

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

Part II: REQUIREMENTS FOR PATENTABILITY

Chapter 5. Treatment of Information Disclosed on the Internet as Prior Art

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Chapter 5. Treatment of Information

Disclosed on the Internet as Prior Art

(Applied to Applications on January 1, 2000 and after)

Patent Act Article 29 (1) reads:

“An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention, except for the following:

.....
(iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent application.

<Explanation of Terms>

- (1) A “line” means a two-way transmission line, generally constituted by send and receive channels. Broadcasting, which is only capable of one-way transmission, does not fall under the definition of a “line” (except for cable TV etc. that is capable of two-way transmission).
- (2) The “public” means an unspecified person in the society.
- (3) “Available to the public” means situations where information can be seen by an unspecified person, and it does not necessarily require that the information has actually been accessed. More specifically, information is considered as being available to the public in cases where a site on the Internet disclosing the invention is linked with any other sites on the Internet, the site is registered with any search engines, or the URL of the site appears in mass media (e.g., a widely-known newspaper or magazine), on condition that public access to the site is not restricted.
- (4) “Internet etc.” mentioned in this chapter refers to all means that provide technical information through electric telecommunication lines, including the Internet, commercial databases, and mailing lists. “Web page etc.” refers to what provides information on the Internet etc.

1. Information Made Available to the Public through Electric Telecommunication Lines that can be Cited as Prior Art

In order to cite technical information made available to the public through electric telecommunication lines (hereinafter referred to as “electronic technical information”) as prior art as in the case of the printed publications, it is required that the cited electronic technical information was published as it is before the filing of the application concerned.

The question of whether or not the information was made available before the filing of the application is judged based on the time of publication indicated in the cited electronic technical information. Therefore, electronic technical information without an indication of the time of publication cannot be cited, in principle. (See 1.1(3) for exceptional cases where electronic technical information without an indication of the time of publication is citable).

The following points explain how the cases should be handled when the time of publication indicated in the cited electronic technical information is before the filing of the application.

1.1 Cited Electronic Technical Information was Published As It Is before Filing of the Application

(1)The problem concerning the time of publication and alteration of the contents of the cited electronic technical information

Since electric information on the Internet etc. can be easily altered, the issue will always arise of whether the cited electronic technical information was published as it is at the indicated time of publication.

Even if the indicated time of publication thereof was before the filing of the application at the time the examiner discovered that information ^(Note), there is still a slight possibility that the indication itself was altered.

Even if the cited electronic technical information was published at the time the examiner discovers that information, there is still a slight possibility that its content was altered.

(Note)The time of publication is determined by converting the local time in the country or region where the information on the Internet etc. was published into the Japanese Standard Time.

(2)Measures to cope with the problems concerning the time of publication and alteration of the content of the cited electronic technical information

With regard to web sites etc. where there is only extremely small doubt that the cited electronic technical information was not published as it is at the indicated time of publication, the examiner should cite the information on the presumption that the content of information published at the time of the examiner's access was the same at the time of publication indicated in the web site etc.

With regard to cases where there is doubt as to whether the cited electronic technical information was published as it is at the indicated time of publication, the examiner should investigate whether the information is citable.

The examiner should not cite information on web sites etc., if there is only a small possibility of clearing the doubt that the cited electronic technical information was not published as it is at the indicated time of publication.

(3)Web sites etc. where there is only extremely small doubt that the cited electronic technical information was not published as it is at the indicated time of publication

Information published on the following web sites usually indicates points of contact clearly and thus are hardly considered to be altered.

- Web sites of publishers that have been issuing well-established publications etc. (e.g. web sites with electronic data from newspapers, magazines, etc. which offer electronic publications etc. of academic magazines.)
- Web sites of academic institutions (e.g. web sites of academic societies, universities, etc. which publish electronic data (technical papers) of academic societies, universities, etc.)
- Web sites of international organizations (e.g. web sites of standardization bodies, etc.)

which publish information on standard of measures etc.)

- Web sites of public organizations (e.g. web sites of ministries and agencies which publish the details of research activities, outline of research findings, etc. especially on the web sites of research institutes.)

Examiners should not cite information on these web sites etc., in principle, when the information does not indicate the time of publication, but they can cite such information if a certificate on the time of its publication as well as content thereof from a person with authority or responsibility for the publication, maintenance etc. of the published information is available.

- (4) Handling policy where there is doubt that the cited electronic technical information was not published as it is at the indicated time of publication

When the examiner judges that the cited electronic technical information is subject to the doubt above, he/she should inquire to the point of contact indicated in the web sites as to whether the information is altered, and examine.

If and only if, the doubt is cleared consequently, the examiner can cite the information.

- (5) Web sites etc. where there is only a small possibility of clearing the doubt that the cited electronic technical information was not published as it is at the indicated time of publication

The examiner should not cite information on web sites etc. for which neither points of contact nor time of publication thereof is clearly indicated, because there is only a small possibility of clearing the doubt.

1.2 Cited Electronic Technical Information was Available to the Public before Filing of the Application

Information on the Internet etc. is usually available to the public since it may be accessible to unspecified persons and can be transmitted in the same way as information disclosed in the distributed publications.

Information can be considered as being available to the public if it is published on the Internet etc., and its presence and location can be found by the public, and it is accessible by unspecified persons, even if the access to the web sites etc. requires a password or a charge.

- (1) Examples of cases where electronic technical information is available to the public

Web sites that are registered with search engines and that can be searched for, or whose presence and location can be found by the public (e.g. web sites linked from the web site of related academic bodies or news sites; the URL of the web site appears in mass media, such as newspapers or magazines.)

