Outline

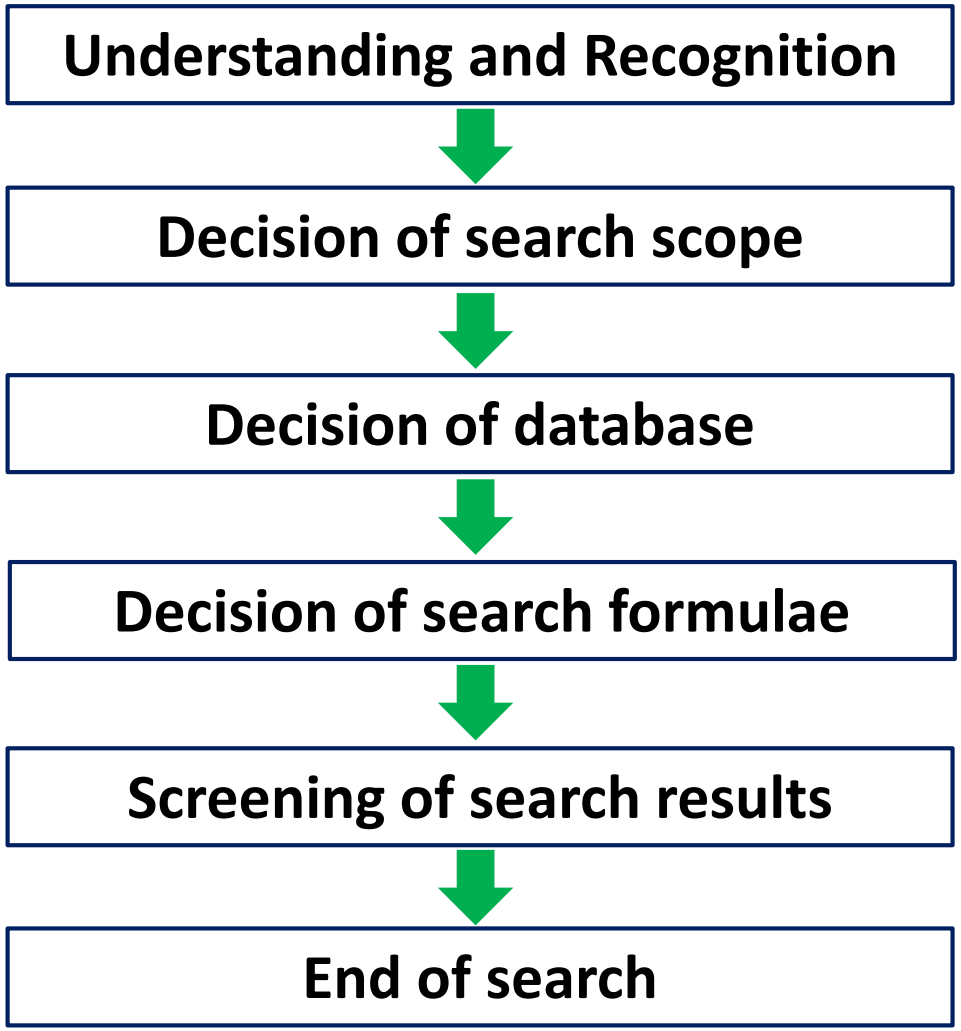
I. Basics of Prior Art Search

II. Search Strategy

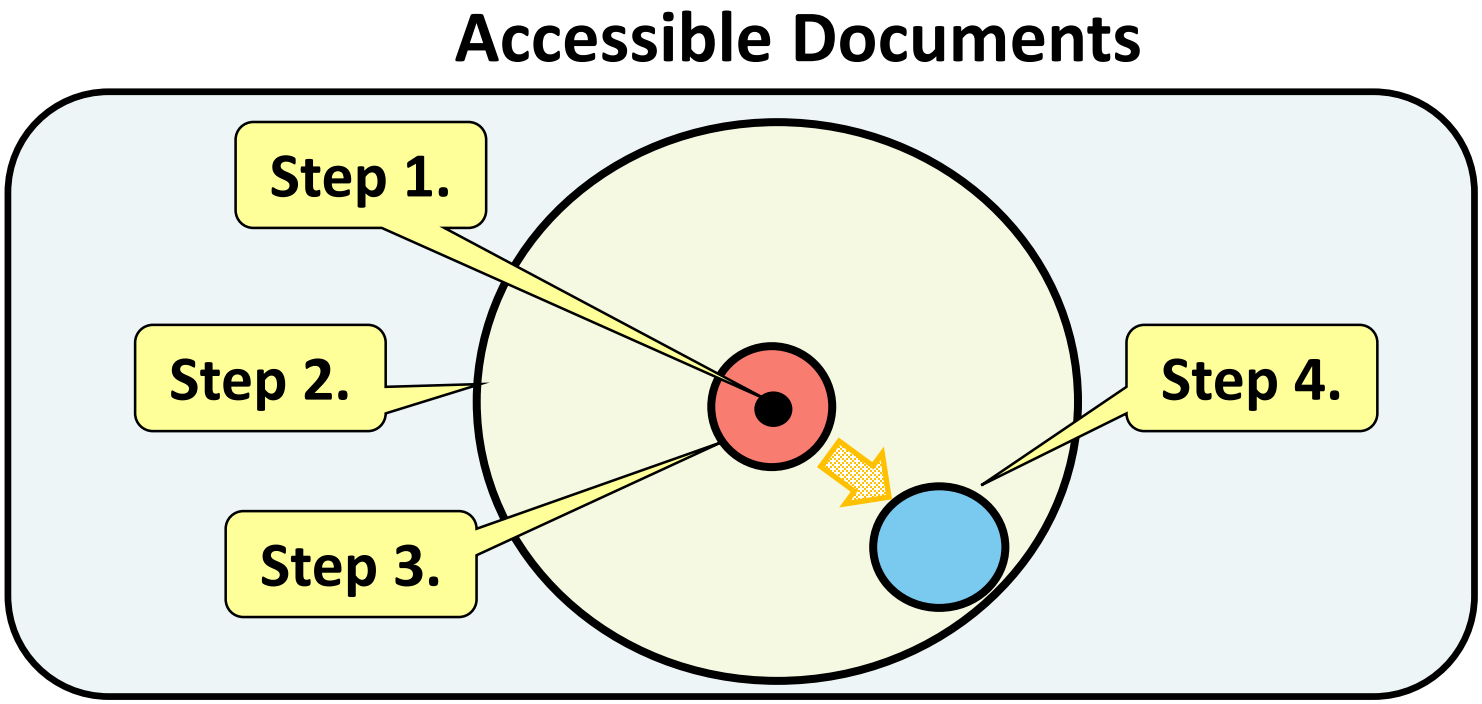
III. Search Tool - J-PlatPat

IV. Search Tool - PATENTSCOPE

A. Search Flow



B. Decision of search scope - 1/7



Step 1. Recognize an invention
Step 2. Determine outer border of search scope
Step 3. Determine search scope
Step 4. Change search scope

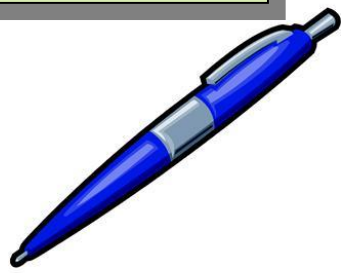
B. Decision of search scope - 2/7

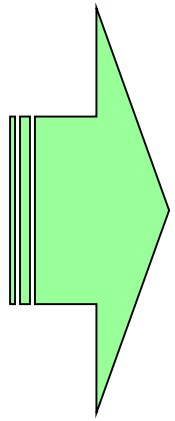
~ Step 3. Determination of search scope ~

