

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

## Part II Description and Claims

### Contents

2001	Regarding Provisions of Article 36 and Effective Dates Thereof .....	- 1 -
2002	Dealing with Cases Where Descriptions, Claims or Drawings have Description Deficiencies Not Applicable to the Reasons for Refusal .....	- 4 -
2003	Handling of Trademark Name Appearing in Descriptions, Claims, or Drawings .....	- 10 -
2004	Measurement Act [Extract] .....	- 12 -
Chapter 1	Requirements for Description .....	- 1 -
2101	Points to Note When Acquisition of Prior Art Documents is Difficult.....	- 1 -
2102	Determination Regarding An Amendment Adding Prior Art Document Information (Applied to Applications for Which the Filing Date (For Divisional/Converted Applications, Etc., the Actual Filing Date) Is On or Before December 31, 2008).....	- 2 -
2103	Example in Which It is Possible to Perform Notification of Article 48septies at the Same Time as or Subsequent to Notification of A First Reason for Rejection-	3 -
2104	Description Procedure for Journals.....	- 4 -
Chapter 2	Requirements for Claims .....	- 1 -
2201	Requirement of Definiteness When Description Using Alternative Forms Such as Markush Form Pertains to a Chemical Substance .....	- 1 -
2202	Description Forms for Claims - Independent and Dependent Forms .....	- 2 -
2203	Points to Note in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product .....	- 8 -
2204	Determination on Whether or Not "When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product" is Relevant .....	- 10 -
2205	Determination on "Impossible/Impractical Circumstances" in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product .....	- 14 -
2299	Miscellaneous.....	- 24 -

Chapter 3	Unity of Invention (Patent Act Article 37).....	- 1 -
2301	Regarding Procedure for Determining Subject of Examination on the Basis of Special Technical Features When a Plurality of Invention Groups Containing the Original Invention Exist.....	- 1 -
2302	Regarding " An Invention for Which an Examination may be Made without Substantially Conducting Additional Prior Art Searches and Making a Determination as a Result of Examining Inventions that is Decided the Subject of the Examination"-	- 3 -

## 2001 Regarding Provisions of Article 36 and Effective Dates Thereof

Regarding provisions of article 36 and effective dates thereof, a list for the same is indicated in a table.

Table List of Provisions of Article 36 and Effective Dates Thereof

Law	Act in 1990	Act in 1994	Act in 2002
Effective Date	From December 1, 1990	From July 1, 1995	From September 1, 2002
Summary of Revision	* Introduction of Abstract Numbering of paragraphs was changed due to revision of Article 36(2)	*Revision of Article 36 Easing of the description requirement for the description: The detailed description of the invention shall be "clear and sufficient;" the scope of claims shall state "matters that the applicant considers necessary;" and the statement of the claims shall be "clear and concise."	Revision of Article 36 Introduction of information disclosure system for disclosure of prior art document (from September 1, 2002*1) Separation of the claims from the description (from July 1, 2003*2)
Provisions	Detailed Description of the Invention	Fourth paragraph The statement of the detailed description of the invention as provided in item (iii) of the preceding Paragraph shall be so clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention in accordance with Ordinance of the Ministry of Economy, Trade and Industry.	Fourth paragraph The statement of the detailed description of the invention as provided in item (iii) of the preceding paragraph shall comply with each of the following items: (i) in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall be so clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention; and (ii) where the person requesting the grant of a patent has knowledge of any invention(s) (inventions as provided in Article 29(1)(iii), hereinafter the same shall apply in this item) related to the said invention, which has been known to the public at the time of filing of the patent application, the statement shall provide the source of the information concerning the invention(s) known to the public through publication such as the name of the publication and others.
	Claims	Fifth paragraph The scope of claims as provided in item (iv) of paragraph (3) shall state a claim or claims and state for each claim all the matters that the applicant considers necessary to specify the invention for which the grant of a patent is sought. In this case, one claimed invention is not precluded from being the same as another claimed invention.	Fifth paragraph The scope of claims as provided in paragraph (2) shall state a claim or claims and state for each claim all the matters that the applicant considers necessary to specify the invention for which the grant of a patent is sought. In this case, one claimed invention is not precluded from being the same as another claimed invention.
		Sixth Paragraph The provisions of the preceding paragraph do not preclude the scope of claims in one claimed invention from being the same scope of invention in another claimed invention.	Sixth Paragraph The statement of the scope of claims as provided in item (iv) of paragraph (3) shall comply with each of the following items: (i) the invention for which a patent is sought is stated in the detailed description of the invention; (ii) the invention for which a patent is sought is clear; (iii) the statement for each claim is concise; and (iv) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry.

