

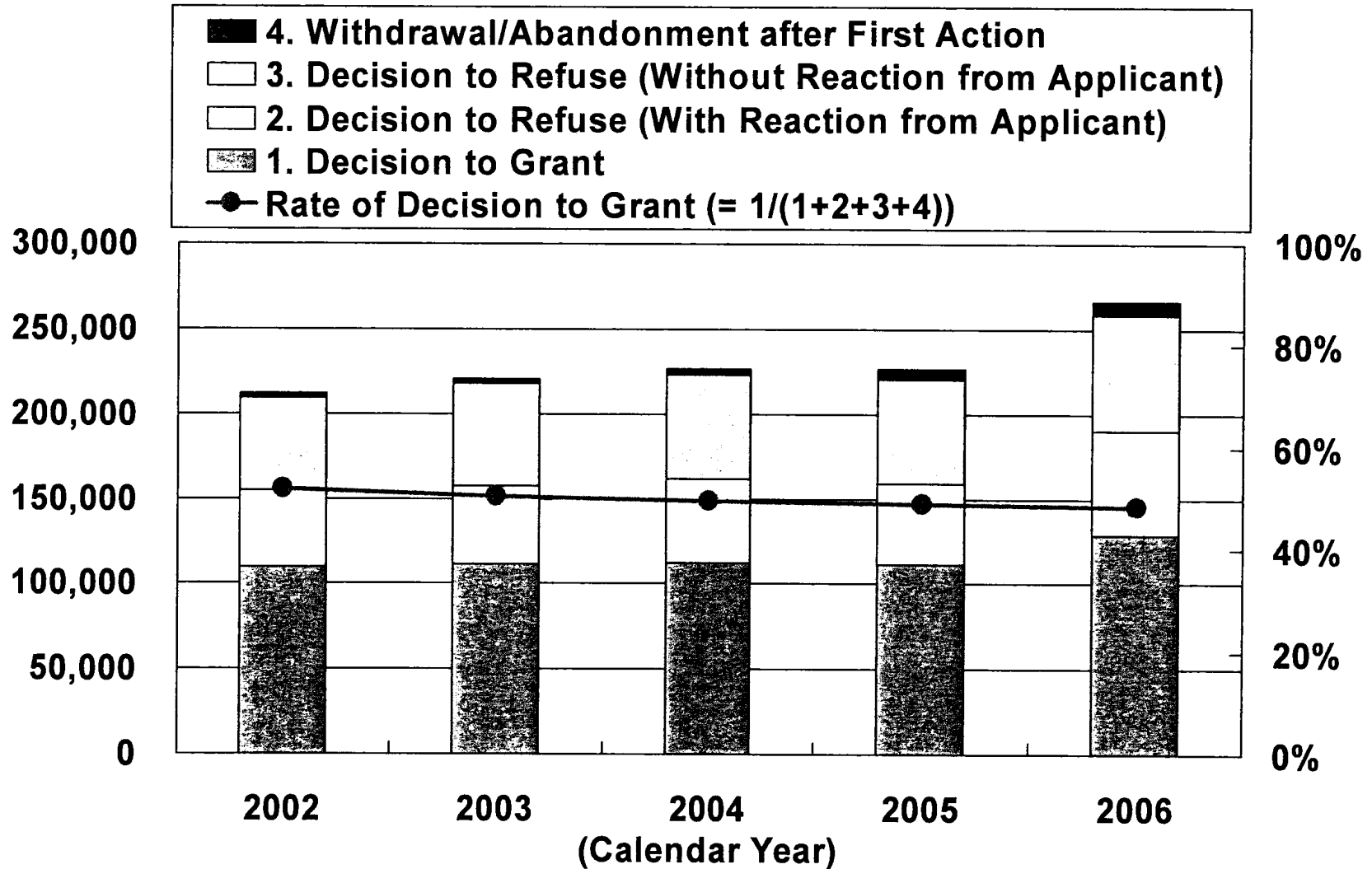
**Meeting of US Patent Bar/JPO Liaison Council, October 15th, 2007**

