

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

## Chapter 2 Utility Model Technical Opinion

### 1. Overview

Article 12(1) of the Utility Model Act stipulates that any person may file with the JPO Commissioner a petition requesting a technical opinion about a device claimed in a utility model registration application or a registered utility model in the light of certain provisions. It also stipulates that such a petition may be filed on a claim-by-claim basis.

Under the utility model system which provides for early establishment and registration of a utility model right without substantive examination, judgment as to whether a registered right satisfies substantive requirements is left to parties concerned, in principle. However, judgment on the validity of a utility model right that has been established and registered requires technical expertise, and this may present a difficulty to parties concerned in making a decision or may bring about an unexpected confusion. Given this, a utility model technical opinion system was introduced to provide, at request, utility model technical opinion reports (referred to as "technical opinion reports" hereafter in this Part) as objective information to assist parties concerned in assessing novelty, inventive step, etc., which is hard for parties concerned, in relation to prior art documents (Articles 12, 29bis and 29ter).

### 2. Utility Model Technical Opinion

To form a utility model technical opinion, the examiner shall only evaluate whether the claimed device satisfies the substantive requirements set forth in (i) to (iv) below (Article 12).

- (i) Novelty in the light of devices published in documents (Article 3(1)(iii))
- (ii) Inventive step in the light of devices published in documents ((Article 3(2) (limited to devices set forth in Article 3(1)(iii))
- (iii) Enlarged earlier applications (Article 3bis)
- (iv) Earlier applications (Articles 7(1) to 7(3) and 6 )

The requirements (i) to (iv) are referred to as "novelty, inventive step etc." hereafter in this Chapter.

When evaluating the novelty, inventive step, etc., of a claimed device, the examiner shall substantially follow patent application Examination Guidelines pertaining to each of the substantive requirements ("Part III Chapter 2 Novelty and

Inventive step” to “Part III Chapter 4 Prior Application” (Note)).

(Note) "Novelty in the light of devices published in documents" and "inventive step in the light of devices published in documents" are evaluated on the basis of publicly known devices published in documents, so 3.1.3 and 3.1.4 in “Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step” are excluded.

### 3. Procedure for Forming a Utility Model Technical Opinion

#### 3.1 Determination of the subject of evaluation

The examiner shall evaluate claimed devices for which petitions for utility model technical opinions have been filed. If any amendment or correction is made (whether lawfully or not) prior to the preparation of a technical opinion report, then the examiner shall evaluate the claimed device as amended or corrected.

For the avoidance of doubt, it is not necessary to evaluate (i) any device pertaining to a claim that was invalidated in a trial for invalidation prior to the preparation of a technical opinion report, (ii) any device pertaining to a claim that was deleted as part of a correction prior to the preparation of a technical opinion report, and (iii) any device claimed in a utility model registration application that was withdrawn or abandoned prior to registration thereof and the preparation of a technical opinion report.

(Explanation) Article 12(2) stipulates that no petition for a utility model technical opinion may be filed after the relevant utility model right is invalidated in a trial for invalidation. In the meantime, the Act is silent as to what happens if, after the filing of a petition for a utility model technical opinion, the relevant utility model right is invalidated in a trial for invalidation before a technical opinion report is prepared (3.1(i)).

However, invalid registration implies the absence of the subject of evaluation, so evaluation need not be done where the relevant utility model right is invalidated in a trial for invalidation at any time between the filing of a petition and the preparation of a technical opinion report.

The same applies to any device pertaining to a claim that was deleted as part of a correction(3.1(ii))and any device claimed in a utility model registration application that was withdrawn or abandoned prior to registration thereof(3.1(iii)).

### 3.2 Finding of the device as claimed in the application concerned

The examiner shall recognize the claimed device, based on the statement of the claims. The claimed device is recognized substantially in accordance with Clause 2 of "Part III Chapter 2 Section 3 Procedure of Determining Novelty and Inventive Step."

### 3.3 Determination of the subject of prior art search

The examiner shall conduct prior art search for the claimed devices that have been found to be the subject of evaluation under 3.1.

The examiner shall perform prior art search for all the claimed devices that have been found to be the subject of evaluation, regardless of whether they meet the unity requirement or not. When conducting prior art search, the examiner shall also give consideration to the embodiments of the claimed devices (limited to those which embody the matters specifying those claims).