	Abstract	<p>Seventh paragraph The abstract as provided in paragraph (2) shall state a summary of the invention described in the descriptions or drawings, and any other matters as provided by Ordinance of the Ministry of Economy, Trade and Industry.</p>	<p>Seventh paragraph The abstract as provided in paragraph (2) shall state a summary of the invention described in the descriptions, the scope of claims or drawings, and any other matters as provided by Ordinance of the Ministry of Economy, Trade and Industry.</p>
Supplementary Provisions	Transitional Measures	(Omitted)	<p>The old act applies to applications filed under the old act (Supplementary Provisions §6(2)).</p> <p>*1 The old act applies to applications filed under the old act (Supplementary Provisions §2(1)). *2 Applicable to patent applications filed on or after the effective date (including divisional applications, etc., filed prior to the effective date) (Supplementary Provisions §3).</p>

## 2002 Dealing with Cases Where Descriptions, Claims or Drawings have Description Deficiencies Not Applicable to the Reasons for Refusal

1. In a case where description deficiencies not applicable to the reasons for refusal have been found in the descriptions, claims or drawings (hereinafter, referred to as "descriptions, etc.")

When the Examiner notifies an applicant of a notice of reasons for refusal regarding novelty, inventive step or other reasons for refusal, he/she points out a part where the deficiencies exist in the descriptions, etc., in the "proviso" of the notice of reasons for refusal.

When a notice of reasons for refusal is not issued, the Examiner can deal with any one of the followings before a decision to grant a patent.

- (1) Contacting the applicant or the representative (hereinafter referred to as "applicant, etc.") by telephone to facilitate correcting the deficiencies by voluntary amendment (limited to the period when the voluntary amendment by the applicant, etc. is allowed.).
- (2) Correcting the descriptions, etc. by ex officio (see the following 2).
- (3) Contacting Formality Examination Office to ask to notify an applicant of an invitation for amendment under the Commissioner's name for the deficiencies (see the following 3).

When deficiencies in the descriptions, etc. (Note) fall under a reason for refusal, the Examiner notifies a notice of reasons for refusal, etc. due to description deficiencies of the description, etc., without following the above (1) ~ (3). Correction by ex officio stated in (2) is made only when it is requested by the applicant, etc. in principle (see 2.2(1)).

(Note) When determining deficiencies in the descriptions, etc. fall under a reason for refusal, the followings should be taken into consideration:

- (i) Even if there is minor deficiencies in the claims such as a clerical error, etc., it is not immediately determined that the deficiencies fall under a reason for refusal due to a violation of Clarity Requirement. When, for example, a person skilled in the art has found the claimed invention not ambiguous with minor deficiencies, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II,

Chapter 2, Section 3, 2.2(1)a).

- (ii) Even if there is minor deficiencies in the claims such as a clerical error, etc. but the statement of the descriptions, etc. is clear and sufficient in such a manner that a person skilled in the art can work the claimed invention based on the common general knowledge as of the filing, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 1, Section 1, 6.).

## 2. Correction by ex officio of descriptions, etc.

### 2.1 Examples of description deficiencies which can be subject to correction by ex officio

(1) Cases where both expression and contents result in one as follows, with respect to the correction to the deficiencies

- (i) the Oatent Office → the Patent Office
- (ii) linear tor → linear motor
- (iii) the Patent Office the Patent Office → the Patent Office

(2) Cases where the expression is not resulted in one but contents are resulted in one, and the expressional difference does not become an issue, with respect to the correction to the deficiencies

(i) Additional remarks that it is a trade name

(ii) Correction of the following misspelling or omitted letters

... that is X ... → ... that is as ..., or that is to ...

(X represents misspelling or omitted letters.)

(iii) Correction of the title of the invention obviously different from the claims

(Example) Title of the Invention: XX DEVICE AND YY PROCESS → XX DEVICE

(Claims: XX device)

(iv) Addition of a publication number, etc. for an application described as a conventional art

(Example) Japanese Patent Application No. S50-12345

→ Japanese Patent Application No. S50-12345 (JP S51-54321A)

