

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

Section 3 Requirements for Disclosure of Information on Prior Art Documents

(Patent Act Article 36(4)(ii))

1. Overview

The Patent Act Article 36(4)(ii) prescribes the effect that the source of the information concerning the inventions known to the public through publication (Note such as the name of the publication and others (hereinafter referred to as "information on prior art documents" in this section.) should be described in the detailed description of the invention when the person requesting the grant of a patent (hereinafter referred to as "applicant" in this section.) has knowledge of any inventions related to said invention, that has been known to the public through publication at the time of filing of patent application (hereinafter referred to as "Requirements for disclosure of information on prior art documents" in this section.).

The information on prior art documents is required for a person skilled in the art and the examiner to understand what technical significance the invention for which a patent is sought has and what technical contribution is brought about in light of the state of the art at the time of filing of patent application. Also, the information on prior art documents is required for the examiner to assess the novelty and inventive step of the invention for which a patent is sought. Therefore, the disclosure of information on prior art documents contributes to prompt examination. Moreover, it contributes to stabilization of the right as accurate evaluation on the relation between the invention for which a patent is sought and the prior art can be made if the information on prior art documents is stated in the detailed description of the invention. To that effect, Article 36(4)(ii) prescribes requirements for disclosure of information on prior art document.

Although the non-compliance with requirements for disclosure of information on prior art documents does not directly correspond to the reason for refusal, it corresponds to the reason for refusal where the notice on non-compliance with requirements for disclosure of information on prior art document under the provision of Article 48septies (hereinafter referred to as "notice under Article 48septies" in this section.) was issued and these requirements have still not been satisfied based on the detailed description of the invention (Article 49(5)).

The provision of the Patent Act Article 48septies prescribes that the notice on non-compliance with these requirements may be issued where the examiner recognized

that it does not comply with the requirements for disclosure of information on prior art documents based on the detailed description of the invention. Although the notice under Article 48 septies shall not be issued uniformly, it shall be issued where the examiner recognizes it to be necessary. Even when it does not comply with these requirements, there shall be no substantial deficiency in the invention and it shall not damage the interest of a third person remarkably when it is patented. Also, the reason for refusal on non-compliance with these requirements would be notified surely even to applications without any reasons for refusal on other requirements, which may be contrary to the aim of Article 36(4)(ii) this system whose main purpose is achievement of prompt examination.

(Note) The "inventions known to the public through publication" refer to inventions as provided in Article 29(1)(iii) in the "prior art" in this chapter (the parenthesized portion of Article 36(4)(ii)). The "prior art" means inventions as provided in Article 29(1)-(3) in this chapter, and does not include inventions published at the time of filing of the patent application.

<b>2. Determination of Requirements for Disclosure of Information on Prior Art Documents</b>
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The information on prior art documents is required to be described in the detailed description of the invention relating the inventions whose information on prior art documents should be disclosed (see 2.1) in the prior art. (see 2.2)

### 2.1 Inventions whose information on prior art documents should be disclosed

Inventions for which information on prior art documents should be disclosed refer to inventions corresponding to all of the cases shown in 2.1.1 to 2.1.4 below.

#### 2.1.1 To be the inventions known to the public through publication

An examiner shall note that inventions known to the public through publication (see 1.(Note)) are inventions does not include inventions that were publicly known (Article 29(1)(i) in the same paragraph) and inventions that were publicly worked ((ii) in the same paragraph).

Considering the purposes of requirements for novelty, inventive step, and disclosure of information on prior art documents, it is appropriate to interpret that the

source of the information should be stated in the detailed description of the invention even though it does not fall under the an "invention" that is the creation of a technical idea utilizing a law of nature (Article 2(1)), if it relates to the invention for which a patent is sought. For example, where the invention for which a patent is sought is an invention relating to a business method, the applicant is required to describe the name of publications in which the business method is stated if the applicant knows of the related business method being described in a publication. On the other hand, as an invention described in a prior application, which is undisclosed at the time of filing of the patent application to be examined(In this part, hereinafter, referred to as "present application"), is not an invention known to the public through publication, it is not the subject for disclosure of information on prior art documents. However, it is desirable to describe the application number when the invention concerned relates to the invention for which a patent is sought.

