
Topic 8: Case Study 1

Understanding Inventions and ISRs

JAPAN PATENT OFFICE

1. First action procedures at the national stage
2. Understanding ISRs/WOISAs (Review of Topic 3)
3. How to understand claimed inventions
 - Brief explanation
 - Group work
 - Discussion
4. How to evaluate XY citations in ISRs
 - Brief explanation
 - Group work
 - Discussion
5. Summary and preview of Case Study 2

- Outline of first action procedures at the national stage
 1. Understanding ISRs/WOISAs
 2. Understanding inventions
 3. Prior art search, if necessary
 4. Understanding prior art documents, etc.
 5. Examination of requirements for patentability in terms of novelty, inventive step, etc.

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Let's start group work about understanding ISRs/WOISA!

What can you learn about the invention based on the ISR and WOISA of PCT/JP2012/123456? (If necessary, see Topic 3 slides.)

- ① International application number?
- ② International filing date?
- ③ Priority number?
- ④ Priority date?
- ⑤ Requirement of unity met?
- ⑥ Any claims which were found unsearchable?
- ⑦ Classification?
- ⑧ Electronic DB?
- ⑨ Number of claims?
- ⑩ Number of X/Y citations?
- ⑪ Publication number of each citation and category?
- ⑫ Assessment of patentability of each claim?

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Question 1

- When conducting patent examination at the national stage, why do examiners need to correctly understand the claimed invention?

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Answers

- To evaluate X/Y citations (knowing that X/Y citations can be used for refusal)
- To decide whether to conduct additional prior art searches
- To conduct timely and high-quality examination

Question 2

- How do examiners correctly understand a claimed invention?

Question 2

- How do examiners correctly understand a claimed invention?

Answers

- Carefully reading claims, specifications and drawings
- Color-highlighting and segmenting claims
- Color-highlighting items in specifications and drawings with the claims

Example of Color-highlighting and Segmenting

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
 - an image obtaining unit configured to obtain an image;
 - a server information storage unit configured to store plural items of superimposed data;
 - a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items;
 - a superimposing unit configured to superimpose the identified information on the obtained image and;to present the image having the superimposed information.
2. The superimposition information presentation apparatus according to Claim 1, further comprising a local information storage unit configured to store local information related to a user of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the local information.
3. The superimposition information presentation apparatus according to Claim 2, further comprising a sensor unit configured to obtain sensor information related to position and time of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information based on the sensor information.

Let's start group work about understanding claimed inventions!

- Discussing the invention:
For example, technical field, background art, problem the invention is to solve, means to solve the problems, etc.
- Color-highlighting and segmenting claims
- Color-highlighting items in specifications and drawings with the claims (if possible)
- Filling out Section 1 of the work sheet

Let's compare our results and discuss them!

- Problems that the invention is to solve
- Features of the invention (means to solve the problems)
- Color-highlighting and segmenting

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Question 3

- Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?

Question 3

- Why do examiners need to evaluate all X/Y citations when conducting patent examination at the national stage?

Answers

- To confirm whether each citation can be used as an X/Y citation
- To decide whether additional searches should be conducted

(Reference) excerption of Chapter 21 of PCT ISPE Guidelines

21.01 International Searching Authorities and International Preliminary Examining Authorities are entrusted to apply and observe all the common rules of international search and examination. Although applicants can generally expect the International Searching and Examining Authorities to act in accordance with the Guidelines, due to the involvement of several States in the international search and examination process and to the multitude of personnel within the various Authorities, **some variability is inherent to the international search and examination process**. At the same time, it is recognized that minimizing inconsistencies between or within the International Searching and Examining Authorities is crucial to the unqualified acceptance of an Authority's work product by the States.

Question 4

- How do examiners evaluate all X/Y citations?
(If necessary, please refer to Slide 8 of Topic 2.)

Question 4

- How do examiners evaluate all X/Y citations?
(If necessary, please refer to Slide 8 of Topic 2.)

Answers

- Carefully reading all X/Y citations
- Color-highlighting identical or similar technical features the same color as the corresponding elements in the claimed invention
- Comparing prior art to the claimed invention from the following view points:
 - Whether the technical field is the same
 - Whether each technical element of the claimed invention has been disclosed

Let's start group work on evaluating XY citations in ISRs!

- Discussing whether each technical element in the claimed invention is disclosed in the citations
- Color-highlighting identical or similar technical features the same color as the elements in the claimed invention
- Categorizing the citations as X, Y, or A
- Filling out Section 2 of the work sheet

Let's compare our results and discuss them!

- How did you evaluate D1?
 - Same technical field?
 - Are all technical elements in each claimed invention disclosed?
 - X, Y, or A for Claim 1?
 - X, Y, or A for Claim 2?
 - X, Y, or A for Claim 3?
- How did you evaluate D2?
 - Same technical field?
 - Are all technical elements in each claimed invention disclosed?
 - X, Y, or A for Claim 1?
 - X, Y, or A for Claim 2?
 - X, Y, or A for Claim 3?

