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# *Examination Guidelines for Patentability - Inventive Step*

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## *Outline*

1. Overview – Judgments on Inventive Step
2. Main Factors for Reasoning
3. Examples of Factors - Advantageous Effects over Prior Arts
4. Examples of Factors - Obstructive Factors for Reasoning
5. JPO's Initiatives to Reduce Discrepancies in Judgements

## Patent Act of Japan: Article 1

The purpose of this Act is to promote inventions by protecting them and encouraging their utilization, and thereby contribute to the development of industry.

A large, light blue arrow pointing downwards, indicating a logical flow or consequence.

*Granting an exclusive right to an invention, in regard to which a person ordinarily skilled in the art of the invention would have been able to easily make, does not contribute to the development of industry.*

The patented invention needs to have an inventive step beyond any prior art.

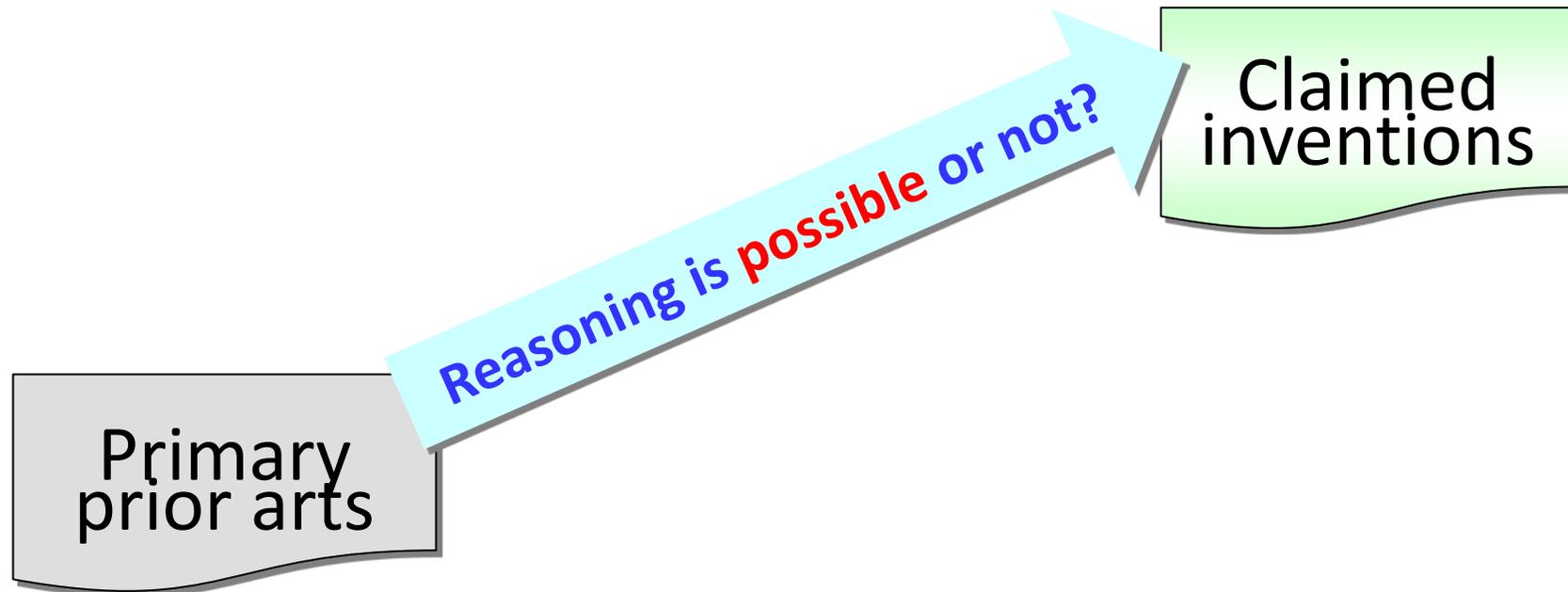
# 1. Overview – Judgments on Inventive Step

