

Examination Procedure

Japan Patent Office

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Now let's start the examination procedure lecture.

- I. Overview
- II. First Action (FA)
- III. Second Action (SA)

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The outline of this lecture is as follows:

1. Overview
2. First Action
3. Second action

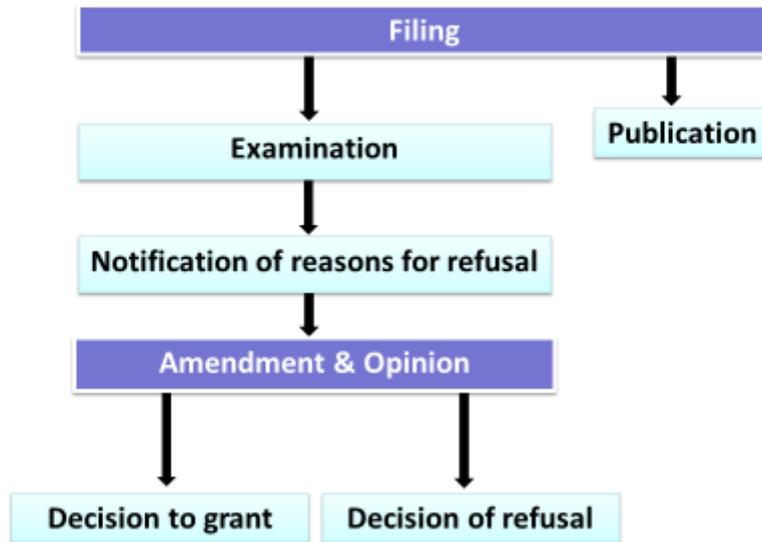
- I. Overview
- II. First Action (FA)
- III. Second Action (SA)

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First, let me explain the overview.

A. General Flow of Patent Examination



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This flow chart shows the general global flow of patent examinations.

The deep-blue colored boxes with white characters indicate actions by applicants.

The light-blue colored boxes with black characters show actions by patent offices.

It begins with a patent application being filed by an applicant.

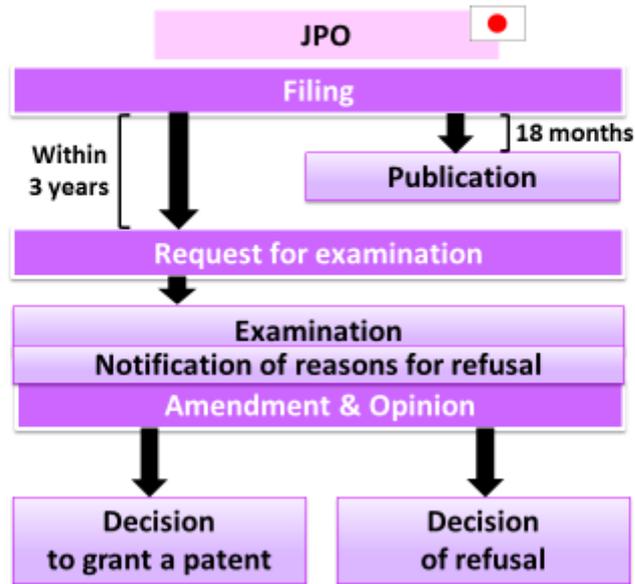
The application will be published.

After filing, a patent examiner will then examine the application and send notification of reasons for refusal.

After that, the applicant will amend the claims of the application and submit an opinion.

Finally, the patent examiner will judge whether the application should be granted or refused.

B. Flow of Patent Examination (JP)

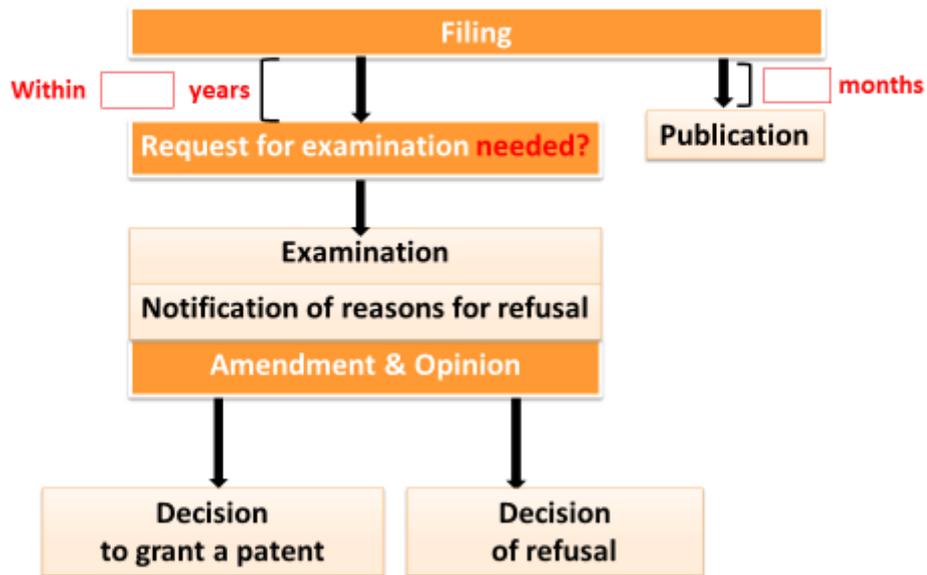


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This is the examination flow of the Japan Patent Office.

