

Examination Guidelines for Patentability

- Novelty and Inventive Step

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1. Flowchart of Determining Novelty and Inventive Step
2. Novelty
3. Inventive Step
 - 3-1. Overview of Inventive Step
 - 3-2. Procedure of evaluating Inventive Step
 - 3-3. Examination Guidelines in JPO

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1. Flowchart of Determining Novelty and Inventive Step

PCT guideline 13.08

(1) Determination of the claimed invention



(2) Determination of the closest prior art



(3) Identification of the difference(s) between the claimed invention and the closest prior art

↓ identical

The claimed invention
lacks novelty

↓ different

(4) Considering whether or not the claimed invention would have been obvious to the skilled person

↓ obvious

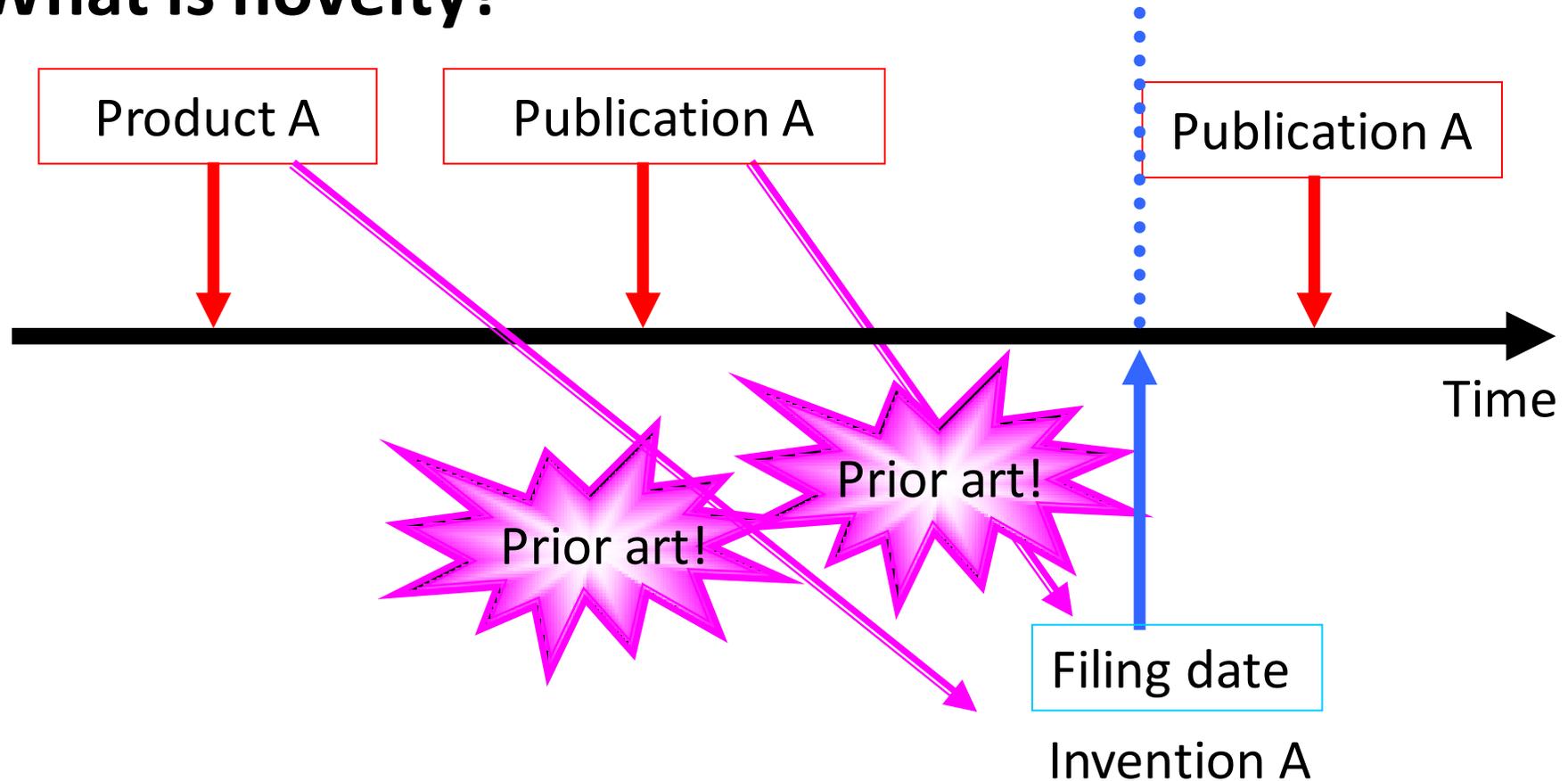
The claimed invention
lacks an inventive step

↓ not obvious

The claimed invention
involves an inventive step

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What is novelty?