## Reasoning

Factors that support the non-existence of an inventive step

Factors that support the existence of an inventive step

→ Fully assessed



## 2. Main Factors for Reasoning

Part III, Chapter 2, Section 2,  
2.&3.  
In Examination Guidelines

Factors that support the  
**non-existence**  
of an inventive step

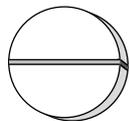
1. **Motivation for applying secondary prior art to primary prior art**
2. **Design variation of primary prior art**
3. **Mere aggregation of prior arts**

Factors that support the  
**existence**  
of an inventive step

1. **Advantageous effects over prior arts**
2. **Obstructive factors for reasoning**

#### Primary prior art

Drug X for severe cough



- contains **Compound A**
- dosage: **1mcg/kg body weight**  
(mcg: microgram)
- administered once **daily**

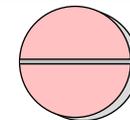


**Side  
effect B**



#### Claimed invention

Drug Y for severe cough



- contains **Compound A**
- dosage: **30-40mcg/kg body weight**
- administered once **every 3 months**



- **Reduced side effect B**
- **Prolonged beneficial effect**

Reducing side-effect B and prolonging the beneficial effect **goes beyond the extent predictable** from the state of the arts at the time of the filing.



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

# 4. Examples of Factors - Obstructive Factors for Reasoning

## Primary prior art

### Stainless steel

C :	a-b%
Si:	c-d%
Mn:	e-f%
Cr:	g-h%
P:	<0.02%
<b>S:</b>	<b>0.1-0.2%</b>

- A prescribed amount of **element S (Sulfur)** is put into stainless steel to improve machinability of the stainless steel.
- However, it reduces corrosion resistance of the steel, and is a problem.

## Well-known art

- **Element S** is known to reduce corrosion resistance of steel.
- It is a well-known art to reduce **Element S** in steel in order to improve corrosion resistance of the steel.