#### 2.1.2 To be invention relating to invention for which patent is sought

The invention for which a patent is sought means the claimed invention.

The examiner shall determine whether an invention known to the public through publication "relates to" the claimed invention by considering matters shown in (i) to (iii) below.

- (i) Relevancy between the claimed invention and the invention known to the public through publication in terms of their technical field
- (ii) Relevancy between in the claimed invention and the invention known to the public through publication in terms of their problems to be solved
- (iii) Relevancy between the claimed invention and the invention known to the public through publication in terms of their matters specifying the invention

For example, an inventions known to the public through publication to be a direct premise of the claimed invention (the inventions known to the public through publication corresponding to a part "in ..." when the claim is recited in the forms of "in ..., characterized in ...") relates to the claimed invention.

Also, when the accumulation of technology that has relevancy with the claimed invention is less, there may be no invention that has direct relevancy such as identical technical field or problem. In such a case, the invention showing the general state of the art to be the technical background of the claimed invention is contained in the invention relating to the claimed invention.

Example : the inventions known to the public through publication relating to the claimed invention

The claimed invention relates to "a portable telephone set with a case consisting of special magnesium alloy", on the contrary, the invention known to the public through publication relates to "a portable telephone set with a case consisting of titanium alloy" and when both have the problem to be solved of weight reduction of a portable telephone set.

### 2.1.3 To be invention known to applicant

The following are inventions known to the applicant, for example.

- (i) Inventions obtained by the applicant in the prior art search, which was carried out in the research and development stage or filing stage of the claimed invention
- (ii) Invention disclosed in a writing such as a thesis etc. that was announced by the applicant prior to filing of the patent application
- (iii) Invention disclosed in the specifications, claims or drawings of a prior patent application that was filed by the applicant.

The applicant usually seems to understand the information known to the inventor with regard to the claimed invention. Therefore, the inventions known to the inventor may be estimated to be known to the applicant.

Where the applicants are more than one person, the inventions known to the public through publication that are known to at least one of the applicants correspond to the inventions known to the applicant.

### 2.1.4 To be invention known to applicant at the time of filing of patent application

The applicant is required to describe the information on prior art documents concerning the inventions known to the applicant at the time of filing of the patent application. There is not requirement to carry out the prior art search newly for an applicant who does not know the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application.

Also, Article 36(4)(ii) does not require to add to the detailed description of the invention by amendments the inventions known to the public through publication that were known to the applicant after filing of the patent application. However, it is desirable to add to the specification by amendment the information on prior art

documents concerning the inventions known to the public through publication that were known to the applicant after filing of the patent application, or to present said information by a written statement where the applicant considers said inventions to contribute to prompt and accurate examination.

Where there are inventions known to the public through publication at the time shown in the right column regarding the application shown in the left column in the following table, the information on prior art documents concerned is required to be described. Where a divisional application, a converted application or a patent application based on utility model registration is filed at the time of filing of new patent application, as they do not comply with requirements for divisional application, converted application or patent application based on utility model registration, the inventions known to the public through publication that were known to the applicant at the time of filing of new patent application are the inventions that were known to the applicant at the time of filing of the patent application.

Kinds of application	Time of filing of patent application
Divisional application, converted application or patent applications based on utility model registration	Time of filing of the original application (Article 44(2), Article 46(5), Article 46bis(2))
Application with internal priority claim	Time of filing of the present application (Article 41(2))
Application claiming priority under the Paris Convention (or recognized under the Paris Convention)	Time of filing of the present application (application to Japan)
International patent application	International filing date (Article 184ter(1))

## 2.2 Description of information on prior art documents in the detailed description of the invention

### 2.2.1 Description of information on prior art documents

It is enough to describe the source of the information concerning the inventions known to the public through publication that were known as the applicant at the time of filing of patent application, such as the name of the publication and others (bibliographic items on a publication describing the inventions known to the public

through publication, and the technical information and other information obtained through electric communication lines). Also, the applicant is not required to submit an original or a copy of the publications etc.