In Japan, a patent application is published 18 months after filing. A request for the examination within 3 years from filing date is necessary in order to initiate the examination.

C. How about your country?



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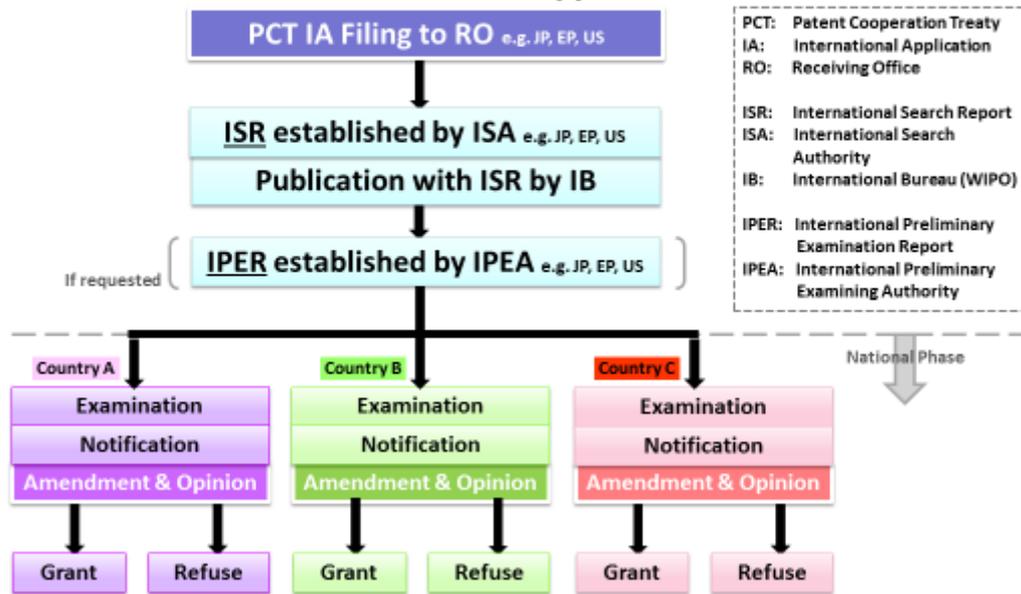
How about your country?

How long will it take from filing to publication?

Is a request for examination needed?

Within how many years can the request for examination be made?

D. Flow of Examination of PCT Application



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This is the flow of a PCT international application. This begins as a single “international” application, and can spread to many countries as one patent application in each country.

The granting of patents, however, remains under the control of the national patent offices in what is called the “national phase.”

A PCT application is submitted to the Receiving Office. After submission, an International Search Report is established by the International Search Authority, and the PCT application is published with the ISR.

If the applicant makes a request for an International Preliminary Examination, the International Preliminary Examining Authority will issue an International Preliminary Examination Report.

After that, the PCT international application enters the national phase.

An examiner in each country can refer to the ISR or IPER before conducting the patent examination.

E. Sample PCT Publication with ISR

INTERNATIONAL APPLICATION UNDER THE PATENT COOPERATION TREATY (PCT)

World Intellectual Property Organization

International Bureau

WIPO | PCT

International Publication No. **WO 2013/019268 A1**

IPC International Patent Classification: **A67F 2001/00001**

International Filing Date: 1 January 2012 (2012.01.01)

Filing Language: English

Publication Language: English

Priority Date: 2 August 2011 (2011.08.02)

Applicant: OMEGA S.p.A. (Italy)

Agent: BELLAZZANI, Stefano (Italy)

Abstract: A watchable portable stand that can be quickly and easily assembled and disassembled by a user without the need for any tools or hardware in a very short time. In its disassembled condition, the stand includes a first and second base there, a first and second side frame, and four legs. For a third component aspect of eight, with only three simple components, the base frame, side frame, and leg. The simplicity of construction provides simplified manufacturing, while allowing for relatively small disassembled packaging, or transport, shipping or storage. The interlocking of the components a work-area provides a still and sturdy platform there when assembled, also however, more rigid to locked with flat propagation lines, SA, table, or other heavy items that require level surfaces support.

