

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part X: UTILITY MODEL

Chapter 1 Establishment of the Report of Utility Model Technical Opinion

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Chapter 1 Establishment of the Report of Utility Model Technical Opinion

1. Basic Concept

(1) Basic concept on report of technical opinion

Under a utility model system having no substantive examination to grant a right as promptly as possible, it is principally left to the judgment of persons/parties concerned whether or not a registered right of utility model would satisfy substantive requirements. However, because judging validity of the right needs technical and professional abilities, difficulties would bring unexpected confusion to judgment of persons/parties concerned. Therefore, Utility Model Act officially established the system of the report of utility model technical opinion, under which the Japan Patent Office provides objective materials upon a request useful for persons/parties concerned to determine novelty etc. of claimed devices in relation to prior art documents. (Refer to Article 12, 29bis and 29ter of Utility Model Act)

(2) Basic concept on establishment of a report of a technical opinion

A report of utility model technical opinion should be prepared promptly and appropriately by taking into consideration of fairness and objectivity.

2. Subject of Evaluation

A report of utility model technical opinion must be prepared on a claimed device for which the request was made. If amendment or correction (including those violating limitations pertaining to amendment or correction) is made prior to preparation of a report of utility model technical opinion,, the report must be prepared for claimed devices including the amendment or correction. Any report is not prepared for the claims which have been determined invalid in a trial for invalidation, for those deleted by correction of claims, and for devices pertain to a withdrawn or abandoned application for utility model before registration (See, "Note" below).

(Note) Article 12(2) of Utility Model Act stipulates that a request for preparing a report of utility model technical opinion cannot be made after the claim has been invalidated in a trial. Although there is no definitive rule for a case where invalidation is determined in a trial after the request has been made, the report of utility model technical opinion is not prepared even if invalidation was determined in a trial after the request for preparation of a report of utility model technical opinion was made, because no subjects for the report exist when the registration is invalidated. It is similar to claims deleted by correction and to devices pertaining to a withdrawn or abandoned application for utility model.

With regards to claimed devices, technical evaluation (i.e., evaluation on the provisions of Article 3(1)(iii), Article 3(2) (limited to those prescribed in Article3(1)(iii)), Article 3bis and Article 7(1)- (3) (hereinafter referred to as "evaluation on novelty etc.)) must be conducted (Article 12).

There are some cases where novelty etc. cannot be sufficiently evaluated if they failed to meet requirements stipulated in Article 5(4), (6), etc.. In these cases, the requirements stipulated in Article 5(4), (6), etc. are not evaluated, and then the report of utility model

technical opinion must contain an indication that novelty etc. cannot be sufficiently evaluated due to ambiguity etc. of claimed devices.

3. Prior Art Search

In principle, prior art search for preparing a report of utility model technical opinion must be conducted in a similar manner of examination for patent applications.

However, unpublished applications are outside the scope of prior art search. (see, Note)

(Note) In relation with a request date of a report of utility model technical opinion, there is possibility to find other applications from unpublished applications for a patent and a utility model registration etc. under Article 3bis. Even if such applications are found, it is not appropriate that an examiner waits to prepare the report until the applications will be published, because of demand of promptness in providing the report. Therefore, the scope of prior art search should be limited to published literature.

3.1 Subject of Prior Art Search

(1) Each device described in claims that are requested for a report of utility model technical opinion is a subject of prior art search. All claimed devices that are regarded as a subject of evaluation based on above 2., from those having the broadest concept to those having the narrowest concept, must be considered as a subject of prior art search.

(2) It is unnecessary to determine whether or not the requirements of unity are met.

(3) Findings of claimed devices must be made based on matter described in claims. The following points should be taken into consideration when an examiner finds claimed devices:

(i) If description in a claim is clear, finding of a claimed device must in principle be made based on description in the claim. Terms described in the claim must be interpreted as what they ordinarily mean.

(ii) Even if description in a claim is clear, where terms used in a claim are defined or explained in a description and drawings, the definition or explanation should be taken into consideration when the terms are interpreted. Meanwhile, even if mere illustration of more specific concept exists in a detailed description of a device or drawings, which is included in the concept of terms described in claims, the illustration is not considered as the definition or explanation explained above.