### 2.2 Points of correction by ex officio

- (1) The Examiner communicates the content of correction with the applicant, etc. by telephone, etc. prior to a correction by ex officio and makes a response record clearly and specifically indicating the content of correction. This indication in the record can be replaced with the correction proposed by the applicant, etc., via a facsimile, etc., by attaching it on the record. If the Examiner cannot obtain a consent of the correction from the applicant, etc., the correction by ex officio is not made except when the correction by ex officio is related to "matters or contents that clearly damage the public order or morality" in accordance with Examination Handbook, 3501, 2(2)), and the Examiner describes the non-consent of the correction from the applicant in a response record.
- (2) A correction by ex officio of descriptions, etc. (except the title of the invention) is conducted by selecting "Data of Correction by Ex Officio" from a button of "Internal Document Preparation" of WindowManager (for Examiner) , the patent and utility models peripheral examination assistance system.
- (3) A correction by ex officio of the title of the invention is conducted by selecting a button of "Change" of Title of the Invention/Device which appears on a setting screen of Decision to Grant a Patent/Decision of Registration in the patent and utility models peripheral examination assistance system. In this case, "Examination Memo" is also selected from a button of "Internal Document Preparation" of WindowManager (for Examiner) in the system to prepare the memo with the following points in mind.

(Example)

<<Data of Correction of Title of the Invention by Ex-Officio>>

[Title of Document to be Corrected] Descriptions

[Unit to be Corrected] Title of the invention

[Method of Correction] Change

[Content of Correction]

[Title of the Invention]

XXX...

### 3. Invitation for amendment under the Commissioner's name

When description deficiencies are found in unclear drawings, etc. and the deficiencies are not relevant to other rejection such as addition of new matter, etc. (including matters excluded from the subject of the formality examination), the

Examiner may contact Formality Examination Office and request to notify an applicant of an invitation for amendment for the deficiencies under the Commissioner's name if he/she finds it particularly necessary. In this regard, however, Formality Examination Office makes the final decision of an issuance of an invitation for amendment under the Commissioner's name for each case.

Examples of matters related to the description deficiencies which can be the subject of the request include the followings.

(Common to the Descriptions and the Claims)

- (1) Cases where a part of the descriptions or the claims is written in a foreign language (except for cases where general terms and technical terms are described in the original language in parentheses after Japanese names and cases where an application is filed in English or other foreign language under Article 36bis(1) of the Patent Act)
- (2) Cases where the column [Drawings] is provided in the descriptions or the claims

(Title of the Invention)

- (1) Cases where no title of the invention is described
- (2) Cases where a more than one columns of [Title of the Invention] are provided

(Brief description of drawings)

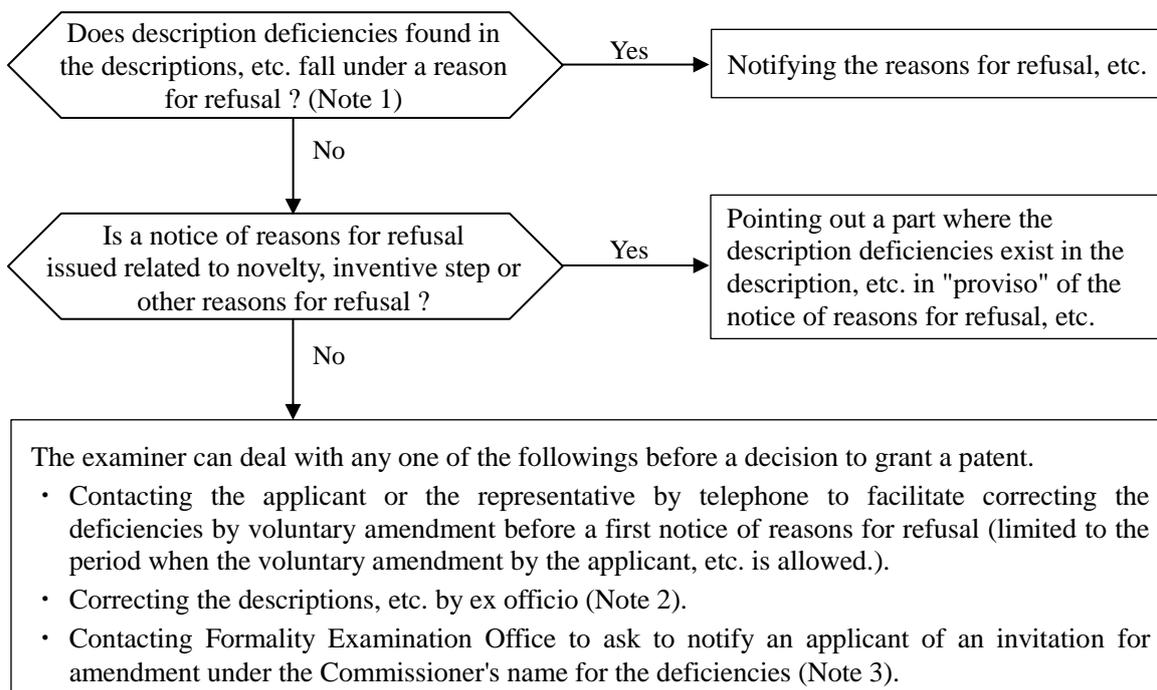
- (1) Cases where the drawing number is not a consecutive number starting from 1
- (2) Cases where the Figure number and sub-drawing number of the drawings are not identified with the drawing number and sub-drawing number of the brief description of drawings
- (3) Cases where descriptions of all drawings and sub-drawings are not provided
- (4) Cases where more than one columns of [Brief Description of Drawings] are provided