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



PCT (PCT Guidelines 12.03)

(i) Evaluate the elements of the claimed invention



(ii) Determine if a document under consideration forms part of the “prior art”



(iii) Assess whether each and every element or step of the claimed invention was explicitly or inherently disclosed in combination by the document, to a person skilled in the art, on the date of publication of the document.



PCT

(i) Evaluate the elements of the claimed invention

In interpreting claims for the consideration of novelty,
the examiner should have regard to the guidance
given in Interpretation of Claims
(PCT Guideline 5.20 to 5.41)

(PCT Guideline 5.20)

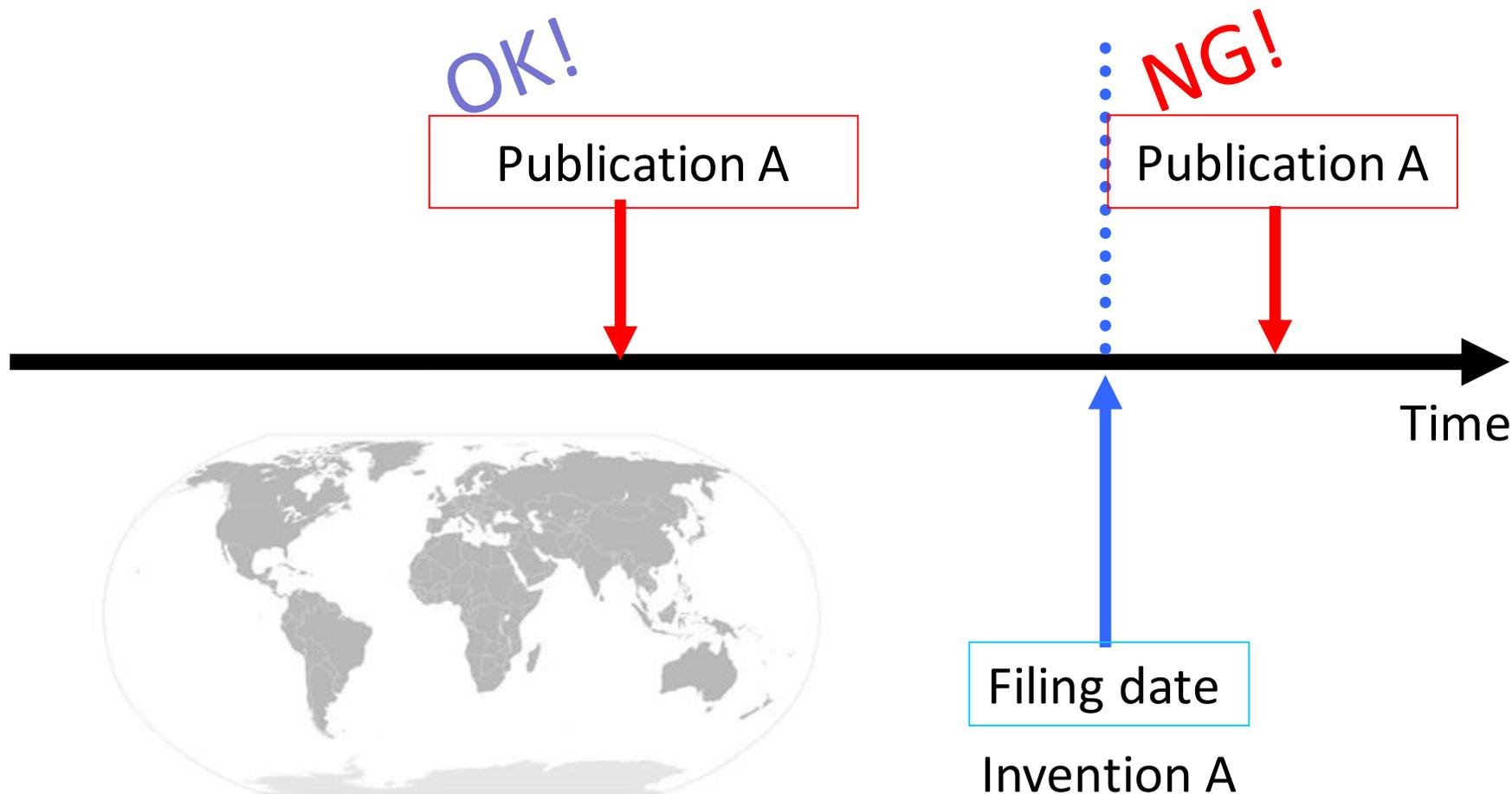
Each claim should be read giving the words the ordinary meaning and scope which would be attributed to them by a person skilled in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise.