(iii) Even if inconsistency exists between a device found based on description in a claim and a device described in a description or drawings, finding of the claimed device should not be made solely on the description or drawing, without referring to description of the claim.

Namely, matter not described in a claim must be treated as it does not exist in the claim, even though it is described in a description or drawings, when an examiner finds a claimed device. On the other hand, matter described in a claim must always be treated as it exists in the claim.

(iv) Where a description in a claim allows various ways of interpretation, an examiner should consider all possible ways of interpretation for the purpose of conducting the widest scope of prior art search.

(v) Where a device is unclear or a device is not described enough to be carried out etc., matter in a description and drawings, and common general technical knowledge as filed, should be taken into consideration when an examiner interprets terms in a claim.

(4) Embodiments of claimed devices must be taken into consideration as a subject of prior art search.

(5) Prior art search must be done as far as possible, even if prior art search cannot be effectively conducted, because a description is so unclear that a claimed device cannot be found even by referring to the description or drawings, or because a claimed device is deemed not to fall under a statutory device. In this case, the indication that prior art search could not be effectively conducted must be written together with the reason why the search failed.

3.2 Method of Prior Art Search

(1) An examiner is expected to make an effort for finding all relevant prior art documents which could show lack of novelty, etc. of claimed devices based on the provisions of (i) lack of novelty based on a device publicly known by a reference (Article 3(1)(iii)); (ii) lack of inventive step based on a device publicly known by a reference (Article 3(2) (limited to those referred to Article 3(1)(iii))); (iii) prior art effect (Article 3bis); (iv) first-to-file rule (Article 7(1), (3)); (v) co-pending applications filed on the same date (Article 7(2), (7)). Prior art search must be conducted by paying due attentions to related examination guidelines concerned.

(2) Other respects are similar to those in the method of prior art search described in “Part 7: Examination Procedure, 2. Prior art search” for an examination of patent applications. However, it is not determined whether the requirements of unity are satisfied or not.

4. Evaluation of novelty etc.

(1) Examination Guidelines for patents are applicable to utility models when an examiner determines novelty etc. based on the provisions of (i) lack of novelty based on a device publicly known by a reference (Article 3(1)(iii)); (ii) prior art effect (Article 3bis); (iii) first-to-file rule (Article 7(1), (3)); and (iv) co-pending applications filed on the same date (Article 7(2), (7)).

(2) In reference to the manner of the Examination Guidelines for inventive steps of patent applications, whether or not a claimed device involves inventive steps must be determined by examining whether or not the claimed device would have been exceedingly easily arrived by a person having an ordinary skill in the art to which the device pertains, on the basis of devices publicly known by references.

(3) Under Utility Model Act, no opportunity for making an argument against evaluation of a report of utility model technical opinion is given to applicants and holders of a utility model right. The report provides the persons/parties concerned with objective materials useful for determining novelty etc. in view of prior art.

Consequently, when preparing a report of utility model technical opinion, examiners must make an effort to evaluate as objectively as possible, and when making a negative evaluation on novelty, they should evaluate them with convincing evidence for lack of novelty etc. Concretely, the evaluation should be done in the similar manner of making final decisions (i.e., “decision of rejection” or “decision of patent grant”) in a patent examination procedure.

(4) Where examiners cannot sufficiently evaluate novelty etc., because a claimed device is unclear or is not described enough to be carried out, etc., they should evaluate novelty etc. based on the most rational presumption for the evaluation derived from the description, claims and drawings and common general technical knowledge at the time of filing. In this case, deficiency in a description, etc. is also indicated on a report of utility model technical opinion (refer to Article 5.4.(2)), but no opportunity for making an argument against the deficiency is given to applicants and holders of utility model right. Therefore, only where an examiner is convinced that there must exist deficiency in a description, the most rational presumption for the evaluation should be established.

(The following examples explain how to put presumption for evaluation, which basic requirements and other requirements are not considered in.)

Example 1:

(Claim for utility models)

A comfortable chair shown in Fig. 1.

(Summary of description)

A chair whose seatback has a hollowed portion with the shape of human’s back is shown in Figure 1.