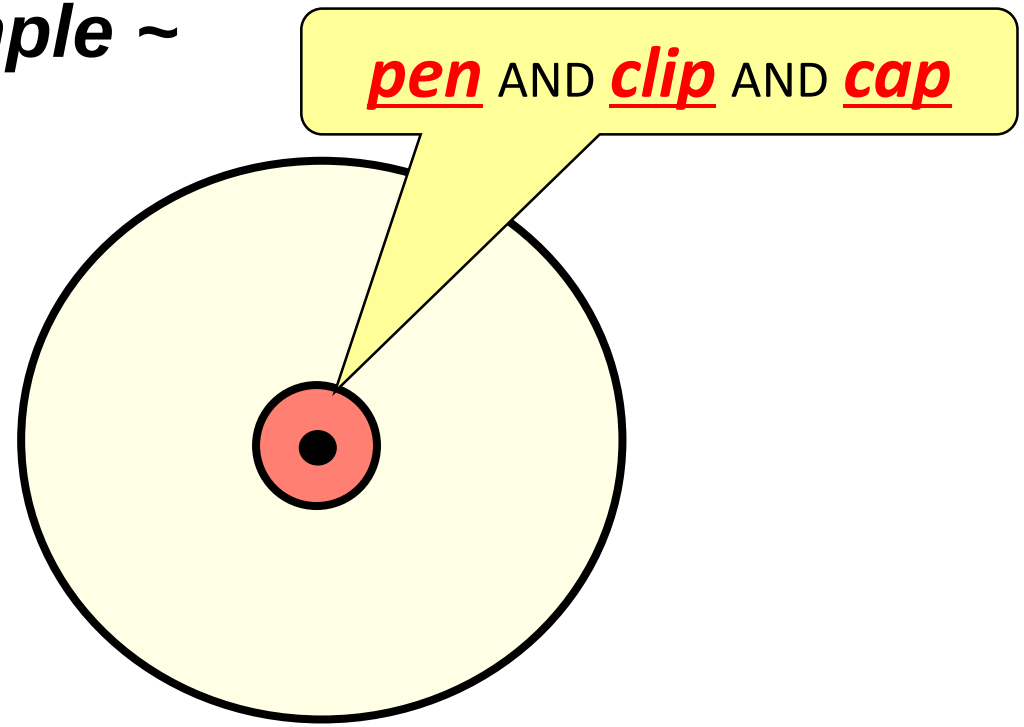
Search scope having all the elements of the claimed invention

~ Example ~

Claim
A pen having
a clip and a cap





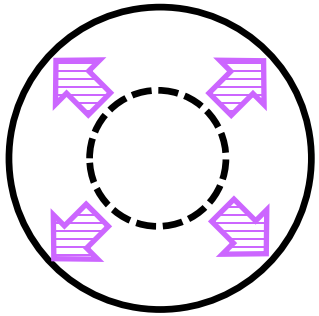


B. Decision of search scope - 3/7

~ Step 4. Change of search scope ~

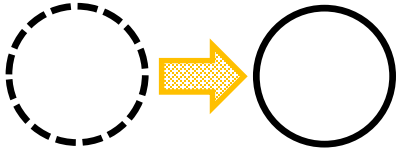
Expansion **or** ***Shift*** **of search scope**

Expansion



- ✓ Generalization of element(s)
- ✓ Deletion of element(s)

Shift



- ✓ Neighboring technical field(s)

B. Decision of search scope - 4/7

~ Step 4. 1. Expansion of search scope ~

Claim
A pen having
a clip and a cap

- ✓ Generalization of element(s)
  - ➢ ***A writing instrument*** having a clip and a cap
- ✓ Deletion of element(s)
  - ➢ A pen ***having a cap***
  - ➢ A pen ***having a clip***

