

Examination Practice in the JP National Phase



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I. Examination Procedure



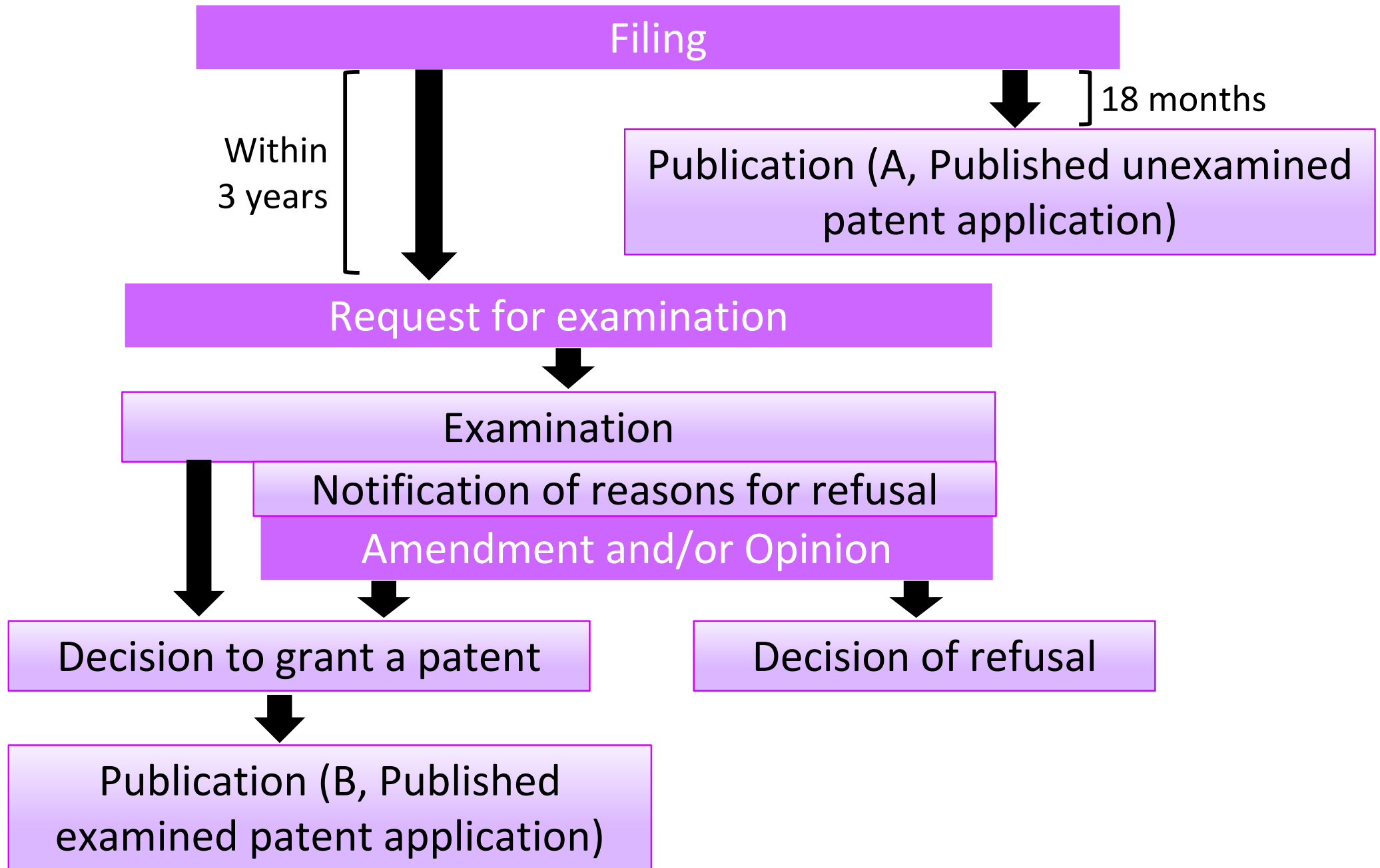
II. Novelty



III. Inventive Step

