

Examination Guidelines for Patentability

- Inventive Step

Tatsuo TAKESHIGE
International Policy Division
Japan Patent Office
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Outline

1. Overview – Judgments on Inventive Step
2. Main Factors for Reasoning
3. Examples of Factors Denying Existence of Inventive Step
4. Examples of Factors Determining Existence of Inventive Step
5. Support for SCP/24/3

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1. Overview – Judgments on Inventive Step



Process of making judgments on Inventive Step

1. Examiners select cited inventions as **primary prior arts** from among all prior arts. Primary prior arts are considered to be **the most appropriate for applying “reasoning”** to determine or deny inventive step in claimed inventions. In general, **primary prior arts** are identical or close to the claimed inventions in terms of their technical fields or issues to be solved.
2. The examiners determine whether or not **any reasoning** is available for denying inventive step of the claimed inventions that persons skilled in the art would easily be able to create by applying **the primary prior arts**.
3. After that, in case the examiners determine that they are **able to set forth the reasoning** for denying inventive step, they determine the claimed inventions **lack inventive step**. On the contrary, in case the examiners determine that they are **not able to set forth any reasoning**, they determine the claimed inventions **involve an inventive step**.

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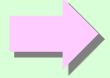
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2. Main Factors for Reasoning

Reasoning for making judgments on inventive step of claimed inventions

Factors that deny the existence of inventive step

Factors that determine the existence of inventive step



Evaluate all factors that determine or deny inventive step.

Factors that **deny** the existence
of inventive step

1. Motivation for denying inventive step by applying secondary prior arts to primary prior arts
2. Design changes of primary prior arts
3. Mere aggregation of prior arts

Factors that **determine** the existence
of inventive step

1. Advantageous effects over prior arts
2. Obstructive factors for reasoning
Example: Cases in which applying secondary prior arts to primary prior arts becomes contrary to the original purpose of the primary prior arts.

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1. 1. Motivation for applying secondary prior arts to primary prior arts

Is there any motivation for applying secondary prior arts to primary prior arts?

Examiners take into consideration all of the following four points of view.

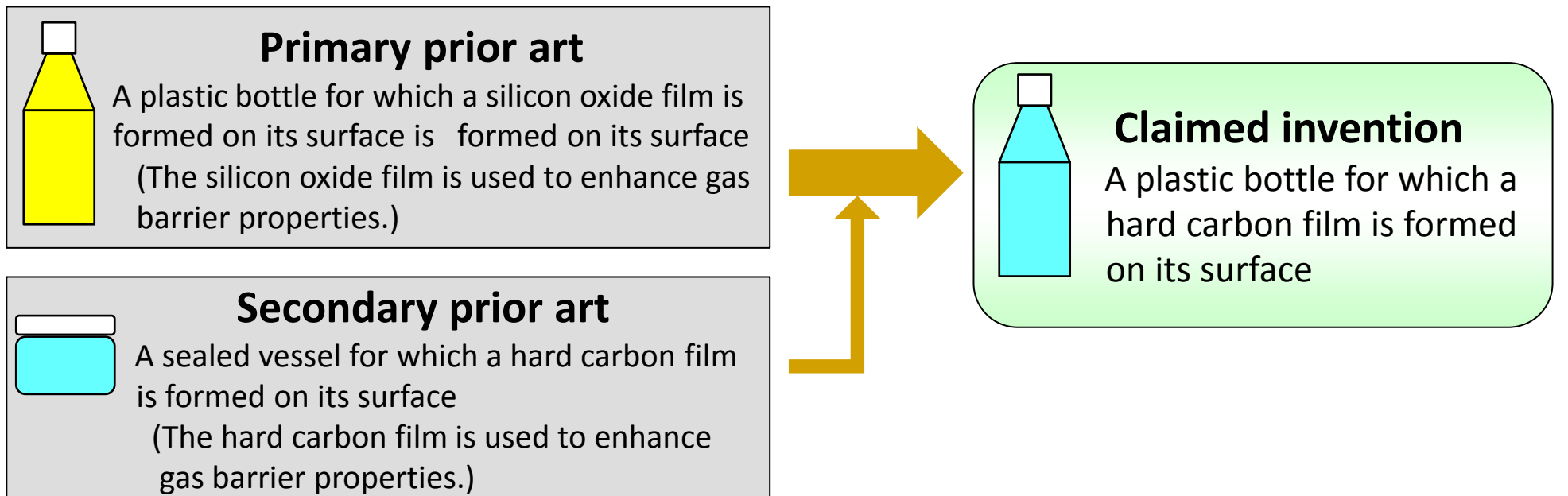
Nonetheless, examiners cannot always determine whether there is such motivation, only by paying attention to one of them:

- (1) Relation of technical fields;
- (2) Similarity of problems to be solved;
- (3) Similarity of operations or functions; and
- (4) Suggestions shown in the details of primary prior arts

1. Motivation for applying secondary prior arts to primary prior arts

(2) Similarity of problems to be solved

Example:



