Topic 8: Case Study 1
Understanding Inventions and ISRs
1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   - Brief explanation
   - Group work
   - Discussion
4. How to evaluate XY citations in ISRs
   - Brief explanation
   - Group work
   - Discussion
5. Summary and preview of Case Study 2
1. First action procedures at the national stage

- Outline of first action procedures at the national stage
  1. Understanding ISRs/WOISAs
  2. Understanding inventions
  3. Prior art search, if necessary
  4. Understanding prior art documents, etc.
  5. Examination of requirements for patentability in terms of novelty, inventive step, etc.
1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   - Brief explanation
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   - Discussion
5. Summary and preview of Case Study 2
Let’s start group work about understanding ISRs/WOISAs!

What can you learn about the invention based on the ISR and WOISA of PCT/JP2012/123456? (If necessary, see Topic 3 slides.)

① International application number?
② International filing date?
③ Priority number?
④ Priority date?
⑤ Requirement of unity met?
⑥ Any claims which were found unsearchable?
⑦ Classification?
⑧ Electronic DB?
⑨ Number of claims?
⑩ Number of X/Y citations?
⑪ Publication number of each citation and category?
⑫ Assessment of patentability of each claim?
1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   • Brief explanation
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4. How to evaluate XY citations in ISRs
   • Brief explanation
   • Group work
   • Discussion
5. Summary and preview of Case Study 2
Question 1

- When conducting patent examination at the national stage, why do examiners need to correctly understand the claimed invention?
Question 1
- When conducting patent examination at the national stage, why do examiners need to correctly understand the claimed invention?

Answers
- To evaluate X/Y citations (knowing that X/Y citations can be used for refusal)
- To decide whether to conduct additional prior art searches
- To conduct timely and high-quality examination
Question 2

- How do examiners correctly understand a claimed invention?
Question 2
- How do examiners correctly understand a claimed invention?

Answers
- Carefully reading claims, specifications and drawings
- Color-highlighting and segmenting claims
- Color-highlighting items in specifications and drawings with the claims
Example of Color-highlighting and Segmenting

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
   - an image obtaining unit configured to obtain an image;
   - a server information storage unit configured to store plural items of superimposed data;
   - a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items;
   - a superimposing unit configured to superimpose the identified information on the obtained image and;
   to present the image having the superimposed information.

2. The superimposition information presentation apparatus according to Claim 1, further comprising a local information storage unit configured to store local information related to a user of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the local information.

3. The superimposition information presentation apparatus according to Claim 2, further comprising a sensor unit configured to obtain sensor information related to position and time of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the sensor information.
Let’s start group work about understanding claimed inventions!

- Discussing the invention:
  For example, technical field, background art, problem the invention is to solve, means to solve the problems, etc.
- Color-highlighting and segmenting claims
- Color-highlighting items in specifications and drawings with the claims (if possible)
- Filling out Section 1 of the work sheet
Let’s compare our results and discuss them!

- Problems that the invention is to solve
- Features of the invention (means to solve the problems)
- Color-highlighting and segmenting
1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
   - Brief explanation
   - Group work
   - Discussion
4. How to evaluate XY citations in ISRs
   - Brief explanation
   - Group work
   - Discussion
5. Summary and preview of Case Study 2
Question 3

- Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?
Question 3

- Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?

Answers

- To confirm whether each citation can be used as an X/Y citation
- To decide whether additional searches should be conducted

(Reference) excerption of Chapter 21 of PCT ISPE Guidelines

21.01 International Searching Authorities and International Preliminary Examining Authorities are entrusted to apply and observe all the common rules of international search and examination. Although applicants can generally expect the International Searching and Examining Authorities to act in accordance with the Guidelines, due to the involvement of several States in the international search and examination process and to the multitude of personnel within the various Authorities, some variability is inherent to the international search and examination process. At the same time, it is recognized that minimizing inconsistencies between or within the International Searching and Examining Authorities is crucial to the unqualified acceptance of an Authority’s work product by the States.
Question 4

- How do examiners evaluate all X/Y citations?
  