B. Decision of search scope - 5/7

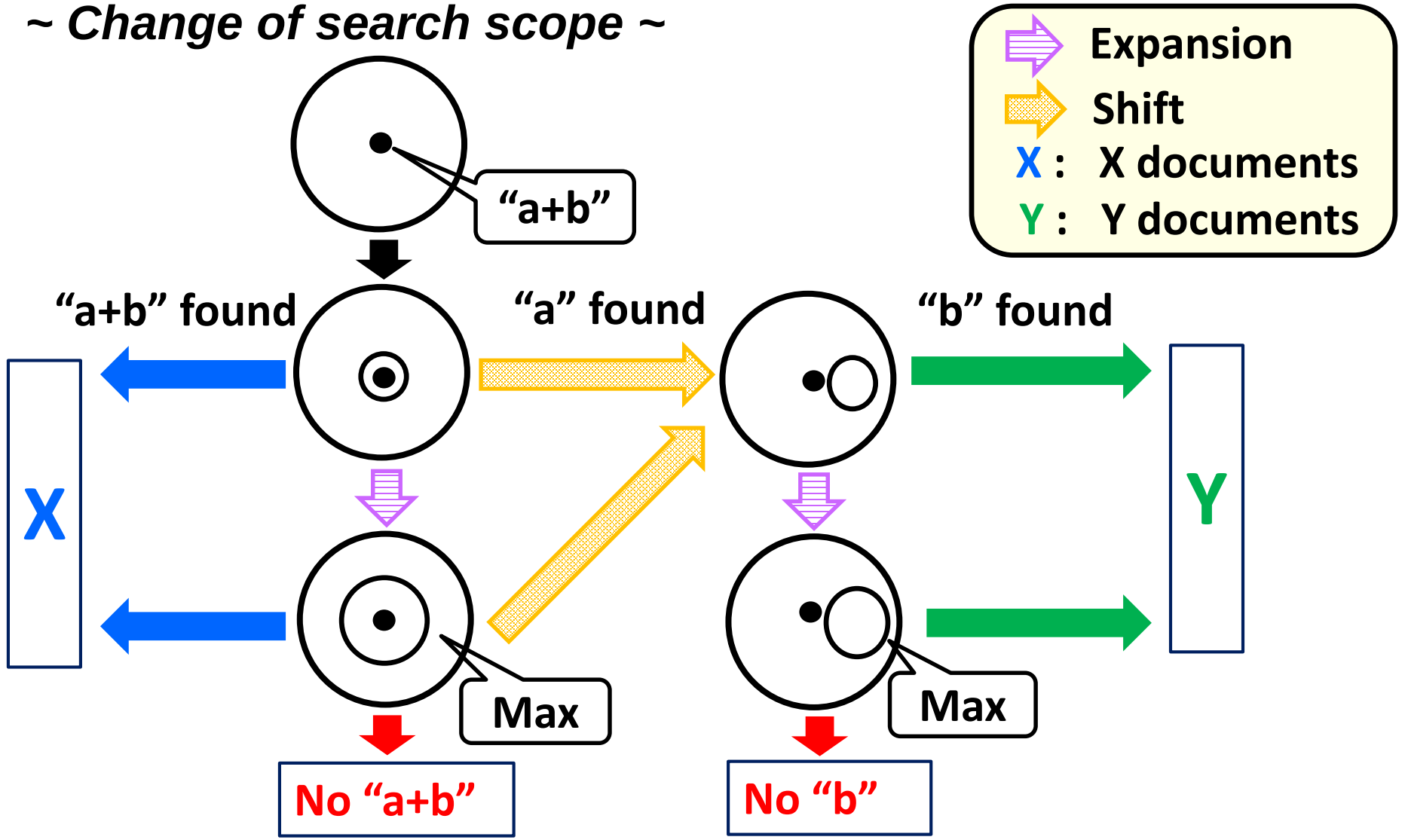
~ Step 4. 2. Shift of search scope ~

Claim
A pen having
a clip and a cap

- ✓ Neighboring technical field
  - ➢ ***An electronic stylus*** having a clip and a cap