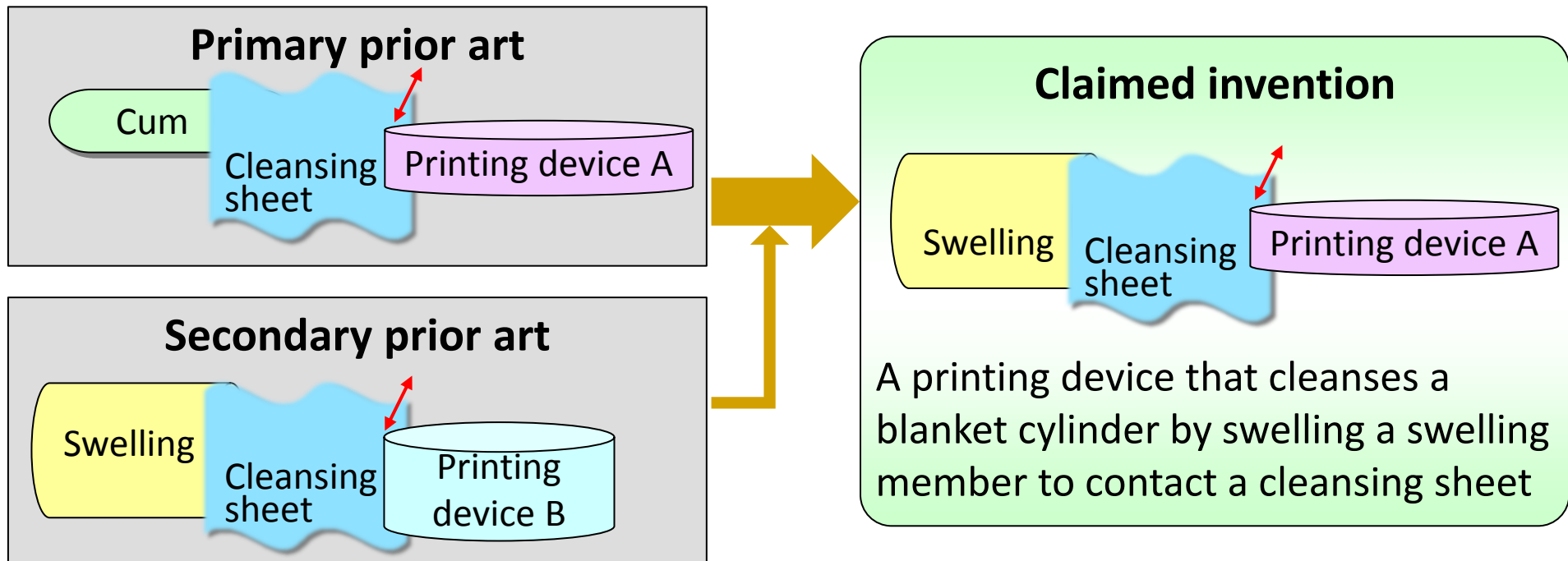
Similarity of the problem to be solved:

The specifications of the both prior arts include a statement that a film coating is used to **enhance gas barrier properties**.

1. Motivation for applying secondary prior arts to primary prior arts

(3) Similarity of operations or functions

Example:



Similarity of operations or functions:

Both of the prior arts **cleanse a cylinder of a printing device by pressing a cleansing sheet** to the device.

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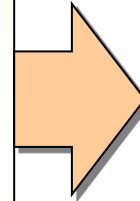
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Factors determining the existence of inventive step

1. Advantageous effects over prior arts

If any advantageous effects of claimed inventions over prior arts fall under the following effects, and when these effects are remarkable that **go beyond the scope** for persons skilled in the art **to predict** from the state of the art

- Effects that are **different** from those of prior arts
- Effects that have the same nature of, but are **significantly superior** to those of prior arts



The effects should be considered as positive factors that **support the existence of inventive step**

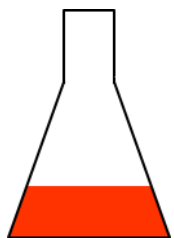
Examiners should consider **the effects that are claimed and proved in written opinions.**

Examiners **should not take into account** the effects of claimed inventions, which **are not stated in the specifications and cannot be speculated** by persons skilled in the art from the descriptions of the specifications or drawings.

1. Advantageous effects over prior arts (contin'd)

Example:

Primary prior art



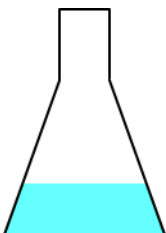
Compound A
-Used to treat diabetes
-Known to have **side effects such as weight gain**



Side effects!

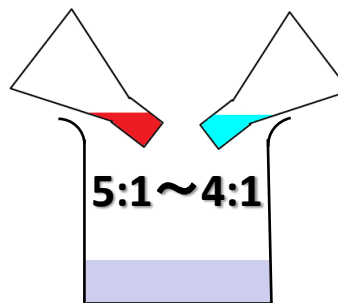


Secondary prior art



Compound B
-Used to treat diabetes

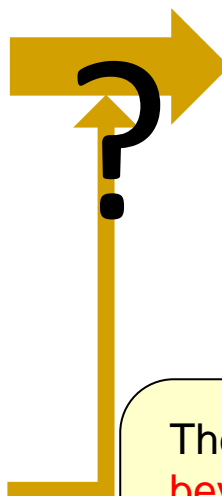
Claimed invention



A composition to treat diabetes, which is comprised of both Compound A and Compound B in a ratio of 5:1 to 4:1 by weight



Reduced side effects!



The effect of reducing the side effects **goes beyond the extent predictable** from the state of the arts at the time of the filing.



The claimed invention **involves an inventive step.**

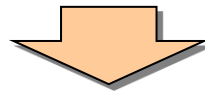
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In order to promote innovations, it is important not only to appropriately evaluate factors that serve as grounds for denying the inventive step of inventions claimed in patent applications but also to appropriately evaluate factors that serve as grounds for determining the inventive step.

We believe that taking such approaches can avoid any analysis based on impermissible hindsight in novelty or inventive step and lead to appropriate protection for genuinely patentable inventions.



[Support for SCP/24/3]

Based on this, Japan supports the proposal by the delegation of Spain, which was indicated in document SCP/24/3.

In particular, we support topics on factors that serve as grounds for determining inventive steps, such as synergic effects and secondary indicia.

Thank you !