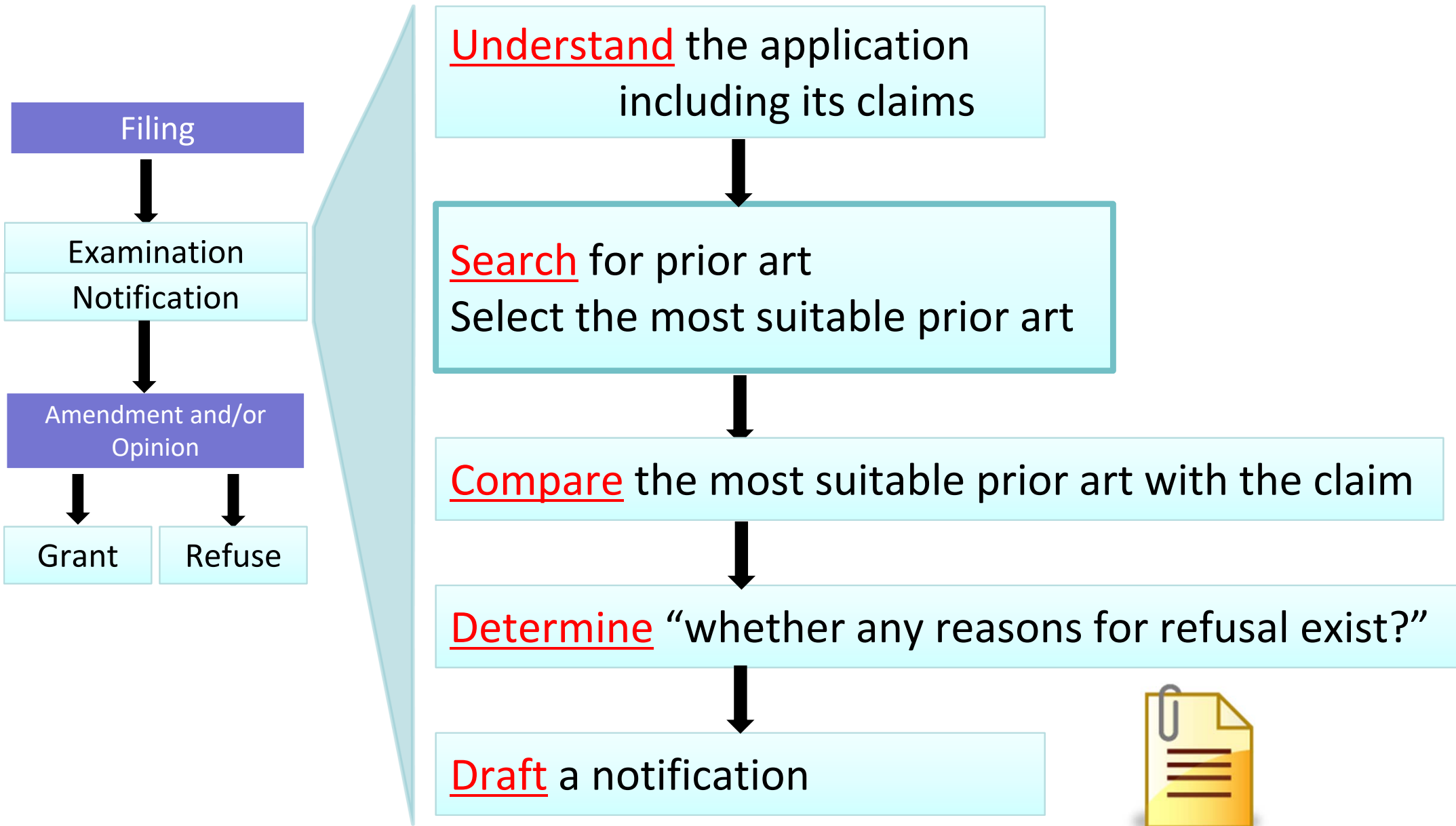


JPO's Patent Examination Flow



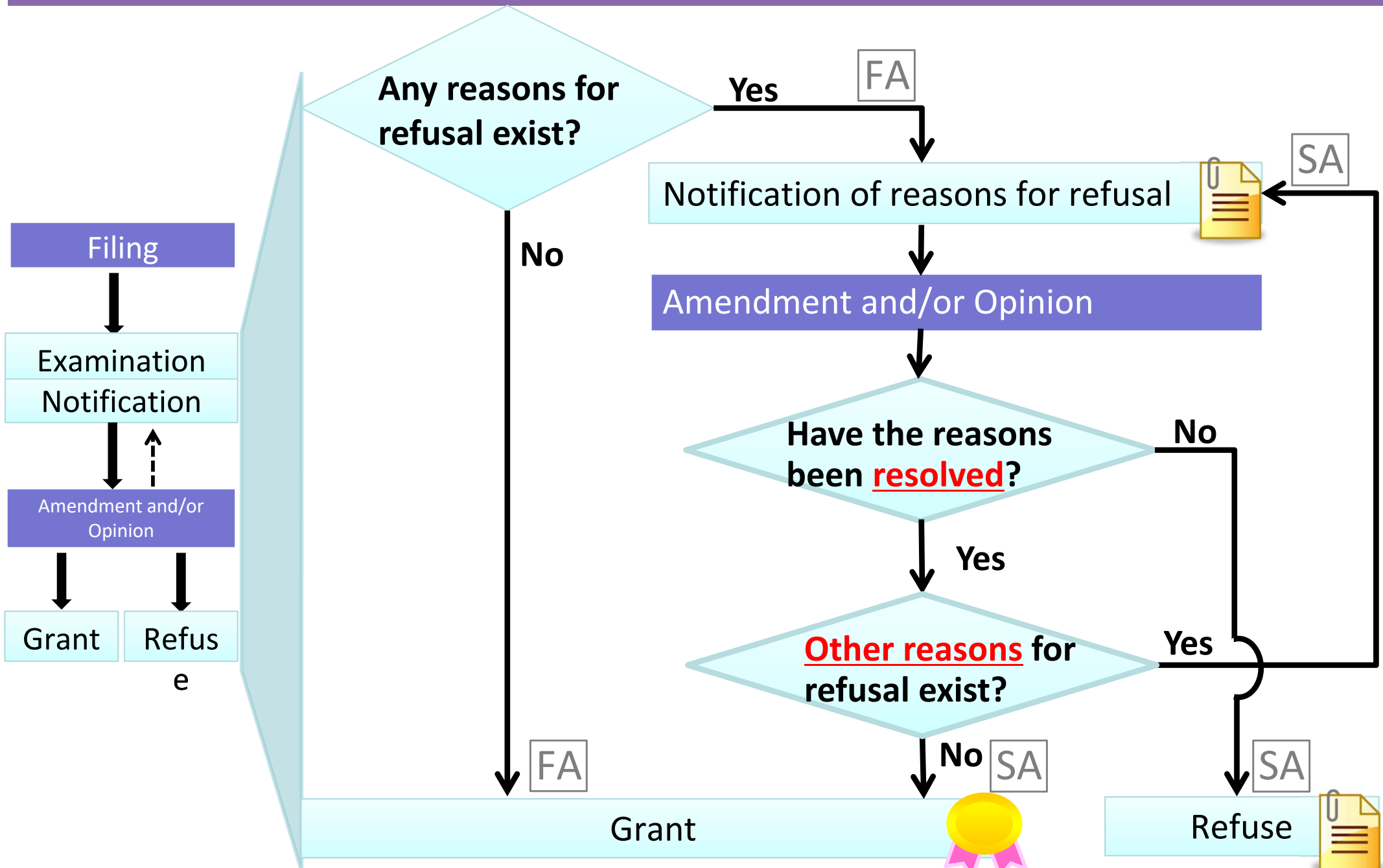


Details of Examination - First Action -





Details of Examination - Second Action -





I. Examination Procedure



II. Novelty



III. Inventive Step



Purpose of Novelty

JPO Examination Guideline (Part III, Chapter 2, Section 1)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0201_e.pdf

