

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

Part II Chapter 2 Section 1 Patent Act Article 36(5)

Chapter 2 Requirements for Claims

Section 1 Patent Act Article 36(5)

(1) In the first sentence of Article 36(5), it is provided that the claims shall state a claim or claims and state for each claim all matters necessary to specify the invention for which the applicant requests the grant of a patent. This sentence is provided that matters which the applicant deems necessary to define the invention for which a patent is sought should be stated in the claims without excess or shortage, so that he/she neither states unnecessary matters nor omits necessary matters.

Since it is the applicant who determines for what invention to seek a patent, the Article sets forth that the applicant shall state in the claim all matters the applicant himself/herself deems necessary to define the invention for which a patent is sought.

(2) In the second sentence of Article 36(5), it is provided that an invention specified by a statement in one claim may be the same invention specified by a statement in another claim. This sentence is provided to prevent the misunderstanding that a single invention shall not be defined in more than a single claim.

(3) Article 36(5) also makes clear the nature of the claims. By clearly providing that it is in a claim that the applicant states matters specifying the invention, this Article makes it clear that the technical scope of the patented invention is determined based on the statement of the claim (Article 70(1)), and that the subject of the examination is the invention identified based on the statement of the claim.

(4) The claims must be divided into one or more claims, and each of which sets forth matters specifying the invention. A claim constitutes a basic unit for a determination of patentability (Articles 29, 29bis, 32 and 39), effects of a patent right (Article 68), abandonment of a patent right (Articles 97(1) and 185), a request for a trial for patent invalidation (Article 123), fees (Articles 107 and 195), etc.

(5) It is neither a reason for refusal nor a ground for invalidation whether all matters necessary to specify the invention are stated in a claim.