

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

## Section 2 Ministerial Ordinance Requirement (Patent Act Article 36(4)(i))

### 1. Overview

The Ordinance of the Ministry of Economy, Trade and Industry (Article 24bis of the Regulations under the Patent Act) pursuant to the delegation by Article 36(4)(i) requires stating in the detailed description of the invention "matters necessary for a person ordinarily skilled in the art to which the invention pertains to understand the technical significance of the invention" such as the problem to be solved by the invention and its solution so that the nature of the technical contribution realized by the invention can be understood and examination and search are facilitated (hereinafter referred to as "the Ministerial Ordinance requirement").

Since an invention is a creation of new technical idea, it is important that the invention is stated in the detailed description of the invention so as to make a person skilled in the art understand the technical significance of the invention (i.e., the technical contribution made by the invention) in light of the state of the art as of the filing. The statement relating to what is an unsolved problem, in which technical field such a problem resides, and how such a problem has been solved by the invention in the detailed description of the invention is useful for understanding of the technical significance of the invention.

Also, one who wishes to obtain a hint for research and development or to utilize useful patented inventions from patent documents can easily conduct a search of patent documents by paying attention to the problems to be solved by the inventions. Further, in determining inventive step of an invention, a publicly-known prior art document illustrating a problem to be solved which is common to the invention can be a ground for negating the inventive step of the invention. Meanwhile, determination of inventive step becomes easier for applicants and third parties if both the detailed description of the invention of a patent application subject to the examination and a prior art document contain the statements of problems to be solved.

For these reasons, the Ministerial Ordinance requirement is provided.

### 2. Determination Regarding Ministerial Ordinance Requirement

(1) Matters required to state under the Ministerial Ordinance requirement are regarded as the following items a and b.

a. Technical field to which an invention pertains

It is required in normal cases that at least one technical field to which a claimed invention pertains be stated in the detailed description of the invention as a technical field to which an invention pertains.

However, the "technical field to which an invention pertains" is not required to be explicitly stated if a person skilled in the art can understand it without such explicit statements when taking into account the statements of the description and drawings, as well as the common general knowledge as of the filing.

Further, on the technical field to which an invention pertains, in cases where the invention does not pertain to existing technical fields such as an invention developed based on an entirely new conception which is completely different from prior art, it suffices that the statements of the new technical field developed by the invention be provided and an application for such an invention does not need to state the existing technical fields.

b. Problem to be solved by the invention and its solution

(a) It is required in normal cases that at least one technical problem that the claimed invention aims to solve be stated as "the problem to be solved by the invention" in the detailed description of the invention.

Also, it is required in normal cases that how the problem has been solved by the claimed invention be explained as "its solution" in the detailed description of the invention.

(b) However, the "problem to be solved by the invention" is not required to be explicitly stated in a case where a person skilled in the art can understand it without such an explicit statement, when taking into account the statements of the description and drawings, which include statements of prior art or advantageous effects of the invention, as well as the common general knowledge as of the filing (including a case where a person skilled in the art could comprehend the problem when considering prior art which falls within the common general knowledge). Also, the statement of the solution of the problem to be solved by the invention does not need to be provided in cases where a person skilled in the art would understand how the problem has been solved by a claimed invention by identifying technical problem in the absence of the explicit statement (for example, in a case where how the invention solved the technical problem can be

understood by identifying the claimed invention in view of the statements of the embodiment, etc.).

(c) Further, the technical problem does not need to be explicitly stated in a case where a technical problem is by nature not conceived for the invention such as the following item (i), (ii), etc.

(i) An invention based on an entirely new conception which is completely different from prior art.

(ii) An invention which is based on a discovery resulting from trials and errors (e.g., inventions of chemical compounds).

In addition, when the technical problem is not conceived as mentioned above, how the problem has been solved by the invention (i.e., its solution) is not necessary, either. This is because "its solution" is only meaningful in connection with the technical problem, and how the technical problem was solved by the invention cannot be identified as long as the very technical problem remains unidentified.

(2) The enablement requirement ensures that the disclosure of how the invention is carried out to the public in return for granting of a patent. Accordingly, granting a patent to an application that does not satisfy the requirement would lead to inadmissible unfairness between a patentee and the third parties.

