

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.

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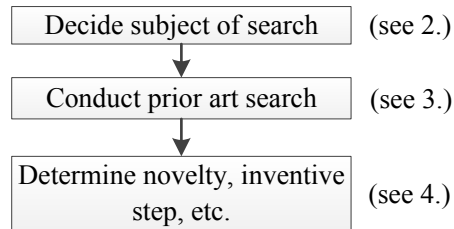
### 1. Overview

The examiner conducts the prior art search in relation to determining novelty, inventive step, etc. of the claimed invention.

When the prior art search is to be conducted, the examiner first decides the invention regarded as the subject of the prior art search (in this part, hereinafter referred to as "subject of search" through this Part) from among the claimed inventions of the application concerned.

Also, in cases where information on relevant prior art documents is disclosed in the detailed description of the invention or search results and examination results of any foreign patent office, or search results of any registered search organization or prior art information provided by third parties is available, the examiner considers the content of such information and conducts the prior art search.

The examiner renders determination of novelty, inventive step, etc. on the basis of the results of the prior art search.



### 2. Subject of Search

#### 2.1 Decision regarding subject of search

In the first round of examination, the matters of the claimed invention (Note) falling within the range to be subjected to the examination in light of the aspects set forth in 4. in "Part II Chapter 3 Unity of Invention" (Article 37) are defined as the subject of search by the examiner. In the second round of examination as well as in any other round of examination that follows, the range to be subjected to the examination in light of the aspects set forth in the above mentioned "Part II Chapter 3 Unity of Invention" and 3. in "Part IV Chapter 3 Amendment Changing Special Technical

Feature of Invention" (Article 17bis(4)) is defined as the subject of search by the examiner.

(Note) With regard to the claimed invention whose matters for specifying the invention (in this part, hereinafter referred to as "matters specifying the invention" throughout this Part) are expressed in the form of alternatives, the term "claimed invention" refers to the invention that is recognized from the alternatives. The same applies to the subsections 2 and 3 of this section.

## 2.2 Matters to be considered in deciding subject of search

(1) The examiner takes into consideration the embodiments of the claimed invention as the subject of search.

(2) The examiner takes into consideration the matters reasonably expected to be added to claims by an amendment as the subject of search in view of the efficiency of the procedures until a decision to grant a patent is rendered.

## 2.3 Invention that may be excluded from the subject of search

Inventions that fall under any one of the following cases (i) to (vi) (in this part, hereinafter referred to as the "subject of exclusion" throughout this Part) may be excluded from the subject of prior art search.

However, with regard to the inventions for which the examination of requirements other than Article 37 and Article 17bis(4) is to be conducted, the examiner should give due consideration such that the least number of inventions are excluded from the subject of the prior art search.

(i) Invention to which new matters have been clearly added (non-compliance with the requirements of Article 17bis(3))

(ii) Invention clearly directed to a category of unpatentable invention (violation of the provisions of Article 32)

(iii) Invention clearly not falling under the "invention" defined in Article 2 or invention clearly not industrially applicable (violation of the provisions of the main paragraph of Article 29(1))

(iv) Claimed invention whose statement is so unclear that the invention cannot be recognized even by taking into consideration the detailed description of the invention, drawings and common general technical knowledge as of the filing (non-compliance

with the requirements of Article 36 (6)(ii)

(v) In a case where it is obvious that the statement in the detailed description of the invention is unclear or insufficient for a person skilled in the art to carry out the claimed invention, the invention directed to the part that cannot be carried out by the person skilled in the art due to unclear or insufficient statement in the detailed description of the invention (non-compliance with the requirements of Article 36 (4)(i))

(vi) In a case where it is obvious that the claimed invention exceeds the extent of disclosure in the description to which a person skilled in the art would recognize that a problem to be solved by the invention, the invention directed to the part that “exceeds the extent of disclosure in the detailed description of invention” (non-compliance with Article 36(6)(i))

### 2.3.1 Points to note

(1) Even when the invention falls under the subject of exclusion from the prior art search due to clerical errors or minor deficiencies in the recitations of the claims, the examiner conducts the prior art search on the basis of the recognized invention as long as the invention that is not the subject of the exclusion can be recognized in light of the detailed description of the invention, drawings, or common general technical knowledge as of the filing.