(Presumption for evaluation)

The evaluation will be conducted under the presumption that the phrase “comfortable as shown in Figure 1” means “the seatback has a hollowed portion with the shape of human’s back”.

Example 2:

(Claim for utility models)

A dog-shaped toy comprising: a numerical evaluation means for numerically evaluating human’s emotion, an emotional judgment means for judging human’s pleasure based on signals from the numerical evaluation means, and a wagging control means for controlling a waggle of the dog’s tail based on signals from the emotional judgment means.

(Summary of description)

A detailed description for the device only describes a dog-shaped toy having a means for wagging the tail on the basis of detecting the sound louder than the definite level.

(Presumption for evaluation)

When these phrases “a numerical evaluation means for evaluating human’s emotion” and “an emotional judgment means for judging human’s pleasure based on signals from the numerical evaluation means” are interpreted literally, no concrete example cannot be pictured, therefore novelty etc. cannot be sufficiently evaluated. At the same time, the detailed description of the device seems not to indicate a means other than that of detecting sound louder than the definite level. As the result, the “numerical evaluation means for numerically evaluating human’s emotion” and the “emotional judgment means for judging human’s pleasure based on signals from the numerical evaluation means” are evaluated on the assumption that they are detecting sound larger than the definite level.

(5) When arguments for claiming novelty etc. are provided in a written statement, they should be fully taken into consideration for evaluation.

(6) Where claims have been invalidated by an irrevocable appeal decision in a trial for invalidation, the content of a decision must be taken into consideration for evaluation. A report of utility model technical opinion must not be made for claims that were invalidated in the trial.

(7) In the case of a divisional or converted application, prior art search should be conducted based on the actual filing date. In principle, only when distributed publications etc. or applications for a patent or utility model registration having earlier filing dates, which can deny novelty etc. of claimed devices, are found between the original filing date and the actual filing date, whether or not these applications satisfy the requirements for a divisional and converted application should be determined according to the guidelines in "Part V, Chapter 1, Division of Application" and "Chapter 2, Conversion of Application"(see, Note). If these applications are not considered to meet the requirements of divisional or converted application, they are evaluated to be lack of novelty etc. based on the above distributed publications etc. or applications. On the other hand, if these applications are considered to meet the requirements of divisional or converted application, they are not evaluated to lose novelty etc..

(Note) Regarding the substantial requirement of the application for a utility model registration converted from a patent application, the requirement of "Part V, Chapter 2, Conversion of Application, 2.2(1)" doesn't have to be satisfied as far as the requirement of "Part V, Chapter 2, Conversion of Application, 2.2(2)" is satisfied. That is because a converted application can be made to meet the requirement of "Part V, Chapter 2, Conversion of Application, 2.2(1)" and the requirement of "Part V, Chapter 2 by amendment of the original application, even if the matters which are not described in the description, claims or drawings of the original application just before the conversion but described in the description, claims or drawings of the original application as originally filed are described in the description, claims or drawings of a converted application.

(8) In the case of an application which claims internal priority and/or priority under the Paris Convention, prior art search must be conducted on the actual filing date. In principle, only when distributed publications or prior applications for a patent or a utility model registration, which can deny novelty etc. of claimed devices, are found between the priority date and the filing date, whether or not the claimed priority for the devices takes effect should be determined in the same way as described in "Chapter IV Priority." If the claimed priority does not take effect, novelty etc. will be denied on the basis of the above publications and the precedent applications. On the other hand, if the claimed priority takes effect, novelty etc. will not be denied.

5. Description of the Report of Utility Model Technical Opinion

The content of the report of utility model technical opinion consists of: (i) the scope of prior art search; (ii) evaluation; (iii) indications of cited documents; and (iv) explanations of evaluation.

5.1 Indication of Scope of Prior Art Search

(1) The scope of prior art search actually conducted by examiners must be indicated, so that the scope of searched documents can be recognizable clearly and objectively.

(2) In principle, the scope of prior art search is identified by: (i) type of document; (ii) technical field; and (iii) period of time. Individual document, which cannot be identified in this way, is identified by the name of the publication, the name of the author or publisher and the publication date etc.