4. How to evaluate XY citations in ISRs : Discussion

PCT/JP2012/123456 Claims 1-3	D1: US 2010/335934 A1	D2: JP 2009-198012 A
1. Selection superimposed information from plural items	X [0052] - [0058]	X [0021] - [0024]
2. Selection based on the local information (user information)	X [0052] - [0058]	
3. Selection based on the sensor information	Y [0043] - [0046]	Y [0025] - [0034]

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5. Summary and preview of Case Study 2

- It is very important to precisely understand the claimed invention. In order to do so:
 - Carefully read specifications,
 - Color-highlight and Segment claims,
 - Color-highlight specifications and drawings with the claims.
- It is also important to correctly evaluate all X/Y citations. In order to do so:
 - Carefully read each citation, focusing on the reference points suggested in ISRs;
 - Color-highlight identical or similar technical features the same color as the corresponding elements in the claimed invention.

5. Preview of Case Study 2

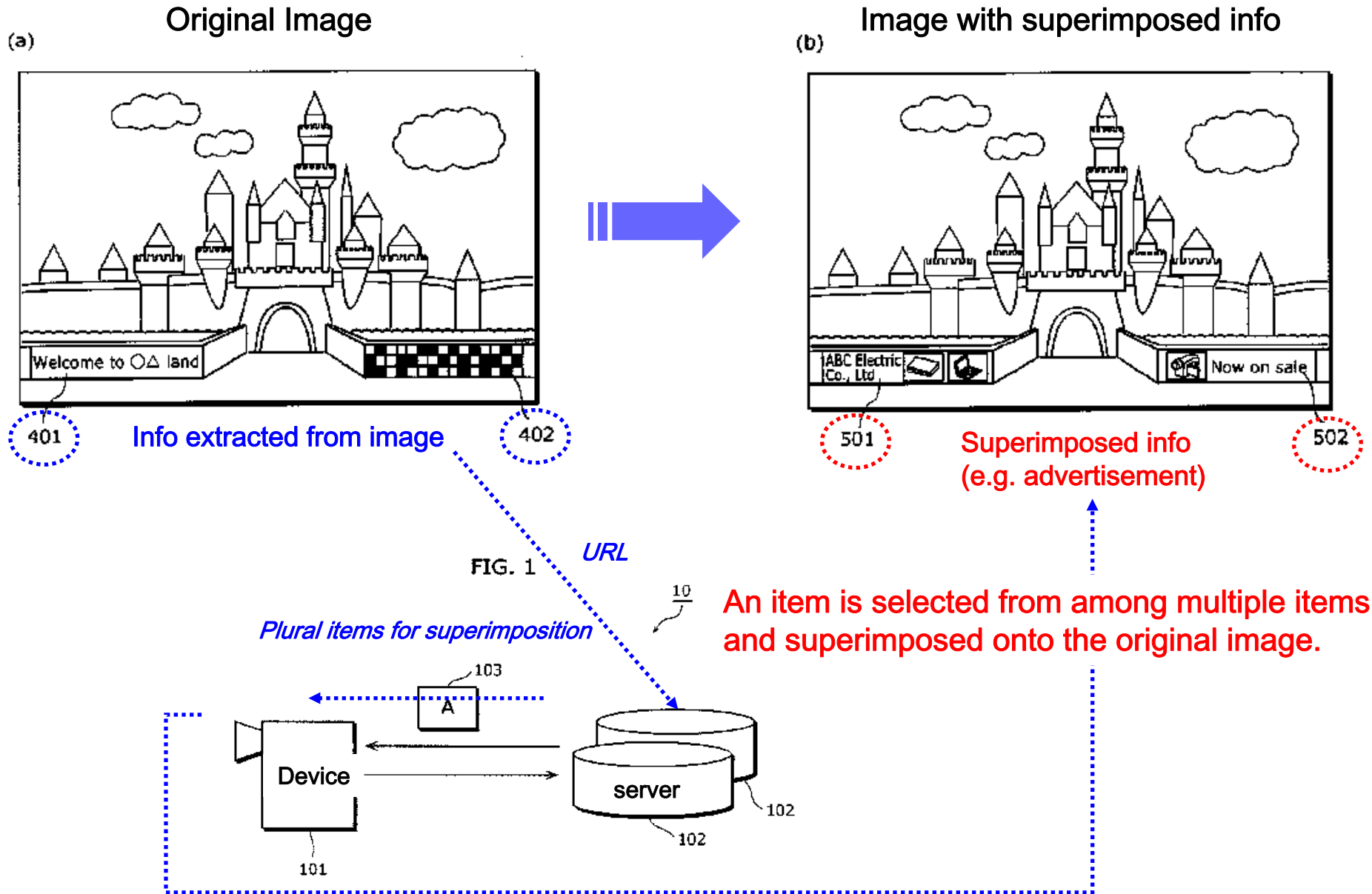
- As you learned in Topic 6, in order to make the claimed invention patentable (novel or non-obvious), amendments are often done sometime between the time that the ISR is established and the time that the first action is made at the national stage.
- In most of these cases, amended inventions include at least a technical element that has not been disclosed in any citations.
- Consequently, examiners need to conduct additional searches.
- In Case Study 2, based on the amended claims, you will learn:
 - How examiners decide whether to conduct additional searches; and
 - How examiners conduct additional searches, when needed.

