

National Workshop on the Patent Cooperation Treaty (PCT) System

# Case Study 1

PCT/US2015/068095  
(Partially Changed for the Workshop)

November 28, 2016  
Japan Patent Office

## International Search Stage

- (Step 1) Understanding the Invention
- (Step 2) Check the Application
- (Step 3) Search
- (Step 4) Understanding the Prior Arts
  - (Lecture Session for “Unity”)
- (Step 5) Examining Novelty and Inventive Step
- (Step 6) Finding “Unity”
- (Step 7) Drafting ISR

## International Search Stage

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# 1. Understanding the Invention – 1/4

Application Number : PCT/US2015/068095 (Partially changed)

IPC: B42D 15/02, B42D 3/12

Title : BOOK WITH GREETING CARD COVER

Applicant : COTTAGE DOOR PRESS, LLC.

Priority date : Feb. 13, 2015

International filing date : Dec. 30, 2015

Abstract (Partially changed):

A card book having at least one page permanently connected to or attached with a card, such as a greeting card cover of the book. The card cover has a surface that displays a message. A flap or other suitable structural device can be used or operated between a closed position and an open position to at least partially hide or reveal the message.

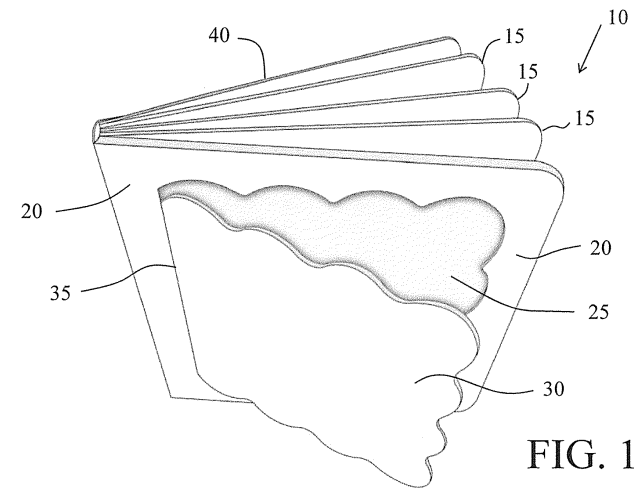
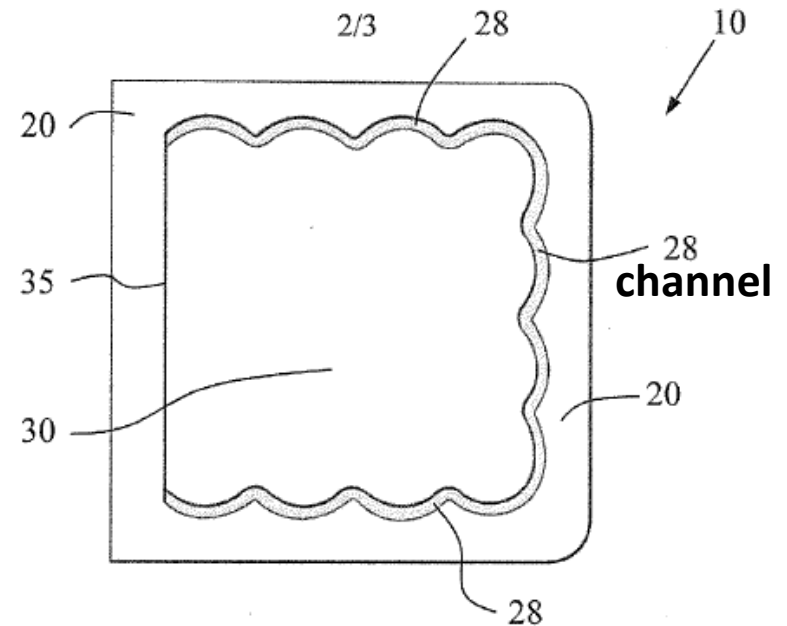
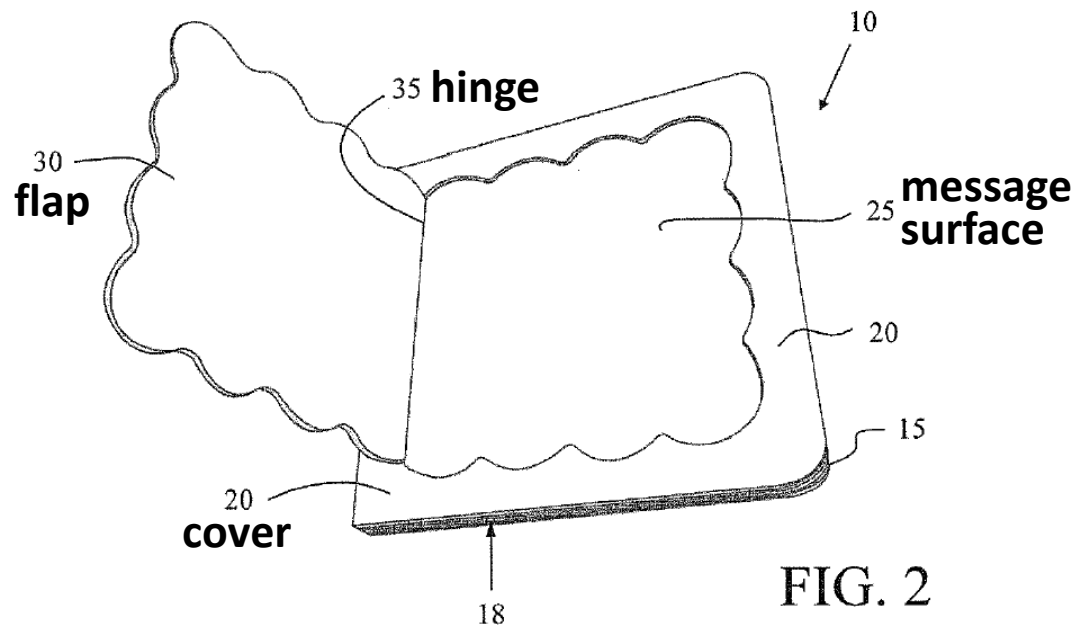