Cited from WO 2013/019268 A1

INTERNATIONAL SEARCH REPORT

International application No. **PCV01/100001**

A. CLASSIFICATION OF SUBJECT MATTER
 (IPC) - **A67F 2001 (2012.01)**
 According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELD SEARCHED
 Information Systems searched (classification system followed by classification symbols)
INSPG - A67F 2001/0001/01
INSO - 20120101

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of documents, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 8,342,008 A (2009/09/01) at ¶ 21 August 1999 (21 08 1999) Fig. 1-2, 5-8, 10-14, 16-18, 20, 22, 24-26, 28, 30, 32-34	1
Y	US 2008/011328 A1 (2008/05/14) at 01/14 August 2008 (14 08 2008) Fig. 1-2, 4, 10, Para. 0005, 0007, 0008, 0010	2, 3
Y	US 2008/014414 A1 (2008/04/15) at 16 December 2008 (15 12 2008) Fig. 1-2, 4, Para. 0005, 0007, 0008	3

* Further documents are listed in the recapitulation of this C.

Legend:
 X: Document considered to be highly relevant to the claims of the application.
 Y: Document considered to be relevant to the claims of the application.
 C: Document considered to be pertinent to the search of the application.
 I: Document considered to be of interest to the applicant.
 A: Document considered to be of interest to the applicant and the public.
 E: Document considered to be of interest to the applicant and the public.
 F: Document considered to be of interest to the applicant and the public.
 G: Document considered to be of interest to the applicant and the public.
 H: Document considered to be of interest to the applicant and the public.
 J: Document considered to be of interest to the applicant and the public.
 K: Document considered to be of interest to the applicant and the public.
 L: Document considered to be of interest to the applicant and the public.
 M: Document considered to be of interest to the applicant and the public.
 N: Document considered to be of interest to the applicant and the public.
 O: Document considered to be of interest to the applicant and the public.
 P: Document considered to be of interest to the applicant and the public.
 Q: Document considered to be of interest to the applicant and the public.
 R: Document considered to be of interest to the applicant and the public.
 S: Document considered to be of interest to the applicant and the public.
 T: Document considered to be of interest to the applicant and the public.
 U: Document considered to be of interest to the applicant and the public.
 V: Document considered to be of interest to the applicant and the public.
 W: Document considered to be of interest to the applicant and the public.
 X: Document considered to be of interest to the applicant and the public.
 Y: Document considered to be of interest to the applicant and the public.
 Z: Document considered to be of interest to the applicant and the public.

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This document is a sample PCT international application publication with ISR. Red circles indicate important information, as follows: International Publication Number, assigned IPC, International Application Number, fields searched, and documents considered to be relevant.

- I. Overview
- II. First Action (FA)
- III. Second Action (SA)

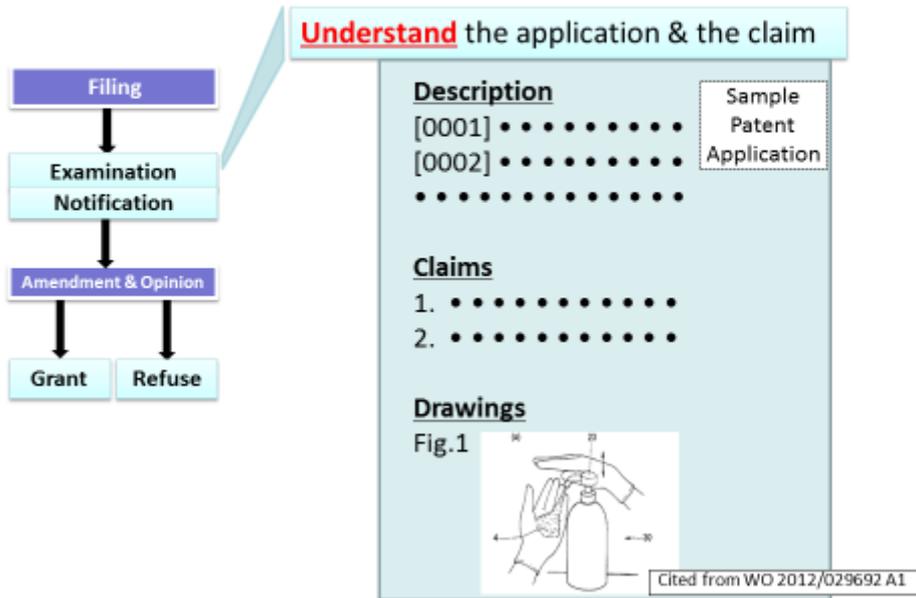
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Next, let me explain First Action.

II. First Action (FA)

A. Flow of FA 1/2



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Now, let's look at the FA examination procedure.