B. Decision of search scope - 6/7

~ *Change of search scope* ~



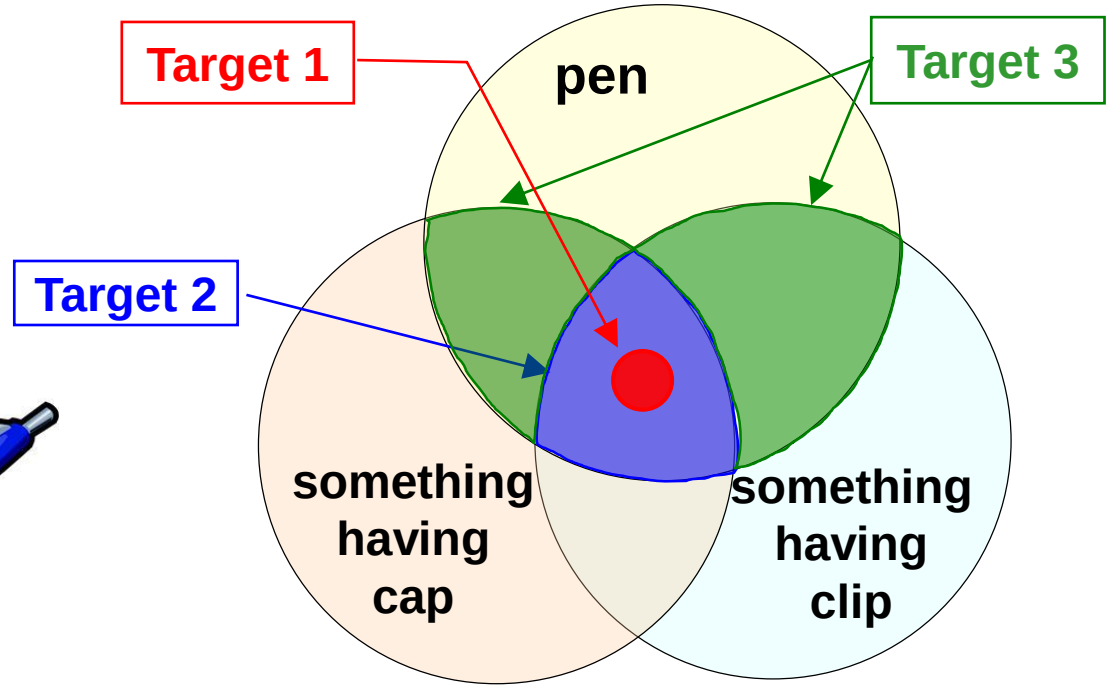
B. Decision of search scope - 7/7

~ *Tips for more efficient search* ~

Claim
A pen having
a clip and a cap

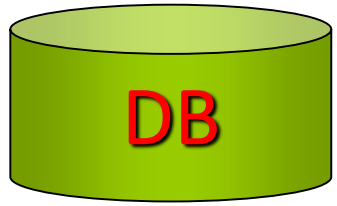
Embodiment
A *ball-point* pen
having a clip and
a cap

Target 1: A *ball-point* pen having a clip and a cap
Target 2: A pen having a clip and a cap
Target 3: A pen having a clip (prior art 1) and another pen having a cap (prior art 2)



C. Decision of database

~ How to select database ? ~



- Basic inventions and academic inventions of element(s)
  - **Patent Gazette**
  - Papers by using **Commercial DB** and **Internet**
- The fields where specific search tools have been established
  - **CAS** for compounds
  - **ICIREPAT** for metal alloys
- Improvement invention
  - **Patent Gazette**

D. Decision of search formulae - 1/3

- Search formulae are created based on **search scope** and **database**

- **Search scope** determines the ***contents*** of search formulae.
  - When search scope is "***pen*** AND ***clip*** AND ***cap***", search formulae can be "***(pen*clip*cap)/tx***".

- **Database** determines the ***description methods*** of search formulae.
  - When classification(IPC) is assigned to documents in the database, search formulae whose search scope is "***pen*** AND ***clip*** AND ***cap***" can be "***B43K9/00 * clip/tx***" (B43K9/00 : Cap for pen)

***Search formulae are described so as to be available in JPO's search system**

D. Decision of search formulae - 2/3

~ *Tips for keyword search* ~

Search formulae : ***(pen*clip*cap)/tx***

Claim
A pen having
a clip and a cap

- Synonym
  - ***(pen*[clip+pin]*cap)/tx***
    ("pin" is a synonym of "clip")
- Proximity
  - ***{pen,clip,cap},10n/tx***
    ("pen" and "clip" and "cap" are within 10 words)

***Search formulae are described so as to be available in JPO's search system**

D. Decision of search formulae - 3/3

~ Tips for classification search~

Claim
A pen having
a clip and a cap

- When classification is not available…
  - ***(pen*clip*cap)/tx***
- When IPC is available…
  - ***B43K9/00*clip/tx***

    (IPC　B43K9/00 : Cap for pen)
- When FI is available…
  - **B43K9/00@F**

    (FI　B43K9/00@F : Cap and clip for pen)

***Search form*ulae* are described so as to be available in JPO's search system**

E. Screening of search results - 1/3

Screening the documents

Prior-art documents are found

- Can the documents deny novelty, inventive step?
- Are the documents conflicting applications ?

Yes

End of search

No

Can any other useful documents be found ?