FIG. 1

# 1. Understanding the Invention – 2/4

Object:

In the future when reading the book the communicated message or greeting card is always accessible as an integral part of the book.



## Claims (Partially changed)

1. A card book comprising:  
a plurality of book pages bound with respect to each other and forming a book, the book pages movable with respect to each other,  
a card cover connected to the book,  
a message surface of the card cover, the message surface displaying a message,  
a flap movable with respect to the card cover, and the flap opening with respect to the card cover to reveal at least a portion of the message surface of the card.

## Claims (Partially changed)

2. A card book comprising:
  - at least one book page forming a book,
  - a card cover permanently connected to or integrated with the book, the
  - at least one book page movable with respect to the card cover,
  - a message surface of the card cover displaying a message,
  - a flap movable with respect to the card cover, the flap opening with respect to the card cover to reveal at least a portion of the message surface of the card,
  - a channel formed by a cut between the flap and the card cover,
  - and a magnetic securing the flap with respect to the card cover.

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## 2. Check the Application – 1/2

- Is this application qualified for the unity of invention “a priori”?
- Is each claim clear?
- Is each claim supported by description?
- Is the subject matter of each claim required to be searched?
- Are there any obvious errors?
- Are the title, the abstract and the figure appropriate?

### <Exercise>

- Read the bibliographic data, description, claims, and drawings
- Grasp the content of the invention

## International Search Stage

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<Exercise>

Search the prior arts related to the claimed invention

-Tips-

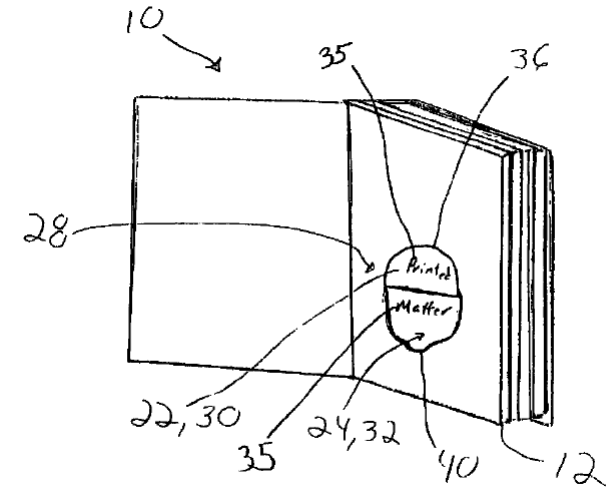
- Classification
- Key words ...