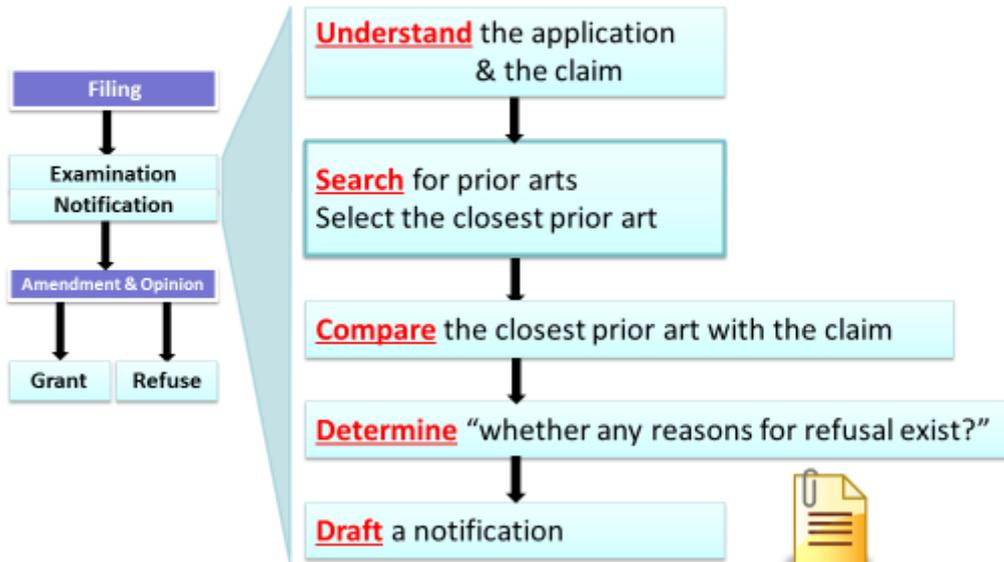
First, examiners must understand the content of the present application.

The patent application consists of claims, descriptions and drawings.

Examiners must read these parts carefully, and understand what is being claimed as a patent right by the applicant.

II. First Action (FA)

A. Flow of FA 2/2



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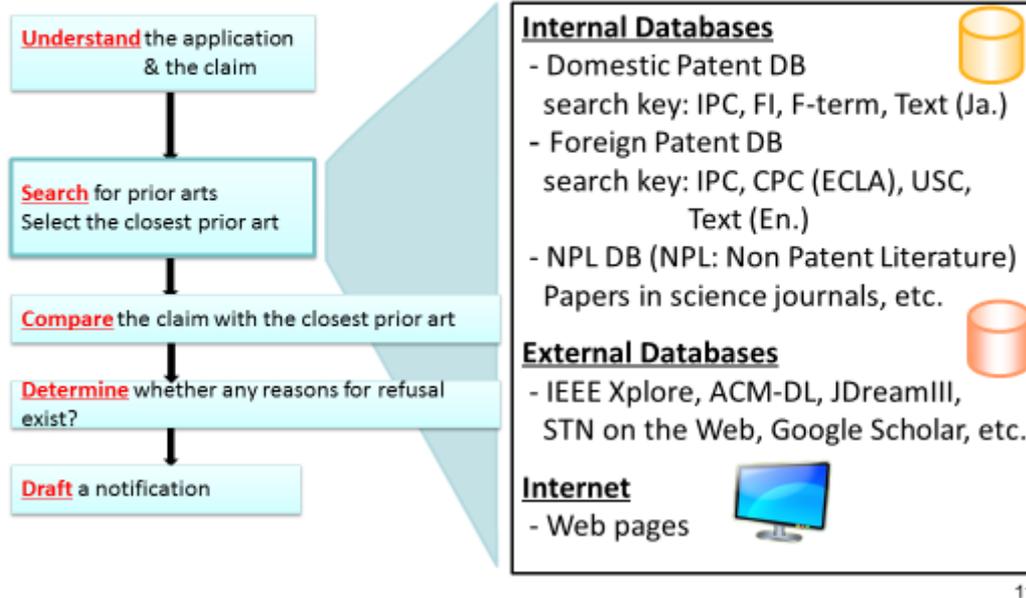
Now, let's take a look at the details of the FA procedures.

First, examiners must understand the content of the application and the claimed invention that is written in the claim.

Next, they must search for prior arts using specific databases, and retrieve the prior art that is the closest to the claimed invention. Next, they compare the closest prior art with the claim, and judge whether or not there exists any reason for refusal.

Finally, examiners draft a notification.

B. Flow of FA - Search DB in JPO -



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For your information, I would now like to show you the actual databases that the JPO uses for prior art searches.

First, there are Internal Databases that have been developed and maintained by the JPO. These databases include three different databases: one for domestic patents, another for foreign patents, and a third for NPL, or Non Patent Literature.

For the domestic patent database, examiners use FI, F-term, keyword, and full-text as search keys. The keyword and the full-text are used in Japanese.

For the foreign patent database, examiners mainly use IPC, CPC, and full-text. The full-text is used in English.

The NPL database accumulates non patent literature such as science journal papers, computer software manuals, or technological books.

Second, there are External Databases.

The JPO has a contract with many external databases such as IEEE Xplore or ACM Digital Library in the computer area, and STN on the Web in the chemical field.