2. Novelty



PCT

(ii) Determine if a document under consideration forms part of the “prior art”



2. Novelty

PCT

Described in a distributed publication
or
Publicly available through electric telecommunication lines

Example:
Patent gazette,
Research paper,
Article, Book,
Internet

Determination is made on the basis of “the matters described in a publication.”

JPO

Publicly known

Publicly worked

Example:
Broadcasting on TV,
Conference presentation

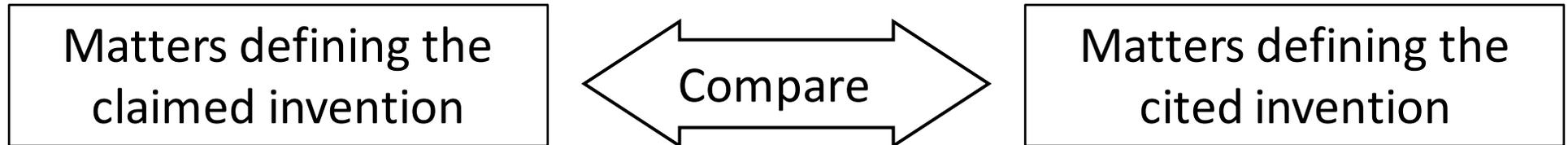
Example:
Being sold in stores

Determination is made on the basis of facts.



PCT

(iii) Assessment

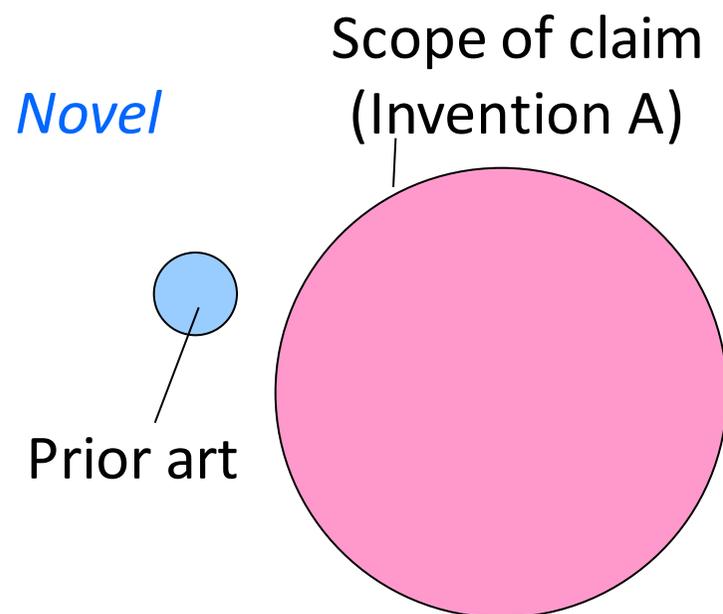
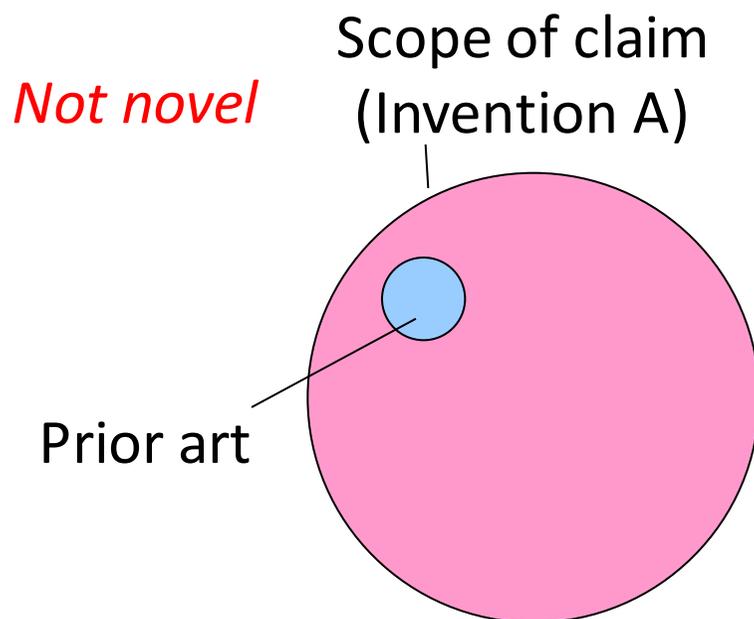


Determining the identicalness and the difference



If there is a difference, the claimed invention is novel.

