

- I. Overview of Inventive Step
- II. Procedure of Evaluating Inventive Step
- III. Examination Guidelines in JPO**

The purpose of Japanese patent law is to contribute to the development of industry. (Japanese Patent Act, Article 1)

Question: What would happen if the invention which lacks an inventive step could be granted a patent?

Answer:

“...granting patent rights for inventions which a person skilled in the art would have been easily able to make does not promote the progress of the technology but rather prevents it.”

(JPO Examination Guidelines, Part III, Chapter 2, Section 2, 1.)

Detail of Determination of Inventive Step

(JPO Examination Guidelines, Part III, Chapter 2, Section 2, 3.)

1. Specifying the claimed invention
2. Selecting and specifying the most suitable prior art for the reasoning
3. Comparing the claimed invention and cited invention to find the correspondences and differences
4. Seeking reasons for denying the presence of an inventive step
5. Taking into consideration an advantageous effect
6. Determining existence of an inventive step

Novelty and Inventive Step

When an invention does not involve novelty → the examiner may consider the invention also does not involve an inventive step.

■ Basic practice of determination of an inventive step

- The examiner considers whether or not it could be reasoned that a person skilled in the art easily arrives at the claimed invention based on the prior art.
- The examiner assesses comprehensively various facts in support of the existence or non-existence of an inventive step.

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

Facts in support of the **non-existence** of an inventive step

- Motivation for applying a secondary prior art to a primary prior art
 - (1) Relation of technical fields
 - (2) Similarity of problems to be solved
 - (3) Similarity of operations or functions
 - (4) Suggestions shown in the content of prior art?
- Design variations of primary prior art
- Mere aggregation of prior art

Facts in support of the **existence** of an inventive step

- Advantageous effects
- Obstructive factor
Example: It is contrary to the purpose of the primary prior art to apply the secondary prior art to the primary prior art.



Main factors for reasoning



Novelty and Inventive Step

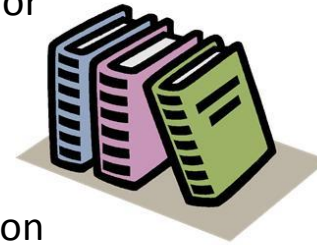
< Facts in support of the non-existence of an inventive step >

■ Motivation for applying a secondary prior art to a primary prior art

- (1) “Relation” of technical fields (2) “Similarity” of problems to be solved (Note1) (3) “Similarity” of operations or functions → Relation or similarity between a primary prior art and a secondary prior art

(Note 1) Similarly to the previous edition of the guidelines, a problem to be solved obvious to a person skilled in the art is also included.

- The examiner considers comprehensively four points of view which can be a motivation of invention (the above (1)-(3) and (4) (Suggestions shown in the content of prior art)), and determines whether or not motivation involves.
 - It is not always possible for the examiner to determine whether or not motivation is supported by paying attention to only one of these points of view.



~ Relation of technical fields ~

- The examiner should consider other points of view such as “Similarity of problems to be solved” at the same time when considering “Relation of technical fields”.

Novelty and Inventive Step

< Facts in support of the existence of an inventive step >

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.2.1

■ Advantageous effects

- The advantageous effects over the prior art satisfies the following condition (i) or (ii) and exceeds what is predictable based on the state of the art, they should be considered as factors in support of the existence of an inventive step.
 - (i) The claimed invention has an effect different from that of the prior art and a person skilled in the art is not able to expect the effect.
 - (ii) The claimed invention has an effect of the same nature but significantly superior to that of the prior art.

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.2.2

■ Obstructive Factors

- For example, the situations showing below which obstruct application of a secondary prior art to a primary prior art are regarded as the factors which prevent reasoning (obstructive factor) and support an inventive step.
 - (i) The secondary prior art applied to the primary prior art cannot achieve the purpose of the primary prior art.
 - (ii) The secondary prior art applied to the primary prior art cannot adequately function.
 - (iii) The secondary prior art which is considered to be excluded from application and unable to be adopted by the primary prior art.
 - (iv) The secondary prior art which a person skilled in the art would not apply due to a publication disclosing that the secondary prior art is inferior to the other embodiment in respect of operations and effects of the prior art.

Novelty and Inventive Step

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(1)

■ Notes for determining an inventive step (1)

- ☐ The examiner should take note of the avoidance of hindsight such as below:
 - I. The examiner assumes that a person skilled in the art would have easily arrived at the claimed invention.
 - II. The examiner understands that a cited prior art is approximate to the claimed invention.

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(2)

■ Notes for determining an inventive step (2)

- ☐ Primary prior art

The examiner usually selects a primary prior art which is same or close to the claimed invention in respect of the technical fields or the problems to be solved.
- ☐ When the technical field or problem to be solved of the selected primary prior art is considerably different from that of the claimed invention, the examiner should take note that it is likely to make the reasoning difficult.

The examiner needs to reason more deliberately for the fact that a person skilled in the art can easily arrive at the claimed invention starting from the primary prior art.



Novelty and Inventive Step

■ Notes for determining an inventive step (3)

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(3)

- The examiner should not omit to consider the reasoning (considering such as whether or not there is a factor teaching away from applying the well-known art) only because the cited prior art is well-known.

■ Notes for determining an inventive step (4)

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(6)

- The examiner may consider commercial success and the fact that the invention had been desired to achieve for a long time as a secondary consideration for supporting an inventive step.

Only if the examiner is convinced that these facts are not derived from other factors such as sales promotion techniques or advertisements but from the technical features of the claimed inventions on the basis of the applicant's arguments and evidences.



Detail of Determination of Inventive Step

(JPO Examination Guidelines, Part III, Chapter 2, Section 2, 3.)

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Novelty and Inventive Step

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(1)

■ Notes for determining an inventive step (1)

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 - I. The examiner assumes that a person skilled in the art would have easily arrived at the claimed invention.
 - II. The examiner understands that a cited prior art is approximate to the claimed invention.

JPO Examination Guidelines
Part III, Chapter 2, Section 2, 3.3(2)

■ Notes for determining an inventive step (2)

- ☐ Primary prior art
The examiner usually selects a primary prior art which is same or close to the claimed invention in respect of the technical fields or the problems to be solved.
- ☐ When the technical field or problem to be solved of the selected primary prior art is considerably different from that of the claimed invention, the examiner should take note that it is likely to make the reasoning difficult.
The examiner needs to reason more deliberately for the fact that a person skilled in the art can easily arrive at the claimed invention starting from the primary prior art.

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JPO Examination Guidelines
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■ Notes for determining an inventive step (4)

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Only if the examiner is convinced that these facts are not derived from other factors such as sales promotion techniques or advertisements but from the technical features of the claimed inventions on the basis of the applicant's arguments and evidences.