(2) Even when the invention falling under the subject of exclusion from the prior art search, the examiner conducts the prior art search on the basis of the reasonably expected invention when it is reasonably expected that the invention will be excluded from the subject of exclusion as a result of any amendment changing the categories of invention or minor amendment to the statement in the claim.

(3) The examiner must not apply the above type (iv) to a case where the invention can be clearly recognized in light of the detailed description of the invention, drawings or common general technical knowledge as of the filing.

#### (i) Examples of inappropriate exclusion from the subject of search)

(i-1) A case where the claimed invention is not described in the detailed description of the invention due to a clerical error but the invention(s) not to be excluded from the subject of the prior art search can be correctly recognized in light of the description, drawings or common general technical knowledge as of the filing.

Example 1:

[Claim]

"An automatic brake system characterized by the fact that automatic braking control is performed in response to a distance  $d$  between a traveling own vehicle and a preceding traveling vehicle satisfying the following condition:

$d \geq th(v)$  wherein  $th(v)$  is a threshold determined in accordance with a speed of the own vehicle."

[Detailed description of the invention)

It is described that control of automatic braking is performed when  $d \leq th(v)$  is satisfied.

(Explanation)

Since the direction of the inequality symbol of the claimed invention is different from that described in the detailed description of the invention, the recitation of the claimed invention is in appearance not described in the detailed description of the invention. However, it is found that the inequality symbol in the claim is a clerical error taking into account the statements of the detailed description of the invention as well as the common general technical knowledge as of the filing that the automatic braking control is carried out in response to the distance between the own vehicle and the preceding vehicle becoming equal to or less than a predetermined distance, so that the symbol should correctly be read as  $d \leq th(v)$ . Accordingly, the claimed invention is so recognized as such and the prior art search is conducted on the basis of the above.

(i-2) A case where the claimed invention is not an industrially applicable invention but the examiner can reasonably expect that the claimed invention be modified into an invention that is not to be excluded from the subject of prior art search.

Example 2:

[Claim]

"A method of treatment of disease A of humans using a pharmaceutical containing ... as an active ingredient."

(Explanation)

Since the claimed invention is a method of treating humans, it is not an "industrially applicable invention." However, it is reasonably expected that the claimed invention will be modified into an invention that is not the subject of exclusion from the prior art search by virtue of an amendment changing the categories of invention, such as "A pharmaceutical for treatment of disease A containing ... as an active ingredient." Therefore the examiner recognizes the claimed invention as such and conducts the prior art search based on the above finding.

(i-3) A case where the claimed invention is not clear but can be recognized in light of the detailed description, drawings or common general technical knowledge as of the filing.

Example 3:

[Claim]

"A hybrid car whose energy efficiency during electric traveling is from a% to b% wherein the energy efficiency is measured by an X test method."

(Detailed description of the invention)

The detailed description of the invention only describes a hybrid car including a controller that performs Y-control for a belt type continuously variable transmission, and it is stated therein that the energy efficiency of the hybrid car during electrical traveling falls within the range from a% to b% when the energy efficiency is measured using the X test method. Also, the belt type continuously variable transmission is a more specific concept of the continuously variable transmission, and it is described in the description that the controller performing the Y-control may be adopted in any continuously variable transmissions other than the belt type. The definition of the X test method is also provided in the description.

(Explanation)

Even when the invention cannot be clearly recognized though the terms described in the claims are interpreted taking into account the description, drawings as well as common general technical knowledge as of the filing, it can be recognized, in light of the description, that the claimed invention is at least directed to a hybrid car comprising a controller performing Y-control for the continuously variable transmission, wherein the energy efficiency of the hybrid car falling within the range of a% to b% during electrical traveling wherein the energy efficiency is measured using the X test method. Accordingly, the claimed invention is so recognized in the prior art search and subjected to the search.

(ii) Examples of excludable subjects from the subjects of search

(ii-1) A case where the claimed invention is unclear and cannot be recognized even in light of the detailed description, drawings as well as common general technical knowledge as of the filing.

Example 4:

[Claim]

"An invention as described in the description."

(Premise)

The examiner cannot recognize what kind of invention is specifically intended by the recitation of the claim even when the description, drawings as well as common general technical knowledge as of the filing are taken into account.

(Explanation)

Given the above recitation of the claim, the claim language is not sufficiently clear to the extent that the invention can be clearly recognized even when the statement of the description and drawings or are taken into account. Also, an amendment that would take the claimed invention out of the range of subject of exclusion cannot be reasonably expected. Accordingly, the above claim may be treated as the subject of exclusion.

