

Understanding and Utilization of the ISR and WOISA

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Japan Patent Office
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■ ISR

- The result of the international search are recorded in the International Search Report.
- The Search Report is published by the International Bureau.
- The Search Report serves as a basis for any examination of the International application by the designated Offices.

(PCT ISPE guidelines 16.01)

■ WOISA

- Its primary role is to identify whether or not the claimed invention appears to be novel, involve an inventive step (be non-obvious) and be industrially applicable.

(PCT ISPE guidelines 17.02)

- The written opinion will be issued by the International Searching Authority together with the international search report.

(PCT ISPE guidelines 17.04)

- International Search Report (ISR)
- Written Opinion of the International Searching Authority (WOISA)
- Using ISR and WOISA in National/Regional Phase

- International Search Report (ISR)
- Written Opinion of the International Searching Authority (WOISA)
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■ Front Page

➤ Basic information

- International application number
- International Filing Date
- Earliest Priority Date
- Name of the applicant

Applicant's or agent's file reference 5 6 7 8 H	FOR FURTHER ACTION	see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No. PCT/JP2013/999999	International filing date(<i>day/month/year</i>) 01 . 02 . 2013	(Earliest) Priority Date (<i>day/month/year</i>) 01 . 02 . 2012
Applicant PATENT CORPORATION		

- Basis of the Report
- Certain claims were found unsearchable
- Unity of invention is lacking

1. **Basis of the report**

a. With regard to the **language**, the international search was carried out on the basis of:

the international application in the language in which it was filed.

a translation of the international application into _____ which is the language of
a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

b. This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.6bis(a)).

c. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I

2. **Certain claims were found unsearchable** (see Box No. II).

3. **Unity of invention is lacking** (see Box No. III).

■ Observation where certain claims were found unsearchable.

- The international application relates to a subject matter which the ISA is not required to search (Article 17(2)(a)(i))
 - Scientific and mathematical theories
 - Plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes
 - Schemes, rules or methods of doing business, performing purely mental acts or playing games
 - Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods
 - Mere presentation of information
 - Computer programs to the extent that the ISA is not equipped to search prior art concerning such programs
- The description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out. (Article 17(2)(a)(ii))

■ Observation where certain claims were found unsearchable.

Box No. II Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. Claims Nos.: 8

because they relate to subject matter not required to be searched by this Authority, namely:

The subject matter of claim 8 relates to a method of doing business, which does not require an international search by the International Searching Authority in accordance with PCT Article 17(2) (a) (i) and Rule 39.1(iii).