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
 - an image obtaining unit configured to obtain an image;
 - an analysis unit configured to analyze the obtained image and to extract related information that relates to superimposed information;
 - a server information storage unit configured to store plural items of superimposed data;
 - a superimposition data selection unit configured to identify the to-be-superimposed information among the plural items based on the extracted related information;
 - a superimposing unit configured to superimpose the identified information on the obtained image and;
 - to present the image having the superimposed information.
2. The superimposition information presentation apparatus according to Claim 1, wherein the related information is URL information for accessing a server, and the plural items of superimposed information are obtained from the server and stored in the superimposed information storage unit.

Question (homework):

Does each amended claim appear to be novel and involve an inventive step?

Thank you!



Selection of an item for superimposition

Superimposition data management information

Superimposition data ID	Genre	Manufacturer	Target gender	Target age	Weather	Season	Location	...
1	Character	A	Male	10	—	—	Tokyo	...
2	Life	B	Female	40	Fine	Spring	Kobe	...
3	Character	A	Female	10	—	—	Tokyo	...
6	Sightseeing	C	Female	20	Rain	Autumn	Osaka	...
7	Food	D	Male	30	Fine	Summer	Kyoto	...
⋮	⋮	⋮	⋮	⋮	⋮	⋮	⋮	⋮

matching

Local information

1. User information

User identification	User registration information				Device Unique information		
	Gender	Age	Favorite genre	...	Manufacturer code	Key word	...
User 1	Male	28	Food/Sightseeing	...	D	—	...
User 2	Female	26	Character	...	D	—	...
⋮	⋮	⋮	⋮	⋮	⋮	⋮	⋮

2. Sensor information

- position
- time

Claims 1-3

1. Selection of an item for superimposition
2. Local information (user information)
3. Sensor information (position and time)

1. A superimposition information presentation apparatus which superimposes information in association with an image and presents the image having the superimposed information, said apparatus comprising:
 - an image obtaining unit configured to obtain an image;
 - a superimposed information storage unit configured to **store plural items of superimposed information**;
 - a superimposition data selection unit configured to **identify the to-be-superimposed information among the plural items**;
 - a superimposing unit configured to superimpose the identified information on the obtained image and;
 - to present the image having the superimposed information.
2. The superimposition information presentation apparatus according to Claim 1, further comprising a local information storage unit configured to **store local information related to a user** of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information **based on the local information**.
3. The superimposition information presentation apparatus according to Claim 2, further comprising a sensor unit configured to obtain **sensor information related to position and time** of said superimposition information presentation apparatus, wherein said superimposition data selection unit is further configured to identify the to-be-superimposed information **based on the sensor information**.

Information about additional images

Overlaying of an additional image



XX Sports is behind athletes all the way! 79

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	TYPE OF THE IMAGE	COLOR/TONE	MOTIF	SEASON	FITTING FRAME		USAGE NUMBER
					NUMBER	SHAPE	
ADDITIONAL IMAGE A1	DECORATIVE IMAGE	WARM COLOR	FLOWER	SPRING	—		3
ADDITIONAL IMAGE A2	DECORATIVE IMAGE	WARM COLOR	ANIMAL	ALL	—		4
ADDITIONAL IMAGE A3	DECORATIVE IMAGE	WARM COLOR	LANDSCAPE (MOUNTAIN)	AUTUMN	—		1
ADDITIONAL IMAGE A4	DECORATIVE IMAGE	WARM COLOR	LANDSCAPE (JUNGLE)	SUMMER	—		4
ADDITIONAL IMAGE B1	MARK IMAGE	BROWN	CONSTELLATION (CAPRICORN)	WINTER	—		4
ADDITIONAL IMAGE B2	MARK IMAGE	WHITE	CONSTELLATION (AQUARIUS)	WINTER	—		3
ADDITIONAL IMAGE C1	TEMPLATE IMAGE	WARM COLOR	EGG	ALL	1	ROUND	2
ADDITIONAL IMAGE C2	TEMPLATE IMAGE	PLANE WHITE	—	ALL	4	SQUARE	1

