box, because JPO requires no protest fee.

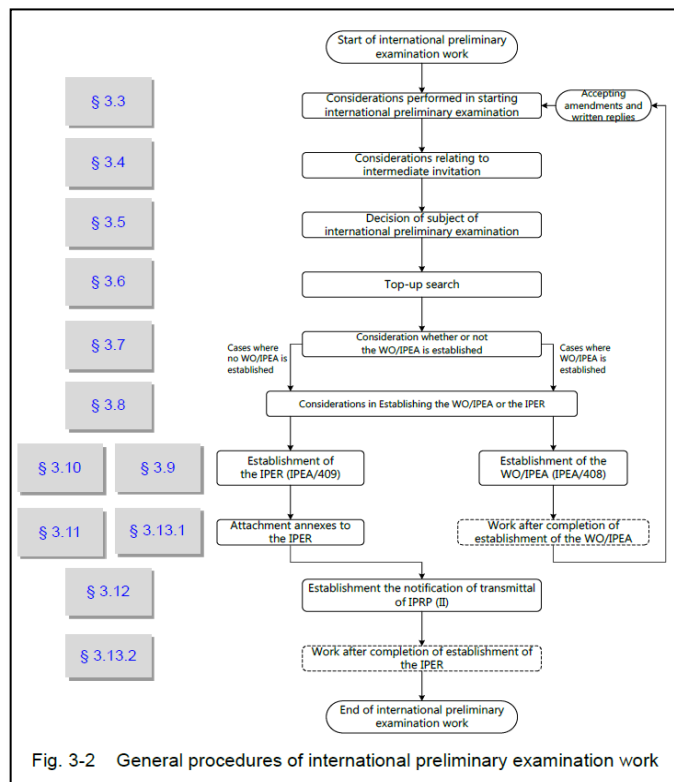
Additional notes:

- Do not check this check box. The JPO does not exclude claims from international search by the reason of item 3.
- Check box 2 if it is decided at the time of establishing ISR that the requirement of unity of invention is not met while no payment of additional fees was invited under ISA/206 at the time of intermediate invitation.

Footnote:

*1 This sheet is not used if the international application is found to meet the requirement of unity of invention by the decision on a protest against additional fees under ISA/212 after the examiner otherwise decided at the time of intermediate invitation.
 *2 If specified choices of any claim are excluded (→ § 4.1 Attention), state, for example, "Claims Nos. Part of X" and specify which choices are excluded.
 *3 If a decision different from one made at the time of intermediate invitation is stated concerning unity of invention, explain which claim is subject to the search in order for the applicant to be able to understand, considering that the subject of international search is specified depending on "Determination of the Subject of Search in the International Search" (→ § 2.5).

- Explains common works conducted by examiners during the international preliminary examination stage.
 - Examiners' workflow during the international preliminary examination stage
 - Instructions for preparing WO/IPEAs, IPERs, etc.



This sheet is employed where particular claims are excluded from the international preliminary examination (→ § 3.3.5) (where "the Box No. III" is selected in the item 1. of cover sheet). Otherwise, this sheet is not included in the IPER.

Difference from the instructions for preparation of the WO/ISA or the WO/IPEA

- The particular claims may be excluded on the grounds for corresponding to "the invention for which no ISR has been established" (→ § 4.1.4) in the IPER unlike the WO/ISA.
- In this respect, there is no difference between the WO/IPEA and the IPER.

Normally, check the lower box (*1) Indicate the claim numbers excluded if the lower check box is checked (→ § 3.8.11). (*2)

Check the appropriate box. The following (i) and (ii) shall be described.

(i) Claim numbers considered to be the excluded subjects (*2)
 (ii) Grounds for being excluded

Check the second box in the dotted frame if the box "no available sequence listing" is selected. (*3)

Check this box, if the supplemental box is employed. Employment of the supplemental box shall be indicated clearly by describing "See the supplemental box," "Continue to the supplemental box," and so on in the field to be supplemented.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY International application No. PCT/JP2013/000000

Box No. III The establishment of options with regard to priority, intermediate step and national applicability

The question whether the claimed invention appears to be novel, to involve an inventive step (to be so viewed), or to be industrially applicable have not been examined in respect of:

the entire international application.

or

claim No. 0-0

Indicate the following subject matter which does not require international preliminary examination (p.10):

the description, claims or drawings (indicate particular elements below) or said claim No. 0-0 as to whether that or meaningful options could be formed (p.10)(3)

the claim, or said claim No. as so inadequately supported by the description that no meaningful options could be formed (p.10)(3)

no international search report has been notified for said claim

meaningful options could not be formed without the sequence listing, the optional data set, within the prescribed time limit.