2. Claims Nos.:

because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

3. Claims Nos.:

because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

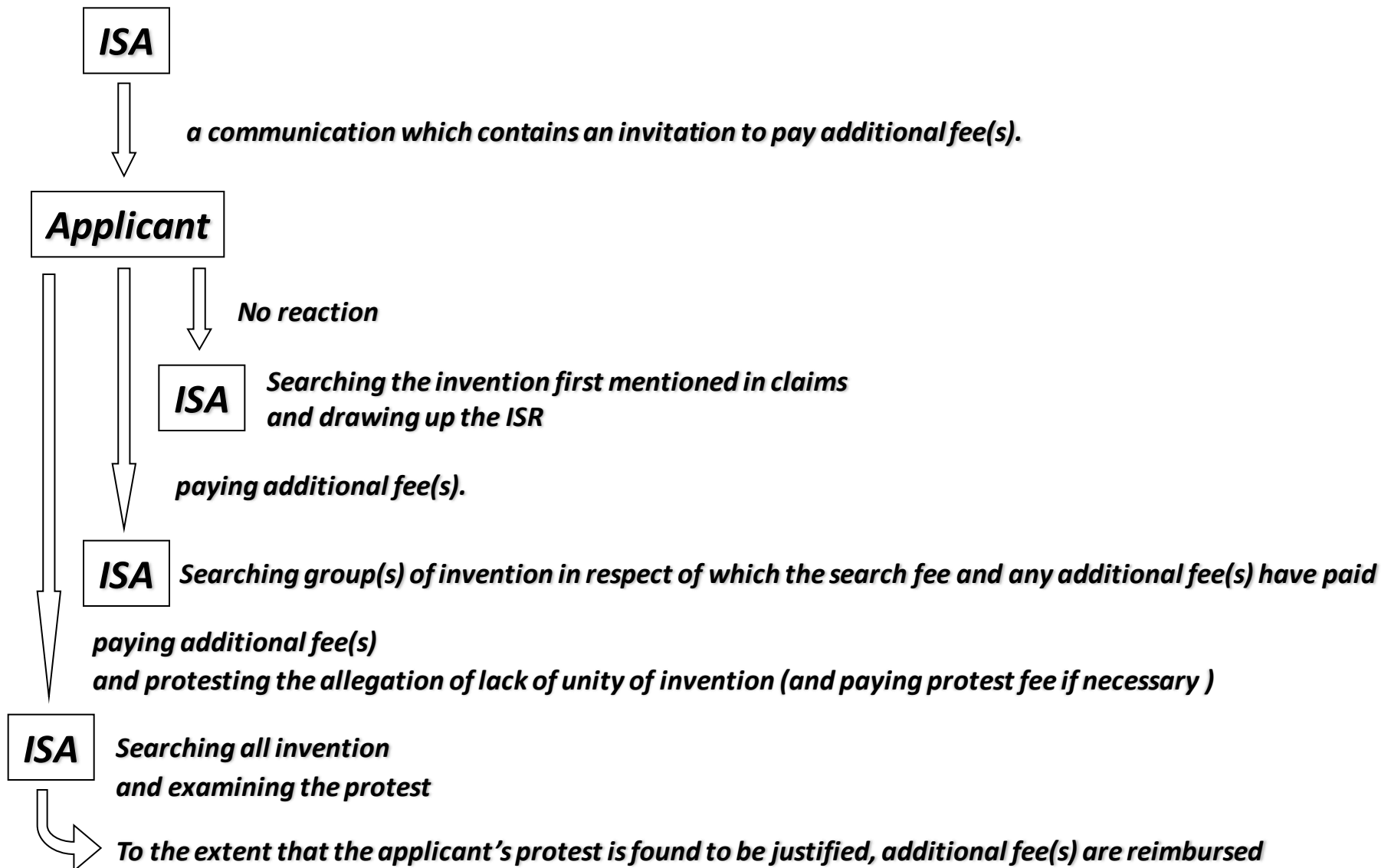
■ Lack of Unity of Invention

- The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").
- If the ISA considers that the international application does not comply with the requirement of unity of invention, it shall invite the applicant to pay additional fees.

■ Example

- Claim 1: A process of manufacture comprising step **A** and **B**
- Claim2 : Apparatus specifically designed for carrying out step **A**
- Claim3 : Apparatus specifically designed for carrying out step **B**

■ Procedure for determining the Unity of invention in the international phase



■ Observation where unity of invention lacking

This International Searching Authority found multiple inventions in this international application, as follows:

D1 (JP 987654 A) discloses an apparatus including "A". Therefore, claim 1 lack novelty over D1 and involves no special technical features. Thus there are 2 inventions in the claims of this application.

Note that claim1, which involves no special technical features, is grouped into invention 1.

(invention 1) claim 1-7, 9-15

(invention 2) claim 16-20

Basis

1. As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.
2. As all searchable claims could be searched without effort justifying additional fees, this Authority did not invite payment of additional fees.
3. As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:
4. No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

**Applicant's
Reaction**

Remark on Protest

- The additional search fees were accompanied by the applicant's protest and, where applicable, the payment of a protest fee.
- The additional search fees were accompanied by the applicant's protest but the applicable protest fee was not paid within the time limit specified in the invitation.
- No protest accompanied the payment of additional search fees.

**Remark of
Protest**

- Classification and Fields searched
- Minimum documentation Searched
- Documentation Searched Other than Minimum Documentation
- Electronic Database Consulted

Not the same

A. CLASSIFICATION OF SUBJECT MATTER

Int.Cl. G06Q50/00 (2012.01) i

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

Int.Cl. G06Q50/00, G06Q10/00

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Published examined utility model applications of Japan 1922-1996
Published unexamined utility model applications of Japan 1971-2005
Registered utility model specifications of Japan 1996-2005
Published registered utility model applications of Japan 1994-2005

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

CA (STN), [?root?*74/SX]

■ Documentation

- Citation category, citation of the document, identification of relevant claim numbers

■ Citation of the Documentation

- WIPO Standard ST.14

■ Patent Family

- Sign &

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 2010-987654 A (PCT SYSTEM CORP)	1-7
Y	2010.10.07, paragraphs [0026]-[0030]	9-13
A	& US 6543210 A, column 5, lines 5-30	14-20
	Patent Family	
Y	JP 2009-111111 A (INDUSTRIAL PROPERTY INC) 2009.09.28, Claim 1, Figure 1	9-13
	& WO 2007/222222 A1	

■ Category Code

- X
- Y
- A
- E
- O
- P
- L

(WIPO Standards ST.14 <http://www.wipo.int/standards/en/pdf/03-14-01.pdf>)

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category ⁺	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 2010-987654 A (PCT SYSTEM CORP)	1-7
Y	2010.10.07, paragraphs [0026]-[0030]	9-13
A	& US 6543210 A, column 5, lines 5-30	14-20
Y	JP 2009-111111 A (INDUSTRIAL PROPERTY INC) 2009.09.28, Claim 1, Figure 1 & WO 2007/222222 A1	9-13

■ Relevant to claim numbers

➤ Relationship Between Documentation and Claims

- Each citation should include a reference to the claims to which it relates.
- It is also possible for the same document to represent a different category with the respect to different claims.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 2010-987654 A (PCT SYSTEM CORP)	1-7
Y	2010.10.07, paragraphs [0026]-[0030]	9-13
A	& US 6543210 A, <u>column 5, lines 5-30</u>	14-20
Y	JP 2009-111111 A (INDUSTRIAL PROPERTY INC) 2009.09.28, Claim 1, Figure 1 & WO 2007/222222 A1	9-13

relevant passage of patent family

■ Patent Family

<i>Cited document</i>	<i>Publication date</i>	<i>Patent Family</i>
JP 2010-987654 A	2010.10.07	US 6543210 A
JP 2009-111111 A	2009.09.28	WO 2007/222222 A1
US 0123456 B1	2013.02.15	DE 1123456 A1 FR 2123456 A1
JP 4321567 B2	2006.02.20	Family: none
JP 5-222222 U	1993.07.01	Family: none

