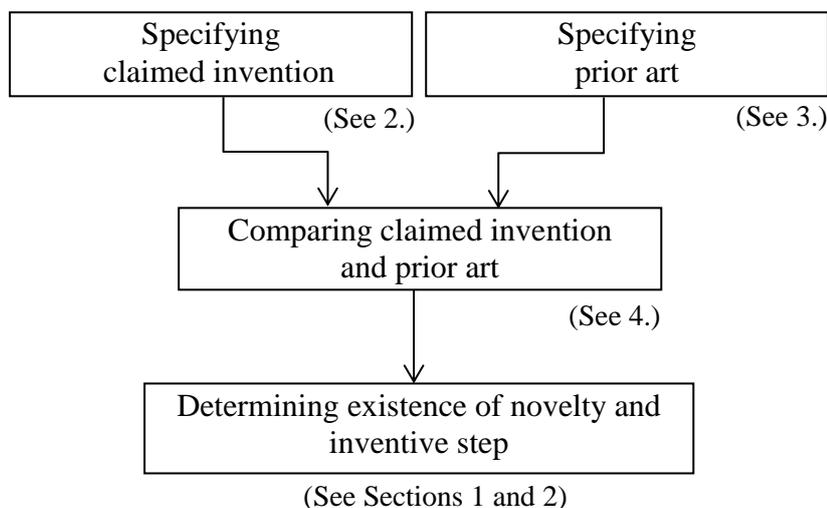


Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Section 3 Procedure of Determining Novelty and Inventive Step

1. Overview

The examiner specifies the claimed invention and the prior art, and then compares both in determining novelty and an inventive step. As a result of the comparison, the examiner determines that the claimed invention lacks novelty where there is no difference (Section 1). The examiner determines whether there is an inventive step where there is a difference (Section 2).



2. Specifying Claimed Invention

The examiner specifies the claimed inventions based on the claims. The examiner takes the description, drawings and the common general knowledge at the time of filing into consideration in interpreting the meanings of words in the claims.

Even if an invention identified by the claims does not correspond to the invention described in the description or drawings, the examiner should not ignore the claims and specify the claimed invention which is subject to examination based only on the description or drawings. The examiner specifies the claimed invention without considering the technical matters or terms which are not described in claims but in the description or drawings. On the other hand, the examiner should always consider the matters or terms described in the claims and should not ignore them.

(Reference) Judgment of the Second Petty Bench of the Supreme Court (March 8, 1991, 1988(Gyo-Tsu) No. 3, Minshu vol. 3 No. 45 Page 123) "Method for measuring triglyceride" ("Lipase Case")

2.1 The case where the claims are clear

In this case, the examiner should specify the claimed invention as is written in the claim. The examiner also interprets terms in the claim based on their usual meanings.

However, where meanings of the terms described in the claims are defined or explained in the description or drawings, the examiner takes the definition and explanation into consideration to interpret the terms. In addition, examples of more specific concepts included in the concepts of the terms in the claims, which are merely shown in the description or drawings, are not the definition or explanation mentioned above.

2.2 The case where the claims appear to be unclear and incomprehensible

In this case, where the claims are clear by interpreting the terms in the claims based on the description, drawings and common general knowledge at the time of filing, the examiner takes them into consideration.

2.3 The case where the claims are unclear even if description, drawings and common general knowledge at the time of filing are taken into consideration

In this case, the examiner does not specify the claimed inventions. Such claimed inventions may be excluded from the prior art search (see 2.3 in “Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.”).

3. Specifying Prior Art

The examiner specifies the prior art based on evidence for the prior art.

3.1 Prior art

The prior art falls into any one of the cases 3.1.1 to 3.1.4 prior to the filing of

the application in Japan or foreign countries. It is determined whether or not it is prior to the filing of the application in units of hours, minutes and seconds. Where it is publicly known in a foreign country, it is determined based on Japan time translated from the foreign country's time.

3.1.1 Prior art disclosed in a distributed publication (Article 29(1)(iii))

"Prior art disclosed in a distributed publication means prior art described in the publications (Note 2) which anyone can read (Note 1).

(Note 1) The fact that someone actually accessed such publications is not necessary.

(Note 2) "Publications" include documents, drawings or other similar information media which are duplicated to distribute and disclose the contents to the public.

(1) Prior art disclosed in publications

a "Prior art disclosed in publications" mean prior art recognized on the basis of the descriptions in the publications or equivalents of such descriptions. The examiner specifies prior art recognized on the basis of the descriptions as the prior art described in publications. Equivalents of descriptions in the publications mean descriptions that a person skilled in the art could derive from the description in the publications by considering the common general knowledge at the time of filing.

