

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

Section 4 Conciseness Requirement (Patent Act Article 36(6)(iii))

1. Overview

Article 36(6)(iii) of the Patent Act provides that the statement for each claim shall be concise (Conciseness Requirement).

Claims are to be used for the basis of identifying the claimed invention which is a subject of examination of the patentability requirements such as novelty, inventive step, etc., and the description requirements. The statement of claims should also serve as a document of title defining the technical scope of a patented invention accurately (see Section 1 Patent Act Article 36(5)). Therefore, it is appropriate to recite the claims with conciseness while also complying with the requirement for clarity in order for third parties to understand the claimed invention as easily as possible. From this purpose, Article 36(6)(iii) prescribes the conciseness requirement.

This provision does not deal with the inventive concept defined by the statement of the claim but deals with the conciseness of the statement itself. Also when the application contains two or more claims, it does not require for the entirety of claims to be concise, rather requires each claim to be concise.

2. Determination of Conciseness Requirement

The following (1) and (2) are typical examples of the statement of claims not complying with the conciseness requirement.

(1) A claim includes statements with same the contents in a duplicated manner, and these statements are excessively redundant.

However, in light of the purpose of Article 36(5) that a claim shall state the matters an applicant itself deems necessary to define the invention, the examiner shall deem "excessively redundant" only when the duplication is excessive, even where matters having the same contents are included in a claim. It shall not be deemed "excessively redundant" merely because a matter to define a claimed invention is an obvious limitation to a person skilled in the art or is a dispensable limitation for meeting the patentability requirements or the description requirements (excluding Article 36(6)(iii)).

When the statement of a claim is made by reference to the statement in the detailed description of the invention or drawings, an applicant shall note that the statement of the claim and the corresponding statement in the detailed description of the invention or the drawings should not be redundant as a whole.

- (2) Where claims are expressed in alternatives (e.g., a Markush-type claim for chemical compounds) and the number of alternatives is so large that conciseness is drastically damaged

When determining whether the conciseness is extremely damaged or not, the following matters should be taken into account by the examiner.

- (i) In a case where a significant structural element is not shared by the alternatives, fewer alternatives should be deemed so large that conciseness is drastically damaged than in a case where a significant structural element is shared by the alternatives.
- (ii) In a case where the alternatives are expressed in a complicated way, such as conditional options, fewer alternatives should be deemed so large that conciseness is drastically damaged than otherwise.

Even in this case, the examiner should choose at least one group of chemical compounds which is expressed as alternatives in the claim and which involves a chemical compound indicated as a working example ("a group of chemical compounds expressed as specific alternatives corresponding to a working example"), and shall examine the patentability of those chemical compounds. Regardless of existence or nonexistence of reason for refusal under patentability requirements, the examiner should point out in the notice of reasons for refusal, the group of chemical compounds which is examined on patentability.

3. Procedure of Examination for Determination of Conciseness Requirement

3.1 Notice of reason for refusal

Where the examiner determines that the statement of claims does not comply with the conciseness requirement, the claim concerned and the matters on which such

determination is based in the claim shall be described in the notice of reason for refusal. Also, the reason for determining that the invention is not concise shall be described specifically.

It is inappropriate to describe "the claimed invention is not concise" only without the specific reason, because it is difficult for the applicant to file the effectual response and to understand the direction for amendments to overcome the reason for refusal.

The examiner should note that the notice of reason for refusal may be issued only when duplication is excessive, even where matters having the same contents are included in a claim as stated in 2. Also, the examiner should note that the notice of reason for refusal may be issued only when the conciseness in the statement of claims is drastically damaged even where the claims are expressed in alternatives (e.g., a Markush-type claim for chemical compounds), and the number of alternatives is very large.

3.2 Arguments and clarifications, etc. of applicant

The applicant may make an argument or clarification by filing the written argument and the like against the notice of reason for refusal on violation of the conciseness requirement.

3.3 Handling of examiner on argument, clarification of applicant and so on

Where the examiner comes to be convinced that the statement of claims complies with the conciseness requirement by arguments and clarifications, etc. (see 3.2), the reason for refusal will be overcome. Otherwise, the decision of refusal shall be issued based on the reason for refusal that the statement of claims does not comply with the conciseness requirement.