# **Inventive Step in Japan**

**Toshimichi Moriya**  
Deputy Commissioner  
Japan Patent Office

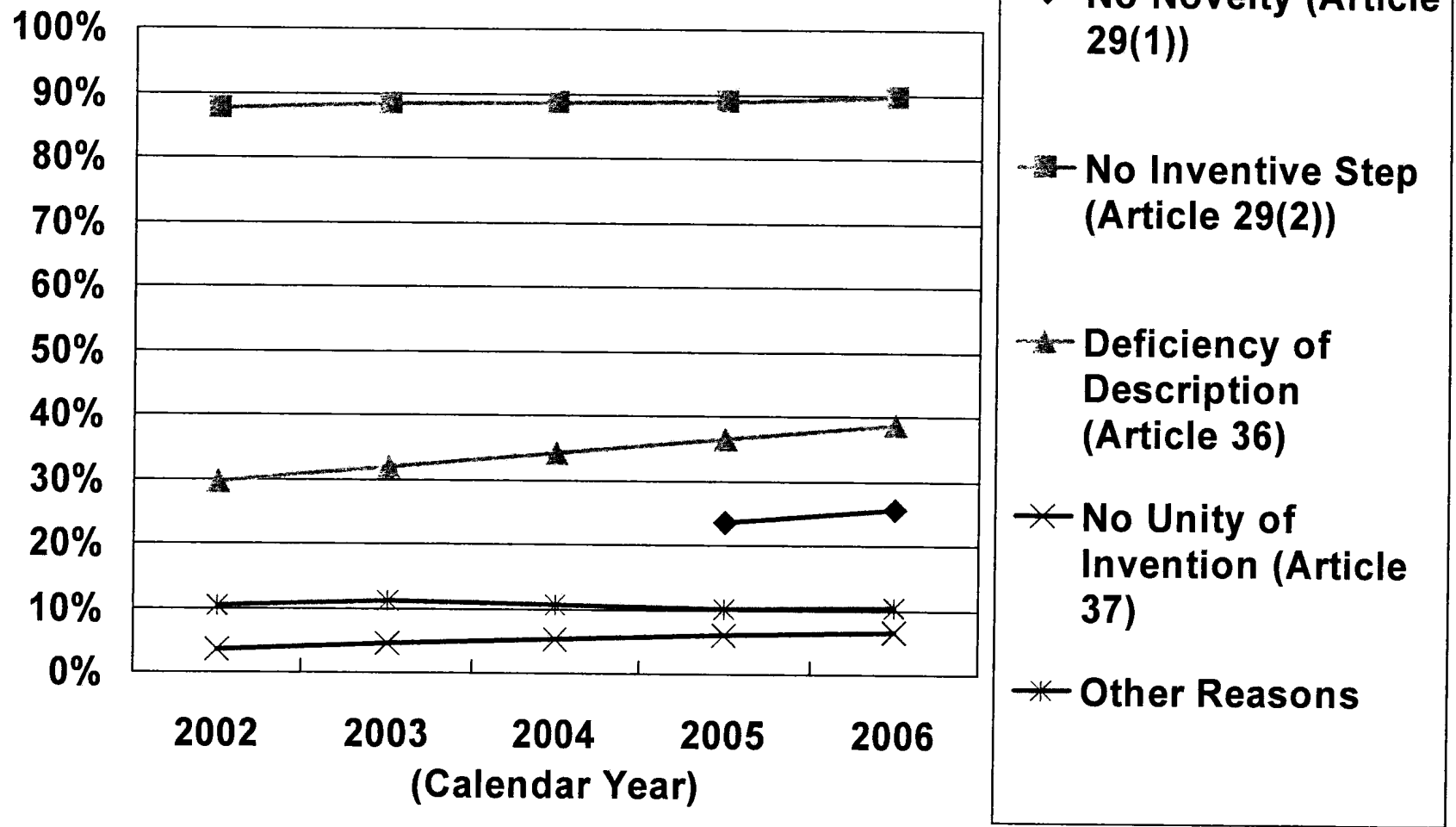
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# Patent Examination Results