Describe a sequence listing on paper complying with the model provided for in Annex C of the Administrative Instructions, and such listing was not available to the International Preliminary Examining Authority as a form and manner acceptable to it.

Describe a sequence listing in electronic form complying with the model provided for in Annex C of the Administrative Instructions, and such listing was not available to the International Preliminary Examining Authority as a form and manner acceptable to it.

By the required time deadline for the furnishing of a sequence listing in response to an invitation under Article 17b(1)(a) or (b) and 17b(2).

See the supplemental box for further details.

From PCT/IPEA-409 (Box No. III) (July 2010)

*1 The upper check box shall be selected only where the all claims are excluded (→ § 3.3.5).
 *2 If particular choices of any claim are excluded (→ § 4.1 Attention), state, for example, "Claims Nos. Part of X" and specify which choices are excluded.
 *3 The most upper check box shall not be selected in the dotted frame since the sequence listing in writing or image file is not requested to be present. The lowest check box shall not be selected in the dotted frame, since the late furnishing fee is not requested to be paid.

- Explains judgement criteria for following substantive requirements:
 - Exclusion from search/examination, unity of invention, prior art, novelty, inventive step, industrial applicability, requirements for description and claims (clarity, etc.), amendment, and priority

- Structure of explanation
 1. **Summary of the provisions** in the Treaty, the Regulations, etc. for each substantive requirement
 2. **How to make a determination** with regard to each requirement
 3. **Differences of the practices between the international and national phases**, with a reference to the *Examination Guidelines* which are applied to national applications.

- Explains practices and procedures for atypical works
 - Instructions for preparation of:
 - Invitations to pay additional fees (ISA/206, IPEA/405);
 - Declarations of non-establishment of ISR (ISA/203), etc.

 - Explanation of procedures related to:
 - Corrections and incorporation by reference;
 - Declarations as to exceptions to lack of novelty (Non-prejudice disclosure);
 - Third party observations, etc.

■ Appendix A: Categories of Cited Documents

- Explains definitions of category codes, such as X, Y, A, etc.

■ Appendix B: Manner for Identification of Cited Documents

- Explains how examiners should identify documents cited in the ISRs, etc.

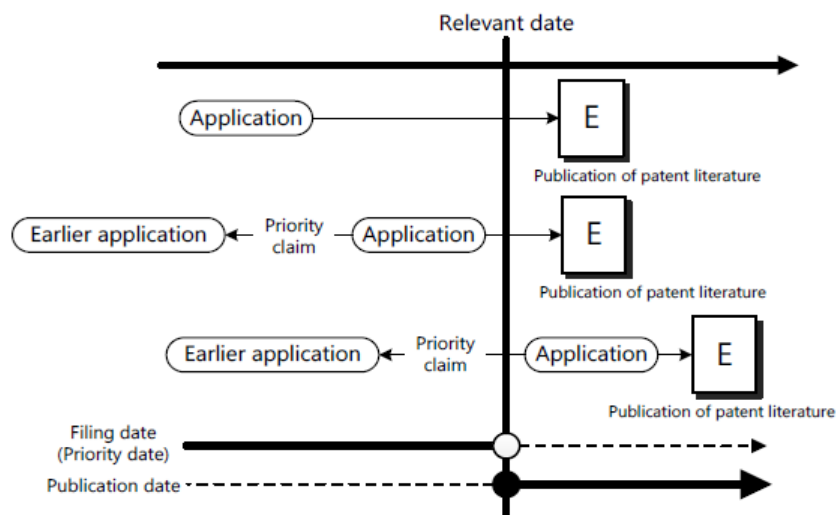
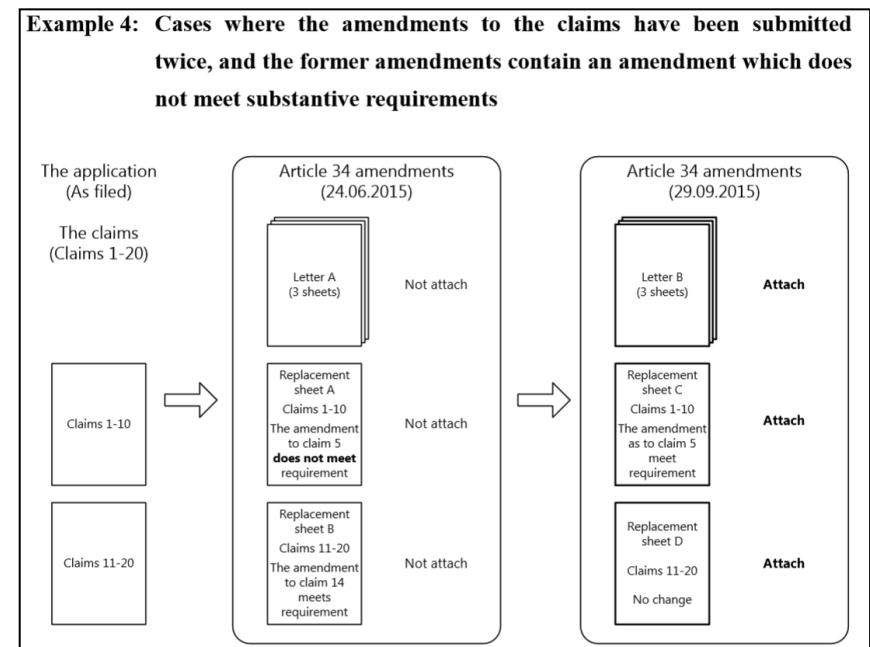
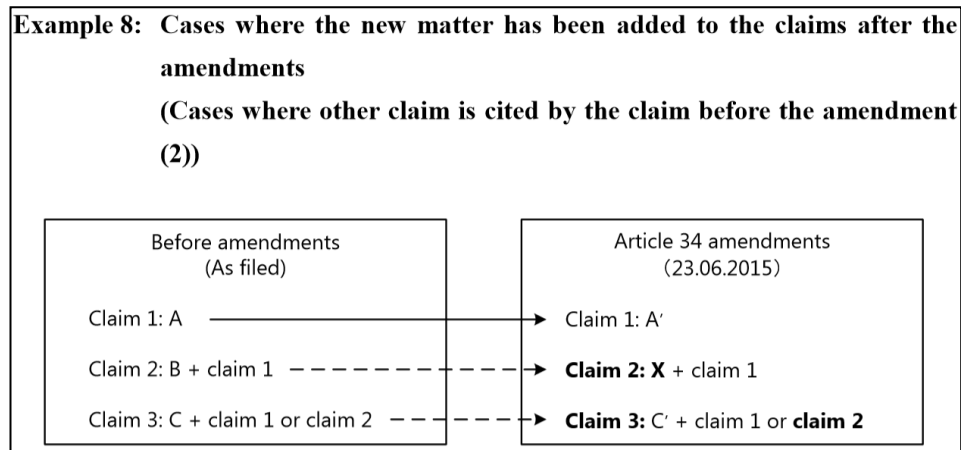