Is the claimed invention A novel or not ?



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3-1. Overview of Inventive Step

A claimed invention is considered to involve an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art. (PCT guideline 13.01)

Who is “a person skilled in the art”?

A hypothetical person having ordinary skill in the art, who is aware of common general knowledge in the art at the relevant date, and has access to everything in the prior art. (PCT guideline 13.11)



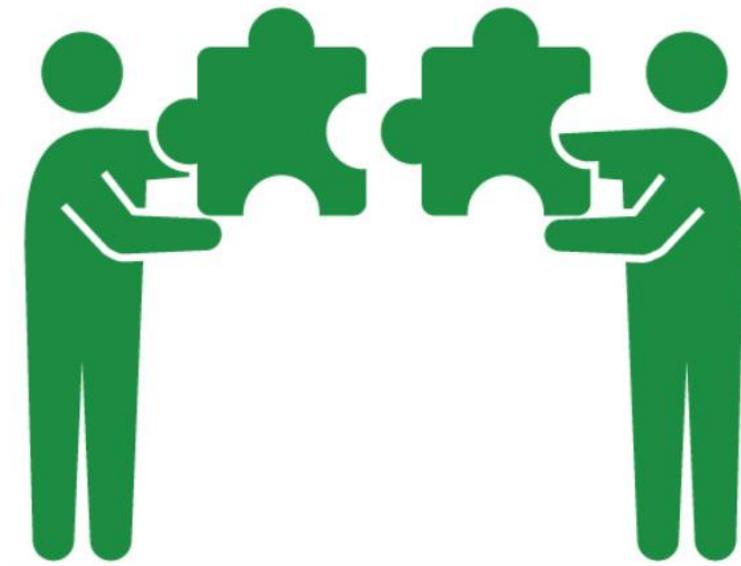
What is “obvious”?

The claimed invention is obvious if the person skilled in the art on the relevant date would have been motivated or prompted to realize the claimed invention by substituting, combining, or modifying one or more of those items of prior art with a reasonable likelihood of success. (PCT guideline 13.03, 13.09)

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Considering whether or not the claimed invention would have been obvious to the skilled person

In considering whether there is an inventive step as distinct from novelty, it is permissible to combine the teachings of two or more prior art references only where such combination would be obvious to the person skilled in the art.(PCT guideline 13.12)



Examples of Motivation to combine prior art references

- Whether the documents come from similar or neighboring technical fields and, if not, whether the documents are reasonably pertinent to the particular problem with which the invention was concerned. (PCT guideline 13.12(ii))
- It would, generally speaking, also be obvious to combine the teachings of two documents, one of which contains a clear and unmistakable reference to the other. (PCT guideline 13.13)
- It would normally be obvious to combine with other prior art documents with a well-known text book, or a standard dictionary. (PCT guideline 13.13)

Examples of cases where the claimed invention should be regarded as obvious

- The claimed invention resides in the choice of particular parameters from a limited range of possibilities, and it is clear that these parameters or workable ranges were encompassed by the prior art and could be arrived at by routine trial and error or by the application of normal design procedures.(PCT guideline 13.14(e) (ii)) (e.g., design modification)
- The claimed invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.(PCT guideline 13.14(e) (iii)) (e.g., range of number)
- The claimed invention is merely a juxtaposition of features, that is, there is no functional relationship between the features.(PCT guideline 13.05) (e.g., simple aggregation)

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Art. 29(2): Inventive Step

Subject matter which a person skilled in the art would have easily made



Excluded from the subject to be granted

A person skilled in the art (to which the invention pertains)

means a hypothetical person who meets all the following conditions:

- ◆ who has the common general knowledge in the technical field of the claimed invention;
- ◆ who is able to use ordinary technical means for R&D;
- ◆ who is able to exercise ordinary creativity, such as selection of materials, design modifications; and
- ◆ who is able to comprehend all the matter in the state of the art in the technical field, of the claimed invention, and relevant to problems to be solved by the invention.