JDreamIII is a Japanese commercial database that includes science journals in Japan and many foreign countries.

Finally, there is the Internet, which examiners can also use in order to find related prior arts.

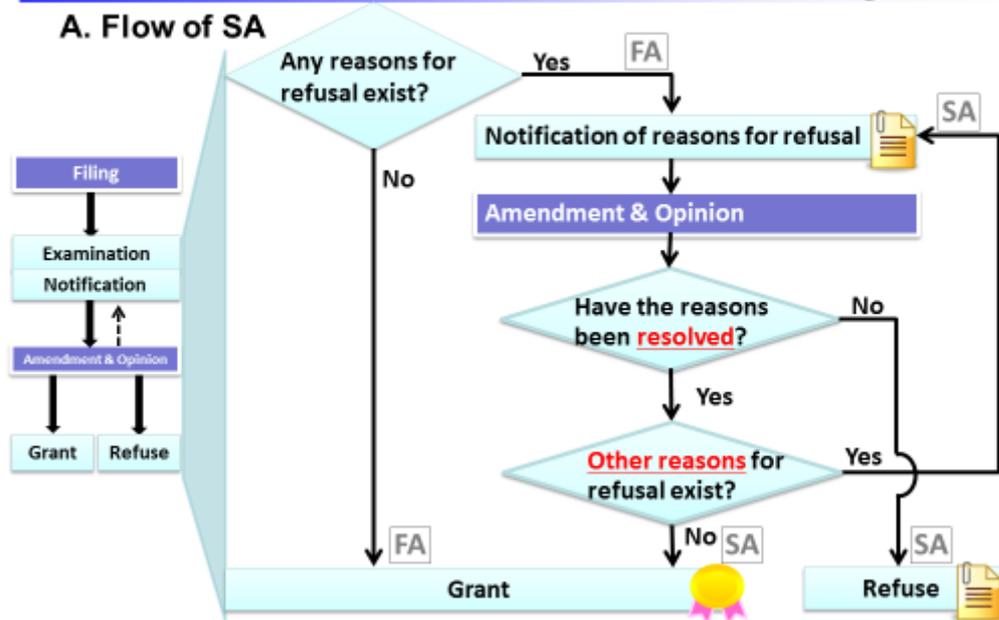
In Japan, examiners can cite a web document or a web page as a prior art in notification.

- I. Overview
- II. First Action (FA)
- III. Second Action (SA)

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Next, let me explain the Second Action.

III. Second Action (SA)



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This is the flow of the SA.

This slide shows not only SA itself, but also the relationship between SA and FA.

If the present application doesn't have any reasons for refusal, the application is granted directly.

If the present application has reasons for refusal, a patent examiner drafts a notification in this regard and sends it to the applicant as an FA.

After the FA, the applicant usually submits an amendment and an opinion. Often, the claims of the application are amended.

After the amendment, the examiner must judge whether or not the reasons stated in the FA have been resolved.

If not, the examiner refuses the application.

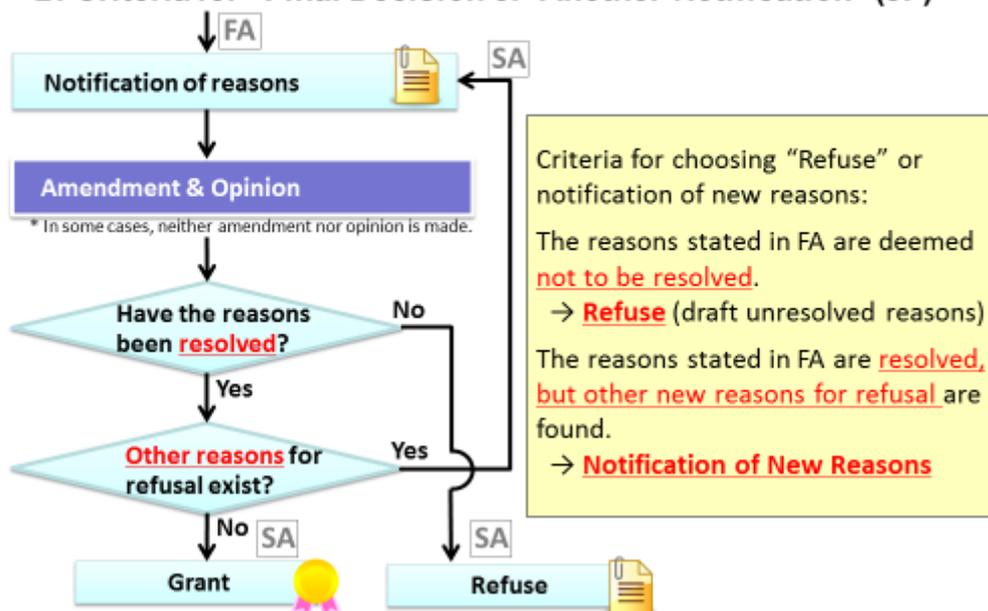
If yes, the examiner must judge whether or not other reasons for refusal exist.