The examiner should not cite what is neither a disclosure of the publications nor the equivalent of the disclosure of the publications because such a matter is not "prior art disclosed in publications."

b The examiner should not cite a disclosure that a person skilled in the art is able to recognize based on the descriptions in publications or equivalents to such descriptions as "prior art" where it falls into the following case (i) or (ii).

(i) Where it is not clear that a person skilled in the art is able to manufacture a product of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing, for the inventions of product.

(ii) Where it is not clear that a person skilled in the art is able to use the process of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing, for the inventions of process.

(2) Determining publication date

a Estimated publication date

Whether or not a publication date is indicated in the publication		Estimated publication date
Indicated	Where only a publication year is indicated	The last day of the year
	Where publication month and year are indicated	The last day of the month of the year
	Where publication day, month and year are indicated	The day, month and year
Not indicated	Where the date received in Japan is indicated in a foreign publication	The date which is several days before the date received in Japan by considering the period normally taken for shipping the publications from abroad to Japan
	Where there is a related publication which includes book review, excerpts or catalogs of the publication	The publication date estimated from the date of the related publication
	Where a reprinted publication indicates the initial print date	The indicated initial print date
	Where there is relevant information	The date estimated from the relevant information

(Note) If there is relevant information in addition to the publication date indicated in the publication, the examiner can use the publication date estimated from the relevant information.

b The case where a filing date and a publication date are the same date

Where a filing date and a publication date are the same date, the examiner should not deem the publication to be prior to the filing unless the publication is obviously before the filing.

3.1.2 Prior art made publicly available through an electric telecommunication line
(Article 29(1)(iii))

"Prior art made publicly available through an electric telecommunication line" means prior art published in webpages etc. (Note 3) which can be read by anyone

(Note 2) through an electric telecommunication line (Note 1).

(Note 1) A "line" means a two-way transmission line constituted by sending and receiving channels generally. Broadcasting, which is only capable of one-way transmission, does not fall under the "line." Cable TV etc. that is capable of two-way transmission falls under the "line."

(Note 2) The fact that someone has actually accessed the webpages etc. is not necessary. More specifically, the webpages etc. are publicly available (in other words, anyone can read the webpages etc.) where both of the following cases (i) and (ii) are satisfied.

- (i) Where a webpage can be reached through a link from another publicly known webpage, a webpage is registered with a search engine, or the address (URL) of a webpage appears in the mass media (e.g., a widely-known newspaper or magazine) on the Internet.
- (ii) Where public access to the webpage is not restricted.

(Note 3) "Webpages etc." means what provides information on the Internet etc. "Internet etc." means all means that provide information through electric telecommunication lines, including the Internet, commercial databases, and mailing lists.

(1) Prior art published in webpages etc.

"Prior art published in webpages etc." means prior art published in webpages etc. and prior art recognized from equivalents of such a publication.

The examiner specifies prior art published in webpages etc. according to the descriptions in 3.1.1. However, the examiner should not cite the content of the webpages etc. unless it was made available to the public as it is at the time of the publication.

The examiner determines whether or not webpages etc. are publicly available prior to the filing of the application based on the publication date indicated in the webpages etc. (Note 4).

(Note 4) Where the publication date is not indicate or only the publication year or month is indicated and thus it is unclear whether the publication date is prior to the filing of the application, the examiner can cite such information if he/she obtains a certificate on the publication date from a person with authority and responsibility for the publication, maintenance etc. of the published information and the publication date is prior to the filing of the application.

(2) Counterargument by an applicant on the date and content of publication (whether or not the information on the webpages etc. is published as it is at the publication date)

a The case where an applicant counter-argues that the indicated date and content of publication are unreliable just because the information disclosed on a webpage, and the counterargument is not supported by evidence.

In this case, the examiner rejects the counterargument due to lack of concrete evidence.

b The case where an applicant's counterargument based on concrete evidence raises a doubt about the date or content of publication

The examiner checks with a person with the authority and responsibility for the publication, maintenance, etc. of the published information, and request him/her to issue a certificate on the date or content of publication on the webpages etc.

Where the doubt remains as a result of examining the counterargument etc. by the applicant, the examiner should not cite the prior art published on the webpages etc.

3.1.3 Publicly known prior art (Article 29(1)(i))

"Publicly known prior art" means prior art which has become known to anyone as an art without an obligation of secrecy (Note).

(Note) Prior art disclosed by a person on whom obligation of secrecy is imposed to another person who are not aware of its secrecy is "publicly known prior art" irrespective of the inventor's or applicant's intent to keep it secret.