As the requirements for disclosure of information on prior art documents defines the requirements for the statement of the detailed description of the invention, the information on prior art documents is required to be described in the detailed description of the invention. It is impossible to comply with the requirements for disclosure of information on prior art documents by submitting a written opinion or the written statement in which the information on prior art documents is described.

#### 2.2.2 Where there is a large amount of information on prior art documents to be described

Where there is a large number of inventions known to the public through publication relating to the claimed invention, describing all of them may hinder the understanding of the claimed invention and go against the purpose of the requirements for disclosure of information on prior art documents. Therefore, it is desirable to describe appropriate number of inventions with higher relevancy among them. In addition, the inventions known to the public through publication not relating to the claimed invention should not be described.

#### 2.2.3 Where there is no information on prior art documents to be described

Where there is no information on prior art documents to be described at the time of filing of the patent application, it is desirable to describe the effect with reasons in the detailed description of the invention. For example, where the prior art known to the applicant is not that relating to the inventions known to the public through publication (for example corresponding to the inventions provided in Article 29(1)(ii); that is, "inventions that were publicly worked"), that effect shall be described. In addition, the effect that there is no information on prior art documents to be described and reasons may be shown in the written statement.

### 2.3 Addition of information on prior art documents by amendments

#### 2.3.1 Determination of amendments for adding information on prior art documents

Amendments for adding information on prior art documents to the detailed description of the invention do not fall under the addition of new matter, and are appropriate. Moreover, amendments for adding the contents described in the prior art documents to the column [Background Art] of the detailed description of the invention do not fall under the addition of new matter, and are appropriate. However, amendments to remove the deficiencies under the provision of Article 36(4)(i) by adding the information on evaluation and implementation of the invention such as comparison with the claimed invention and adding the contents described in the prior art documents fall under the addition of new matters, and are inappropriate.

For details, refer to “Part IV Chapter 2 Amendment Adding New Matter”, 3.3.2(1).

### 2.3.2 Where requirements for disclosure of information on prior art documents are not satisfied by amendments

The requirements for disclosure of information on prior art documents are not satisfied by amendments in the cases shown in (i) and (ii) below. In this case, the requirements for disclosure of information on prior art documents are not satisfied unless the information on prior art documents is added by the amendments.

- (i) Where the claimed invention becomes one that does not correspond to the information on prior art documents by the claim amendments
- (ii) Where the applicant knows the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application

### 2.4 Typical cases in which requirements for disclosure of information on prior art documents are not satisfied

The following are typical cases in which it is recognized that the requirements for disclosure of information on prior art documents are not satisfied.

- (i) Where the information on prior art documents is not described and in addition, the reason is not described at all.
- (ii) Where the information on prior art documents is not described and the reason is described; however, it is recognized that the probability is high that the applicant

knows of the inventions known to the public through publication relating the claimed invention at the time of filing of the patent application.

Example 1: Where the information on prior art documents is not described and as the reason, it is described that the prior art known to the applicant is not that relating to the inventions known to the public through publication, however, the applications are disclosed by the applicant in great numbers in the technical field relating to the claimed invention.

(iii) Where the prior art is described in the specifications or drawings but the information on prior art documents corresponding to the prior art concerned is not described and the reason is not described.

The invention described in the specifications or drawings as a prior art shall be treated as an invention that was known to the applicant at the time of filing of the patent application.

(iv) Where only the source of information concerning the inventions known to the public through public not relating to the claimed invention is described, and it is recognized that the probability is high that the applicant knows the inventions known to the public through publication relating to the claimed invention at the time of filing of the patent application.

Example 2: Where only the information on prior art documents on the matters not relating to the claimed invention and being different in technical field or subject from the claimed invention is described, in spite of the fact that the inventions known to the public through publication, which are identical in technical field and subject to the claimed invention are known widely in general

Example 3: Where the information on prior art documents on an old invention known to the public through publication with less connection is described in spite of the fact that new inventions known to the public through publication with high relevancy to the claimed invention are known widely in general

<p>3. Procedure of Examination for Determination of Requirements for Disclosure of Information on Prior Art Documents</p>
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The non-compliance with the requirements for disclosure of information on prior art documents does not directly correspond to the reason for refusal. It corresponds to the reason for refusal where the notice under Article 48septies was issued and these requirements have still not been satisfied based on the detailed description of the invention(Article 49(v)).