(Drawings)

- (1) Cases where no drawing number is described when there are two or more drawings
- (2) Cases where the drawing number is not a consecutive number starting from 1
- (3) Cases where a drawing intended to form one drawing with one drawing number drawn on more than one sheet
- (4) Cases where a leader line that cannot be distinguished from other lines is drawn

- (5) Cases where drawings are unclear
- (6) Cases where letters in the drawings are extremely small
- (7) Cases where the explanation of the drawings is written in a foreign language (except for cases where general terms and technical terms are described in the original language in parentheses after Japanese names and cases where an application is filed in English or other foreign language under Article 36bis(1) of the Patent Act)
- (8) Cases where identical drawing numbers are not described to the same drawings when the same drawing numbers are assigned more than one drawing (Example. [Figure 2] and Fig. 3 are described for the same drawing)
- (9) Cases where the sub-drawing number is not a consecutive number (symbol)

Fig. Dealing with a case where description deficiencies have been found in descriptions, claims or drawings (descriptions, etc.)



(Note 1) When determining deficiencies in the descriptions, etc. fall under a reason for refusal, the followings should be taken into consideration:

- (i) Even if there is minor deficiencies in the claims such as a clerical error, etc., it is not immediately determined that the deficiencies fall under a reason for refusal due to a violation of Clarity Requirement. When, for example, a person skilled in the art has found the claimed invention not ambiguous with minor deficiencies, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 2, Section 3, 2.2(1)a).
- (ii) Even if there is minor deficiencies in the claims such as a clerical error, etc. but the statement of the descriptions, etc. is clear and sufficient in such a manner that a person skilled in the art can work the claimed invention based on the common general knowledge as of the filing, such deficiencies do not fall under a reason for refusal due to a violation of Clarity Requirement (see Examination Guidelines, Part II, Chapter 1, Section 1, 6.).

(Note 2) The examiner communicates the content of correction with the applicant, etc. by telephone, etc. prior to a correction by ex officio and makes a response record clearly and specifically indicating the content of correction. This indication in the record can be replaced with the correction proposed by the applicant, etc., via a facsimile, etc., by attaching it on the record. If the Examiner cannot obtain a consent of the correction from the applicant, etc., the correction by ex officio is not made except when the correction by ex officio is related to "matters or contents that clearly damage the public order or morality" in accordance with Examination Handbook, 3501, 2(2)).

(Note 3) Formality Examination Office makes the final decision of an issuance of an invitation for amendment under the Commissioner's name for each case.

## 2003 Handling of Trademark Name Appearing in Descriptions, Claims, or Drawings

Any trademark name (including a registered trademark throughout this section) that appears in the descriptions, claims, or drawings is to be handled as follows.

- (1) If a trademark name appears in the claims or in a portion or portions of the descriptions or drawings describing the claimed invention, a reason for refusal is generally notified for the patent application concerned on the grounds that it fails to comply with the requirement of Article 36(4)(i) or Article 36(6)(ii) of the Patent Act.

However, the above general rule shall not apply to cases (a) where it is found that the trademark name is in effect a common name of a substance or an item, or (b) where the trademark is not a common name of a substance or an item but it can be established that the following three conditions are all met (Notes 1, 2).

- (i) It can be recognized that there is sufficient significance as an invention in selecting the one having the trademark name selected in particular from among other similar products.
- (ii) The presence of the trademark name does not render the invention unclear (for example, it is unambiguous that the trademark had been always given only to items that have a constant quality, composition, configuration, and the like at least at the time of or prior to filing of the patent application for the claimed invention).
- (iii) It can be recognized in spite of the presence of the trademark name that the technique of the invention is sufficiently disclosed (for example, even when the commodity having the trademark name becomes commercially not available for a certain reason, an invention substantially identical with that invention can be readily worked by a person ordinarily skilled in the art to which the invention pertains).

(Note 1) Finding in accordance with the above case (a) shall not be made for a registered trademark name.

(Note 2) There would be substantially no situations where the finding in accordance with the case (b) can be made.

