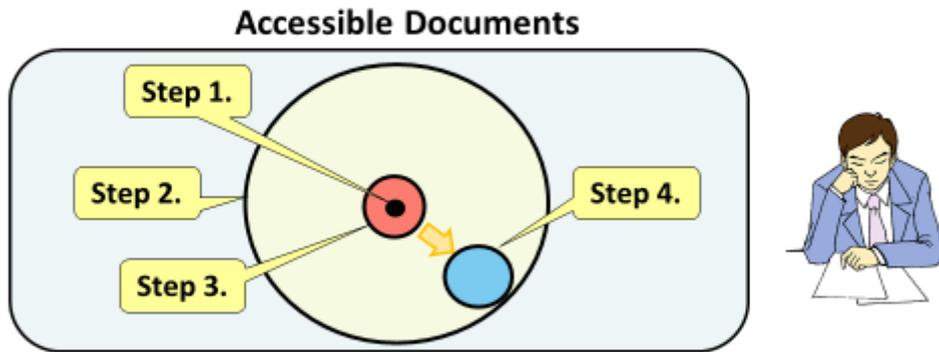


### B. Decision of search scope - 1/7



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

8

--- (Slide 8) ---

Next, let me explain the decision of the search scope.

The first step is to recognize the invention. This is represented as a black dot, and will be a standard point to decide the scope of the search.

The second step is to determine the outer border of the search scope. This is determined based upon examiners' knowledge and experience.

The third step is to determine the search scope.

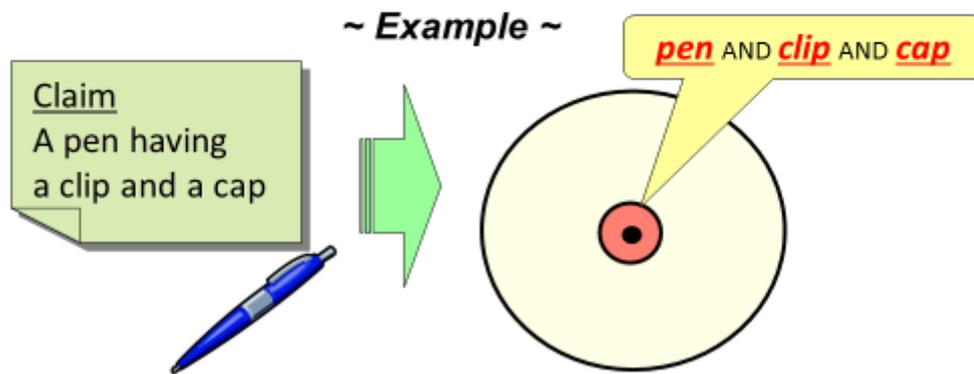
The fourth step is to change the search scope. As you continue your search, the scope will be changed.

Let's have a closer look at steps 3 and 4 in the following slides.

### B. Decision of search scope - 2/7

#### ~ Step 3. Determination of search scope ~

**Search scope having all the elements of the claimed invention**



9

--- (Slide 9) ---

Let's take a closer look at step 3, the search scope decision.

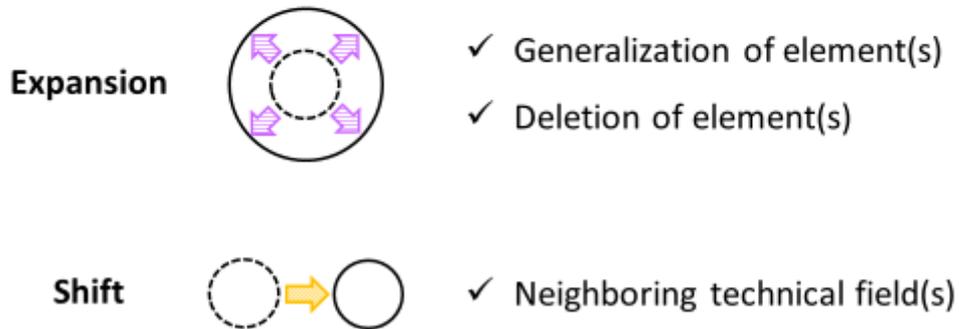
The first search scope is determined so as to have all elements of the claimed invention.

