

“The Industrial Property Rights System in Japan”

Chapter 2. The Patent System and Utility Model System

Inventive Step

An invention that can easily be conceived by a person with ordinary knowledge in the same technical field is not considered to represent an “inventive step”.

For example, inventions that are simply an aggregation of other publicly known inventions, feature just slight structural modifications with no advantageous effect, or that could easily be created by anyone, are regarded as lacking an inventive step and will not be granted patent rights. The “Inventive step” is an important examination requirement.

Now let’s consider some test cases.

A yacht and a motorboat are publicly known products. Can a “motor yacht” that combines those two technologies be regarded as an “inventive step”?

In this case, it’s regarded as *not* having an “inventive step” because it’s just an aggregation of publicly known technologies.

Well then, what about the invention of a motor yacht which has a digital anemometer installed that automatically changes between use of the sail and the motor according to the wind speed?

If the same technical idea cannot be found in existing technologies, then this can be considered to involve an “inventive step”.

How about the case in which switching between use of the sail and the motor of a motor yacht is not controlled *automatically* but *manually* by a person observing a digital anemometer?

In this case, the examiners could make two possible decisions regarding its validity as an “inventive step”.

Some examiners might determine that it *does* involve an “inventive step” because no existing technology has included the installation of a digital anemometer.

Other examiners might determine that it does *not* involve an “inventive step” because anyone could come up with the idea of switching between use of a motor yacht’s sail and motor manually by observing a digital anemometer.

We've included these examples to help you understand the concept of an "inventive step". As you have seen, the presence of an inventive step cannot be determined unconditionally. The point is that the examination should be carried out by comparing the scope of claims of an invention with the existing technologies.

For that purpose, examiners need to possess a wide range of expertise, including the ability to fully comprehend the substance of the invention under examination and the ability to compare it with existing technologies.

It's important to foster such expertise in order to carry out examinations appropriately.