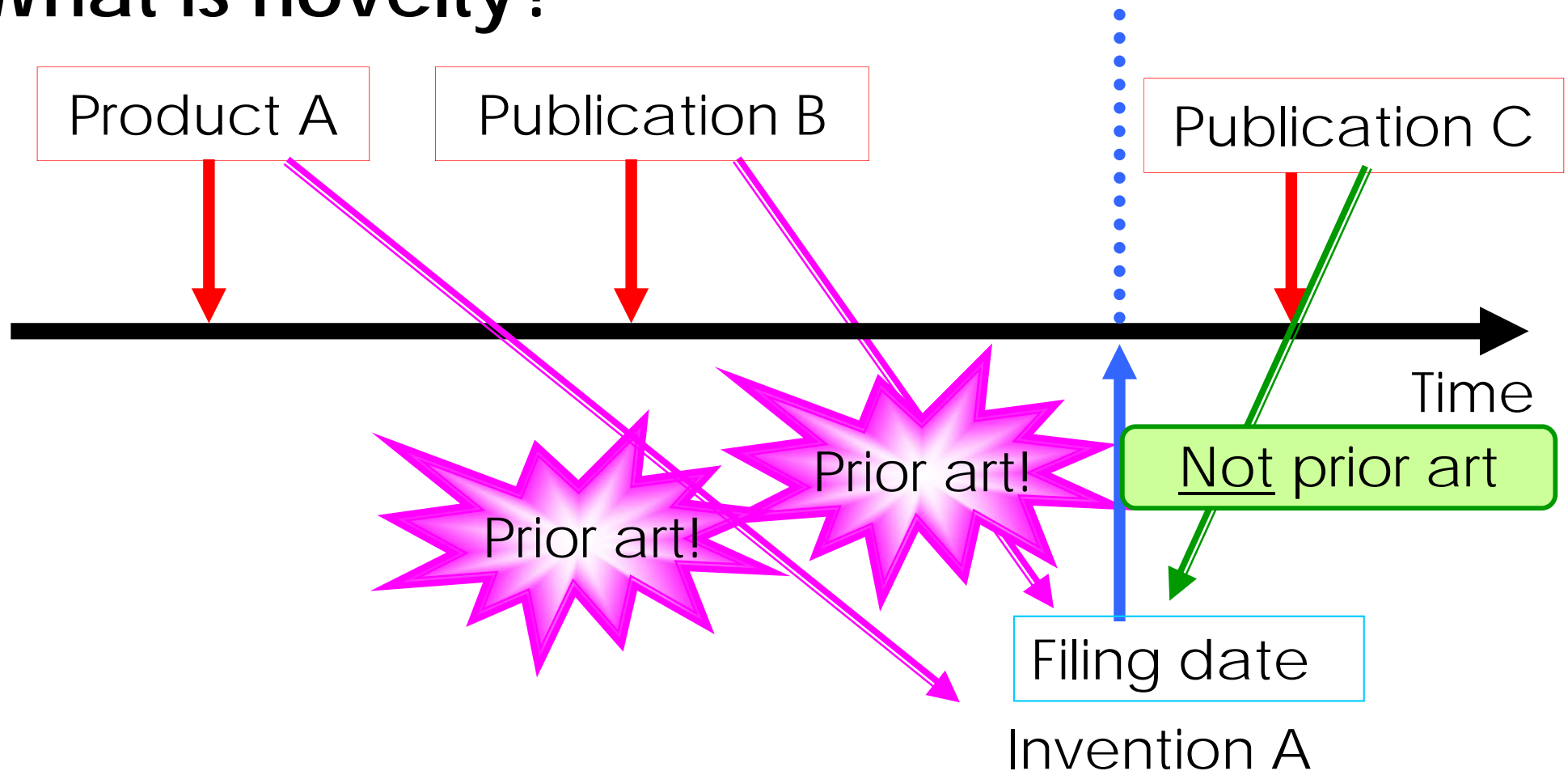
Patent Act Article 29(1) provides as the unpatentable cases (i) inventions that were publicly known, (ii) inventions that were publicly worked (iii) inventions that were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or a foreign country prior to the filing of the patent application. The same paragraph provides that a patent shall not be granted for these publicly known (Note) inventions (inventions lacking novelty, hereinafter referred to as "prior art" in this chapter.).

The patent system is provided to **grant an exclusive right to the patentee in exchange for disclosure** of the invention. Therefore, the invention which deserves the patent should be novel. This paragraph is provided to achieve such a purpose.



Procedure of Determining Novelty

What is novelty?