In case of web sites that require passwords, those that are accessible by unspecified persons merely by inputting the password (i.e. the information is considered as being available to the public, if anybody can access the web site etc. by acquiring a password through a non-discriminating procedure, regardless of whether acquisition thereof is charged).

In case of charged web sites etc. those that are accessible by unspecified persons

merely by paying a fee (i.e. the information is considered as being available to the public if anybody can access the web site etc. by paying a fee).

(2) Examples of cases where electronic technical information is not considered available to the public

Even if the information appears on the Internet etc., information falling under the following is not considered as being available to the public:

Web sites etc. that are on the Internet, but are only accessible by chance due to the lack of publication of the URL.

Web sites etc. that are only accessible by members of a specific body or a company and of which information is treated as secrets (e.g. an in-house system only accessible by the employees, etc.).

Web sites etc. on which information is encoded in such a way that it cannot generally be read (excluding cases where a decoding tool is openly available, with or without a fee)

Information that is not published long enough to be accessed by the public (e.g. information which published on the Internet for a short period of time).

2. Method of Citation

The electronic technical information retrieved from the Internet etc. shall be treated as follows at the time of citation.

(1) When there is the paper publication describing the same content as the electronic technical information, and when both can be cited, the paper publication shall be cited.

(2) Handling of cited electronic technical information

Even if information on the Internet etc. appeared at the time when the examiner conducted searching prior art, the information may be altered or deleted by the time the applicant or a third party accessed. Since this is a difficult situation for the applicant or the third party to correspond sufficiently, the examiner shall take the following procedures to store the electronic technical information on the Internet etc. that was cited in the notice of reasons for refusal etc. in a patent-related document database:

examiner prints out the information such as a web page;

examiner writes the time of access, the name of the examiner who accessed, the application number of the application for which the information was cited, and the URL of the web site on a paper printout mentioned in ; and

after that, the paper printout is handled in the same way as in digitizing cited non-patent literatures (NPLs).

(3) Manner of indicating electronic technical information as cited document etc

In the case of citing electronic technical information retrieved from the Internet etc., the bibliographical items about the electronic technical information, as far as they have been known, shall be listed in the following order which is in compliance with WIPO Standards ST.14:

Name of the author

Title

Relevant parts

Indicating the page, column, line, item number, drawing number, index within a

database, or the first and the last phrases of the cited part.

Type of medium (online)

Date of publication, name of publisher, location of publication, and the page(s) in which the relevant information is published

Date of retrieval

Describing the date when the electronic technical information was retrieved from the electronic media in parenthesis.

Identification of the source of the information and its address

Describing the source of electronic technical information and the URL of the web sites or the accession number.

Examples of indication of electronic technical information retrieved from the Internet

(Example of indication of information obtained from product manuals/catalogs or web sites)

Corebuilder 3500 Layer 3 High-function Switch. Datasheet. [Online]. 3Com Corporation, 1997. [Retrieved on 1998-02-24]. Retrieved from the Internet: <URL: <http://www.3com.com/products/dsheets/400347.html>>.

(Example of the indication in Japanese)

新崎 準、外3名、“新技術の動向”、[online]、平成10年4月1日、特許学会、[平成11年7月30日検索]、インターネット <URT: <http://iij.sinsakijun.com/information/newtech.html>>

Example of indication of electronic technical information retrieved from online database

Dong, X.R. ‘Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency management’, Chung Hua Wai Ko Tsa Chih, May 1993, Vol. 31, No. 5, pages 301-302. (abstract) Medline [online]; United States National Library of Medicine, Bethesda, MD, USA. [retrieved on 24 February 1998] Retrieved from: Dialog Information Services, Palo Alto, CA, and USA. Medline Accession no. 94155687, Dialog Accession no. 07736604

3. Provision of Information

Electronic technical information on the Internet etc. can be provided, similar to a distributed publication. The provider of the information must submit a printout of the electronic technical information on the Internet etc. in order to prove that the provided information is correct. The submitted printout of the information must include the content of information, indication of the time of publication, the URL at which the information was obtained, and the point of contact for the information. In this case, it is desirable to attach a certificate by the person with authority or responsibility for the publication, maintenance etc. of the information.

4. Counterargument of Applicant

(1) Where the counterargument of an applicant against the indicated time of publication and the content of information is not supported by evidence, but only based on his/her suspicion that there is the possibility of the disclosure through the Internet etc., the counterargument cannot prevail due to lack of specific grounds.

(2) Where a counterargument of an applicant raises a doubt that the electronic technical information was not published as it is or was not available to the public before the filing of the application, the examiner shall request with the person with the authority or

responsibility for the publication, maintenance, etc. of the information to issue a certificate as to the date of publication on the web sites etc. and the content of information thereof.

(3) Where, as a result of examining the counterargument etc. of the applicant, the examiner cannot be certain whether the electronic technical information in question was published as it is before the filing of the application, the said information should not be cited as prior art information.

5. Treatment of Unpublished Applications

The examiner can conduct searching prior art using the Internet for a patent application which is still yet to be published at the time of searching prior art. However, since there is possibility that search information such as search query, search keys etc.^(Note) is divulged at the time of searching, and thus the claimed invention in the patent application is leaked to a third party, careful attention shall be paid.

However, in cases where the cited document was found in a document list on the web sites etc. of a scientific society etc., or where the electronic technical information was obtained from information that had been provided, there is no possibility for leakage of the claimed invention in the patent application.

(Note) The following search queries are likely to lead to leakage of the invention to a third party:

- in cases of searching by using a new combination of general terms
- where a publicly known art is used for a new use (using the article for this use is new)