(Explanation)

A trademark is not always used only for a limited range of commodities. Also, even when

a trademark is used only for a limited range of commodities, the same trademark is often used for commodities that vary in their qualities, compositions, configurations, and the like depending upon their manufacturing times and the like. In particular, this tendency becomes conspicuous as the technological progress becomes more rapid. In addition, when commodities having a certain trademark are in particular distinguished over other similar commodities, their manufacturing method, compositions or any other technical aspects are in most cases kept confidential and not opened to public.

As a result, in normal cases, the invention for which a patent is sought will be not clear because a trademark name appears in the claims or in a portion or portions of the description or drawings describing the claimed invention or the detailed description of the invention will not be so clearly and sufficiently described that a person skilled in the art can work the claimed invention because the techniques relevant to the invention are not sufficiently disclosed. This is the reason for a need to comply with the above general rule of handling.

- (2) Where the presence of a trademark name does not cause a reason for refusal to be raised, the applicant is requested to make an amendment such that the trademark in question is replaced by any appropriate technical or scientific terms. When an appropriate technical or scientific term is not found, indication of the trademark name may be maintained. In that case, however, if the trademark in question is a registered trademark, an explanatory mark "(registered trademark)" should be added next to the trademark name, or an explanatory mark "(trademark)" should be added next to an unregistered trademark (Remarks 7, 9 of Form 29 of the Regulations under the Patent Act). The annotation to the effect that the trademark is in fact a trademark name may be made by an ex-officio correction (see 2002 of this handbook).

(Explanation)

If a trademark name is recited on an as-is basis in the descriptions, such recitation may cause confusion of the trademark with a common name of any item or substance, which is not appropriate. Moreover, the presence of the trademark name may cause misinterpretation as if the trademark were a common name, which in turn causes degradation in the function intrinsic to a trademark to represent the origin of goods, which further causes unexpected disadvantage to the holder of a trademark right or the holder of the right to use it.

Hence, if the trademark name remains to appear on an as-is basis in the descriptions without amendment to replace it by appropriate technical or scientific terms, it is necessary to clearly state that the name in question is actually a trademark name. This is the reason for a need to comply with the above general rule of handling.

2004 Measurement Act [Extract]

Patent Law Enforcement Regulations

Article 3 When providing a statement pertaining to the quantity of a state of a physical phenomenon stipulated in the Measurement Act (Act No. 51 of 1992) Article 2(1) in a document, the statement shall be made in accordance with Article 8 of the Act as well as Supplementary Provision Articles 3, 4, 5, 6, 8(1), and 8(3) of the Act.

Measurement Act (Act No. 51 of 1992) [Extract]

(Definitions, etc.)

Article 2 In this act, "measurement" refers to measuring the following listed matter (hereinafter, referred to as "quantity of a state of a physical phenomenon"), and "measurement unit" refers to that which is to be a criterion for measurement.

- i length, mass, time, current temperature, amount of substance, intensity of light, angle, solid angle, area, volume, angular velocity, angular acceleration, speed, acceleration, frequency, rotational speed, wavenumber, density, force, moment of force, pressure, stress, viscosity, kinetic viscosity, work, engineering rate, mass flow rate, flow rate, amount of heat, thermal conductivity, specific heat capacity, entropy, quantity of electricity, electric field strength, voltage, electromotive force, capacitance, magnetic field strength, magnetomotive force, magnetic flux density, flux, inductance, electrical resistance, conductance of electricity, impedance, power, reactive power, apparent power, amount of electrical power, amount of reactive power, amount of apparent power, attenuation of electromagnetic waves, power density of electromagnetic waves, radiation intensity, light flux, luminance, luminescence, sound power, sound pressure level, vibration acceleration level, concentration, neutron emission rate, radiation, absorbed dose, absorbed dose rate, kerma, kerma rate, irradiation dose, irradiation dose rate, dose equivalent or dose equivalent rate
- ii fineness, specific gravity, others defined by Cabinet Order

2 to 8 (omitted)

(Note "Cabinet Order" = Measurement Unit Ordinance, Article 2)

(Measurement Units Related to International System of Units)

Article 3 Among quantities of states of physical phenomena listed in Paragraph 1,

Section 1, of the previous Article, measurement units for those listed in the upper row of the Attached Table 1 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order in accordance with international decisions and practices related to measurement units of the General Conference of Weights and Measures, etc.

(Other Measurement Units)

Article 4 Other than quantities of states of physical phenomena stipulated in the previous article, measurement units for quantities of states of physical phenomena listed in the upper row of the Attached Table 2 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order.