Determination of Inventive Step

Determining **whether a person skilled in the art would** easily arrive at the claimed invention based on the prior art

It is determined after acquiring knowledge of claimed inventions.
Thus, the examiner should take note to avoid hindsight as follows:

- assuming that a person skilled in the art would have easily arrived at the claimed invention.
- understanding that a cited invention is approximate to the claimed invention.

Primary
prior art

Do NOT regard the combination of two or more independent pieces of prior art as the primary prior art.

Reasoned?

Claimed
subject matter

- ◆ **Primary prior art:** generally, an art which is **same as or close** to the claimed invention from the aspect of **technical field or problem to be solved**
- ◆ The primary prior art of which technical field or problem to be solved is considerably different from that of the claimed invention is likely to make the reasoning difficult.
- The fact that the problem to be solved is novel and inconceivable by a person skilled in the art may be a factor in support of the existence of an inventive step.

Reasoning

Facts in support of the non-existence of an inventive step

Facts in support of the existence of an inventive step



Comprehensively assessed

Facts in support of the
non-existence of an inventive step

- 1. Motivation for applying other prior arts to primary prior art:**
 - (1) relation of technical fields;
 - (2) similarity of problems to be solved;
 - (3) similarity of operations or functions; or
 - (4) suggestions shown in the content of the prior art
- 2. Design variation of primary prior art**
- 3. Mere aggregation of prior arts**

Facts in support of the
existence of an inventive step

- 1. Advantageous effects**
- 2. Obstructive factors**

Example: It is contrary to the purpose of the primary prior art to apply other prior art thereto.

Facts in support of the non-existence of an inventive step

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

Would it be reasoned to apply secondary prior arts to the primary prior art?

Comprehensively consider the following points of views, noting that it is not always possible to determine by paying attention to only 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 content of prior arts

- ✓ Relation and similarity between the primary prior art and secondary prior arts should be determined.
- ✓ Applying secondary prior arts to the primary one includes the application with design variation