Fig. A-2 Document given category "E"

US 2008/0123456 A1 (XX CO., LTD.)
 (a) (b) (c) (d)
2008.03.27, paragraphs [0030] to [0037], Fig. 3
 (e) (f)
& JP 2008-110011 A & EP 1234567 A1
 (g)

- (a) Industrial property office
- (b) Number of document
- (c) Kind of document
- (d) Name of the applicant or patentee
- (e) Date of publication
- (f) Location of especially relevant passages
- (g) Patent family

- Appendix C: Decision of the Basis of the International Preliminary Examination in the Cases Where Amendments Have Been Made
 - Explains how to decide the basis of the international preliminary examinations in each case where the claims, description, and drawings have been amended
- Appendix D: Case Examples of Annexes Attached to the IPER
 - Explains which amendment to be annexed with IPER showing case examples



Measure (a-2):

◆ Identification of Cited Patent Document and Relevant Parts

- When the cited patent document is in a language other than English and at least **one family member of the document is available in English**, the examiner mentions that family member and indicates **the part or passage of the family member** corresponding to the relevant part or passage of the cited document. (§B.1 (1) (g) of the Handbook)

Example: JP 4-234567 A (XXコーポレーション)

1992.07.29, 第3頁左上欄第3行—第4頁左下欄第10行, 第1図

& US 5555555 A, 第 10 欄第 5 行—第 11 欄第 19 行

& EP 0456789 A1

col. 10, l. 5 – col. 11, l. 19

(An example in the ISRs for applications filed in Japanese.)

Measure (b-4):

◆ Exclusion from the Subject of Search/Examination

- **Methods for treatment of the human** or animal body by surgery or therapy, as well as diagnostic methods **cannot be excluded** from the subject of searches and examinations. (§4.1.1 of the Handbook)

(Note: **methods for treatment of the human** by surgery or therapy, as well as diagnostic methods, **cannot be patented in the Japanese national phase**, while those of the animal body may be patented.)

■ Useful Links:

- Handbook for PCT International Search and Preliminary Examination in the JPO
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pct_handbook_e.htm
- Examination Guidelines for Patent and Utility Model in Japan
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/1312-002_e.htm
- Examination Handbook for Patent and Utility Model in Japan
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/handbook_sinsa_e.htm

Thank you!