2 Other than measurement units stipulated in the previous article, among quantities of states of physical phenomena listed in the upper row of the Attached Table 1, measurement units for those listed in the upper row of the Attached Table 3 are as listed in the bottom rows of the same table, and definitions for the same are defined by Cabinet Order.

(Note "Cabinet Order" in Paragraphs 1 and 2 = Measurement Unit Ordinance, Article 2)

Article 5 Other than measurement units stipulated in the preceding Article 2, measurement units, and definitions for the same, representing those in which the measurement unit has been multiplied by an integer power of 10 are defined by Cabinet Order.

2 Other than measurement units stipulated in the preceding Article 2 and the preceding Paragraph, measurement units, and definitions for the same, for lengths, masses, angles, areas, quantities, speeds, accelerations, pressures, and amounts of heat used in measurements of length at sea level and other special measurements defined by Cabinet Order are defined by Cabinet Order.

(Note "Cabinet Order" in Paragraphs 1 and 2 = Measurement Unit Ordinance, Articles 4 and 5)

(Prohibition on the Use of Non-Statutory Measurement Units)

Article 8 Measurement units (hereinafter referred to as "non-statutory measurement units") other than measurement units stipulated in Articles 3 to 5 (hereinafter referred to as "statutory measurement units") shall not be used for trading or

certification regarding quantities of states of physical phenomena listed in Article 2(1)(i).

2 to 3 (omitted)

[Attached Table 1] (Pertaining to Article 3)

Quantity of State of Physical Phenomenon	Measurement Unit
Length	Meter
Mass	kilogram, gram, ton
Time	second, minute, hour
Current	ampere
Temperature	Kelvin, Celsius degree or degree
Amount of Substance	mole
Intensity of Light	candela
Angle	radian, degree, second, minute
Solid Angle	steradian
Area	square meter
Volume	cubic meter, liter
Angular Velocity	radians per second
Angular Acceleration	radians per second per second
Speed	meters per second, meters per hour
Acceleration	meters per second per second
Frequency	Hertz
Rotational Speed	per second, per minute, per hour
Wavenumber	per meter
Density	kilograms per cubic meter, grams per cubic meter grams per liter
Force	newton
Moment of Force	newton-meter
Pressure	pascal or newtons per square meter, bar
Stress	pascal or newtons per square meter

Viscosity	pascal-second or newton-seconds per square meter
Kinetic Viscosity	square meters per second
Work	joule or watt-second, watt-hour
Engineering Rate	watt
Mass Flow	kilograms per second, kilograms per minute, kilograms per hour, grams per second, grams per minute, grams per hour, tons per second, tons per minute, tons per hour
Flow	cubic meters per second, cubic meters per minute, cubic meters per hour, liters per second, liters per minute, liters per hour
Amount of Heat	joule or watt-second, watt-hour
Thermal Conductivity	watts per meter per Kelvin, watts per meter per degree
Specific Heat Capacity	joules per kilogram per Kelvin or joules per kilogram per degree
Entropy	joules per Kelvin
Quantity of Electricity	coulomb
Electric Field Strength	volts per meter
Voltage	Volt
Electromotive Force	Volt
Capacitance	farad
Magnetic Field Strength	amperes per meter
Magnetomotive Force	ampere
Magnetic Flux Density	tesla or weber per square meter
Flux	weber
Inductance	henry
Electrical Resistance	ohm
Conductance of Electricity	siemens

Impedance	Ohm
Power	watt
Amount of Electrical Power	joule or watt-second, watt-hour
Power Density of Electromagnetic Waves	watts per square meter
Radiation Intensity	watts per steradian
Light Flux	lumen
Luminance	candelas per square meter
Luminescence	lux
Sound Power	watt
Concentration	mole per cubic meter, mole per liter, kilogram per cubic meter, gram per square meter, gram per liter
Neutron Emission Rate	per second, per minute
Radiation	becquerel, curie
Absorbed Dose	gray, rad
Absorbed Dose Rate	grays per second, grays per minute, grays per hour, rads per second, rads per minute, rads per hour
Kerma	gray
Kerma Rate	grays per second, grays per minute, grays per hour
Irradiation Dose	coulombs per kilogram, roentgen
Irradiation Dose Rate	coulombs per kilogram per second, coulombs per kilogram per minute, coulombs per kilogram per hour, roentgens per second, roentgens per minute, roentgens per hour
Dose Equivalent	sievert, rem
Dose Equivalent Rate	sieverts per second, sieverts per minute, sieverts per hour, rems per second, rems per minute, rems per hour

[Attached Table 2] (Pertaining to Article 4)