  (If necessary, please refer to Slide 8 of Topic 2.)
Question 4
- How do examiners evaluate all X/Y citations?
  (If necessary, please refer to Slide 8 of Topic 2.)

Answers
- Carefully reading all X/Y citations
- Color-highlighting identical or similar technical features the same color as the corresponding elements in the claimed invention
- Comparing prior art to the claimed invention from the following view points:
  - Whether the technical field is the same
  - Whether each technical element of the claimed invention has been disclosed
Let’s start group work on evaluating XY citations in ISRs!

- Discussing whether each technical element in the claimed invention is disclosed in the citations
- Color-highlighting identical or similar technical features the same color as the elements in the claimed invention
- Categorizing the citations as X, Y, or A
- Filling out Section 2 of the work sheet
Let’s compare our results and discuss them!

- How did you evaluate D1?
  - Same technical field?
  - Are all technical elements in each claimed invention disclosed?
    - X, Y, or A for Claim 1?
    - X, Y, or A for Claim 2?
    - X, Y, or A for Claim 3?

- How did you evaluate D2?
  - Same technical field?
  - Are all technical elements in each claimed invention disclosed?
    - X, Y, or A for Claim 1?
    - X, Y, or A for Claim 2?
    - X, Y, or A for Claim 3?
### 4. How to evaluate XY citations in ISRs: Discussion

<table>
<thead>
<tr>
<th></th>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>1. Selection superimposed information from plural items</td>
<td>X [0052] - [0058]</td>
<td>X [0021] - [0024]</td>
</tr>
<tr>
<td>2. Selection based on the local information (user information)</td>
<td>X [0052] - [0058]</td>
<td></td>
</tr>
</tbody>
</table>
1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
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   - Discussion
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   - Brief explanation
   - Group work
   - Discussion
5. Summary and preview of Case Study 2
5. Summary

- It is very important to precisely understand the claimed invention. In order to do so:
  - Carefully read specifications,
  - Color-highlight and Segment claims,
  - Color-highlight specifications and drawings with the claims.

- It is also important to correctly evaluate all X/Y citations.
  In order to do so:
  - Carefully read each citation, focusing on the reference points suggested in ISRs;
  - Color-highlight identical or similar technical features the same color as the corresponding elements in the claimed invention.
As you learned in Topic 6, in order to make the claimed invention patentable (novel or non-obvious), amendments are often done sometime between the time that the ISR is established and the time that the first action is made at the national stage.

In most of these cases, amended inventions include at least a technical element that has not been disclosed in any citations.

Consequently, examiners need to conduct additional searches.

In Case Study 2, based on the amended claims, you will learn:

- How examiners decide whether to conduct additional searches; and
- How examiners conduct additional searches, when needed.
5. Preview of Case Study 2: Claims in National/Regional Phase

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
an image obtaining unit configured to obtain an image;
an analysis unit configured to analyze the obtained image and to extract related information that relates to superimposed information;
a server information storage unit configured to store plural items of superimposed date;
a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items based on the extracted related information;
a superimposing unit configured to superimpose the identified information on the obtained image and;
to present the image having the superimposed information.

2. The superimposition information presentation apparatus according to Claim 1, wherein the related information is URL information for accessing a server, and the plural items of superimposed information are obtained from the server and stored in the superimposed information storage unit.

Question (homework):
Does each amended claim appear to be novel and involve an inventive step?
Thank you!
An item is selected from among multiple items and superimposed onto the original image.
Selection of an item for superimposition

