

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

Section 2 Support Requirement (Patent Act Article 36(6)(i))

1. Overview

Patent Act Article 36(6)(i) provides that a claimed invention shall be disclosed in the description. The purpose of this requirement (support requirement) is to prevent a patent from being granted for an invention which is not disclosed to the public.

2. Determination of Support Requirement

2.1 Basic ideas of determination of support requirement

(1) It is determined whether the statement in the claims satisfies the support requirement by comparing the claimed invention and the invention stated in the description.

This comparison is made by considering what is stated in the description on the basis of the claimed invention. The examiner should not apply the support requirement so strictly as to oblige the applicant to limit the scope of the claimed invention to its specific mode disclosed in the description.

(2) In performing this comparison, the examiner examines a substantial correspondence between the claimed invention and the invention stated in the description regardless of the consistency of expression. Given that the support requirement is satisfied only by the consistency of expression, a patent right for the invention which has not substantially been disclosed to the public would be granted, thus it is against the purpose of the provision of Article 36(6)(i).

(3) The consideration of the substantial correspondence done by the examiner is to examine whether or not the claimed invention exceeds “the extent of disclosure in the description to which a person skilled in the art would recognize that a problem to be solved by the invention would be actually solved” (hereinafter, referred to as “the extent of disclosure in the description”). When it is determined that the claimed invention exceeds “the extent of disclosure in the description,” the claimed invention and the invention disclosed in the description do not substantially correspond with each other, and thus, the statement in the claims does not satisfy

the support requirement.

In principle, the examiner identifies a problem to be solved by the invention from the statement in the description. The examiner, however, identifies the problem while taking into account the common general knowledge at the time of filing in addition to all of the statements in the description and drawings in either (i) or (ii) of the following cases:

- (i) when any problem is not clearly indicated in the description; or
- (ii) when, although a problem is clearly indicated, it is unreasonable as a problem to be solved by the claimed invention in light of the other parts of the statement in the description and/or the common general knowledge at the time of filing, e.g. a case when a problem clearly indicated in the description attached to a divisional application is the same as that indicated in the description attached to the original application (see “Part VI Chapter 1 Section 1 Requirements for Division of Patent Application” 1.), but the problem is found to be unreasonable as a problem to be solved by the invention claimed in the divisional application when taking into account other parts of the statements in the description and/or the common general knowledge at the time of filing.

When identifying “the extent of disclosure in the description,” the examiner takes into account the common general knowledge at the time of filing in addition to all of the statements in the description and drawings.

2.2 Types of violations of support requirement

The following (1) to (4) are types of cases in which the statements in the claims do not satisfy the support requirement.

(1) No statement or implication of claimed elements in the description

Example 1

The claim has a numerical limitation, while any specific numerical value is neither stated nor implied in the description.

Example 2

The claim solely recites an invention using an ultrasonic motor, while the

description states only an invention using a DC motor and it neither states nor implies anything about using an ultrasonic motor.

- (2) Unclear correspondence between the claimed invention and the statement in the description due to inconsistent use of terms therein

Example 3

A “data processing means” of a word processor is recited in the claim, while a “means for changing the size of characters” and a “means for changing line spacing” are stated in the description. It is unclear whether the “data processing means” in the claim corresponds to the former or the latter means in the description, or both of them, thus the claim does not substantially correspond to the statement in the description.

- (3) Over-expanded or over-generalized invention claimed

The examiner should note the following points when applying this type.

- a A claim may be recited with expansion or generalization based on one or more specific examples in the description. The maximum extent to which the claimed invention may be expanded or generalized without going beyond the extent of disclosure in the description depends on technical fields to which the invention pertains. For example, compared with in the technical field where it is difficult to understand the correspondence between function, characteristics, etc. of a product (see 4.1 in “Section 3 Clarity Requirement”) and structure of the product, in the technical field where it is relatively easy to understand such correspondence, the maximum extent to which the invention may be expanded or generalized based on the specific examples tends to be wider. The examiner firstly determines to which technical field the invention concerned pertains and what kind of common general knowledge at the time of filing exists in the relevant technical field. And then, he/she makes a determination, on an invention-by-invention basis, as to whether the details provided in the description can be expanded or generalized to the scope of the claimed invention.
- b Type (3) may be applied only when, in accordance with the basic ideas of the determination of the substantial correspondence (see 2.1(3)), a claimed invention is found to exceed the extent of disclosure in the description. The examiner does

not apply Type (3) independently of the problem to be solved by the claimed invention.

Example 4

A claim comprehensively recites R receptor activating compounds. However, the description discloses no specific example other than the chemical structures and a manufacturing method of novel R receptor activating compounds, X, Y, and Z. The details provided in the description can be neither expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing.

Example 5

A claim is defined by a result to be achieved, e.g. a claim relates to a hybrid car defined by the desired level of energy efficiency. However, the description discloses only an invention with a specified means to achieve the result. The details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing.

Example 6

A claim relates to a product defined by a mathematical formula or a numerical range of values, e.g. a polymer composition, a plastic film, a synthetic fiber, or a tire. The description states that the mathematical formula or the numerical range of values is specified for the purpose of solving a problem. However, the description does not contain such a sufficient example or explanation that a person skilled in the art would recognize that the problem would be solved by such a formula or a range of numerical values even in light of the common general knowledge at the time of filing. Therefore, the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention.

In a case when a numerical range of values is not the technical characteristics of the claimed invention and the numerical range recited in the claim is merely desirable one, such a claim does not fall under Type (3) even if any specific values within such a numerical range are not stated in the description.

- (4) No recitation of elements necessary for the solution of the problem to be solved specified in the description

The examiner should note the following points when applying Type (4).