- International Search Report (ISR)
- **Written Opinion of the International Searching Authority (WOISA)**
- Using ISR and WOISA in National/Regional Phase

■ Front Page

➤ Basic information

- The international application number
- Name of the applicant
- The international filing date
- The claimed priority date

Applicant's or agent's file reference 5678H		FOR FURTHER ACTION See paragraph 2 below	
International application No. PCT/JP2013/999999	International filing date (day/month/year) 01.02.2013	Priority date (day/month/year) 01.02.2012	
International Patent Classification (IPC) or both national classification and IPC Int.Cl. G06Q50/00 (2012.01) i			
Applicant PATENT CORPORATION			

■ Basis of the Written Opinion

Box No. I	Basis of this opinion
1.	<p>With regard to the language, this opinion has been established on the basis of:</p> <ul style="list-style-type: none"><input checked="" type="checkbox"/> the international application in the language in which it was filed.<input type="checkbox"/> a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

■ Priority

***We need to consider
whether or not priority claim
is valid.***

Box No. II	Priority
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1. The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

■ Non-Establishment of Opinion

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

the entire international application.

claims Nos. 8

because:

the said international application, or the said claims Nos. 8

relate to the following subject matter which does not require an international search (*specify*):

The subject matter of claim 8 relates to a method of doing business, which does not require an international search by the International Searching Authority in accordance with PCT Article 17(2) (a) (i) and Rule 39.1(iii).

the description, claims or drawings (indicate particular elements below) or said claims Nos. _____ are so unclear that no meaningful opinion could be formed (*specify*):

the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed (*specify*):

■ Lack of Unity of Invention

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.

***Applicant's
Reaction***

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:

D1 (JP 987654 A) discloses an apparatus including "A". Therefore, claim 1 lack novelty over D1 and involves no special technical features. Thus there are 2 inventions in the claims of this application.
Note that claim1, which involves no special technical features, is grouped into invention 1.

(invention 1) claim 1-7, 9-15

(invention 2) claim 16-20

Basis

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

- all parts.
- the parts relating to claims Nos. 1-7, 9-20

Result

Reasoned Statement and Citations

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	9-20	YES
	Claims	1-7	NO
Inventive step (IS)	Claims	14-20	YES
	Claims	1-7, 9-13	NO
Industrial applicability (IA)	Claims	1-7, 9-20	YES
	Claims		NO

	N	IS	IA
Claim 1-7	No	No	Yes
Claim 9-13	Yes	No	Yes
Claim 14-20	Yes	Yes	Yes

2. Citations and explanations:

- D1: JP 2010-987654 A (PCT SYSTEM CORP)
2010.10.07, paragraphs [0026]-[0030]
& US 6543210 A, column 5, lines 5-30
- D2: JP 2009-111111 A (INDUSTRIAL PROPERTY INC)
2009.09.28, Claim 1, Figure 1
& WO 2007/222222 A1
- D3: JP 4321567 B2 (PATEMARU COMPANY)
2006.02.20, the whole document
(Family: none)
- D4: Microfilm of the specification and drawings annexed
to the written application of Japanese Utility Model
Application No. 222222/1992 (Laid-open No. 111111/1993)
(UTILITY MODEL INC),
1993.07.01, the whole document,
(Family: none)

citations

The subject matters of claim 1-7 are not novel and do not involve an inventive step in view of D1 (see paragraph [0026]-[0030], figure 7) cited in the ISR.

The subject matters of claim 9-13 do not appear to involve an inventive step in view of D1 and D2 (see claim 1, figure 1) cited in the ISR. Employing the feature [...A...] disclosed in D2 to the invention of D1 in order to constitute the present invention would have been easily conceived by the person skilled in the art.

The subject matters of claim 14-20 are neither disclosed in any of the documents cited in the ISR nor obvious to a person skilled in the art. None of the prior art documents cited in the ISR describes [...B...], and it was not obvious for the person skilled in the art to employ that the technical feature [...B...], which presents advantageous effects in that [...C...].

explanations

- International Search Report (ISR)
- Written Opinion of the International Searching Authority (WOISA)
- Using ISR and WOISA in National/Regional Phase

- When the PCT application enters National/Regional phase
 - You can follow the direction of the ISR and WOISA
 - Check the X, Y documents cited in the ISR
 - Patent family information in the ISR is useful

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
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Patent Family

relevant passage of patent family

- When you conduct additional searches in National/Regional phase
 - ISR Box A and B are useful

A. CLASSIFICATION OF SUBJECT MATTER

Int.Cl. G06Q50/00 (2012.01) i

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

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CA (STN), [?root?*74/SX]

Thank you!