### 3.1 Notice under Article 48septies

#### 3.1.1 Notice under Article 48septies

(1) The examiner may issue the notice under Article 48septies where it is recognized that the requirements for disclosure of information on prior art documents are not satisfied based on the detailed description of the invention.

However, the notice under Article 48septies is not issued uniformly; it shall be issued when the examiner recognizes it to be necessary in light of the purpose of these requirements provided for achieving the prompt examination.

The notice under Article 48septies is basically to be issued in order to obtain the information on prior art documents useful for the examination. Therefore, it is appropriate to issue this notice before the first notice of reason for refusal.

(2) Where the notice under Article 48septies is issued, and a part of the claims relates to the non-compliance with requirements for disclosure of information on prior art documents, the claim shall be identified and the reason shall be specifically described in determining that the requirements for disclosure of information on prior art documents are not satisfied.

#### 3.1.2 Response of applicant against notice under Article 48septies

The applicant may add information on prior art documents by filing amendments or argue that the applicant does not know the relating invention known to the public through publication by filing a written opinion against the notice under Article 48septies. When an amendment is performed to add the information on prior art documents, it is desirable to file a written opinion that describes contents of the invention known to the public through publication, and identical features and differences of the claimed invention and the invention known to the public through

publication (see 2.3.1 in this Chapter).

### 3.1.3 Handling of examiner after response of applicant shown in 3.1.2

The examiner shall determine that the reason for refusal is overcome for non-compliance with the requirements for disclosure of information on prior art documents, and proceed with the examination where the examiner comes to be convinced that the description of the information on prior art documents in the detailed description of the invention complies with the requirements for disclosure of information on prior art documents by the filed written amendment or written argument.

Otherwise, where the previous conviction on the non-compliance with the requirements for disclosure of information on prior art documents is not changed even after considering the written amendment and the written opinion; for example, in the case (i) or (ii) below, the examiner may issue the notice of reason for refusal on non-compliance with the requirements for disclosure of information on prior art documents according to 3.2 below (Article 49(v)).

- (i) Where the information on prior art documents is still not disclosed, and the written opinion does not provide a rational explanation that there is no invention known to the public through publication
- (ii) Where the information on prior art documents is disclosed by the amendments, but appropriate information on prior art documents is not disclosed

## 3.2 Notice of reason for refusal

### 3.2.1 Notice of reason for refusal on non-compliance with requirements for disclosure of information on prior art documents

(1) The examiner may issue the notice of reason for refusal on non-compliance with requirements for disclosure of information on prior art documents where the examiner comes to be convinced that the requirements for disclosure of information on prior art documents are not satisfied after considering the written amendment and the written opinion where the notice under Article 48septies was issued (Article 49(v)).

Since Article 49(v) is a provision, which prescribes the case where the requirements for disclosure of information on prior art documents are not satisfied in spite of the notice under Article 48septies, the reason for refusal on non-compliance

with requirements for disclosure of information on prior art documents cannot be issued without the notice under Article 48septies.

(2) Where only a part of the claims relates to the non-compliance with these requirements, the claim shall be identified and the reason shall be specifically described in determining that the requirements for disclosure of information on prior art documents are not satisfied in the notice of reason for refusal.

Where the notice of reason for refusal is issued stating that the requirements for disclosure of information on prior art documents are not satisfied without assessing patentability such as novelty, inventive step and the like, the effect shall be specified.

### 3.2.2 Response of applicant against notice of reason for refusal

The applicant may add information on prior art documents by filing amendments or argue that the applicant does not know of the related inventions known to the public through publication by filing a written opinion against the notice of reason for refusal. When an amendment is performed to add the information on prior art documents, it is desirable to file a written opinion that describes contents of the invention known to the public through publication, and identical features and differences of the claimed invention and the invention known to the public through publication (see 2.3.1).

### 3.2.3 Handling by examiner after response of applicant shown in 3.2.2

The examiner shall determine that the reason for refusal is overcome for violation of the requirements for disclosure of information on prior art documents, and proceed with the examination where the examiner comes to be convinced that the description of the information on prior art documents in the detailed description of the invention complies with the requirements for disclosure of information on prior art documents by the filed written amendment or written argument.