### 3.4 Prior art search

When conducting prior art search, the examiner shall employ the same techniques as he or she uses in prior art search for patent application examination (see "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc."), in principle.

However, the examiner shall not include unpublished applications in the scope of prior art search. The examiner might find an unpublished application which qualifies as "another application for utility model registration or for a patent" as set forth in Article 3bis; however, in terms of promptness required of this system, delaying the preparation of a technical opinion report until after the publication of such application is inappropriate.

If the claims are ambiguous, the examiner shall conduct the broadest thinkable prior art search, taking all possible interpretations into consideration.

### 3.5 Evaluation of novelty, inventive step, etc.

The examiner shall evaluate the subject of evaluation in terms of novelty, inventive step, etc., in accordance with 2.

#### 3.5.1 Points to consider when evaluating novelty, inventive step, etc.

(1) Technical opinion reports are intended to provide parties concerned with objective information to assist them in determining the novelty, inventive step, etc., of the subject of evaluation in relation to prior art documents. The examiner shall, therefore, endeavor to be as fair and objective as possible in making an evaluation. Neither the applicant nor the utility model right holder is given an opportunity to argue against the technical opinion reports; thus, the examiner shall bear it in mind that he or she must base his or her technical opinion report on reliable evidence, just as he or she does in examining and making a decision on a patent application.

(2) If any written statement has been sent which contains some argument about the evaluation of novelty, inventive step, etc., the examiner shall give it full consideration in forming a technical opinion.

(3) If a decision rendered in a trial for invalidation of any of the claims subject to evaluation already became final and binding, the examiner shall take such decision into consideration.

(4) For applications which claim internal priority, priority under the Paris Convention, or a right of priority governed by the Paris Convention, the examiner shall take the filing date as the base date when conducting prior art search. And, in principle, only in the case where the examiner finds any such device published in documents or enlarged earlier application or earlier application filed between the date of filing of the earlier or first application and the filing date as may disallow novelty, inventive step, etc., the examiner needs to judge whether the effect of claim of priority should be recognized for the claimed device subject to evaluation, substantially in accordance with "Part V Priority." If no effect of claim of priority is recognized, the examiner shall judge that novelty, inventive step, etc., is disallowed because of the device published in documents, enlarged earlier application, or earlier application mentioned above. If the effect of claim of priority is recognized, the examiner shall judge that novelty, inventive step, etc., is not disallowed accordingly.

(5) In the case of a divisional or converted application, the examiner shall take the actual date of filing of the new utility model registration application as the base date when conducting prior art search. And, in principle, only in the case where the examiner finds any such device published in documents or enlarged earlier application or earlier application filed between the date of filing of the original application and the actual date

of filing of the new utility model registration application as may disallow novelty, inventive step, etc., the examiner needs to judge whether the application concerned meets the division or conversion requirements, substantially in accordance with "Part VI Chapter 1 Division of Patent Application" or "Part VI Chapter 2 Conversion of Application." If the examiner finds that such requirements are not satisfied, he or she shall judge that novelty, inventive step, etc., is disallowed because of the device published in documents, enlarged earlier application, or earlier application mentioned above. If the examiner finds that such requirements are met, he or she shall judge that novelty, inventive step, etc., is not disallowed accordingly.

3.6 If it is difficult to conduct prior art search and evaluate novelty, inventive step, etc.

(1) The examiner shall conduct prior art search to the extent possible for the claim which he or she has identified as the subject of evaluation.

(2) There may be cases in which the examiner finds difficulty in evaluating the novelty, inventive step, etc., of the claim thoroughly as the claimed device is not clearly defined or the detailed description of the device is not so clear and sufficient as to enable persons ordinarily skilled in the art to which the device pertains to work the device. Even in this case, if the examiner can hypothetically make reasonable assumptions about the subject of evaluation in the light of the description, the scope of claim of the utility model and drawings, and common general knowledge as of the filing, then the examiner shall base his or her evaluation of novelty, inventive step, etc., on the most reasonable assumptions (simply referred to as "assumptions" hereafter in this Part).

In this case, the technical opinion report shall also contain the inadequacies found in the description, scope of claim of the utility model or drawings, and the assumptions mentioned above.