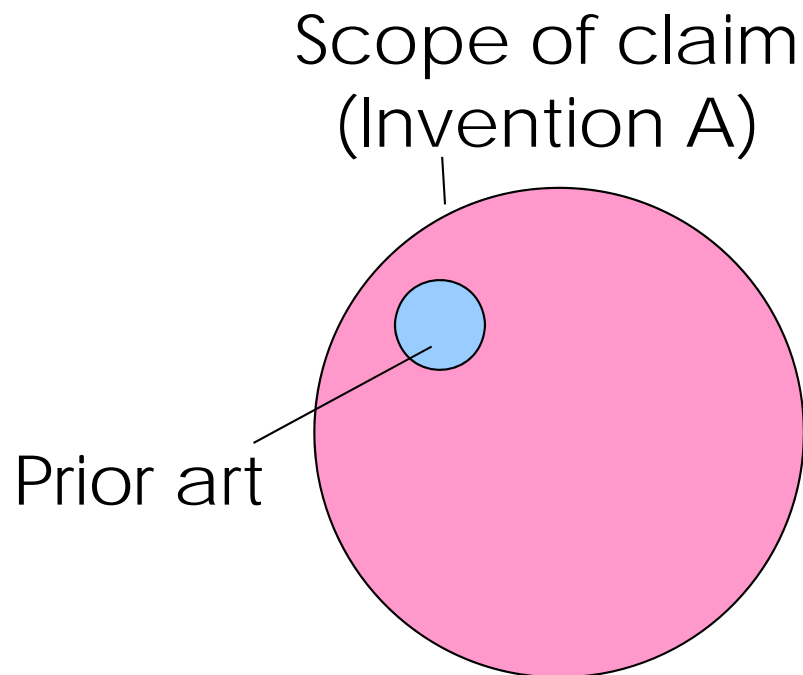
**Invention A is not patentable
if it was known to the public before the filing date.**



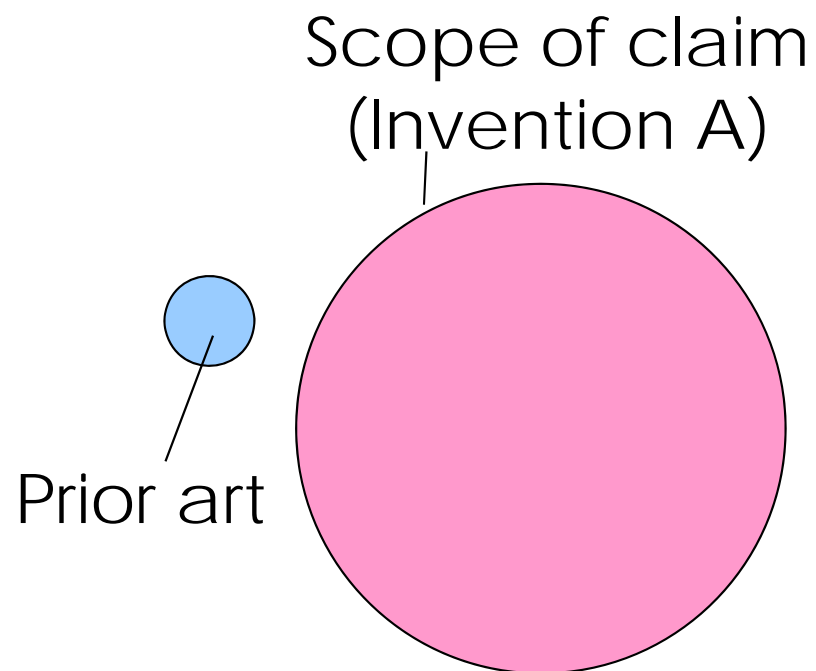
Procedure of Determining Novelty

Is the claimed invention A novel or not ?