# Reasons for Refusal

Number of first notices with a “specific reason” for refusal divided by number of “all” first notices of reasons for refusal



# Comparative Study on Inventive Step

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## Comparative Study on Inventive Step among JP/US/EP by AIPPI · JAPAN

### Committee

Scholars, a Counselor of the Supreme Court,  
Lawyers, Patent Attorneys, Industry Representatives

### Contents

- Comparison among JP/US/EP
- Interviews
- Statistics

The results were published in March 2007 in Japanese.

# Comparative Study on Inventive Step

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## Results of Interviews

JP - Companies (28) and Law Firms (14): Total 42

- The level of inventive step in JP is higher than that of US or EP: 12
- In JP, an inventive step tends to be denied because of high search capability: 11
- The reason for the judgment of lack of an inventive step is not sufficient in the notice of reasons for refusal: 24

US - Companies (5), Law Firms (6) and a Scholar (1):

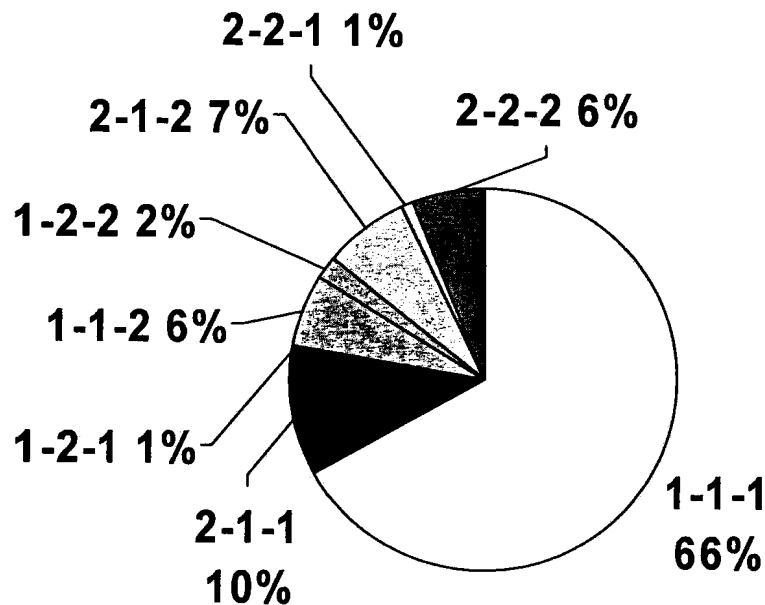
Total 12

EP - Company (1) and Law Firms (5): Total 6

The reason for the judgment of lack of an inventive step is not sufficient in the notice of reasons for refusal.

# Comparative Study on Inventive Step

## Statistics on JP-US-EP Examination Results (1)



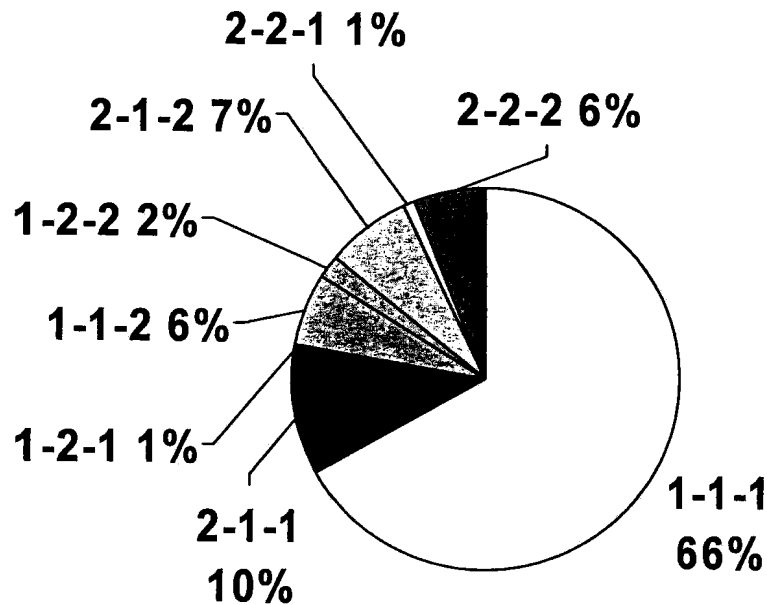
By Groups of Applications filed to the US in April 2002 (Total: 625)