Example 5:

[Claim]

"My invention which is worth one million dollars"

(Premise)

The examiner cannot recognize what kind of invention is specifically intended by the recitation of the claim even when the description, drawings as well as common general technical knowledge as of the filing are taken into account.

(Explanation)

Given the above recitation of the claim, the claim language is not sufficiently clear to the extent that the invention can be clearly recognized even when the description, drawings as well as common general technical knowledge as of the filing are taken into account. Also, an amendment that would take the claimed invention out of the range of subject of exclusion cannot be reasonably expected. Accordingly, the above claim may be treated as the subject of exclusion.

### 3. Prior Art Search

The examiner conducts the prior art search taking note of the examination guidelines regarding novelty (Article 29(1)), inventive step (Article 29(2)), secret prior art (Article 29bis) and prior application (Article 39) (see "Part III Chapter 2 Novelty and Inventive Step" to "Part III Chapter 4 Prior Application") and attempts to exhaustively find relevant prior art.

#### 3.1 Procedures of prior art search

### 3.1.1 Points to note in conducting prior art search

(1) Where information on prior art documents related to the claimed invention is disclosed in the detailed description of the invention, the examiner should consider the content of the prior art documents before the prior art search.

With regard to the requirements for disclosure of information on the prior art documents (Article 36 (4)(ii)), see "Part II Chapter 1 Section 3 Requirements for Disclosure of Information on Prior Art Documents."

(2) Where search results and examination results of any foreign patent office, a report on search results by any registered search organization, and any information made available by the submission of information by third parties can be confirmed with regard to the application concerned, the examiner should consider and effectively utilize the content of the search report and the results of examination, etc.

### 3.1.2 Methodology of prior art search

(1) Among all documents falling in the relevant technical fields to which each of the claimed inventions pertains (domestic and foreign patent literatures (including those for which international publication has been effected) and domestic and foreign non-patent literatures), the examiner should, because of financial reasons of the prior art search, conduct search of a certain range of documents which the examiner, based on his knowledge and experience, expects and determines that the relevant prior art documents will probably be found in.

(2) The examiner should first search the technical fields in which it is most probable to find relevant prior art documents related to the claimed invention. In general, it is appropriate for an examiner to start the prior art search with the most closely relevant technical fields to the working examples disclosed in the detailed description of the invention, and gradually extends the search to less relevant technical fields.

(3) Whether or not the search should be extended from highly relevant technical fields to less relevant fields should be determined by the examiner with the already obtained search results taken into consideration. Where adequate prior art for reasonably denying novelty or inventive step could not be found as the result of the search of the highly relevant fields, the scope of search should be extended by the examiner to these fields if

it is most likely that the prior art documents denying novelty or inventive step are found as the result of the search of less relevant technical fields.

(4) It may be revealed in the course of the prior art search that what was considered to be the subject of search at the beginning of search does not need to be treated as the subject of search (see "Part II Chapter 3 Unity of Invention " and "Part IV Chapter 3 Amendment Changing Special Technical Feature of Invention"). Accordingly, the examiner should evaluate the results of the search as appropriate and, if necessary, redefine the subject of search.

### 3.1.3 Completion of prior art search

The examiner conducts the prior art search for the invention recited in the claim set taking into account the matters that are reasonably expected to be introduced by an amendment. When a highly relevant prior art documents, etc. are obtained, or when it is determined that the probability that the more significant relevant prior art documents, etc. are found in the scope of the search became extremely low, then the examiner may conclude the prior art search (Note).

In addition, when any prior art document has been found that, alone without combination with any other document, denies novelty or inventive step of the claimed invention and the embodiments thereof, the examiner may conclude the prior art search with regard to the claim in question.

However, when the prior art search can be conducted for other embodiments without undue burden of search, it is desirable that the examiner further continues the prior art search.

(Note) In the examination of a certain patent application regarding chemical substances, the claim of a chemical substance expressed by Markush form may be unduly broad and various embodiments may be included, so that prior art search for all of the subjects of search is extremely difficult without necessitating undue burden of search. In this case, the examiner may conclude the prior art search if it falls under either of the following items (i) and (ii) on the assumption that all prior art search within the scope which does not cause undue burden of search has been completed.