If not, the examiner grants a patent. If yes, the examiner again drafts a notification of the reasons for refusal as an SA.

In the next sheet, we can see more details of SA.

III. Second Action (SA)

B. Criteria for “Final Decision or Another Notification” (JP)



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This shows the details and judge criteria for the SA.

After the FA, the applicant sometimes doesn't reply, either with an amendment or an opinion. In this case, it is likely that the examiner will refuse the application.

The applicant usually submits an amendment and an opinion. The examiner fully considers the contents thereof, and considers the next action.

When the reasons stated in the FA are deemed not to have been resolved, the examiner refuses the application and drafts unresolved reasons to the applicant.

Sometimes the amendment is not good enough to resolve the reasons stated in the FA.

In such a case, examiners can refuse the application on the same grounds.

When the reasons stated in the FA are resolved, but other new reasons for refusal are found, the examiner drafts a notification again as an SA.

Sometimes, the examiner finds other new reasons for refusal for an amended claim. In this case, the examiner drafts a notification again.

When the reasons stated in the FA are resolved, and no other reason exists, the examiner grants a patent.

In the next chapter, we will look at samples of amendments.

III. Second Action (SA)

C. Examples of “Refuse” or “Notification of New Reasons”

- | |
|---|
| <ul style="list-style-type: none">• <u>Amended part</u> of a claim <u>is mentioned in the prior art document cited in FA</u>• Addition of a <u>well-known art</u> to a claim• Addition of a <u>commonly used art</u> to a claim<ul style="list-style-type: none">→ The reasons are deemed <u>not to be resolved</u>→ Refuse |
| <ul style="list-style-type: none">• Against the amended claim, <u>a new prior art document is found</u> other than the well-known art and the commonly used art• <u>Amendment made</u> the claim or description <u>unclear</u>• <u>Amendment added a new matter</u> to the claim or description<ul style="list-style-type: none">→ The reasons stated in FA are <u>resolved, but other new reasons for refusal</u> are found→ Notification of New Reasons for Refusal |

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This is an example showing types of amendments and actions that examiners take in this regard.

The square above shows cases of refusal, and the square below shows an SA (i.e., another notification case).

Now, let's look at the details in each case.

First, the following indicates cases for which a decision of refusal is made because the reason for refusal stated in the FA has not been resolved:

- Cases where the amended part of a claim is mentioned in the prior art document cited in the FA,
- Cases where the addition of a well-known art to a claim is made in the amendment
- Cases where the addition of a commonly used art to a claim is made in the amendment

Next, the following are cases in which the notification of reason for refusal is sent in the SA:

- Cases where the amendment resulted in the claim or description becoming unclear
- Cases where the amendment added a new matter to the claim of description
- Cases where a new prior art document is found against the amended claim

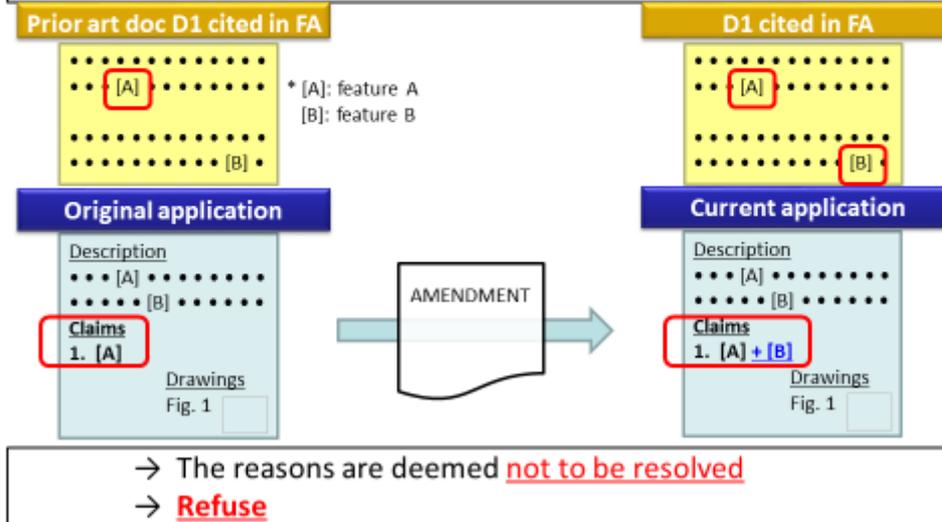
In these cases, the reason for refusal stated in the FA has been resolved, but other new reasons for refusal are found and the notification of reason for refusal is therefore sent in an SA.

We will look at examples of these cases beginning with the next slide.

