

Inventive Step

Japan Patent Office

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

I. Overview of Inventive Step

II. Procedure of Evaluating Inventive Step

III. Examination Guidelines in JPO

A claimed invention is considered to involve an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art. (PCT guidelines 13.01)

Who is “a person skilled in the art”?

A hypothetical person having ordinary skill in the art, who is aware of common general knowledge in the art at the relevant date, and has access to everything in the prior art. (PCT guidelines 13.11)



What is “obvious”?

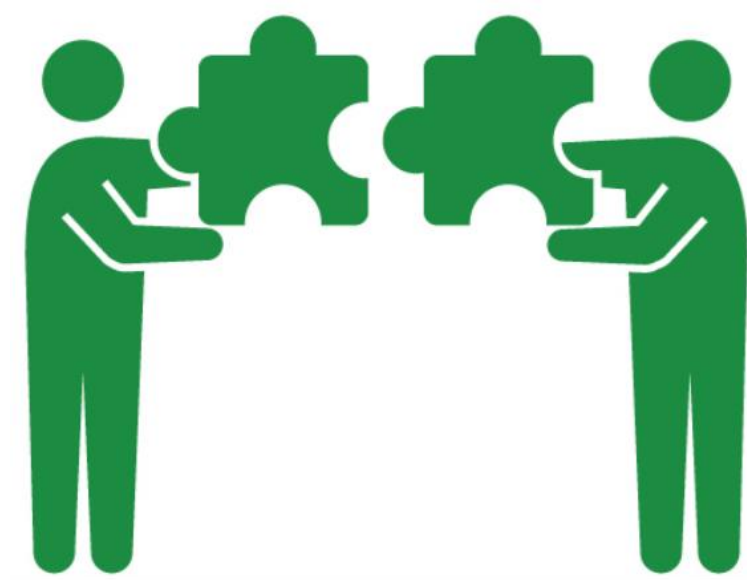
The claimed invention is obvious if the person skilled in the art on the relevant date would have been motivated or prompted to realize the claimed invention by substituting, combining, or modifying one or more of those items of prior art with a reasonable likelihood of success. (PCT guidelines 13.03, 13.09)

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

II. Procedure of Evaluating Inventive Step

Considering whether or not the claimed invention would have been obvious to the skilled person

In considering whether there is an inventive step as distinct from novelty, it is permissible to combine the teachings of two or more prior art references only where such combination would be obvious to the person skilled in the art.(PCT guidelines 13.12)



II. Procedure of Evaluating Inventive Step

Procedure of determining inventive step(PCT guidelines 13.08)

(1) Determination of the claimed invention



(2) Determination of the closest prior art



(3) Identification of the difference(s) between the claimed invention and the closest prior art

Same procedure
as for evaluating
novelty

↓ identical

The claimed invention
lacks novelty

↓ different

(4) Considering whether or not the claimed invention would have been obvious to the skilled person

↓ obvious

The claimed invention
lacks an inventive step

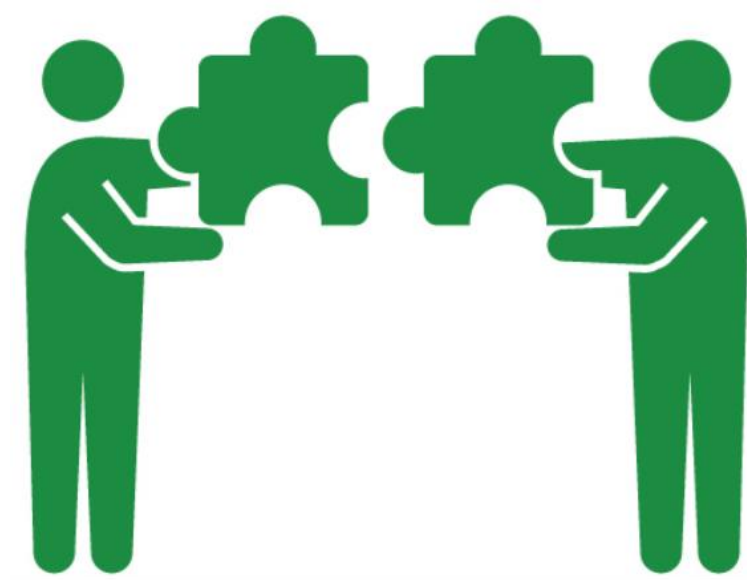
↓ not obvious

The claimed invention
involves an inventive step

II. Procedure of Evaluating Inventive Step

Considering whether or not the claimed invention would have been obvious to the skilled person

In considering whether there is an inventive step as distinct from novelty, it is permissible to combine the teachings of two or more prior art references only where such combination would be obvious to the person skilled in the art.(PCT guidelines 13.12)



Examples of motivation to combine prior art references

- Whether the documents come from similar or neighboring technical fields and, if not, whether the documents are reasonably pertinent to the particular problem with which the invention was concerned. (PCT guidelines 13.12 (ii))
- It would, generally speaking, also be obvious to combine the teachings of two documents, one of which contains a clear and unmistakable reference to the other. (PCT guidelines 13.13)
- It would normally be obvious to combine with other prior art documents with a well-known textbook, or a standard dictionary. (PCT guidelines 13.13)

II. Procedure of Evaluating Inventive Step

Examples of cases where the claimed invention should be regarded as obvious

- The claimed invention resides in the choice of particular parameters from a limited range of possibilities, and it is clear that these parameters or workable ranges were encompassed by the prior art and could be arrived at by routine trial and error or by the application of normal design procedures.(PCT guidelines 13.14(e) (ii)) (e.g., design modification)
- The claimed invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.(PCT guidelines 13.14(e) (iii)) (e.g., range of number)
- The claimed invention is merely a juxtaposition of features, that is, there is no functional relationship between the features.(PCT guidelines 13.05) (e.g., simple aggregation)

- 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

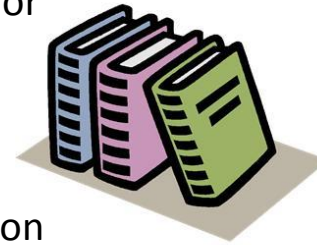
< Facts in support of the non-existence of an inventive step >

■ 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)

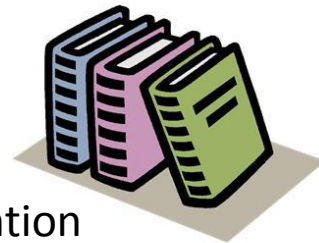
- The examiner should not omit to consider the reasoning (considering such as whether or not there is a factor teaching away from applying the well-known art) only because the cited prior art is well-known.

■ 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.)

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

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.

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

■ Notes for determining an inventive step (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.

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

■ Notes for determining an inventive step (4)

- ☐ 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.