Quantity of State of Physical Phenomenon	Measurement Unit
Reactive Power	Bar
Apparent Power	volt-ampere
Reactive Energy	bar/second, bar/hour
Apparent Energy	volt-ampere, volt-ampere-hour
Attenuation of Electromagnetic Waves	decibel
Sound Pressure Level	decibel
Vibration Acceleration Level	decibel

[Attached Table 3] (Pertaining to Article 4)

Quantity of State of Physical Phenomenon	Measurement Unit
Rotational Speed	revolutions per minute, revolutions per hour
Pressure	atm
Viscosity	poise
Kinetic Viscosity	stokes
Concentration	percent by weight, parts per thousand by weight, ppmw, ppbw, pptw, ppqw, percent by volume, parts by thousand by volume, ppmv, ppbv, pptv, ppqv, pH

## Supplementary Provisions

## (Measurement Units)

Article 3 Measurement units listed in the lower rows of the Attached Table 1 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1995, are treated as statutory

measurement units of Article 8(1) (hereinafter, simply "statutory measurement units") of the Measurement Act, revised (hereinafter, "New Act"), for quantities of states of physical phenomena listed in the upper row of the same table.

- 2 Measurement units listed in the lower rows of the Attached Table 2 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1997, are treated as statutory measurement units for quantities of states of physical phenomena listed in the upper row of the same table.
- 3 Measurement units listed in the lower rows of the Attached Table 3 of the Supplementary Provision, and measurement units representing those in which the measurement unit has been multiplied by an integer power of 10 and which are defined by Cabinet Order, until September 30, 1999, are treated as statutory measurement units for quantities of states of physical phenomena listed in the upper row of the same table.
- 4 Definitions of measurement units stipulated in the prior Paragraph 3 are defined by Cabinet Order.

Article 4 Regarding measurement units stipulated from Paragraphs 1 to 3 of the previous Article, even subsequent to the date defined in these provisions, it is presumed that the measurement units may be treated as statutory measurement units.

- 2 In the case of the previous paragraph, a deadline for treating the measurement units as statutory measurement units by the Cabinet Order, as well as the extent of transactions and certifications that can be used for the same and methods used for the same, shall be defined.

(Measurement Units According to Imperial Units)

Article 5 Measurement units, and their definitions, according to Imperial units are defined by Cabinet Order.

- 2 (omitted)

(French Horsepower)

Article 6 French horsepower, when used for such trading or certification defined by Cabinet Order as trading, certification, etc., relating to an internal combustion engine, for the time being, it to be treated as a statutory measurement unit for engineering rate.

2 The definition of French horsepower is defined by Cabinet Order.

(Identifications, Etc., for Measurement Units)

Article 8 By the due date stipulated in Paragraphs 1 to 3 of Article 3 of the Supplementary Provision, identifications by measurement units defined by these provisions shall be provided in a document, and when attached to exhibits for goods, etc., identification of the same, regardless of provisions in Article 8(1) of the New Act, can be used for transactions or certifications even subsequent to the due date.

[Supplementary Provisions, Appendix 1]

Quantity of State of Physical Phenomenon	Measurement Unit
Force	dyne
Work	erg
Amount of Heat	kilogram-force meter, erg
Neutron Emission Rate	neutrons per second, neutrons per minute
Radiation	disintegrations per second, disintegrations per minute

[Supplementary Provisions, Appendix 2]

Quantity of State of Physical Phenomenon	Measurement Unit
Length	micron
Frequency	cycle or cycles per second
Magnetic Field Strength	ampere turns per mete, oersted
Magnetomotive Force	ampere turns
Magnetic Flux Density	gamma, gauss

Flux	maxwell
Sound Pressure Level	phon
Concentration	as defined

## [Supplementary Provisions, Appendix 3]

Quantity of State of Physical Phenomenon	Measurement Unit
Force	kilogram-force, gram-force, ton-force
Moment of Force	kilogram-force meter
Pressure	kilograms-force per square meter grams-force per square meter, meter mercury column, meter water column
Stress	kilograms-force per square meter, grams-force per square meter
Work	kilogram-force meter
Engineering Rate	kilogram-force meters per second
Amount of Heat	
Thermal Conductivity	calorie calories per second per meter per degree, calories per hour per meter per degree
Specific Heat Capacity	calories per kilogram per degree

## Chapter 1 Requirements for Description

### 2101 Points to Note When Acquisition of Prior Art Documents is Difficult

The Examiner, in such as a case in which acquisition of prior art documents disclosed in the detailed description of the invention is difficult, can issue a Notification by Examiner based on provisions of Article 194(1) (Submission, Etc., of Documents), and require that the applicant provide submission of an exhibit of documents, etc., necessary for examination.