The purpose of the provision of the Ministerial Ordinance requirement, on the other hand, is to clarify the technical significance of an invention and thereby contributes to patent examinations and searches.

Accordingly, the Ministerial Ordinance requirement should be treated as follows.

a. As mentioned in the above section (1), statements of a problem to be solved and its solution may be omitted when it is found that correct understanding of the technical significance of the invention would rather be prevented due to the requirement that the problem to be solved by the invention and its solution be stated.

Also, when it is not conceived that an invention pertains to any existing technical fields, it suffices that the new technical field to which the claimed invention pertains is stated.

b. In the cases other than the above item a, with regard to such a patent application that a person skilled in the art cannot understand the technical field to which the claimed invention pertains or the problem and its solution on the basis of the statements of the description and drawings as well as the common general knowledge as of the filing, the patent application therefor is regarded as not complying with the Ministerial Ordinance requirement.

For example, if the matters specifying the invention include a numerical formula or numerical value but a person skilled in the art is unable to understand the substantial relationship between the problem to be solved by the invention and the specification by such numerical formula or numerical value on the basis of the statements of the description and drawings as well as the common general knowledge as of the filing, and as a result, unable to understand the solution to the problem to be solved by the invention, then the technical significance of an invention is indefinite, which constitutes a failure to comply with the Ministerial Ordinance requirement.

(3) With regard to prior art and advantageous effect in comparison with the prior art, the following points should be noted.

a. Prior art

Statement of prior art is not required under the Ministerial Ordinance requirement. However, when the technical field to which the invention pertains or the problem to be solved by the invention can be understood from the statement of the prior art, the statement of the prior art can be a substitute for statements of the technical field to which the invention pertains or the problem to be solved by the invention.

b. Advantageous effects over prior art

It is not required under the Ministerial ordinance requirement to state an advantageous effect of a claimed invention over a relevant prior art. However, when the problem to be solved by the invention can be understood from the statement of the advantageous effects, the statement of the advantageous effects can be a substitute for a statement of the problem to be solved by the invention.

(4) It is not required under the Ministerial Ordinance requirement to state industrial applicability.

<p>3. Procedures of Examination concerning Determination on Ministerial Ordinance Requirement</p>
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3.1 Notice of reasons for refusal

In the case where the examiner determines that the statement of the detailed description of the invention does not satisfy the Ministerial Ordinance requirement under Article 36(4)(i), the examiner shall issue a notice of reasons for refusal on that requirement. In such case, the examiner shall specify a claim, and clearly present in the notice of reasons for refusal that the detailed description of the invention violates the Ministerial Ordinance Requirement, but does not violate the enablement requirements, while pointing out which of the matters necessary to be stated under Ministerial Ordinance (see 2.(1)) is defective.

3.2 Argument and clarification of applicant

The applicant may present prior arts that the examiner would not have recognized, by a written amendment or a written opinion in response to the notice of reasons for refusal due to the violation of the Ministerial Ordinance Requirement, and may present an argument, a clarification, etc. that a person skilled in the art in the technical field to which the claimed invention pertains could have understood, the problems to be solved by the invention and their solution, by referring to the statements of the description and drawings and common general knowledge as of the filing. The applicant may submit a certificate of experimental results so as to support the argument and the clarification.

However, due to the deficiency of the matters stated in the detailed description of the invention, it sometimes happens that a person skilled in the art could not have recognized the problem to be solved by the invention and its solution, on the basis of the statements of the description and drawings and common general knowledge as of the filing. In such case, even when the applicant submits a certificate of experimental results after the filing of the patent application and compensates for such deficiency in the statement of the detailed description of the invention, and asserts that a person skilled in the art could have recognized the problem to be solved by the invention and its solution, the reason for refusal cannot be overcome.

### 3.3 Response of examiner to argument and clarification of applicant

In the case where the argument, the clarification, etc. (see 3.2) and the amendment make the examiner convinced that the statement of the detailed description of the invention meets the Ministerial Ordinance Requirement, the reason for refusal shall be deemed to have been overcome. If this is not the case, the examiner shall issue a decision of refusal on the grounds of the reason for refusal that the Ministerial Ordinance requirement is not satisfied.