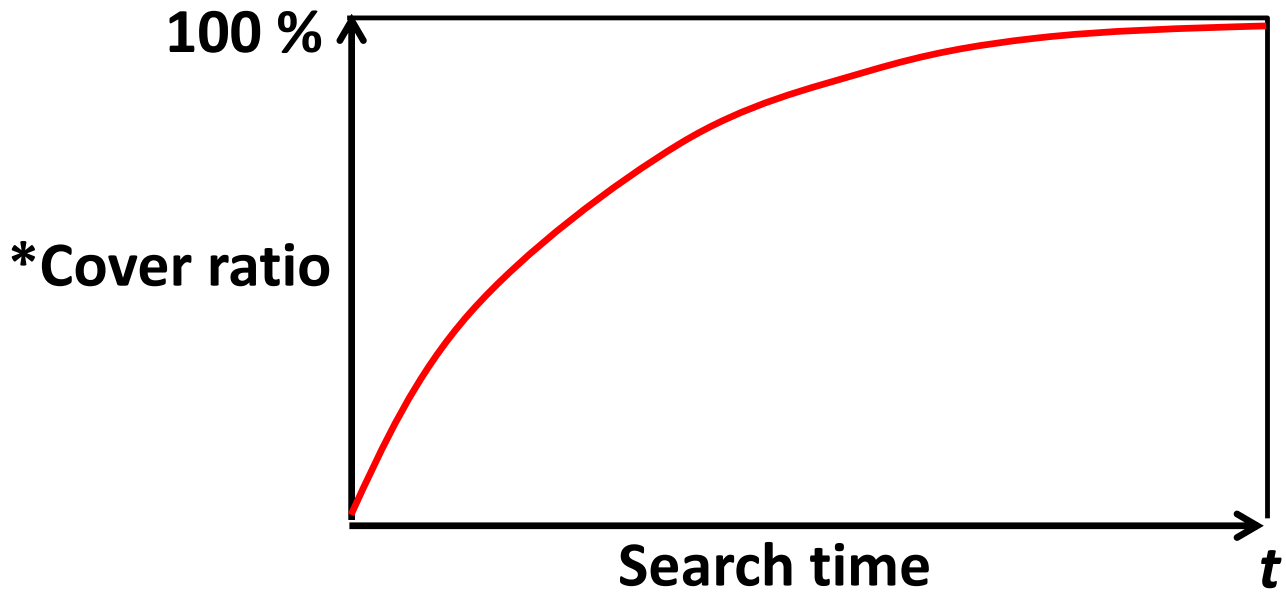
No

Yes

Review of search scope, database and search formulae

E. Screening of search results - 2/3

~ When do you finish prior art search ? ~



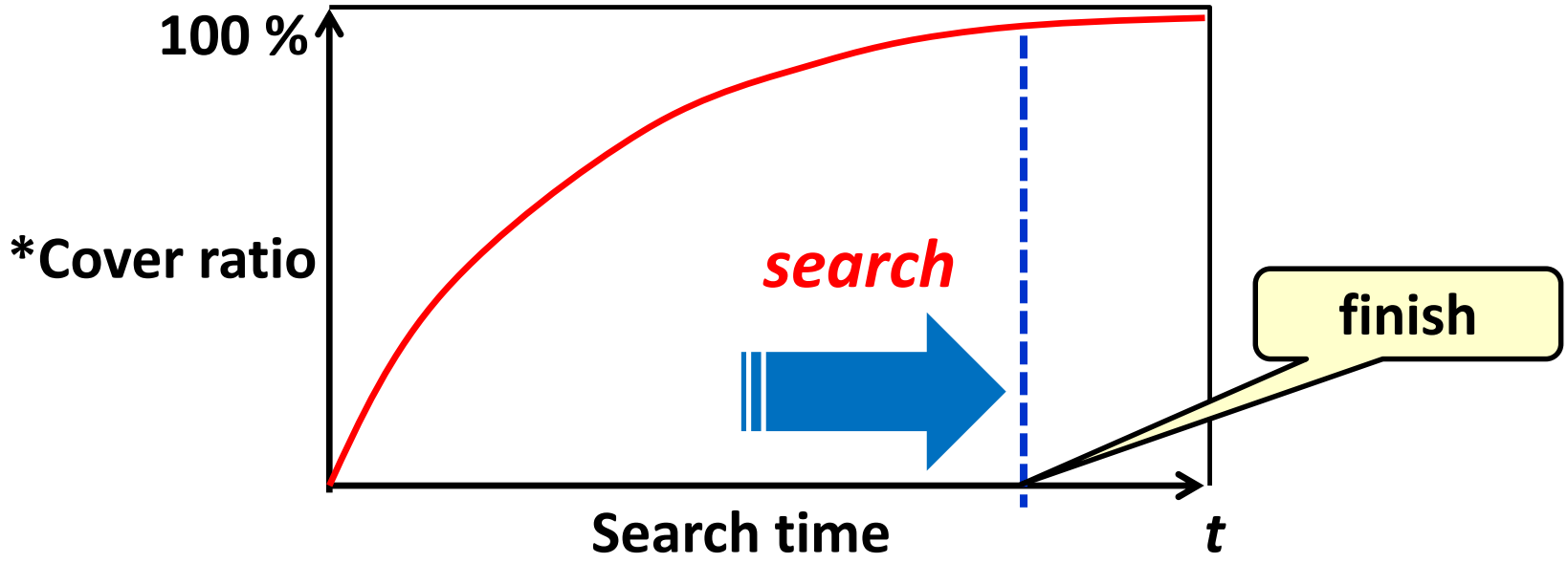
Cover ratio approaches 100 % as search time increases.

