

JPO response to the letter C8728

JPO would like to provide information on the Examination Guidelines in Japan related to inventive step, especially concerning the following topics suggested in paragraph 8 of document SCP/24/3.

1. Combination (synergic effect)

In the Examination Guidelines, 'Advantageous effects' are mentioned as factors in support of the existence of an inventive step. The descriptions are as follows.

(Part III Chapter 2 Section 2 Inventive Step)

3.2 Factor in support of the existence of an inventive step

3.2.1 Advantageous effects

Advantageous effects over the prior art are factors in support of the existence of an inventive step. Where the examiner understands such effects based on the description, claims and drawings, the examiner should take them into consideration as factors in support of the existence of an inventive step. Advantageous effects mean effects which are given by the claimed invention and advantageous over the prior art (particular effects).

(1) Consideration of advantageous effects over the prior art

Where the claimed invention has advantageous effects over the prior art, the examiner should take them into consideration and attempt the reasoning that a person skilled in the art would have easily arrived at the claimed invention. The inventive step of the claimed invention is denied regardless of the existence of the advantageous effects where it is sufficiently reasoned that a person skilled in the art would have easily arrived at the claimed invention.

However, where 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 of the different nature from that of the prior art and a person skilled in the art is not able to expect the effect of the claimed invention on the basis of the state of the art at the time of filing.
- (ii) The claimed invention has an effect of the same nature but significantly

superior to that of the prior art and a person skilled in the art is not able to expect the effect of the claimed invention on the basis of the state of the art at the time of filing.

Especially for claimed inventions that belong to a technical field where it is difficult to expect the effect based on the structures of the products such as a selection invention (see 7 in “Section 4 Claims Including Specific Expressions”), the advantageous effects over the prior art are an important factor for determining the existence of an inventive step.

Example:

The claimed invention relates to motilin which has a specific amino acid sequence, shows six to nine times more active than the motilin of the prior art, and has advantageous effects in increasing intestinal motility. Where such effects exceeds what is predictable based on the state of the art at the time of filing, these effects are factors in support of the existence of an inventive step.

2. The danger of hindsight analysis

In the Examination Guidelines, there is a description below as one of the ‘Notes for determining an inventive step’.

(Part III Chapter 2 Section 2 Inventive Step)

3.3 Notes for determining an inventive step

(1) The examiner should take note of the avoidance of hindsight such as the following case (i) or (ii) due to determining an inventive step after acquiring knowledge of the claimed inventions.

- (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 invention is approximate to the claimed invention (see 3.3 in “Section 3 Procedure of Determining Novelty and Inventive Step”).

3. Secondary indicia

In the Examination Guidelines, there is a description below as one of the 'Notes for determining an inventive step'.

(Part III Chapter 2 Section 2 Inventive Step)

3.3 Notes for determining an inventive step

(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 the existence of 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.

4. Selection Invention

In the Examination Guidelines, there is a description below with regard to what the examiner should take into consideration in examining novelty or an inventive step concerning selection invention.

(Part III Chapter 2 Section 4 Claims Including Specific Expressions)

7. Selection Invention

7.1 Specifying the claimed invention

A selection invention is an invention that belongs to a technical field where an effect, which would be yielded by a structure of an article, is difficult to predict and fulfills the following items (i) or (ii).

- (i) An invention (b) which is selected from invention (a) expressed in a broader concept in publications, etc. and which is expressed in a narrower concept embraced within the broader concept, wherein novelty of the invention (b) is not denied by the invention (a) expressed in the broader concept in publications, etc.
- (ii) An invention (b) which is selected from invention (a) expressed by multiple choices (Note) in publications, etc. and which has a part of the choices as invention elements, wherein novelty of the invention (b) is not denied by the invention (a) expressed by the multiple choices in publications, etc.

Therefore, an invention which cannot be said to be stated in prior art documents can be a selection invention.

Even in connection with a selection invention, a claimed invention is specified in the same manner as in an ordinary case (see 2 in “Section 3 Procedure of Determining Novelty and Inventive Step”.)

(Note) see 4.1.1(note1) in "Section 3 Procedure of Determining Novelty and Inventive Step" for "choices."

7.2 Determination of an inventive step

When effects of a selection invention fulfill all of the following items (i) to (iii), the examiner determines that the selection invention involves an inventive step.

- (i) The effect of the selection invention is an advantageous effect which is not stated in prior art documents, etc.
- (ii) The selection invention yields an effect which is different from, or identical but prominently superior to an effect yielded by an invention expressed in a broader concept or multiple choices.
- (iii) The effect of the selection invention cannot be predicted by a person skilled in the art from the state of the art.

Example:

Compounds expressed by a certain general formula have been known to have insecticidal property. A claimed invention is included in the general formula.

However, the claimed invention is based on a finding that a certain specific compound, which is not specifically well-known about its insecticidal property, is remarkably less poisonous to human beings than the other compounds expressed by the general formula, and is conceived by selecting the specific compound as an active ingredient of an insecticide. There is no evidence from which the compound is predictable.

In this case, the claimed invention involves an inventive step as a selection invention

As to the whole Examination Guidelines in Japan, please refer to the link below.
“Examination Guidelines for Patent and Utility Model in Japan”

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/1312-002_e.htm

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