In case the claimed invention is “a pen having a clip and a cap”, the search scope should be “pen AND clip AND cap”.

### B. Decision of search scope - 3/7

#### ~ Step 4. Change of search scope ~

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



10

--- (Slide 10) ---

Next, let's see step 4, changes to the scope of the search.

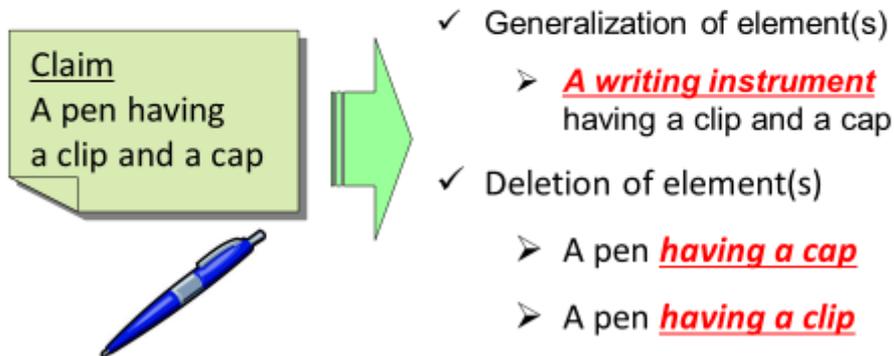
Roughly speaking, there are two types of search scope changes: expansion and shifts.

An example of expansion is generalizing or deleting elements of the claimed invention.

By contrast, an example of shifting is making a change to a neighboring technical field.

### B. Decision of search scope - 4/7

#### ~ Step 4. 1. Expansion of search scope ~



11

--- (Slide 11) ---

I will explain how you can expand the scope of your search.

First, you can generalize the concept of the elements. (This is known as “generic conceptualization”).

A pen is a type of writing instrument. Therefore, “a pen having a clip and a cap” can be generalized and defined as “a writing instrument having a clip and a cap”.

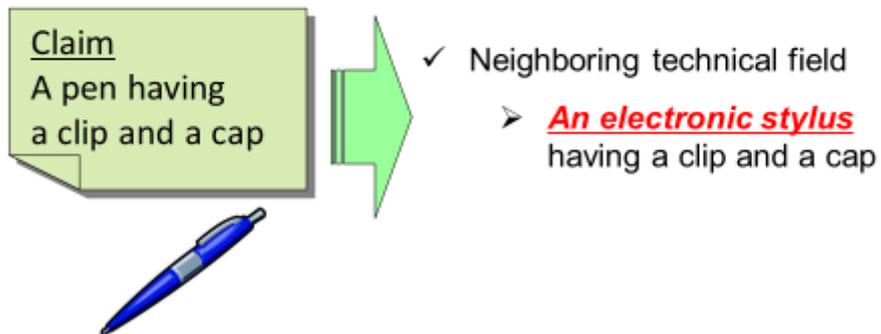
Second, you can delete a part of the elements.

If you delete the element “clip” from “a pen having a clip and a cap”, the search scope will be “a pen having a cap”.

Or, if you delete the element “cap” from “a pen having a clip and a cap”, the search scope will be “a pen having a clip”.

### B. Decision of search scope - 5/7

#### ~ Step 4. 2. Shift of search scope ~



12

--- (Slide 12) ---

Next, I will explain the shift of the search scope.