However, search time is limited for examiners…

***The percentage of documents you have searched within the outer border of the search scope**

E. Screening of search results - 3/3

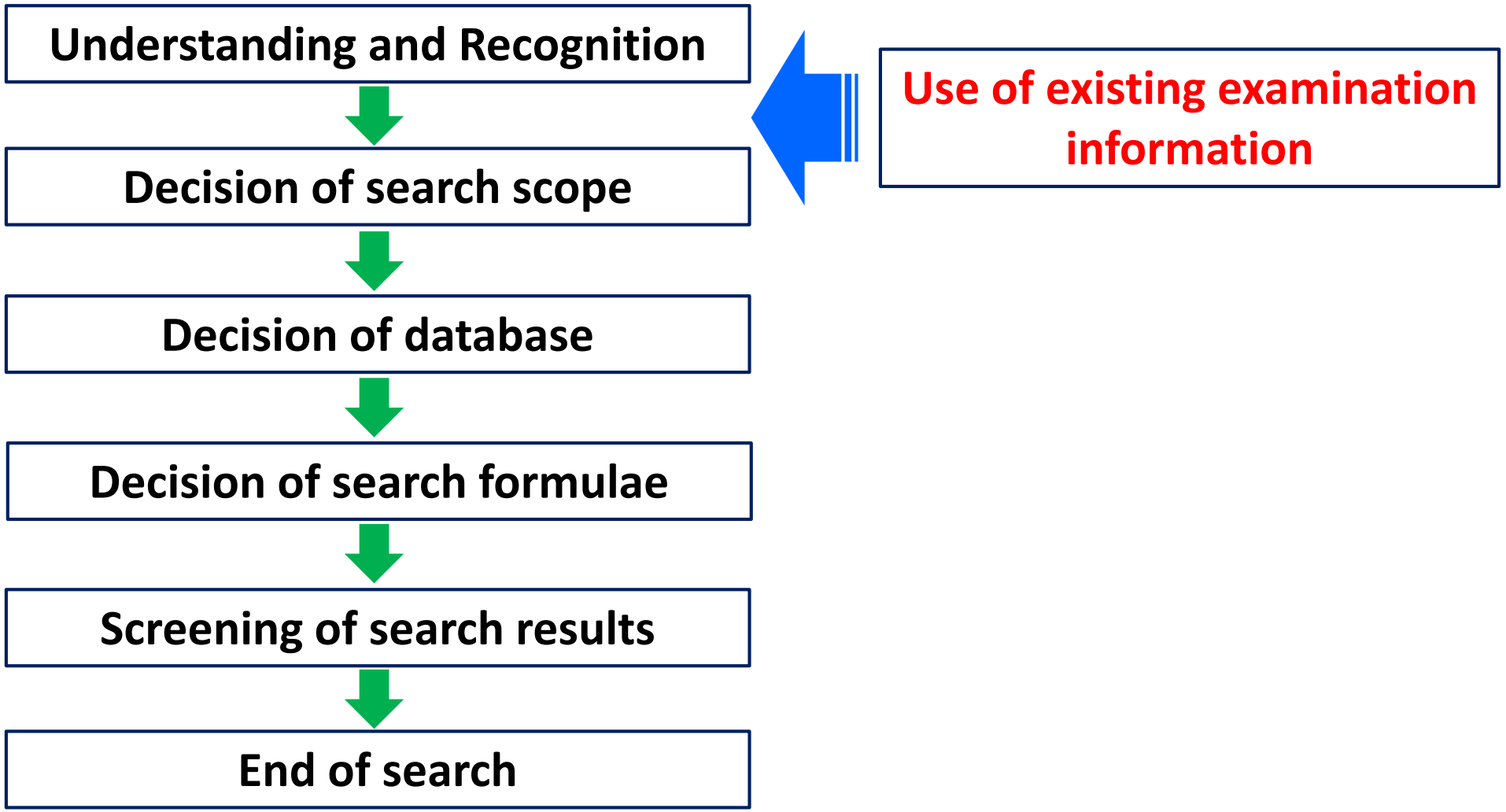
~ When do you finish prior art search ? ~



- Finish prior art search when an examiner judges that no more useful documents can be found.
  - ✓ The judgment is made based on the **examiners' knowledge and experience.**
  - ✓ Young examiners are recommended to consult with experienced examiners.