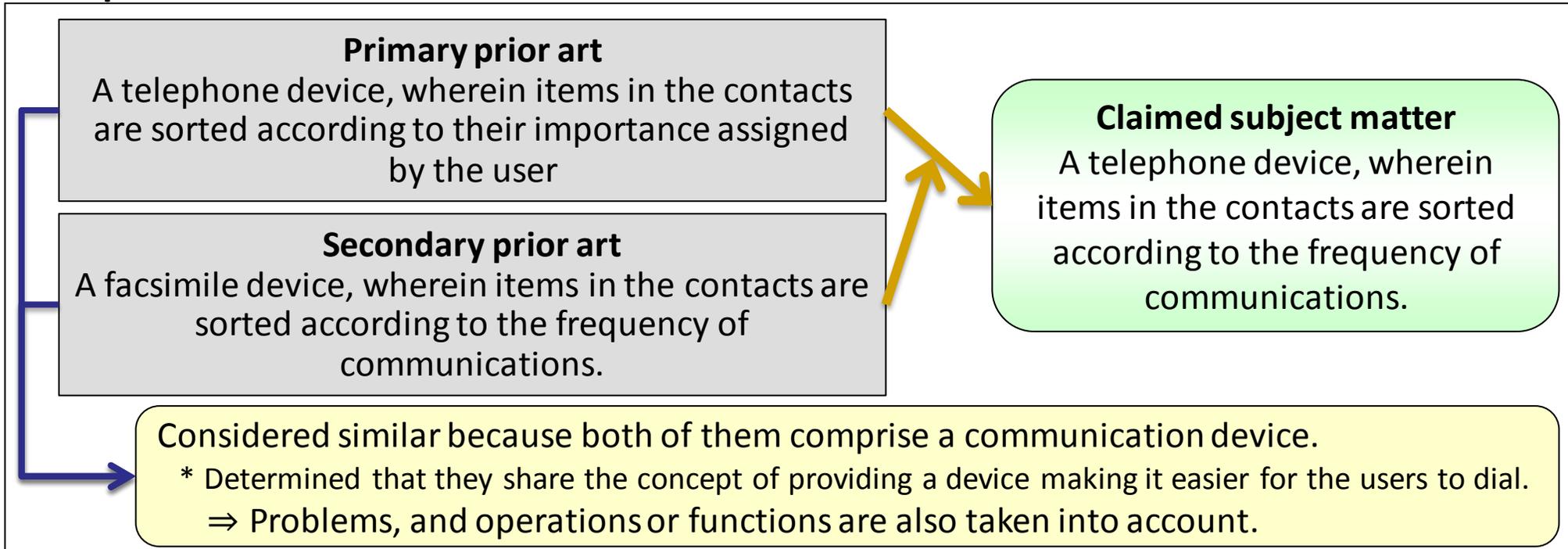
3-3. Examination Guidelines in JPO

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

(1) Relation of technical fields

- The examiner should consider not only the relation of technical fields, but **also other points of view**.

Example:



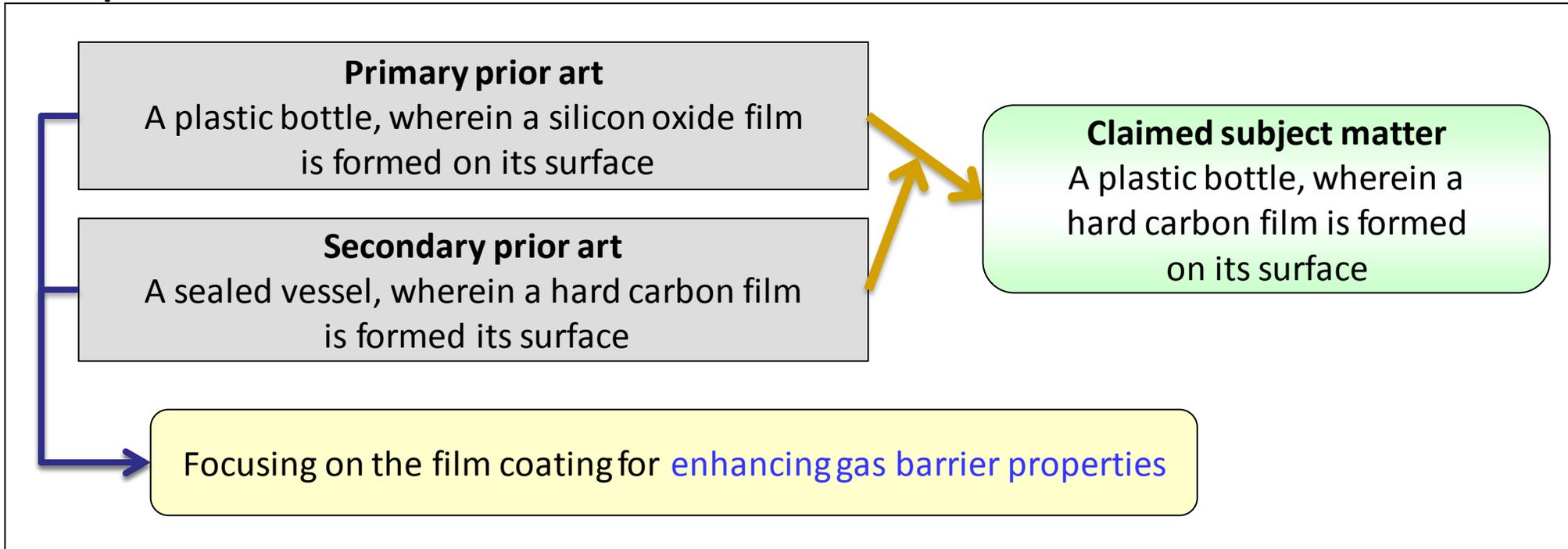
3-3. Examination Guidelines in JPO

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

(2) Similarity of problems to be solved

- Even though the problems are **obvious or easily conceivable for a person skilled in the art**, “similarity of problems” may be recognized.
- It may be different from the problem solved by the invention.