Generally, an article of academic journal would not be put in public view even if it was just received. Therefore, prior art described in the article is not "publicly known prior art" until the article is published.

"Publicly known prior art" often become known in lecture, briefing session and so on generally. In this case, the examiner specifies the prior art on the basis of the matters explained in the lecture, briefing session and so on.

In interpreting the explained matters, the examiner may use the matters derived by a person skilled in the art as a base for specifying "publicly known prior art" by considering the common general knowledge at the time of the lecture, briefing session and so on.

3.1.4 Publicly worked prior art (Article 29(1)(ii))

"Publicly worked prior art" means prior art which has been worked in a situation where the prior art is or could be publicly known (Note).

(Note) Prior art that also become publicly known by working of the prior art also falls into "publicly known prior art" under Article 29(1)(i).

"Publicly worked prior art" is often worked by using machinery, device, system etc. generally. In this case, the examiner specifies the prior art based on how the machinery, device, system etc. operate.

In interpreting the fact that the machinery, device, system etc. operate, the examiner may use the matters derived by a person skilled in the art as a base for specifying "inventions that were publicly worked" by considering the common general knowledge at the time when the inventions were publicly worked.

3.2 Prior art disclosed as generic concepts or more specific concepts in an evidence

(1) The case where the evidence discloses prior art as generic concepts (Note 1)

In this case, the examiner should not specify the prior art as more specific concepts because the prior art as more specific concepts is not disclosed. However, the examiner may specify the prior art as more specific concepts where they are derived on the basis of the common general knowledge (Note 2).

(Note 1) The term "generic concept" means a comprehensive concept consisting of ideas belonging to the same family or type, or integrating a plurality of ideas sharing a common nature.

(Note 2) A prior art as a more specific concept is not considered to be derived from (disclosed in) a generic concept just because the more specific concept is merely included in the generic concept or the more specific concept could be picked up from the generic concept.

(2) The case where an evidence discloses prior art as more specific concepts

In this case, when the evidence disclosing the prior art describes prior art utilizing the same family or type of matters or common features as elements of the prior

art, the examiner may specify the prior art as the generic concepts. As a method for determining novelty, the examiner may determine the existence of novelty of the claimed inventions which is described as generic concepts without specifying the prior art as generic concepts (see 4. and 5.1, especially see 4.2)

3.3 Points to note

The examiner should take note of the avoidance of hindsight which brings about a misunderstanding of the evidence which discloses the prior art according to the contexts of the description, claims or drawings of the application subject to the examination after obtaining knowledge of the claimed inventions. The prior art should be understood based on the evidence disclosing the prior art (for publications, along the contexts of the publications).

4. Comparison between Claimed Invention and Prior Art

4.1 General methods of comparison

The examiner compares the claimed invention and the prior art which he/she has specified. Comparison between the claimed invention and the prior art is conducted by determining identical features and differences between the claimed elements and the elements which specifies the prior art (hereinafter referred to as "elements of the prior art" in this Chapter). The examiner should not compare a combination of two or more independent pieces of prior art with the claimed invention.

4.1.1 The case where the claim includes alternatives

The examiner may choose one of the alternatives (Note 1) as a claimed element, and compare the claimed invention and the prior art (Note 2).

(Note 1) "Alternatives" means both formal alternatives and substantial alternatives.

"Formal alternatives" means a description of the claim which is understood obviously as alternatives.

"Substantial alternatives" means a comprehensive expression which is intended to include a limited number of more specific matters substantially.

(Note 2) In order to determine whether the claimed invention has novelty and involves an inventive step, the examiner need to determine on all of the matters in the inventions identified based on the claim. Therefore, it should be noted that the determination on novelty and an inventive step of the claimed invention cannot be always achieved by partially comparing the claimed invention and the prior art.

4.2 Methods for comparing more specific concept of claimed invention with prior art

The examiner may compare a more specific concept of the claimed invention and the prior art and determine identical features and differences between them (Note).

The more specific concept of the claimed invention includes such as a mode for carrying out the claimed invention which is described in the description or drawings. Other than such a mode can be a subject of the comparison, so long as that is a more specific concept of the claimed invention.

This method of comparison is effective in determining novelty in the following claims, for example.

- (i) a claim including a description of functions or features specifying a product
- (ii) a claim including a description of numerical range

(Note) See 4.1.1 (Note 2)

4.3 Methods for considering the common general knowledge at the time of filing in comparing the prior art and the claimed invention

The examiner may consider the common general knowledge at the time of filing to interpret the description of the prior art documents when he/she compares the prior art and the claimed invention to specify identical features and differences between them. The results obtained by this method and the methods as mentioned above must be same.

