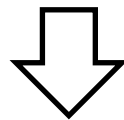


Recent Determination of Inventive Step in Japan

Recent Criteria for Determination of Inventive Step

The Intellectual Property High Court 2008 (Gyo-Ke) 10096

Whether the requirements specified in Article 29, paragraph (2) of the Patent Act are fulfilled, ... may be determined based on whether it was easy to arrive at such feature (the structures that constitute the difference from the prior art) of the invention claimed in the application starting from the prior art. ... it is indispensable to appropriately grasp the feature of the invention, in other words, to appropriately grasp the problem to be solved by the invention, in order to objectively determine whether the invention is easily conceived of. ... in order to determine that the invention would have been easily conceived of, **it is not sufficient to be able to merely presume**, based on the results of the examination of the details of the prior art, **that efforts to arrive at the feature of the invention could have been made**. It should be considered reasonable to **necessitate the existence of the fact that suggests that efforts would have been made in order to arrive at the feature of the invention**.



In order to determine that the invention lacks the inventive step, **there needs to be the reasoning** that a person skilled in the art **would** arrive at the present invention from the prior art (primary prior art).

Due to recent precedents and revised examination guidelines for patent, **the patent allowance rate has sharply increased.**

The trend is for **pro-patent** (advantageous to applicants) for the past few years.

The recent patent allowance rate

(patent allowance rate = number of granted patents/(number of granted patents + number of refused patents + number of abandoned applications after first actions))

2010	2011	2012	2013	2014	2015	2016
54.9%	60.5%	66.8%	69.8%	69.3%	71.5%	75.8%

Source: Japan Patent Office Statistics Data in 2017

Determination Method for Inventive Step

Proposition

Is it possible to reason that a person skilled in the art would easily arrive at the claimed invention from the primary prior art?

Determination 1

Is it possible to reason or not by **adopting a secondary prior art** or **considering the common general knowledge** (design variation etc.) for the differences between the claimed invention and the primary prior art?

Impossible to reason

Possible to reason

- There is a **motivation** for applying the secondary prior art to the primary prior art.
- Corresponds to a **design matter** from the primary prior art.

Motivation

- Relation of technical fields
- Similarity of **problems to be solved**
- Similarity of **operations or functions**
- **Suggestions** shown in the cited invention

Determination 2

Is it possible to reason or not by comprehensively assessing various factors that includes factors in support of the existence of an inventive step (**advantageous effects** and **obstructive factors**) ?

Impossible to reason

- There is the advantageous effect.
- There is the obstructive factor against the combination of the primary prior art and the secondary prior art.

Possible to reason

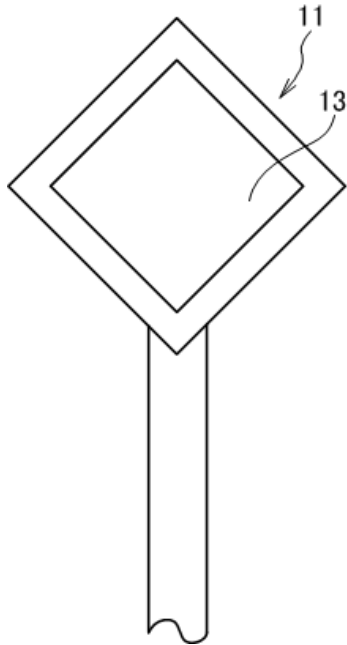
Non-existence of
inventive step

Existence of
inventive step

EXAMPLE

Traffic sign with anti-sticker effect

(Samples provided by: Bockermann Ksoll Griepenstroh Osterhoff (DE) and Hauptman Ham, LLP (US))



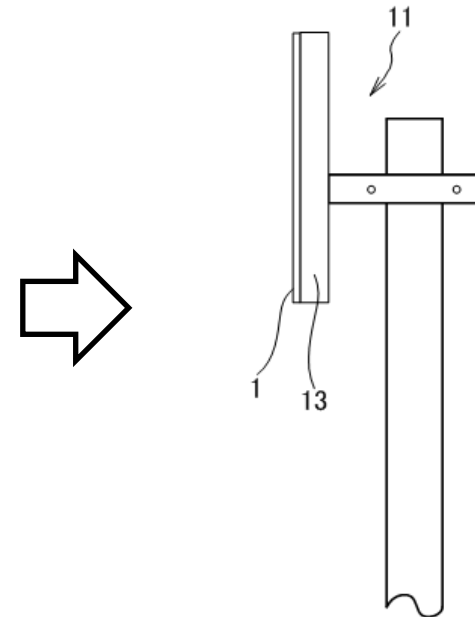
[Prior art]

A traffic sign 11 including a display plate 13.



[Problem to be solved]
Countermeasure against stickers.

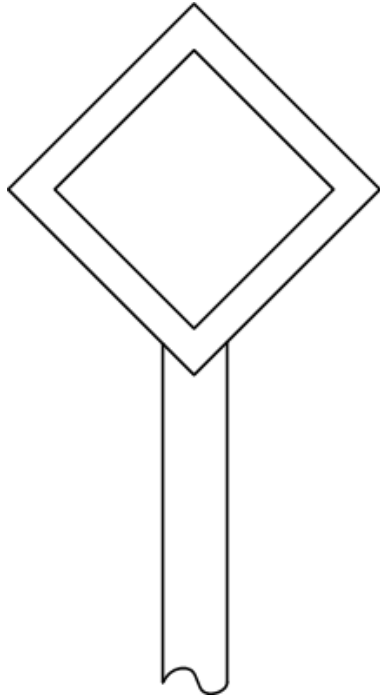
Present invention



[Solution]

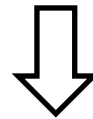
A film 1 having a surface with uneven protrusions is disposed on the display plate 13.