Not novel



Novel

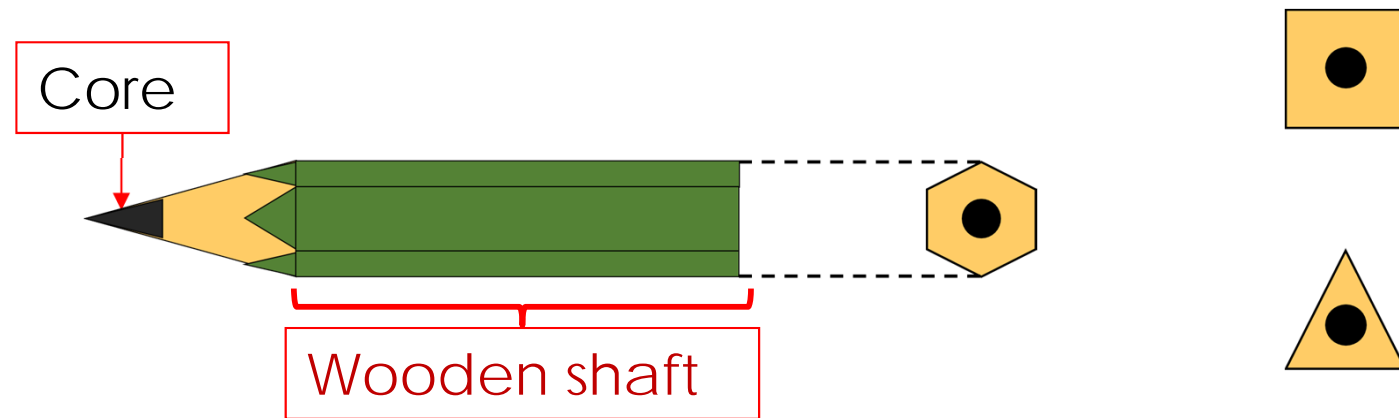




Exercise - Novelty -

Claimed invention

A pencil comprising
a core made of graphite and clay,
a wooden shaft having a polygonal cross-section



graphite -- a soft black substance that is a kind of carbon, used in pencils, paints, and electrical equipment
polygonal -- a flat shape with three or more sides. triangular, quadrangular, pentagonal, hexagonal etc.
cross-section -- something that has been cut in half so that you can look at the inside



Identified Prior Art

Description in Prior art

A pencil is a writing implement usually constructed of a narrow, solid pigment core inside a protective casing which prevents the core from being broken or leaving marks on the user's hand during use.

Most pencil cores are made of graphite mixed with a clay binder, which leaves grey or black marks that can be easily erased. Graphite pencils are used for both writing and drawing and result in durable markings: though writing is easily removable with an eraser, it is otherwise resistant to moisture, most chemicals, ultraviolet radiation, and natural aging. Other types of pencil core are less widely used, such as charcoal pencils, which are mainly used by artists for drawing and sketching.

The most common type of pencil casing is made of thin wood, usually hexagonal in cross-section but sometimes cylindrical, permanently bonded to the core. Similar permanent casings may be constructed of other materials such as plastic or paper. To use the pencil, the casing must be carved or peeled off to expose the working end of the core as a sharp point.

Identified prior art

A pencil comprising
a core made of graphite and clay,
a wooden casing having a hexagonal cross-section



I. Examination Procedure



II. Novelty



III. Inventive Step



Purpose of Inventive Step

JPO Examination Guideline (Part III, Chapter 2, Section 2)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0202_e.pdf

Article 29(2) provides that a patent shall not be granted for an invention (an invention lacking an inventive step) where a person ordinarily skilled in the art of the invention (hereinafter referred to as "a person skilled in the art" in this Part) would have been easily able to make the invention based on the prior art.

That is because granting patent rights for inventions which a person skilled in the art would have been easily able to make **does not promote the progress of the technology but rather prevents it.**



Details of Determination of Inventive Step

JPO Examination Guideline (Part III, Chapter 2, Section 2, 3)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0202_e.pdf

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0203_e.pdf

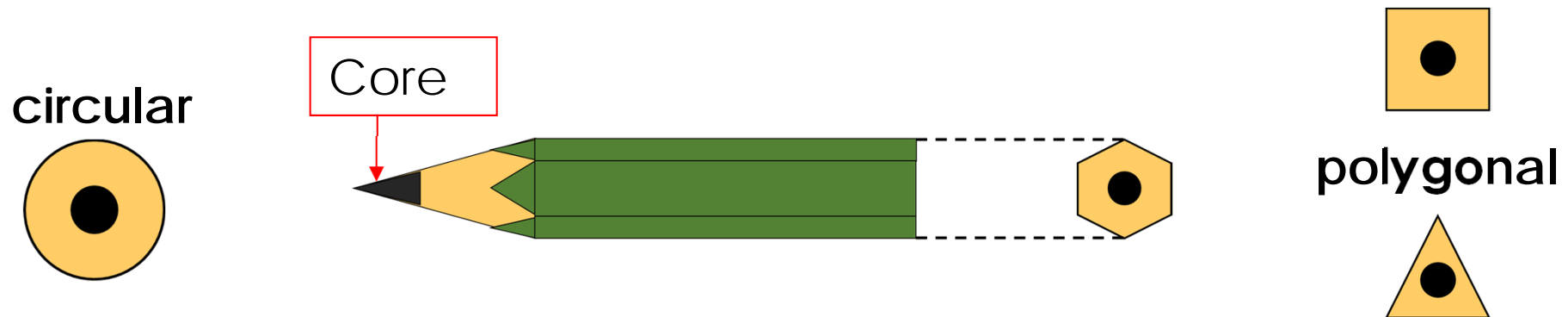
1. Specifying the claimed invention
2. Selecting and specifying the most suitable prior art for the reasoning
3. Comparing the claimed invention and cited invention to find the correspondences and differences
4. Seeking reasons for denying the presence of an inventive step
5. Taking into consideration an advantageous effect
6. Determining existence of an inventive step



Exercise - Inventive Step -

Claimed invention

A pencil comprising
a core made of graphite and clay,
and a wooden shaft having a polygonal cross-section.