## International Search Stage

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## 4. Understanding the Prior Arts – 1/4

D1: US 6951352 B1  
(THE CLEVER FACTORY, INC.), Oct. 4, 2005,



D2: US 8341862 B1  
(Julie Gunther), Jan. 1, 2013,

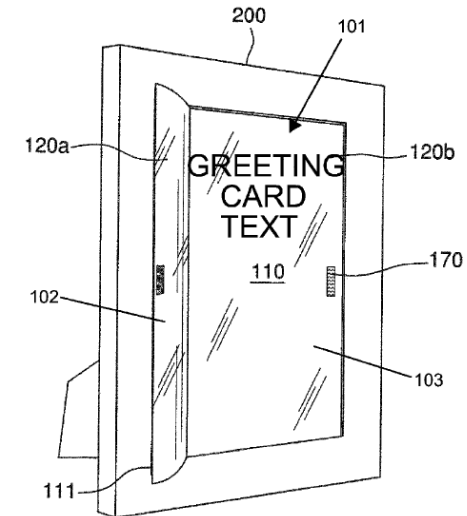


FIG. 6

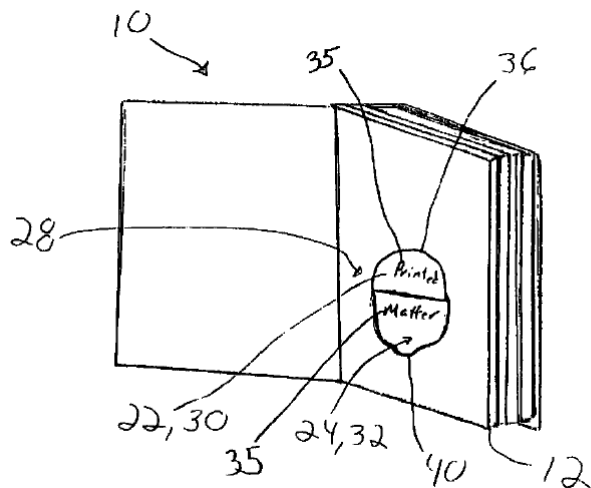
<Exercise>

- Read D1 and D2
- Grasp the contents of D1 and D2

### D1: US 6951352 B1

#### Object:

- This improved book facilitates children's learning process by more effectively posing a test/question/picture to the child and revealing the answer under the flap.
- It is an object of the invention to provide a lift-a-flap board book at a less expensive price that is conventionally available while still maintaining the quality of the book.



- 10: flap board book
- 12: individual page
- 28: flap
- 35: printed matter
- 40: notched opening



### D2: US 8341862 B1

#### Object:

- The system of the present invention provides an aesthetically pleasing means of displaying greeting cards, whether on a frame, or in books and albums.

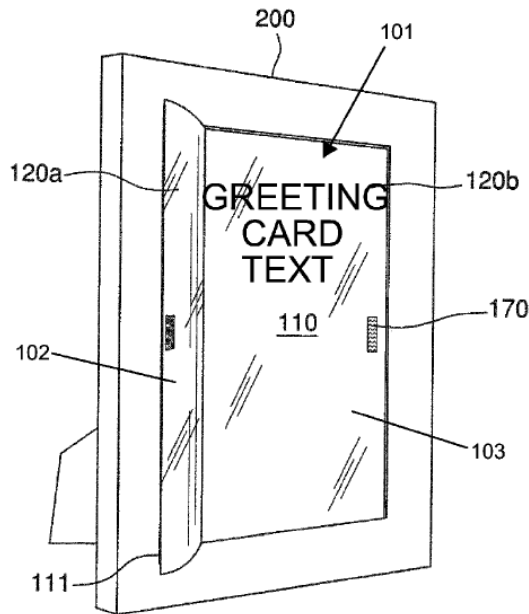


FIG. 6

- 101: greeting card
- 102&103: greeting card panel
- 110: sleeve
- 111: side edge
- 120a&b: inside surface
- 170: secure means
- 200: frame

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- (Step 4) Understanding the Prior Arts

(Lecture Session for “Unity”)

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## International Search Stage

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<Discussion>

- Discuss whether Claims 1 satisfies the requirement of “Novelty” or “Inventive step”

## 5. Examining Novelty and Inventive Step – 2/2

### Examination – Claim 1 (Novelty and Inventive step)

Claim 1	D1
A card book comprising:	The flap board book 10
a plurality of book pages bound with respect to each other and forming a book, the book pages movable with respect to each other	Standard “board books” are composed of multiple “leaves”, or pages
a card cover connected to the book	The flap board book 10 comprises at least one page 12 constructed of a first piece of grayback board 14 and a second piece of grayback board 16
a message surface of the card cover, the message surface displaying a message	The printed matter 35
a flap movable with respect to the card cover, and the flap opening with respect to the card cover to reveal at least a portion of the message surface of the card.	This positioning and alignment allows a reader to view ... the printed matter 35 therein, when the flap 28 is raised