III. Second Action (SA)

D. Examples of “Refuse” 1/2

- Amended part of a claim is mentioned in the prior art document cited in FA



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This picture shows an example where an amended part of a claim is mentioned in the prior art document cited in the FA.

The claim filed in an FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature A.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1, in which feature A is disclosed.

The applicant filed an amended claim 1 which includes feature A and B in response to this FA.

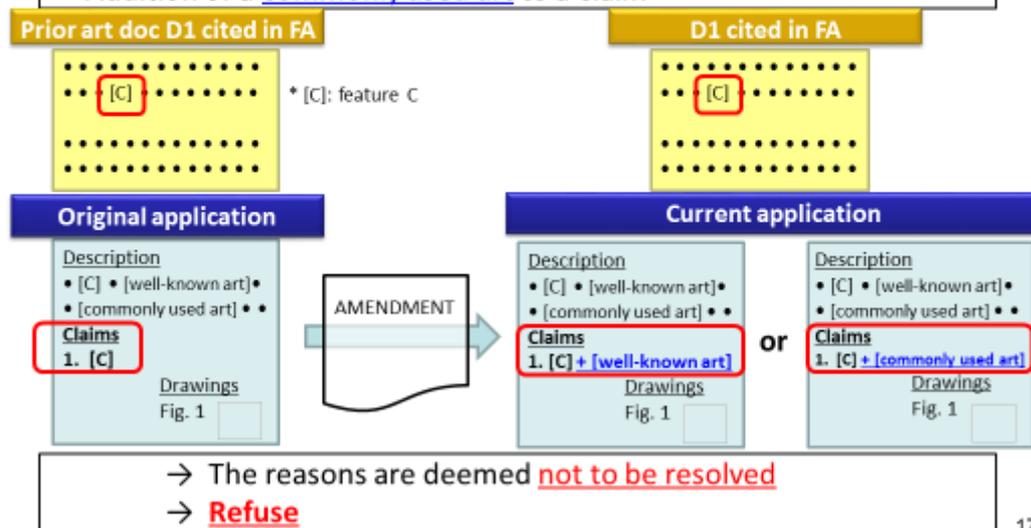
Feature B, which has been added to the claim in the amendment, is the feature disclosed in D1, which is the document the examiner cited in the FA.

In this case, therefore, the reason for refusal based on D1—the reason for which was notified to the applicant in the FA—has not been resolved, and the examiner therefore makes a decision of refusal.

III. Second Action (SA)

D. Examples of “Refuse” 2/2

- Addition of a well-known art to a claim
- Addition of a commonly used art to a claim



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This picture shows an example of an “addition of the well-known art or commonly used art to a claim.”

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature C.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1, where feature C is disclosed.

The applicant made an amendment in response to this FA.

Please look at the amended claim on the left.

In this case, the well-known art has been added to the element of the invention C in the amendment.

Also, please look at the amended claim on the right.

In this case, the commonly used art has been added to the feature C in the amendment.

On the other hand, the feature C has already been disclosed in D1.

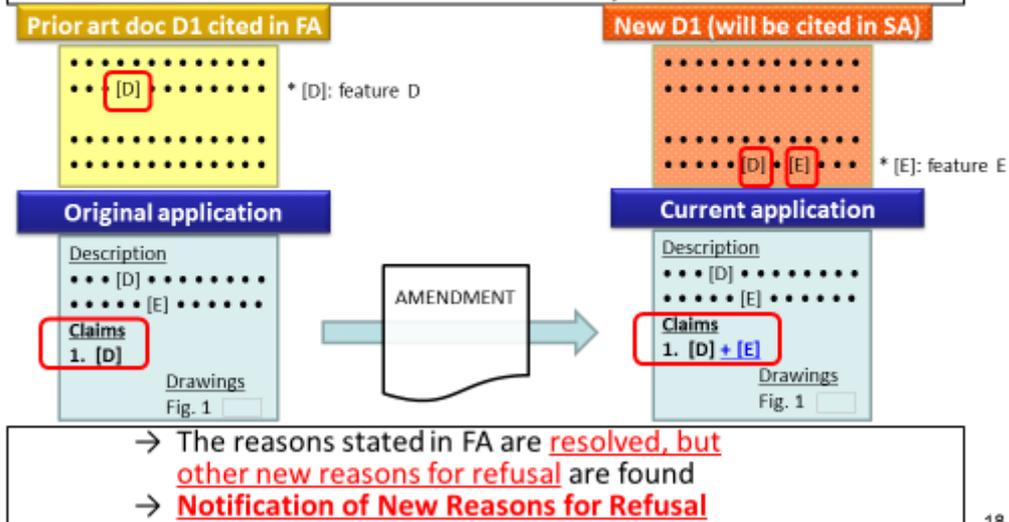
This means that a person skilled in the art can easily achieve the claimed invention in this application by applying the well-known or commonly-used art to feature C, which is disclosed in D1.