Cited document 1
(Primary prior art)



Difference in the present invention
from the primary prior art:

“a film has a surface with uneven protrusions.”



Proposition

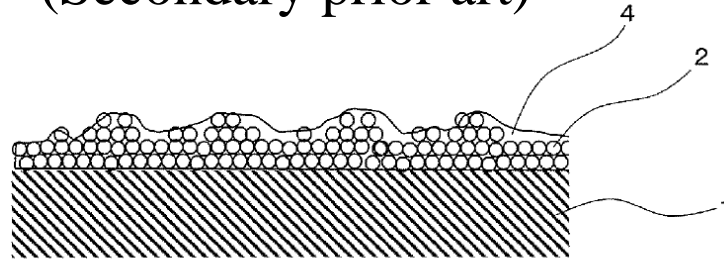
Is it possible to reason that a person skilled in the art would easily arrive at the above-described difference “a film has a surface with uneven protrusions” from the primary prior art?

[Technical field] A traffic sign having a display plate.

[Problem to be solved] An improvement of visibility of a display plate in night time.

[Solution] Disposing a film with retroreflective ability on the display plate.

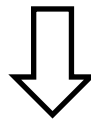
Cited document 2
(Secondary prior art)



[Problem to be solved] A countermeasure against organic dirt (finger marks) on an inner surface of a window glass of an automobile.

[Solution] Applying a film 4 having a surface with uneven protrusions on an inner surface of a window glass 1 of an automobile.

[Effect] The protrusions of the film 4 have an effect to prevent the organic dirt.



The cited document 2 discloses about the difference between the present invention and the primary prior art, “a film has a surface with uneven protrusions.”

How to respond against Office Action

How to deal with the following notification of reasons for refusal that determines non-existence of inventive step by the cited documents 1 and 2?

Notification of reasons for refusal (reasoning by Examiner)

It is easily conceivable for a person skilled in the art to constitute the present invention by applying a film having a surface with uneven protrusions as disclosed in the secondary prior art instead of the film on the display plate of the traffic sign in the primary prior art.

- Regarding difference between the present invention and combination of the cited documents 1 and 2:
Difficult to make an objection since all the configuration of the present invention can be obtained by combining the cited documents 1 and 2.
- Regarding motivation:
Possible to make an objection.

Arguments of **no motivation** to combine the cited document 2 to the cited document 1 (Determination 1 in the flowchart)

■ **The technical fields** of the cited documents 1 and 2 are different.

→ This objection alone is hard to win the inventive step affirmation.

■ **The problem to be solved** of the present invention (countermeasure against stickers) is **not described** in the cited document 1 (improvement of visibility) and the cited document 2 (countermeasure against organic dirt).

→ Reasoning by **a thinking process identical to the present invention** (countermeasure against stickers) cannot be made.

“The examiner selects generally the primary prior art which is the same as or close to the claimed invention from the aspect of technical field or problem to be solved. The primary prior art of which technical field or problem to be solved is considerably different from that of the claimed invention is likely to make the reasoning difficult. In this case, it should be noted that it is required to reason more deliberately whether or not a person skilled in the art would arrive at the claimed invention starting from the primary prior art” (Examination Guidelines, Part III, Chapter 2, Section 2, 3. 3 (2)).

■ **Problems to be solved** of the cited document 1 (improvement of visibility) and the cited document 2 (countermeasure against organic dirt) **are different**.

→ Reasoning cannot be made even **by a thinking process different from the present invention**.

“The similarity of the problems to be solved between the primary prior art and the secondary prior art can be a ground for determining that there is a motivation for a person skilled in the art to derive the claimed invention by applying the secondary prior art to the primary prior art” (Examination Guidelines, Part III, Chapter 2, Section 2, 3. 1. 1 (2)).

■ **The function** of the film in the cited document 1 (the retroreflective ability) and **the function** of the film in the cited document 2 (the prevention of organic dirt) **are different**.

■ In the cited documents 1 and 2, there is **no suggestion** to apply the film described in the cited document 2 to the cited document 1.

Arguments other than motivation (Determination 2 in the flowchart)

- Argument based on **advantageous effect**
 - The combination of the cited document 1 and the cited document 2 does not provide the effect of the present invention (anti-sticker effect).

- Argument based on **obstructive factor**
 - If the cited document 2 discloses that the film having the surface with the protrusions is applicable only to an inner surface of a window glass of an automobile, this argument is effective. In this case, an objection can be made that a person skilled in the art would not apply the film described in the cited document 2 to an outdoor item such as the road sign described in the cited document 1.

- Argument based on **hindsight**
 - Effective in appeal against examiner's decision of refusal, opposition, and trial for invalidation (pay attention to the way to explain in the examination).
“The examiner should take note of the avoidance of hindsight when making a determination on inventive step after acquiring knowledge of the claimed invention” (Examination Guidelines, Part III, Chapter 2, Section 2, 3. 1. 1 (2)).