D1 destroys “Novelty” and “Inventive step” in Claim 1

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### <Discussion>

- Discuss whether Claims 2 satisfies the requirement of “Unity” in consideration with “a posteriori case”
- Discuss whether you should examine Novelty and Inventive Step for Claim 2 (In Case Claim 2 were determined to be a lack of “Unity” with Claim 1)

## 6. Finding “Unity” – 2/5

Examination – Claim 2 (Unity with Claim 1)

Claim 1 lacks “Novelty” and “Inventive step” over D1



Claim 2 does not involve any other the same or corresponding special technical features as Claim 1



Claim 2 does not satisfy the requirement of “Unity” with Claim 1 (refer to PCT Rule 13.2)



## 6. Finding “Unity” – 3/5

### Examination – Claim 2 (Whether examined or not)

Claim 2	D1
A card book comprising: at least one book page forming a book,	The flap board book 10
a card cover permanently connected to or integrated with the book, the at least one book page movable with respect to the card cover,	Standard “board books” are composed of multiple “leaves”, or pages
a message surface of the card cover displaying a message,	The printed matter 35
a flap movable with respect to the card cover, the flap opening with respect to the card cover to reveal at least a portion of the message surface of the card,	This positioning and alignment allows a reader to view ... the printed matter 35 therein, when the flap 28 is raised
a channel formed by a cut between the flap and the card cover,	Included is notched opening 40 that allows a reader to easily open the flap 28
and a magnetic securing the flap with respect to the card cover.	-

## 6. Finding “Unity” – 4/5

### Examination – Claim 2 (Whether examined or not)

Claim 2	D1	D2
A card book comprising ...	✓	
and a magnetic securing the flap with respect to the card cover.	-	<ul style="list-style-type: none"><li>- The present invention features a novel greeting card display system 100 for displaying greeting cards.</li><li>- The sleeve 110 can move between an open position ... and a closed position ...</li><li>- This movement between the open position and closed position is similar to the opening and closing of the greeting card itself.</li><li>- The securing means 170 comprises ... a magnet system, ...</li></ul>

## 6. Finding “Unity” – 5/5

Examination – Claim 2 (Whether examined or not)

The examiner may be able to establish both an international search and a written opinion covering more than one invention with negligible additional work, in particular, when the inventions are conceptually very close. In those cases, the examiner may decide to complete the international search and written opinion for the additional invention(s) together with that for the invention first mentioned. (PCT guideline 10.65)



Claim 2 should be examined

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### <Exercise & Discussion>

- Draft Box III & Item C in PCT/ISA/210
- Draft Box IV & V in PCT/ISA/237
- Share your drafts with other members of your group
- Choose a draft which is the best in your group



# 7. Drafting ISR

## Item C in PCT/ISA/210

Fill citation .....▶

- Publication number
- Applicant's name
- Publication date
- Relevant passages
- Number of Family

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	WO 2000/000000 A1 (ABC)	1-5
Y	01.01.2000, [0033]-[0049], & US 5555555 B1	6-8
Y	WO 2001/000000 A1 (DEF) 01.01.2001, [0055]-[0070], (Family none)	6-8

Further documents are listed in the continuation of Box C.
  See patent family annex.

* Special categories of cited documents:	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"A" document defining the general state of the art which is not considered to be of particular relevance	"X" 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
"E" earlier application or patent but published on or after the international filing date	"Y" 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
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"&" document member of the same patent family
"O" document referring to an oral disclosure, use, exhibition or other means	
"P" document published prior to the international filing date but later than the priority date claimed	

# 7. Drafting ISR

## Box IV in PCT/ISA/237

Check boxes

**Box No. IV Lack of unity of invention**

1.  In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has, within the applicable time limit:
  - paid additional fees.
  - paid additional fees under protest and, where applicable, the protest fee.
  - paid additional fees under protest but the applicable protest fee was not paid.
  - not paid additional fees.
2.  This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
  - complied with.
  - not complied with for the following reasons:

Fill observations

4. Consequently, this opinion has been established in respect of the following parts of the international application:

Check boxes

- all parts.
- the parts relating to claims Nos. \_\_\_\_\_