<h3>5. Determination on Novelty and Inventive Step, and Procedure of Examination Pertaining to the Determination</h3>

5.1 Determination

The examiner determines whether the claimed invention is novel (see “Section 1 Novelty”) and involves an inventive step (see “Section 2 Inventive Step”) by comparing the claimed invention with the prior art.

5.1.1 Claimed elements including alternatives

The examiner determines that the claimed invention is not novel, in a case where there is no difference between the claimed invention in which an alternative is chosen as an element and the prior art as a result of comparison between the two.

The examiner determines that the claimed invention does not involve an inventive step in a case where he/she is able to reason the non-existence of an inventive step as a result of comparison between the claimed invention in which an alternative is chosen as an element and the prior art and attempt of the reasoning.

5.2 Procedure of examination pertaining to determination on novelty

The examiner issues the notice of reason for refusal to the effect that the claimed invention falls under any of items of Article 29 (1) and a patent shall not be granted for the claimed invention, when he/she is convinced that the claimed invention lacks novelty based on 2. in “Section 1 Novelty.”

As a response to the notice of reason for refusal on the novelty, the applicant may amend the claims by submitting a written amendment, or may make a rebuttal statement by submitting a written opinion or a certificate of experimental results, etc.

The notice of reason for refusal is cancelled where the examiner cannot be convinced that the claimed invention is not novel as a result of amendment, response or clarification. Otherwise, where the examiner's conviction remains unchanged, the examiner issues a decision of refusal based on the reason for refusal to the effect that the claimed invention falls under any of items of Article 29 (1) and a patent shall not be granted for the claimed invention.

5.3 Procedure of examination pertaining to determination on inventive step

(1) The examiner issues the notice of reason for refusal to the effect that a patent shall not be granted for the claimed invention under the provision of Article 29 (2), when he/she is convinced that the claimed invention does not involve an inventive step based on 2 and 3 in “Section 2 Inventive Step.” The examiner should prepare the notice of

reason for refusal so that the applicant can easily understand and response to the notice.. In particular, he/she should describe the differences between the claimed invention and the primary prior art clearly and the reason that a person skilled in the art would easily arrive at the claimed invention from the primary prior art.

As a response to the notice of reason for refusal on an inventive step, the applicant may amend the claims by submitting a written amendment, or may make a rebuttal statement by submitting a written opinion or a certificate of experimental results, etc.

Facts in support of the existence of an inventive step (see 3.2 in “Section 2 Inventive Step”) are often argued in a written opinion, etc. The examiner should take such facts into consideration comprehensively in attempting the reasoning.

(2) The reason for refusal is cancelled where the examiner cannot be convinced that the claimed invention does not involve an inventive step as a result of amendment, response or clarification. The examiner issues a decision of refusal based on the reason for refusal to the effect that a patent shall not be granted for the claimed invention under the provision of Article 29 (2) where the examiner’s conviction that the claimed invention does not involve an inventive step remains unchanged.

Example: a case where the reason for refusal is not maintained

The examiner determines that the reason for refusal in the notice is not maintained when the reasoning cannot be conducted without citing new evidence additionally. As an exception, he/she can show additional evidence indicating well-known art or commonly used art to supplement the reasoning which has already been noticed.

(3) When the examiner cites well-known art or commonly used art for the reasoning in the notice of reason for refusal or decision of refusal, he/she should show their evidence except that no example is required. The above rule is applied regardless of citing well-known art or commonly used art as the prior art, as a basis for design modification or as evidence of the knowledge (Note 1) or ability (Note 2) of a person skilled in the art.

(Note 1) The knowledge of a person skilled in the art means the knowledge of state of the art including common general knowledge etc.

(Note 2) The ability of a person skilled in the art means the ability to use ordinary technical means for research and development, and normal creative ability.

6. Various Patent Applications

The relevant date (the time of filing) for determining on novelty and an inventive step is as shown in the below table.

Types of application	Time of filing
Divisional application, converted application or the patent application based on registration of utility model	The time of filing of the original application (Article 44(2), Article 46(6) or Article 46bis(2))
Application claiming internal priority	The time of filing of the earlier application (Article 41(2))
Application claiming priority under the Paris Convention (or priority claims recognized under the Paris Convention)	Filing date of the application filed in the first country (Article 4B of the Paris Convention) (Note)
International patent application	Filing date of international application (Article 184ter (1)) (Note) See the above column if the application claims priority.

(Note) Exceptionally, novelty and an inventive step are not determined based on "time of filing" but based on "filing date."