(3) Technical field is identified by the International Patent Classification (IPC).

5.2 Indication of Evaluation

Evaluation on novelty etc. for each claim must be indicated independently (If claims whose evaluation and explanation of the evaluation are common, an examiner can describe them together.). The content of evaluation falls under one of the following six categories:

Evaluation 1: The claimed device may be lack of novelty on the basis of cited documents (Article 3(1)(iii)).

Evaluation 2: The claimed device may be lack of inventive step on the basis of cited documents (Article 3(2)(limited to devices referred to Article 3(1)(iii))).

Evaluation 3: The claimed device is deemed identical with a device or an invention disclosed in a description, claims or drawings originally attached to a request of another application which was filed prior to the filing date of the utility model application, and which was published by Utility Model Gazette, Patent Gazette or publication of unexamined applications after the filing date (Article 3bis).

Evaluation 4: A claimed device is deemed identical with a device or an invention claimed in other applications that were filed prior to the filing date of this utility model application (Article 7(1) and (3)).

Evaluation 5: A claimed device is deemed identical with a device or an invention claimed in other applications that were filed on the same date of this utility model application (Article 7(2) and (7)).

Evaluation 6: No specific prior art documents or etc. that deny the novelty etc. are found (including cases where an effective search is difficult because of an ambiguous description).

5.3 Indication of Cited Documents etc.

(1) In a case where novelty etc. is denied,

(i) All discovered prior art documents etc. should be written in a report as long as it is necessary to deny novelty etc.

(ii) Where overlap exists among contents of prior art documents, unnecessary prior art should not be written in a report.

(iii) The best prior art documents etc., which is the closest to a claimed device should be

written in report, upon taking into consideration of embodiments etc.

(2) In a case where novelty etc. is not denied

When prior art documents which could deny novelty etc. of claimed devices are not discovered, other documents showing general state of the art of relevant technical fields pertain to the claimed device should be presented with the evaluation that specifically relevant prior art was not discovered (Evaluation 6).

5.4 Explanation of Evaluation

(1) In a case where novelty etc. is denied, an examiner must explain the reason in the column for explanation of evaluation so that a person who requested the report can understand it. Basically, the specific part of cited documents showing the ground must be described in the column. If the evaluation is Evaluation 1, 3, 4 or 5, it should be explained why novelty etc. of claimed devices was denied on the basis of a description at the specific part. If the evaluation is Evaluation 2, it is also required to describe the rationale for denial of inventive step on the basis of devices found in cited documents.

(2) When an examiner cannot sufficiently evaluate novelty etc. because a claimed device is ambiguously defined etc., it is required for him or her to describe what deficiency exists in a description etc. and what assumption is used for the evaluation of novelty etc.

(3) As described in Section 3.1 (5), when an examiner recognizes that prior art search could not be effectively conducted, the conclusion and the reason why he or she failed to do so must be described.

(4) Where requirements for a divisional or converted application are not satisfied, or where claim of priority is not allowed, the reason why an examiner determined so, and the explanation that the evaluation was made based on the date of the actual application must be indicated in a report.

(Note) Matters unrelated to evaluations of novelty etc. (e.g., whether new matter exists or not, requirement for correction stipulated in Article 14bis) should not be written in a report of utility model technical opinion even if they are clearly found.

6. Offer of Information

(1) Any person can offer information, such as distributed publications against an application for utility model registration, or utility model registration (Article 22 of Regulations under Utility Model Act)

(2) Examiners must fully consider contents of offered information, which is available at the time of preparation of a report of utility model technical opinion.

(3) It must be determined whether or not publications related to offered information, which is considered when an examiner prepared the report, can be prior art documents that deny the novelty etc. of the claimed device. The conclusion must be written at the indication column regarding the scope of prior art search in a report of utility model technical opinion.

7. Interviews

An interview pertain to a claim to meet requirements for novelty etc. (communication via telephone or facsimile is included) should not be taken place. However, an interview to receive technical explanations from an applicant, a right holder or his/her representative is permissible. If the interview is taken place to receive technical explanations, an examiner must keep a record of the explanations