- The earliest application and its divisional/continuation applications are counted as one group.
- A group is classified as "Granted" when there is one or more applications granted a patent.

- 1... Granted
- 2... JP: Refused  
US: Refused + Abandonment  
EP: Refused + Withdrawn after Start of Examination  
+ Withdrawn without Request for Examination

# Comparative Study on Inventive Step

## Statistics on JP-US-EP Examination Results (2)



Percentage of the Same Results  
 Among Trilateral Offices ....72%  
 Between JP and US .....79%  
 Between US and EP .....84%  
 Between EP and JP .....80%

1... Granted  
 2...JP: Refused  
     US: Refused + Abandonment  
     EP: Refused + Withdrawn after Start of Examination  
     + Withdrawn without Request for Examination

## Case studies at the JPO Appeal Department

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The JPO Appeal Department held group discussions on cases involving the inventive step with industry representatives and patent attorneys from July 2006 to March 2007.

### Members of the study group

- a) Appeal examiners
- b) IP staff in private companies (i.e., representatives of industry)
- c) Patent attorneys

### Cases

Eight cases were studied.

- Two cases for each of four technical fields: physics, mechanics, chemicals, and electronics
- They include cases in which a patent was *revoked* or cases in which a *patent application* was refused, by the JPO Board of Appeal or by the IP High Court, due to lack of inventive step.

## Result of the Case studies

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- a) All members agreed with the IP High Court and JPO decisions in six cases.

With regard to two cases, opinions of members were not unanimous.

- b) In some cases, the reasoning in the appeal decision were considered to be insufficient or incorrect.

- c) In some cases, it was noted that the applicants or patentees' arguments were not sufficient.

Case studies continue.

- Further studies are in place in the following technical fields: mechanics, biotech, electronics, and chemicals.

## “Apparatus for Identifying a Bill”

(Heisei 17 (Gyo Ke) 10490)

### (1)JPO Board of Appeal

- The difference between the claimed invention and the cited prior art is regarded as mere design modification and then the invention would have been easily made by a person skilled in the art.

### (2)IP High Court

- Even though a technical field of the claimed invention and the cited prior art is closely related, there is no small difference on their function, effect and specific structure, and the difference is not negligible.
- Features of the invention that are different from the cited prior art have not been disclosed or suggested in the cited document.
- Reasonable motivation is necessary to prove easiness to change the apparatus of the cited prior art into the claimed apparatus, but such motivation is not found in the cited prior art.

# Juridical decision on inventive step

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## “Shoe sole” case

(Heisei 18 (Gyo Ke) 10422)

### (1) JPO Board of Appeal

- Because the difference between the claimed invention and the main prior art is just a trivial technique based on the well known art, a skilled person would have made the invention easily.

### (2) IP High Court

-The main prior art per se intends to improve the waterproof-ness of shoe, but it has not disclosed nor suggested further improvement of waterproof-ness.

-Nor the common knowledge suggests this further improvement.

-Therefore, a person skilled in the art would not have been able to reach the claimed invention from the main prior art and the common knowledge.

-The argument by the JPO Board of Appeal is groundless and it cannot help saying that the JPO Board of Appeal has made reasoning for the features of the claimed invention after it perceived those features.