## Claimed invention

### Stainless steel

C :	a-b%
Si:	c-d%
Mn:	e-f%
Cr:	g-h%
P:	<0.02%
<b>S:</b>	<b>&lt;0.01%</b>

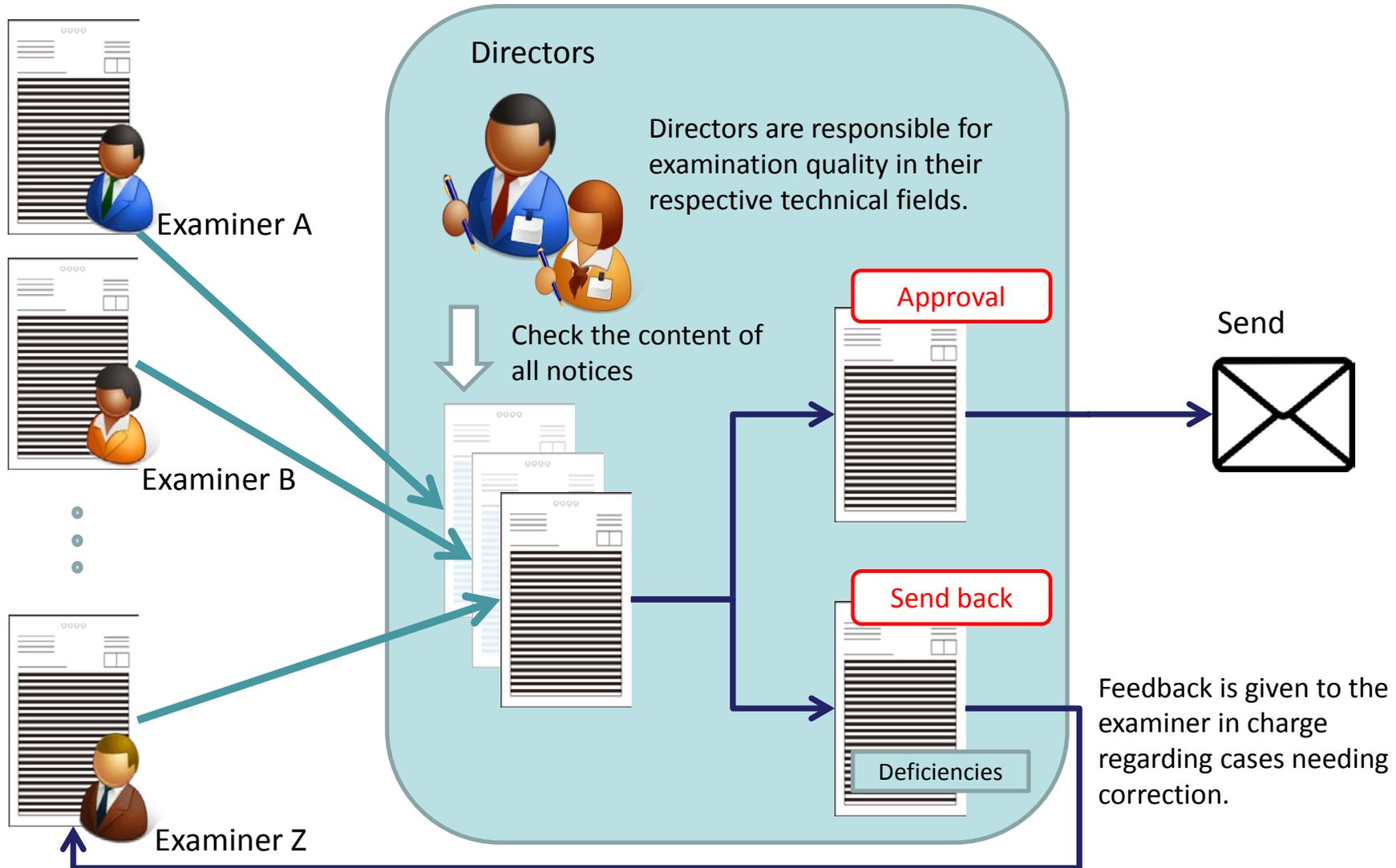
Applying well-known art to the primary prior art becomes **contrary to the original purpose** of the primary prior art.



Reasoning is not possible and the claimed invention **involves an inventive step**.

# 5. JPO's Initiatives to Reduce Discrepancies in Judgements

## - Approval



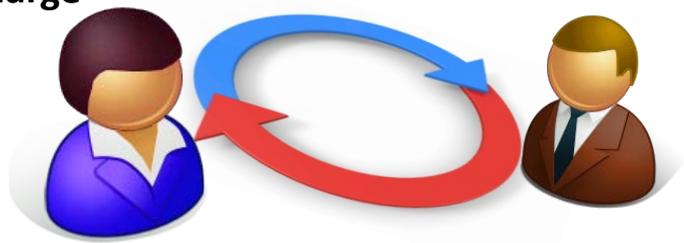
# 5. JPO's Initiatives to Reduce Discrepancies in Judgements

## - Consultations among examiners

Around 50,000 consultations in FY 2016

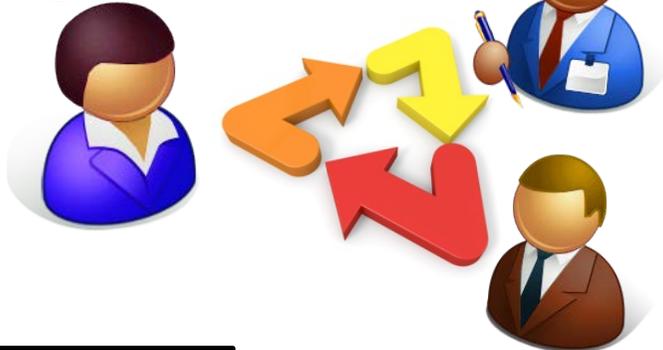
Examiner in charge

Consulting examiner



Examiner in charge

Director in consulting



Consulting examiner

- Opinion/Knowledge Sharing
- Expertise in Search
- Reducing Discrepancies

※ Consultations are conducted not only with examiners from the same examination department but also with examiners from different examination departments.

***Thank you !***