1. User profile information

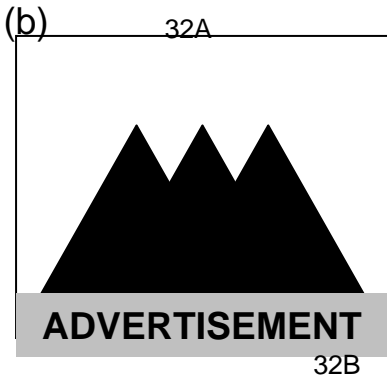
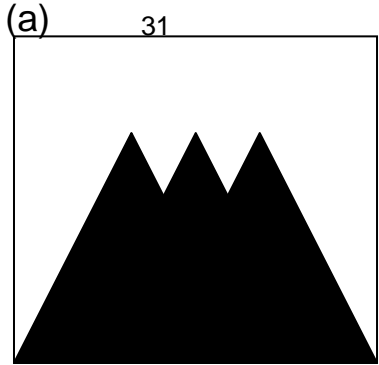
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CUSTOMER No.	NAME	SEXUALITY	BIRTHDAY	HOBBY	FAVORITE SPORTS	FAVORITE COLOR	FAVORITE TONE	FAVORITE TASTE
1	JOHN WILLIAMS	MALE	JUL.27/1950	MOUNTAIN CLIMBING	SOCCER	BLUE	COOL COLOR	CONSERVATIVE
2	DAVID JOHNSON	MALE	JUL.01/1955	WATCHING MOVIE	BASEBALL	YELLOW	WARM COLOR	CONSERVATIVE
3	MICHEL SMITH	MALE	JAN.01/1960	FISHING	SWIMMING	GREEN	WARM COLOR	VIVID
4	LISA JONES	FEMALE	APR.20/1965	FLOWER ARRANGEMENT	MARATHON	RED	WARM COLOR	VIVID
5	A SOCCER CLUB	—	—	—	—	—	—	—

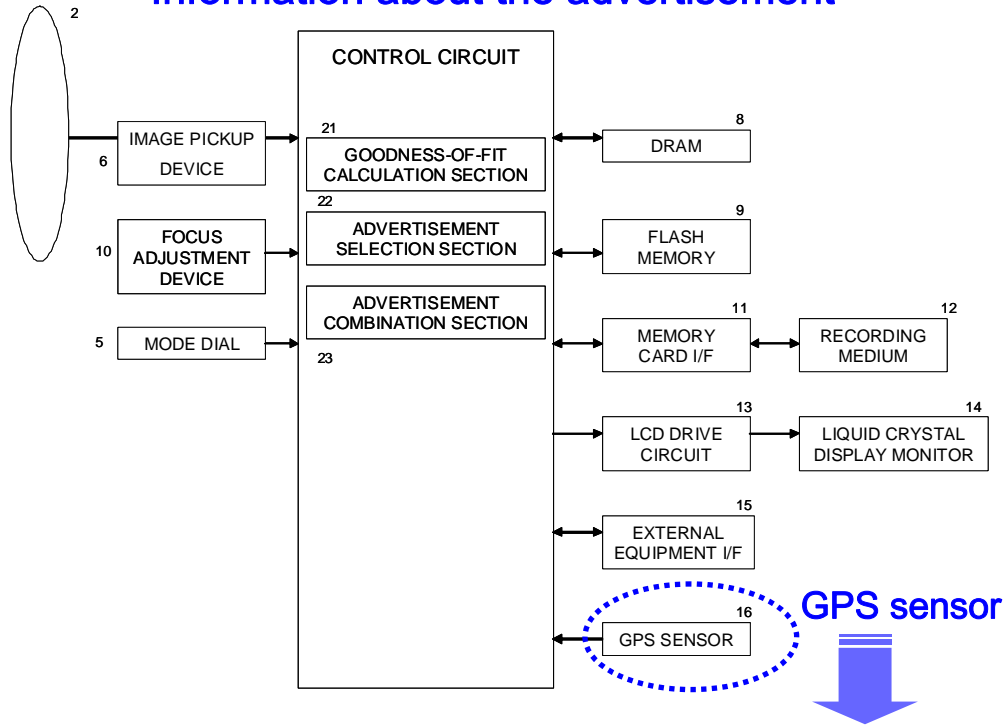
2. Feature information (analyzing images)

- tone
- main subject
- color

Overlaying of an advertisement



Information about the advertisement



	MODEL RANK	DATE AND TIME OF SHOOTING	SHOOTING MODE	SHOOTING LOCATION
ADVERTISEMENT A	0	70	20	10
ADVERTISEMENT B	80	0	20	0
ADVERTISEMENT C	0	80	20	0
ADVERTISEMENT D	40	10	0	50
ADVERTISEMENT E	10	10	40	40
ADVERTISEMENT F	10	10	50	30