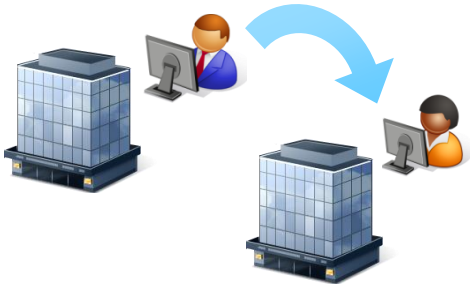
***The percentage of documents you have searched within the outer border of the search scope**

F. Use of existing examination information - 1/3

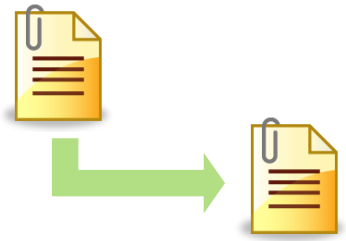


F. Use of existing examination information - 2/3

- Examination results of other patent offices
  - ISR
  - Examination results of JPO, EPO, …



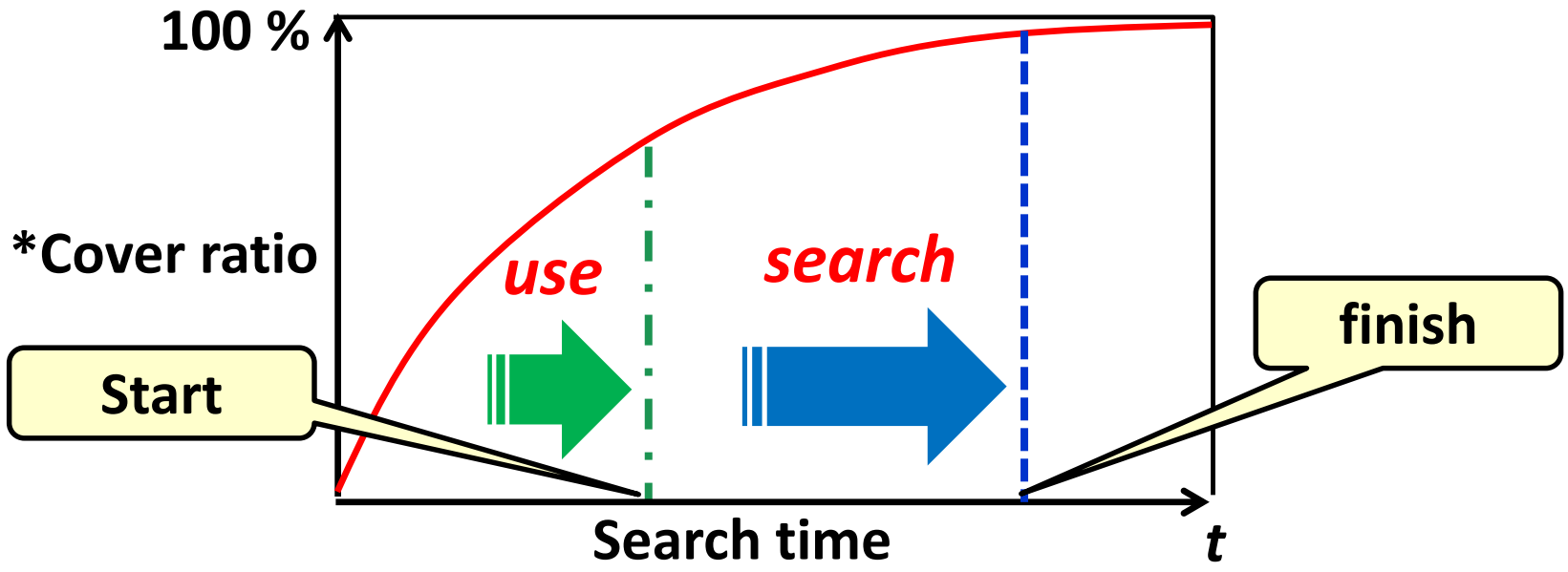
- Examination results of related applications
  - Divisional applications



- Miscellaneous

  Same inventors or applicants

F. Use of existing examination information - 3/3



■ Use of **existing examination information** can reduce search time

*The percentage of documents you have searched within the outer border of the search scope