- a Type (4) may be applied only when, in accordance with the basic ideas of the determination of the substantial correspondence (see 2.1(3)), a claimed invention is found to exceed “the extent of disclosure in the description.”

- b When two or more problems are identified from the statements in the description, it is required that at least one solution for one of the problems to be recited in the claim.

Example 7

According to the description, the problem to be solved is only to provide a system wherein a server can send information to any terminals that use different data formats each other. The description only discloses, as a solution for the problem, a system comprising a server and terminals for providing the terminals with information by the server, wherein the server retrieves from the storage means the data format conversion parameter corresponding to a destination terminal, converts the data format of the information based on the retrieved data format conversion parameter, and transmits the information in the converted format to the terminal. On the other hand, the claim does not recite the conversion of data format. Therefore, the scope of the claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of the element necessary for solving the problem.

Example 8

The problem to be solved by the invention identified from the description is only to prevent an automobile from exceeding the speed limit, and only a solution of the problem provided in the description is a mechanism which increases force needed to push the accelerator pedal further as speed increases. On the other hand, the claim only recites a force adjusting means that adjusts the force required to operate a means of acceleration along with increase in speed, and, even in light of the common general knowledge at the time of filing, it is evident that the problem cannot be solved when the force needed for the operation decreases along with increase in speed. Therefore, the scope of the claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of the element

necessary for the solution of the problem.

3. Examination Procedure for Determination of Support Requirement

3.1 Notice of reasons for refusal

When the examiner determines that the statement in the claims does not satisfy the support requirement, the examiner notifies the reason for refusal.

The following explanation is related to a notice of reasons for refusal coming under Types (3) and (4) in 2.2.

3.1.1 Type (3) (see 2.2(3))

When the examiner determines that the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention in light of the common general knowledge at the time of filing, the examiner notifies the reason for refusal. In the notification of reasons for refusal, the examiner specifically explains the reason why he/she determines so, while showing the grounds for such determination, e.g. a part of the statement in the description and details of the common general knowledge at the time of filing that he/she has taken into account when making the determination. The examiner is also required to set forth in the notification, to the extent possible, such a clue, e.g. the extent to which the invention can be expanded or generalized, that the applicant understands how the claim should be amended in order to overcome the reason for refusal.

The examiner should not state the reason for refusal as stated in the following items (i) or (ii) without specific explanation of the reason, because this would make it difficult for the applicant to make an effective argument or understand the direction of an amendment that should be made in order to overcome the reason for refusal.

- (i) The statement only reads as follows: “The details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing.”
- (ii) The statement of the reason reads that the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention solely relying upon the common belief that “it is difficult to predict in the technical field concerned”.

In addition, the examiner should take care not to determine so strictly as to oblige the applicant to limit the scope of the claimed invention to its specific mode disclosed in the description (see 2.1(1)).

3.1.2 Type (4) (see 2.2(4))

When the examiner determines that a claimed invention goes beyond the extent of disclosure in the description due to lack of recitation of a solution for the problem to be solved, which is stated in the description, the examiner notifies a reason for refusal. In the notification of reasons for refusal, the examiner specifically explains the reason why he/she determines so, while showing the problem to be solved by the invention and the solution therefor as identified by him/her. When the examiner determines that the problem clearly indicated in the description is unreasonable as a problem to be solved by the claimed invention, he/she should also specify a reason for such determination.

When showing the solution for the problem, the examiner should, while being careful not to be prejudiced by specific examples (see 2.1(1)), make efforts to ensure that the applicant understands how the claim should be amended in order to overcome the reason for refusal.

It is not appropriate for the examiner to merely state that “an element necessary for solving the problem, which is stated in the description, is not recited in the claim”, because this would make it difficult for the applicant to make an effective argument or understand the direction of an amendment that should be made in order to overcome the reason for refusal.

3.2 Argument and/or explanation by applicant

In response to a notice of reasons for refusal involving a violation of the support requirement, the applicant may make an argument, explanation, etc. by submitting a written opinion, certificate of experimental results, and the like.

The following explanation is related to Types (3) and (4) in 2.2.

3.2.1 Type (3) (see 2.2(3))

Upon receiving a notice of reasons for refusal coming under Type (3), the applicant may make an argument in a written opinion, for example, pointing out the common general knowledge at the time of filing other than one taken into account by the examiner when making the determination, and arguing that, in light of such common general knowledge, the details provided in the description can be expanded or

generalized to the scope of the claimed invention. The applicant may also submit a certificate of experimental results to support such an argument.

However, when, due to an insufficient statement in the description, the details provided in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge at the time of filing, the reasons for refusal cannot be overcome even by submitting a certificate of experimental results after filing of the application in order to make up for such deficiency, and thereby arguing that the provided details can be expanded or generalized to the scope of the claimed invention.

(see: case on the action to seek rescission of the JPO decision to revoke the patent, Decision by the Intellectual Property High Court, Grand Panel, November 11, 2005 [Heisei 17 (Gyo KE) No. 10042], “Manufacturing Method of Polarizing Film”)

3.2.2 Type (4) (see 2.2(4))

In response to a notice of reasons for refusal coming under Type (4), the applicant may make an argument, while taking into account the statements of the description and drawings as well as the common general knowledge at the time of filing, that it is possible to identify a problem and/or a solution therefor other than those identified by the examiner, and that such a solution is recited in the claim.

3.3 Response by examiner to argument and/or explanation by applicant

In cases when an argument, explanation, etc. (see 3.2) convinces the examiner that the statement in the claims satisfies the support requirement, the reason for refusal is resolved. Otherwise, the examiner issues a decision of refusal based on the same reason as notified before that the statement in the claims does not satisfy support requirement.