**2102 Determination Regarding An Amendment Adding Prior Art Document Information (Applied to Applications for Which the Filing Date (For Divisional/Converted Applications, Etc., the Actual Filing Date) Is On or Before December 31, 2008)**

An amendment which adds content provided in prior art documents to the column for [Background Art] of the detailed description of the invention does not correspond to an addition of new matter, and therefore is legitimate. However, adding such information related to an evaluation of the invention as a comparison, etc., with the invention according to the claimed invention, or information related to an implementation of the invention, or adding contents provided in a prior art document to resolve a defect of Article 36(4)(i), corresponds to an addition of new matter, and therefore is an illegitimate amendment.

Regarding details, refer to 3.3.2(1) of "Part IV Chapter 2 Amendment Adding New Matter" of the Examination Guidelines.

### 2103 Example in Which It is Possible to Perform Notification of Article 48septies at the Same Time as or Subsequent to Notification of A First Reason for Rejection

For an application in which, for example, contents of prior art are provided in the detailed description of the invention, but prior art document information corresponding to the prior art is not provided, and therefore, it is found that the prior art document information disclosure requirement is not satisfied, if the prior art document information is necessary for determining novelty/inventive step, etc., then the Examiner may perform both the notification of Article 48septies and the first Notification of Reason for Rejection (limited to notifications which do not refer to publicly known literature, related to the prior art document information; hereinafter the same shall apply in this item) at the same time, or perform notification of Article 48septies subsequent to notification of the initial Notification of Reason for Rejection.

In addition, even in such a case as when the contents of the application are significantly unclear, and investigation regarding such patent requirements as novelty/inventive step is difficult, it is possible to simultaneously perform the notification of Article 48septies and a Notification of Reason for Rejection notifying only reasons for rejection related to description requirements, etc., of the descriptions and the claims.

However, notification of Article 48septies is not performed uniformly, but is only performed in a case in which the Examiner finds a need.

## 2104 Description Procedure for Journals

For the description procedure for journals, refer to 1207 of "Part I Chapter 2 Procedures of Examination" of the present handbook.

However, even in "(7) Cases of the description, etc. in full text of Japanese utility model applications based on the former act of utility model on or before the date of 31 December, 1993" in "1. Publication of national patent application, utility model application, etc., (Examples of statements)", description of "(5) Case of publication of unexamined patent applications or unexamined utility model application" is sufficient.

## Chapter 2 Requirements for Claims

### 2201 Requirement of Definiteness When Description Using Alternative Forms Such as Markush Form Pertains to a Chemical Substance

When a description using an alternative form such as Markush Form relates to chemical substances, then if the requirements of the following (i) to (ii) are satisfied, the substances possess similar qualities or functions, and therefore, it is possible to clearly understand the one invention.

- (i) Chemical substances pertaining to all options have common properties or activities.
- (ii) There is a common chemical structure, namely, all options share an important chemical structure element (Note 1); or if the shared chemical structure is not a determination criterion, then all options belong to a chemical substance group (Note 2) that is recognized as one group in the technical field to which the invention belongs.

(Note 1) "All options share an important chemical structure element" refers to the following either (a) or (b). Moreover, the chemical structure element may be one portion, or a combination of individual portions that are mutually linked.

- (a) such a case as in which a plurality of chemical substances have a shared chemical structure occupying a significant portion of the chemical structure thereof
- (b) in the case when the chemical substance only shares an insignificant portion of the chemical structure, the case in which the shared chemical structure, in view of the prior art, constitutes a structurally conspicuous portion

(Note 2) "A chemical substance group recognized as one group" refers to a group of chemical substances that are predicted to act in the same manner under the invention provided in the claims on the basis of knowledge in the technical field of the same. That is to say, it means that an equivalent result can be acquired even if each of the chemical substances belonging to this chemical substance group is interchanged.

## 2202 Description Forms for Claims - Independent and Dependent Forms

In Article 24ter(iii) of the Patent Law Rules of Practice, it is described that "citation of another claim in the statement of a claim shall be performed using the number imparted to that claim," and in the item (iv) of the same paragraph, it is described that "when providing a claim so as to refer to a statement of another claim, the claim shall be provided prior to the cited claim." In this manner, as a description form for a claim, providing another claim by reference is admitted, and a claim provided using this type of description form is referred to as a "dependent form claim." In addition, a claim provided which does not refer to another claim is referred to as an "independent form claim." Furthermore, for both types, only the description expression differs, and both types receive equivalent handling.

### 1. Independent-form claims

A description of an independent-form claim is possible regardless of whether or not the invention according to the independent-form claims is the same as an invention according to another claim.

### 2. