

Writing of Reasons for Refusal

Japan Patent Office

Contents

1. Principle of writing of reasons for refusal
2. Structure of reasons for refusal

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1. Principle of writing of reasons for refusal

Applicants or patent attorneys

- receive your reasons for refusal, and
- think about what to do next (how to overcome the reasons, etc.)

1. Principle of writing of reasons for refusal

Reasons for refusal **must be clear** because,

- applicants or patent attorneys need to understand them
- other offices around the world may well take into account them.

Assessment of an inventive step

- What is disclosed in the prior art document ?
- What is the difference between the claimed invention and the invention disclosed in the prior art document ?
- How can a person skilled in the art easily arrive at the claimed invention based on the prior art ?

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2. Structure of reasons for refusal

The subject matter of claim 1 does not involve an inventive step in view of D1 and D2.

D1 discloses a pencil comprising a core made of graphite and clay, and a casing made of thin wood.

A pencil in D1 corresponds to “a pencil” in claim 1, and a core made of graphite and clay disclosed in D1 correspond to “core made of carbon - graphite and clay” in claim 1. Furthermore, casing made of thin wood disclosed in D1 corresponds to “wooden shaft” in claim 1.

The subject matter of claim differs from the invention of D1 in that D1 does not disclose a casing of a polygonal cross-section.

However, D2 discloses a pen comprising a casing with a hexagonal cross-section which makes the pen hard to roll, which brings better usability.

(Continued to the next slide)

Conclusion

**Prior art 1
(D1)**

**Comparison
and
assessment**

**Suggestion
from D2**

2. Structure of reasons for refusal

The invention of D1 and the invention D2 are in the similar technical field in that both inventions relate to writing tools. In addition, it is obvious for a person skilled in the art that the invention disclosed in D1 implicitly have a problem to make a pencil hard to roll for a better usability, which is a similar problem as the invention disclosed in D2.

Therefore, a person skilled in the art would easily conceive the idea of employing a casing with a hexagonal cross-section disclosed in D2 in the invention of D1 in order to make the pencil hard to roll for a better usability.

Considering the effect derived from polygonal cross-section, the present application discloses an effect to make the pen hard to roll. However, this effect is expectable for the person skilled in the art from the disclosure of D2.

Therefore, the subject matter of claim lacks inventive step over D1 and D2.

List of citations

1. JP YYYY-XXXXXXX A
2. JP YYYY-XXXXXXX A

**Factors
(motivations)
to
combine
D1 and D2**

**Consideration
of effects in
the
application**

Conclusion

**List of
citations**

Conclusion

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Thank you for your attention.