Otherwise, where the examiner does not come to convince that the description of the information on prior art documents in the detailed description of invention complies with the requirements for disclosure of information on prior art documents even after considering the amendments and written opinion, for example, in the case (i) or (ii) below, the examiner shall determine that the reason for refusal is not overcome for non-compliance with the requirements for disclosure of information on prior art

documents and issue the decision of refusal.

- (i) Where the information on prior art documents has not been still disclosed, and the written opinion does not provide a rational explanation that there is no invention known to the public through publication
- (ii) Where the information on prior art documents is disclosed by the amendments, but appropriate information on prior art documents is not disclosed

#### 4. Procedures for Describing Information on Prior Art Documents in Specifications

Procedures for describing information on prior art documents in specifications by applicant are as follows.

##### 4.1 Method for describing information on prior art documents

###### 4.1.1 Principle

The information on prior art documents shall be described changing a line for information on prior art documents. The column [Prior art documents] is set forth preferably in front of the information on prior art documents.

In that case, a column with a serial number is prepared in order to describe as [Patent document 1] and [Patent document 2] when names of gazettes on patents, utility models, or designs are described and as [Non-patent document 1] and [Non-patent document 2] when places of other information such as periodical publications or information on the Internet and the like are described and only the information on prior art documents is described one by one in each column. Matters other than information on prior art documents shall not be described in a column for describing information on prior art documents (see 4.2.2).

The columns [Patent documents] and [Non-patent documents] are preferably set forth in front of the columns [Patent document 1] and [Non-patent document 1], respectively.

Where a place for describing information on prior art documents in the publications can be specified, the place concerned shall be specified by describing page number, line, number, paragraph number, drawing number, and the like in the column, in which information on prior art documents is described.

#### 4.1.2 Description of contents of prior art

Where contents of prior art relating to the information on prior art documents and comparison with the claimed invention and the like are described, they shall be described in the column [Background art] of the detailed description of the invention.

Where the information on prior art documents is mentioned in the description of contents and the like of the prior art relating to the information on prior art documents, it is desirable to use the name of the column in which the information on prior art documents is described ([Patent document 1] and the like) (see 4.2.1).

#### 4.1.3 Description of prior application

Where the invention described in a prior application, which is not disclosed at the time of filing of patent application is described, the application number of the application concerned shall be described in the column [Background art] of the detailed description of the invention.

#### 4.1.4 Where there is no information on prior art documents to be described

Where the effect that there is no information on prior art documents to be described and the reason are described, they shall be described in the column [Background art] of the detailed description of the invention.

### 4.2 Examples of description of information on prior art documents

#### 4.2.1 Examples of appropriate description

[Technical field]

[0001]

... ..

[Background art]

[0002]

The existing ... .. is doing (for example, see Patent document 1 (see Pages 5 to 7 and Figure 1)).

Also, some are doing (for example, see Non-patent document 1).

[Prior art documents]

[Patent document]

[0003]

[Patent document 1] Japanese Patent Application Laid-open No. 2001-XXXXXXX

[Non-patent document]

[0004]

[Non-patent document 1] "ΔΔΔΔΔ" Written by OOOOO, XXPublication, January 1, 2001, pages 12 to 34

[Summary of the invention]

[Problem to be solved by the invention]

[0005]

... ..

#### 4.2.2 Examples of inappropriate description

[Technical field]

[0001]

... ..

[Background art]

[0002]

The existing ... .. is doing.

[Prior art documents]

[Patent document]

[0003]

[Patent document 1]

Japanese Patent Application Laid-open No. H5-XXXXXXX

The above document discloses ... ..

[Summary of the invention]

[Problem to be solved by the invention]

[0004]

... ..

(Explanation)

The explanation on contents of information on prior art documents is described in the

column (column in [Patent document 1] and the like) for describing information on prior art documents in the example. However, the matters other than information on prior art documents should not be described in the column for describing information on prior art documents. When explaining contents of information on prior art documents and the like, they shall be described in the column [Background art].