However, given the fact that inadequacies in the description, scope of claim of the utility model or drawings are not the subject of a utility model technical opinion and that neither the applicant nor the utility model right holder is given an opportunity to argue against the opinion, the examiner shall take these actions only when he or she is convinced of such inadequacies.

Presented below are ways of making assumptions for evaluation purposes (note, however, that the basic and other requirements are not taken into account).

Example 1:

[Claims]

Comfortable chair as shown in Figure 1.

[Outline of the description or drawings]

Figure 1 shows a chair whose backrest has a human-back-shaped concave.

(Assumption for evaluation)

The examiner shall perform an evaluation on the assumption that "comfortable ... as shown in Figure 1" means "whose backrest has a human-back-shaped concave."

Example 2:

[Claims]

A toy dog comprising an emotion quantification means that quantifies human emotions, an emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means, and a control means that wags the tail based on signals from the emotion assessment means.

[Outline of the description or drawings]

The detailed description of the device only describes a toy dog which has a means of wagging the tail when such volume of sound that exceeds a certain level is detected.

(Assumption for evaluation)

"Emotion quantification means that quantifies human emotions" and "emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means," if taken literally, do not evoke an image of a concrete article and thus cannot be evaluated fully in terms of novelty, inventive step, etc. And the detailed description of the device cannot be interpreted to suggest something other than a means of detecting such volume of sound that exceeds a certain level. Therefore, the examiner shall perform an evaluation on the assumption that the "emotion quantification means that quantifies human emotions" and the "emotion assessment means that detects a feeling of joy in a human based on signals from the emotion quantification means" are means of detecting such volume of sound that exceeds a certain level.

(3) There may be cases in which the examiner cannot conduct effective prior art search for the claimed device as the claims are not so clearly stated that the claimed device cannot be specified even when the description or drawings are taken into consideration or the claims contain a matter that does constitute a device. In this case, the examiner shall include in the technical opinion report a statement to the effect that he or she was not able to conduct effective prior art search, as well as the reasons.

#### 4. Preparation of a Technical Opinion Report

The examiner shall include the scope of search (scope of documents covered by the prior art search), his or her evaluation, cited documents, etc., and an explanation about his or her evaluation in a technical opinion report.

##### 4.1 Presentation of the evaluation

The examiner shall present his or her evaluation of the novelty, inventive step, etc., of each claim; provided, however, that it is acceptable to group and present together two or more claims to which the same evaluation and explanation apply.

The examiner shall structure and word an explanation about his or her evaluation in such a manner that it can be understood by the requester (see (1) to (5) below for the details).

(1) If novelty, inventive step, etc., is disallowed, the examiner shall give reasons for such evaluation in the provided space in such a manner that they can be understood by a person who request the report. As a general rule, the examiner shall identify and reproduce the statements in the cited documents which support his or her evaluation. In the case of a negative evaluation with respect to 2.(i), (iii), or (iv), the examiner shall describe how he or she can recognize a device, etc., which disallows the novelty, inventive step, etc. of the claimed device, from the identified statements.

In the case of a negative evaluation with respect to 2.(ii), the examiner shall describe what kind of logic underlies his or her determination of lacking inventive step based on the devices identified from the cited documents.

If the examiner was not able to find any prior art documents, etc., (prior art documents, earlier applications, or co-pending applications filed on the same day) which would disallow the novelty, inventive step, etc., of the claimed device, he or she shall include a statement to the effect that such prior art documents were not found, as well as documents showing the general state of the art in the technical field to which such device pertains.

(2) If the examiner finds it difficult to evaluate the novelty, inventive step, etc., of the claimed device thoroughly for some reason, including, but not limited to, the device not being clearly defined, then he or she shall include a statement to that effect and describe what kind of deficiency has been found in the description, etc., and upon what kind of

assumption his or her evaluation of novelty, inventive step, etc., is based.

(3) If the examiner was unable to conduct effective search pursuant to 3.6(3), he or she shall also include a statement to that effect and the reasons.

(4) If the examiner judges that the division or conversion requirements are not met or no effect of claim of priority is recognized, then he or she shall include the reasons and a statement to the effect that he or she took the actual filing date as the base date in his or her evaluation.

(5) The technical opinion report shall not contain any matters not relevant to the evaluation of novelty, inventive step, etc., (such as the existence of any new matter (Article 2bis(2)) and matters pertaining to correction requirements (Article 14bis)), even if they are obvious.