In this case, when a reason for refusal is to be notified, the examiner states in the notice of reason for refusal that the prior art search has been concluded without searching all of the subjects



of search and indicates the range of prior art search that has been conducted in the section "Record of the Results of Prior Art Documents Search."

- (i) At least one prior art document denying its novelty, inventive step etc. has been found regarding at least one of the chemical substance groups expressed in the form of alternatives recited in claims including the chemical substances described as embodiments (a group of chemical substances expressed by specific alternatives corresponding to the embodiments).
- (ii) Prior art search has been conducted for all chemical substance groups expressed in the form of specific alternatives corresponding to the above embodiments, and at least one prior art document denying novelty, inventive step etc. of the claimed invention has already been found by the prior art search of the chemical substance groups expressed by alternatives other than the above alternatives.

### 3.2 Record of search results of prior art documents

When notifying a notice of reasons for refusal after the first prior art search, the examiner should state the technical field(s) subjected to the prior art search in the section "Record of Results of Prior Art Document Search."

With regard to the technical field(s) for which the prior art search has been conducted, the examiner should indicate the code or the like of the international patent classification (IPC), etc. that indicates the range subjected to the prior art search.

In addition, where there is prior art that does not constitute the reasons for refusal but is considered to be useful, for example, as a prior art document that may serve as reference information for the applicant to file an amendment, the examiner may additionally record the information on this document.

## 4. Determination of Novelty, Inventive Step, etc.

The examiner, after the prior art search, renders determination concerning whether or not the prior art described in the prior art documents found in the search constitutes a reason for refusal against the claimed invention regarding novelty, inventive step, etc.

The dates of publication of prior art documents etc. are very important to constitute the reasons for refusal. The examiner must confirm the relationship between

the date of publication of each of the prior art documents, etc. and the filing date (or the priority date) of the application concerned in the examination on novelty and inventive step.

Also, when considering application of the provision of secret prior art (Article 29bis), the examiner must confirm the relationship between the filing date of the application concerned and the filing date and publication date of the prior application and confirm whether or not the inventor and the applicant of the prior application are identical with those of the application concerned. When considering application of the provision of prior application (Article 39), the examiner must confirm the relationship between the filing date of the application concerned and the filing date of the prior application.

With regard to specific methodology of determination of novelty, inventive step, etc., see "Part III Chapter 2 Novelty and Inventive Step" to "Part III Chapter 4 Prior Application."

#### 5. Prior Art Search When the Written Opinion, Written Amendment, etc. are Submitted

When it is determined that the scope of search of the prior art search that was already conducted has become insufficient in view of an amendment made to the description, etc. or a written opinion submitted in response to a notice of reason for refusal, the examiner conducts further prior art search.

The examiner does not need to conduct further prior art search in response to submission of a written opinion, written amendment, etc. when the examination can be continued without conducting further prior art search.

#### 6. Points to Note

(1) A case where, with regard to overseas-related applications (Note), highly relevant prior art documents are included in the search results or examination results by a foreign patent office

In this case, the examiner should take into account the prosecution history and examination results at the foreign patent office (specifying the cited invention, contents of the reason for refusal, final result of examination, recitations of the claim for which a patent was granted) and considers whether or not any content of the prior art documents constitutes a reason for refusal of the claimed invention in terms of novelty, inventive

step, etc. In this case, the examiner should take notice of the differences between the Japanese examination system and practice and those of the foreign country.

(Note) The term "overseas-related applications" refers to any application falling under either of the following items (i) and (ii).

- (i) An application seeking grant of a patent for an invention for which the applicant also filed any patent application in any patent office or intergovernmental organization other than Japan Patent Office
- (ii) An application related to an international application (domestic application serving as the basis of priority claim in an international application, international application that entered the national phase, etc.)

(2) A foreign language application, PCT application in foreign language, and official gazette thereof are subjected to the prior art search (for the foreign language application and PCT application in foreign language, see "Part VII Foreign Language Written Application" and "Part VIII International Patent Application" respectively).

It is highly probable that the description, claims, or drawings of the foreign language document of a foreign language application or a PCT application in foreign language (in this part, hereinafter referred to as "the foreign language document, etc.") coincide with the content of their translation. Accordingly, it is usually considered to be sufficient for the examiner to search only the portion translated into Japanese.

However, if any doubt arises that some differences exist between the translated portion and the statement of the foreign language document, etc., it is necessary to expand the scope of search to the foreign language document, etc.