Example:

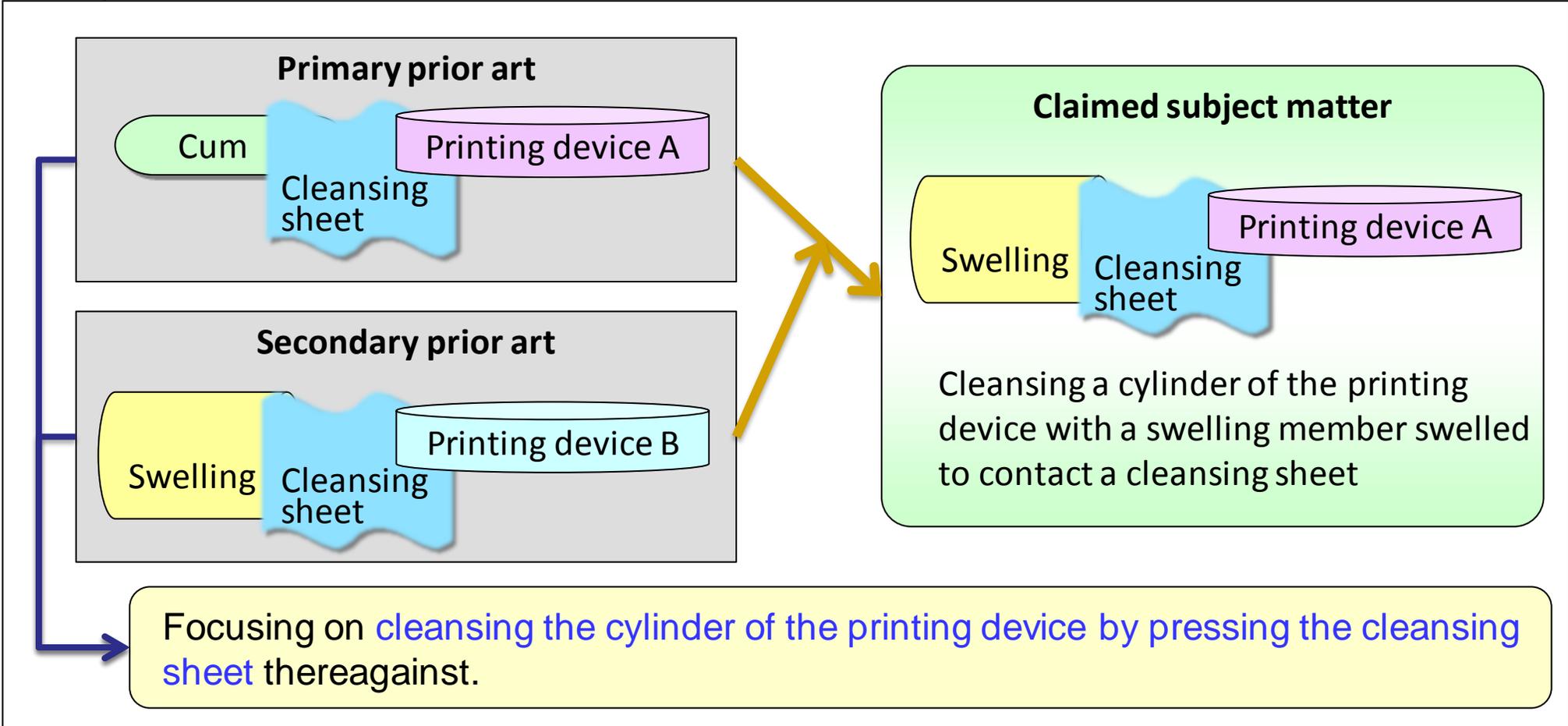


3-3. Examination Guidelines in JPO

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

(3) Similarity of operations or functions

Example:

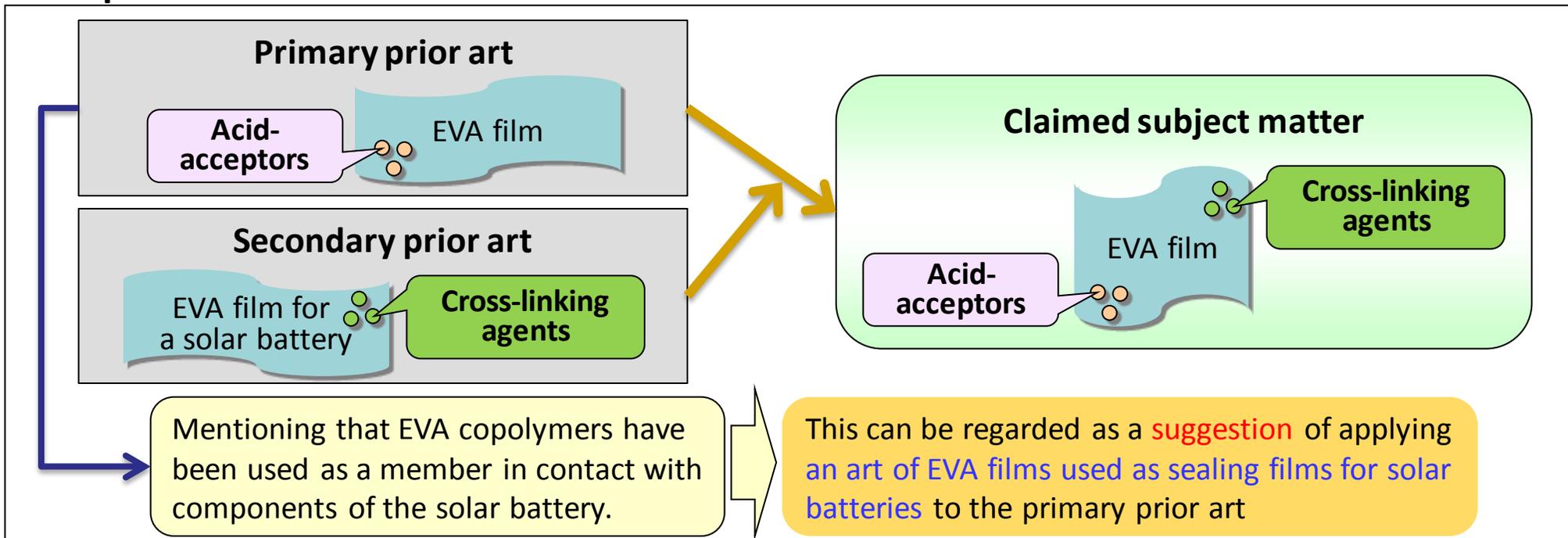


1. Motivation for applying secondary prior arts to primary prior art

(4) Suggestions shown in the content of the prior art

- **Suggestions** shown in a prior art **with regard to applying a secondary prior art to the primary prior art** may **strongly motivate** a person skilled in the art to derive the claimed subject matter by applying the secondary prior art to the primary prior art.

Example:



3-3. Examination Guidelines in JPO

Facts in support of the non-existence of an inventive step

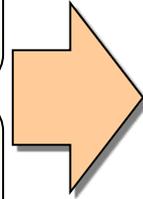
2. Design variation, etc.

Selecting optimum materials

Replacing with equivalents

Optimizing numerical ranges

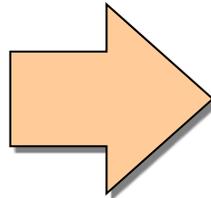
Design variation for applying specific technique



Ordinary creativity of a person skilled in the art

3. Mere aggregation of prior arts

Mere aggregation



Ordinary creativity of a person skilled in the art

Functions or operations of claimed elements are not related to each other.

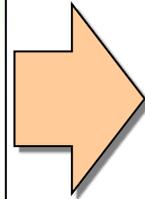
3-3. Examination Guidelines in JPO

Facts in support of the existence of an inventive step

1. Advantageous effects over prior art

Where effects of the claimed subject matter satisfies following conditions and **exceed what is predictable** based on the state of the art:

- **different** from that of prior art; or
- same nature but **significantly superior**,



Such effects may **support the existence of an inventive step**

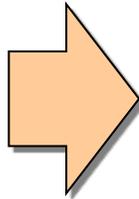
The examiner should consider **the effects argued and proved in the written argument.**

The examiner **should not consider** effects which are **neither stated in the description nor able to speculated** from the statements in the description, even if such effects are stated in the written argument.

Facts in support of the existence of an inventive step

2. Obstructive factors

Factors obstructing the application of a secondary prior art to the primary prior art



Such factors may **support the existence of an inventive step**

<Example cases of such factors>

- when applying the secondary prior art to the primary prior art is **contrary to the purpose of the primary prior art**;
- when applying the secondary prior art **makes the primary prior art unfunctional**;
- when the **application of the secondary prior art is excluded** and unable to be adopted by the **primary prior art**; or
- when a publication discloses that the secondary prior art and other embodiments and that the secondary prior art is inferior to the other embodiments **in respect to operations and effects**, and thus **a person skilled in the art would not apply that prior art** to the primary prior art.

■ Useful Links:

- Examination Guidelines for Patent and Utility Model in Japan
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/1312-002_e.htm
- Outline of the Examination Guidelines for Patent and Utility Model
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/outline_guideline_patents.htm
- Examination Handbook for Patent and Utility Model in Japan
https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/handbook_sinsa_e.htm
- 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

Thank you!