Therefore, the reason for refusal that was notified to the applicant in the FA has not been resolved, and the examiner consequently makes a decision of refusal.

III. Second Action (SA)

E. Examples of “Notification of New Reasons for Refusal” 1/2

- Against the amended claim, a new prior art document is found other than the well-known art and the commonly used art



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This picture shows an example where “a new prior art document is found”.

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature D.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1 in which the feature D is disclosed.

And the applicant filed an amended claim which includes features D and E in response to this FA.

In this case, the reason for refusal based on D1 in which the feature D is disclosed has been resolved.

On the other hand, the examiner conducted a new prior art search and found a new D1 in which the features D and E are disclosed.

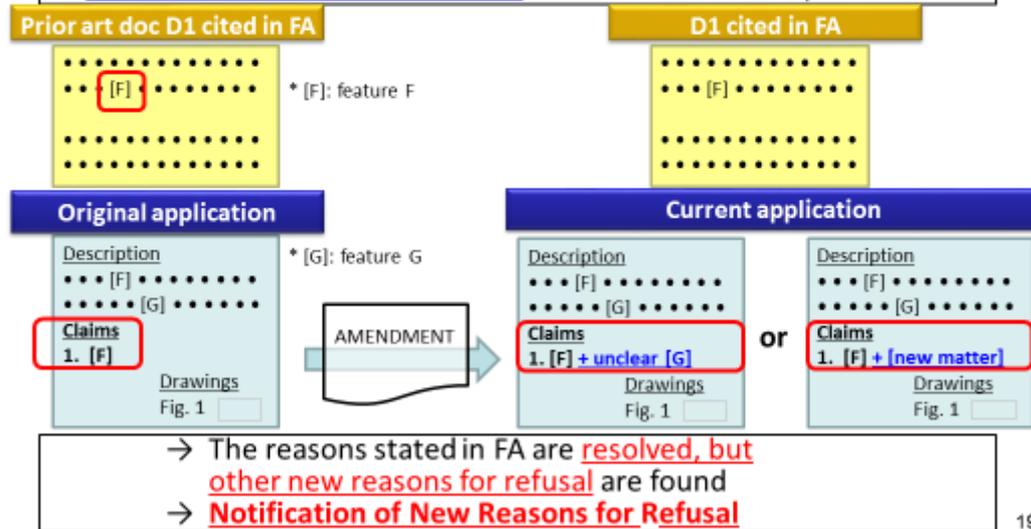
That means that the reason for refusal in the FA was resolved, but the examiner found a new reason for refusal.

In cases like these, the examiner makes the Second Action wherein he or she again sends a notification to the applicant of a new reason for refusal based on a new D1.

III. Second Action (SA)

E. Examples of “Notification of New Reasons for Refusal” 2/2

- Amendment made the claim or description unclear
- Amendment added a new matter to the claim or description



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This picture shows an example of an “Unclear Amendment and Amendment adding new matter”.

The claim filed in the FA is shown on the left, and the amended claim is shown on the right.

The claim 1 filed in the FA includes feature F.

The examiner sent a notification of reason for refusal to the applicant against this claim based on D1 in which the feature F is disclosed.

And the applicant made an amendment in response to this FA.

Please look at the amended claim on the left.

In this case, the applicant filed an amended claim which includes features F and G.

However, feature G which has been added in the amendment is not clear.

In this case, the reason for refusal based on D1 in which the feature F is disclosed has been resolved.

However, the examiner found a new reason for refusal regarding the clarity requirement since the feature G which has been added in the amendment is not clear.

Next, please look at the amended claim on the right.

In this case, the applicant made an amendment but also added new matter in the amendment.

In this case, the reason for refusal based on D1 in which the feature F is disclosed has been resolved.

For the reason that a new matter has been added in the amendment, however, the examiner found a new reason for refusal, which is the “addition of new matter”.

In both of these two cases, the reason for refusal in the FA has been resolved, but the examiner found a new reason for refusal.

In cases like these, the examiner makes the second action wherein he or she again sends a notification of a new reason for refusal to the applicant.

III. Second Action (SA)



F. Points to consider

- Opportunity for amendment
The applicant's opportunity for amendment may not be unreasonably limited.
- Suggestion of amendment
In a notice of reasons for refusal, the examiner may suggest an amendment, which enables applicants to easily respond and thus contributes to prompt and precise examination.
- Communication
When it is considered to contribute to prompt and precise examination, examiners could communicate with the applicant through an interview, by telephone, or by facsimile.

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Lastly, these are the points to consider at the stage of the SA.

- The applicant's opportunity for amendment may not be unreasonably limited.
- The examiner may suggest an amendment in a notice of reasons for refusal, which enables applicants to easily respond—thereby contributing to prompt and precise examinations.
- Examiners can consider communicating with the applicant through an interview, by telephone, or by facsimile when this would contribute to a prompt and precise examination.