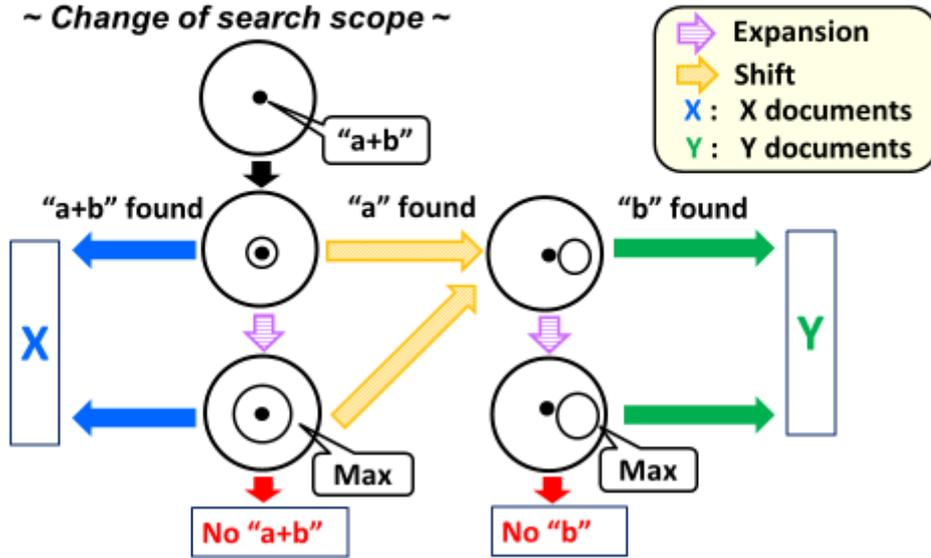
Even in cases where the combination of “clip” and “cap” has not been found in the technical field of “pen”, you may find the same combination in neighboring technical fields. In such cases, the inventive step of the claim “A pen having a clip and a cap” could be denied based on the documents found in neighboring technical fields.

Consequently, in order to conduct searches with no overlooked prior art, there are cases where it may be necessary to shift the scope of your search to encompass the prior art in neighboring technical fields.

For example, you can shift the search scope from “a pen having a clip and a cap” to “an electronic stylus having a clip and a cap”.

### B. Decision of search scope - 6/7

~ Change of search scope ~



13

--- (Slide 13) ---

This diagram illustrates an example of how the scope of a search may be shifted.

In this case, the claimed invention is "a+b". Therefore, the scope including both "a" and "b" should be searched first, as the black arrow indicates. If the prior art document disclosing "a+b" has been found in this scope, the said document is a category "X" document. Therefore, the claim has no novelty or inventive step.

Next, if the search result didn't return the document disclosing "a+b" but returned the document disclosing "a", follow the yellow arrow. In this case, the scope of the search should be shifted to search for documents including "b".

Then, if a document including "b" has been found, each of the documents disclosing "a" or "b" is a category "Y" document.

On the other hand, if a document disclosing "b" has not been found, the purple arrow should be followed and the search scope should be expanded.

The red arrow on the right side shows that the document disclosing "b" was not found even when the search scope was expanded to maximum capacity. In this case, the claim "a+b" has both novelty and inventive step.

### B. Decision of search scope - 7/7

~ Tips for more efficient search ~



14

--- (Slide 14) ---

I will next explain the method for an efficient search.

In some cases, a claim may be the generalization of embodiments disclosed in the description.

For example, let's say that "a ball-point pen having a clip and a cap" is disclosed in the description, while "a pen having a clip and a cap" is described in the claim.

One idea is to set Target 1, "a ball-point pen having a clip and a cap", as the first search scope, to meet later possible amendments to the claim. If the document that satisfies Target 1 has been found, the claim has neither novelty nor inventive step.

If the document that satisfies Target 1 has not been found, the search scope should be expanded to Target 2.

Target 2 is "A pen having a clip and a cap", which is the same as described in the claim. If the document that satisfies Target 2 has been found, the claim has neither novelty nor inventive step.

If the document that satisfies Target 2 has not been found, the claim has at least novelty. In this case, the scope of the search should be expanded to Target 3. That is, the scopes "A pen having a clip" and "a pen having a cap" should both be searched.