Roundtable 4: Collections, Registers and Databases relating to GR, TK and TCEs: Issues and Practical Experiences

WIPO Seminar on Intellectual Property and GR, TK and TCEs: Regional and International Dimensions
Geneva, June 23 to 25, 2015

JAPAN PATENT OFFICE
Yoshinari OYAMA
Activities of Patent Examiners

Understanding the claimed invention → Searching for prior arts → Utilizing Databases and other sources

Directors’ approval (quality check) → Drafting an office action to the applicant → Judging patentability

Send to the applicant
Search Tools

Domestic Patent Documents

Foreign Patent Documents

Machine Translation

Classification

Patent Office’s Databases

Commercial Databases

Internet

STN

✓ MEDLINE
✓ BIOSIS
✓ CAplus
✓ EMBASE

Science Direct, JDream III

Delivery/Copy Service

✓ E-mail
✓ FAX
✓ Express Delivery

Google, Yahoo!, etc

✓ PubMed
✓ TKDL
✓ Herbmed
✓ Traditional Chinese & Western Herbal Medicine in Humans & Animals

PCT Minimum Documentation

✓ Korean Journal of TK
✓ Indian Journal of TK
✓ Journal of Nutrition
✓ Acta Pharmaceutica

GRTK-related Website

Thesaurus
✓ Scientific Name
✓ Commonly Known Name
✓ Names in Foreign Languages
* High-speed screening (viewer): Page-turning rate < 0.8 sec
Understanding of the invention
✓ The examination starts by understanding the claimed invention for the application concerned.
✓ The examiner should understand the claimed invention based on the writing of the claims.

Prior art search
✓ The examiner shall conduct a prior art search targeting the claimed inventions, which are the subjects of the search, in terms of novelty, inventive step and seniority of applications.

Examination of requirements for patentability in terms of novelty, inventive step, etc.
✓ Novelty, inventive step, etc. of the claimed invention should be examined, based on the search results.

When examining patent applications related to GR

• The examiner works to understand the claimed invention based on the wording of the claim including the effect, if any, of GR on the invention.

Typically, the examiner
• Searches for prior patent documents by doing text searches with IPC, FI and F-term.
• Searches for non-patent literature by utilizing commercial databases.
• Searches documents with chemical structures or sequences.
• Utilizes information on the Internet or printed in books such as dictionaries.
• Also utilizes machine/human translation.

For example,
• When the medicinal use of the claimed invention is only expressed as a newly found working mechanism in place of the medicinal use of the cited invention and both uses cannot be substantially distinguished from each other, the novelty of the claimed medicinal invention is denied.
• (i) Selection from optimum materials from publicly known materials, (ii) optimally or preferably modified numerical ranges, (iii) materials replaced by equivalents, or (iv) designs modified along specific application of techniques to solve certain problems are regarded to be arts derived from the ordinary creativity of a person skilled in the art.