Beneficial Effect: A pencil with a shaft having a polygonal cross-section is harder to roll than the one with a shaft having a circular cross-section.



Identified Prior Art 1

Description in Prior Art 1

A pencil is a writing implement usually constructed of a narrow, solid pigment core inside a protective casing which prevents the core from being broken or leaving marks on the user's hand during use.

Most pencil cores are made of graphite mixed with a clay binder which leaves grey or black marks that can be easily erased. Graphite pencils are used for both writing and drawing and result in durable markings: though writing is easily removable with an eraser,

...

The most common type of pencil casing is made of thin wood. Similar permanent casings may be constructed of other materials such as plastic or paper. To use the pencil, the casing must be carved or peeled off to expose the working end of the core as a sharp point.

Identified Prior Art 1

A pencil comprising
a core made of graphite and clay,
and a casing (shaft) made of wood.



Difference and Prior Art 2

Difference

between the Claimed Invention and the Prior Art 1 (D1)

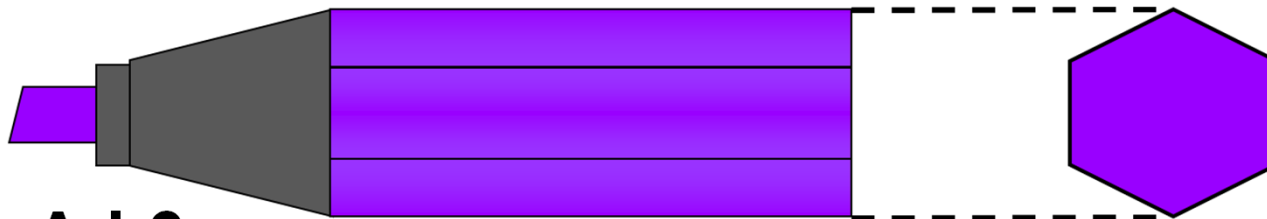
D1 does not disclose a casing having a polygonal cross-section.

Prior Art 2 (D2)

A pen with a casing.

The shape of the casing can be hexagonal in cross-section or cylindrical.

The casing with a hexagonal cross-section makes the pen hard to roll, which brings better usability.



Identified Prior Art 2

A pen comprising a casing with a hexagonal cross-section to make the pen hard to roll, which brings better usability.



Motivations to Combine the 2 Prior Art

Considering whether or not

there is a motivation to combine the prior art 1 and prior art 2

JPO Examination Guideline (Part III, Chapter 2, Section 2)

https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/03_0202_e.pdf

[Factor(s)]

- Design variation etc.
- Mere aggregation of prior art
- Motivation for applying secondary prior art to primary prior art

(1) Relation of technical fields

(2) Similarity of problems to be solved

(3) Similarity of operations or functions

(4) Suggestions shown in the content of prior art

Which Factor(s) or Motivation(s) to combine the prior art 1 & the prior art 2 can be applied?



Conclusion

The claimed invention lacks an inventive step for the following reason.

D1 discloses a pencil comprising a core made of graphite and clay, and a casing (shaft) made of wood. D1 does not disclose a casing of a polygonal cross-section.

D2 discloses a pen comprising a casing with a hexagonal cross-section. D2 also discloses that the casing with a hexagonal cross-section makes the pen hard to roll, which brings better usability.

The pencil in D1 and the pen in D2 are in the similar technical field of writing tools.

Besides, it is obvious for a person skilled in the art that the invention disclosed in D1 implicitly have a problem to make a pencil hard to roll for a better usability, which is a similar problem as the invention disclosed in D2.

So, a person skilled in the art would easily conceive the idea of applying a casing with a hexagonal cross-section disclosed in D2 to the invention disclosed in D1 in order to make the pencil hard to roll for a better usability.

Therefore, based on the prior arts disclosed D1 and D2, the claimed invention would be obvious to a person skilled in the art and it lacks an inventive step.



Thank you.