

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

Chapter 5 Category of Unpatentable Invention (Patent Act Article 32)

1. Overview

Article 32 of the Patent Act provides that any invention that is liable to injure public order, morality or public health (hereinafter, referred to as "public order, morality, etc." in this chapter) shall not be patented even if the invention is industrially applicable. Article 32 provides a category of unpatentable invention for the purposes of public interests.

Whether the public order, morality, etc. is injured is related to general profits of the nation and society and senses of morality and ethics (hereinafter, referred to as "morality, etc." in this chapter). Such senses of morality and ethics can change with time, and can be different for each person. Therefore, if a decision of refusal is made to an invention due to violation of Article 32, an adverse disposition is imposed based on only morality, etc., normative sense of values which can change with time and can be different for each person, regardless of technological evaluations of the invention. Considering this, the examiner shall suppressively make a determination that the claimed invention falls under the category of unpatentable invention, as explained in 2. (2).

In addition, Article 27(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter, referred to as "TRIPS agreement") allows contracting parties to exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment. Meanwhile, Article 27(2) includes the proviso "provided that such exclusion is not made merely because the exploitation is prohibited by their law."

Therefore, as explained in 2. (3), the examiner shall not interpret that an invention falls under the category of unpatentable invention, and shall not issue a notice of reasons for refusal, a decision of refusal, etc. to the effect that the invention falls under the category of unpatentable invention, merely because the exploitation of the invention is prohibited by Japanese law.

2. Determination on whether Invention falls under Category of Unpatentable Invention

(1) Inventions subjected to a determination on whether the invention falls under the category of unpatentable invention are claimed inventions. In the case where there are two or more claims in the claims, the examiner shall make, for each claim, a determination on whether the invention falls under the category of unpatentable invention.

(2) The examiner shall determine that the claimed invention falls under the category of unpatentable invention, only in the case where the claimed invention obviously injures the public order, morality, etc.

The examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because the claimed invention can be carried out in such a manner that may injure the public order, morality, etc.

a Examples of inventions which fall under the category of unpatentable invention

Example 1: Humans themselves produced through genetic manipulation

Example 2: Methods solely used to brutally massacre humans

b Examples of inventions which do not fall under the category of unpatentable invention

Example 1: Poisons

Example 2: Explosives

Example 3: Anticancer drugs with side effects

Example 4: Apparatuses for punching holes in bank bills

(Such apparatuses are not necessarily used for crimes such as forgeries of genuine bank bills.)

(3) The examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because the exploitation is prohibited by Japanese law (the proviso to Article 27(2) of the TRIPS Agreement).

Example 1:

[Claims]

A positional information transmitting apparatus which emits radio waves for improving positioning accuracy.

(Explanation)

Even in the case where the use of the radio waves is prohibited in principle by Japanese regulations concerning radio waves, the examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because of this reason.

Example 2:

[Claims]

An air conditioning method of: measuring the level of stress of people in a building, using a predetermined sensor; performing an operation such that the room temperature in the building exceeds 28 degrees Celsius when the level of stress is equal to or less than a given value; thus saving electricity.

(Explanation)

Even in the case where such room temperature conditioning violates Japanese regulations concerning room temperature, the examiner shall not determine that the claimed invention falls under the category of unpatentable invention merely because of this reason.

<p>3. Procedures of Examination concerning Determination on whether Invention falls under Category of Unpatentable Invention</p>
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In the case where the examiner is convinced that the claimed invention obviously injures the public order, morality, etc., the examiner shall issue a notice of reasons for refusal to the effect that the claimed invention does not fulfill the requirements of Article 32.

In response to this, the applicant may submit a written amendment to amend the claims, and may present an argument or clarification through a written opinion.

In the case where the amendment and the argument or clarification make the examiner unconvinced that the claimed invention obviously injures the public order, morality, etc., the examiner shall determine that the reason for refusal has been resolved. In the case where the examiner remains convinced, the examiner shall issues a decision of refusal based on the reason for refusal under Article 32.