Superimposition data management information

<table>
<thead>
<tr>
<th>Superimposition data ID</th>
<th>Genre</th>
<th>Manufacturer</th>
<th>Target gender</th>
<th>Target age</th>
<th>Weather</th>
<th>Season</th>
<th>Location</th>
<th>...</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Character</td>
<td>A</td>
<td>Male</td>
<td>10</td>
<td>—</td>
<td>—</td>
<td>Tokyo</td>
<td>...</td>
</tr>
<tr>
<td>2</td>
<td>Life</td>
<td>B</td>
<td>Female</td>
<td>40</td>
<td>Fine</td>
<td>—</td>
<td>—</td>
<td>—</td>
</tr>
<tr>
<td>3</td>
<td>Character</td>
<td>A</td>
<td>Female</td>
<td>10</td>
<td>—</td>
<td>—</td>
<td>Tokyo</td>
<td>...</td>
</tr>
<tr>
<td>6</td>
<td>Sightseeing</td>
<td>C</td>
<td>Female</td>
<td>20</td>
<td>Rain</td>
<td>Autumn</td>
<td>Osaka</td>
<td>...</td>
</tr>
<tr>
<td>7</td>
<td>Food</td>
<td>D</td>
<td>Male</td>
<td>30</td>
<td>Fine</td>
<td>Summer</td>
<td>Kyoto</td>
<td>...</td>
</tr>
</tbody>
</table>

Claims 1-3

1. Selection of an item for superimposition
2. Local information (user information)
3. Sensor information (position and time)

Local information

1. User information

2. Sensor information
   - position
   - time
1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
   an image obtaining unit configured to obtain an image;
   a superimposed information storage unit configured to store plural items of superimposed information;
   a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items;
   a superimposing unit configured to superimpose the identified information on the obtained image and;
   to present the image having the superimposed information.

2. The superimposition information presentation apparatus according to Claim 1, further comprising a local information storage unit configured to store local information related to a user of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the local information.

3. The superimposition information presentation apparatus according to Claim 2, further comprising a sensor unit configured to obtain sensor information related to position and time of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the sensor information.
### Information about additional images

**Overlaying of an additional image**

#### 1. User profile information

<table>
<thead>
<tr>
<th>CUSTOMER NO.</th>
<th>NAME</th>
<th>SEXUALITY</th>
<th>BIRTHDAY</th>
<th>HOBBY</th>
<th>FAVORITE SPORTS</th>
<th>FAVORITE COLOR</th>
<th>FAVORITE TONE</th>
<th>FAVORITE TASTE</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>John Smith</td>
<td>Male</td>
<td>July 15, 1980</td>
<td>Running</td>
<td>Soccer</td>
<td>Blue</td>
<td>Cool</td>
<td>Conservative</td>
</tr>
<tr>
<td>2</td>
<td>David Johnson</td>
<td>Male</td>
<td>July 20, 1990</td>
<td>Reading</td>
<td>Baseball</td>
<td>Red</td>
<td>Warm</td>
<td>Conservative</td>
</tr>
<tr>
<td>3</td>
<td>Michael Smith</td>
<td>Male</td>
<td>January 1985</td>
<td>Swimming</td>
<td>Yellow</td>
<td>Green</td>
<td>Cool</td>
<td>Blue</td>
</tr>
<tr>
<td>4</td>
<td>Lisa Jones</td>
<td>Female</td>
<td>April 20, 1985</td>
<td>Flower Arranging</td>
<td>Marathon</td>
<td>Red</td>
<td>Warm</td>
<td>Vivid</td>
</tr>
<tr>
<td>5</td>
<td>Soccer Club</td>
<td>---</td>
<td>---</td>
<td>---</td>
<td>---</td>
<td>---</td>
<td>---</td>
<td>---</td>
</tr>
</tbody>
</table>

#### 2. Feature information (analyzing images)
- tone
- main subject
- color
Overlaying of an advertisement

Information about the advertisement

<table>
<thead>
<tr>
<th>MODEL RANK</th>
<th>DATE AND TIME OF SHOOTING</th>
<th>SHOOTING MODE</th>
<th>SHOOTING LOCATION</th>
</tr>
</thead>
<tbody>
<tr>
<td>ADVERTISEMENT A</td>
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<td>70</td>
<td>20</td>
</tr>
<tr>
<td>ADVERTISEMENT B</td>
<td>80</td>
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<td>ADVERTISEMENT C</td>
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<tr>
<td>ADVERTISEMENT D</td>
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<td>10</td>
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</tr>
<tr>
<td>ADVERTISEMENT E</td>
<td>10</td>
<td>10</td>
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</tr>
<tr>
<td>ADVERTISEMENT F</td>
<td>10</td>
<td>10</td>
<td>50</td>
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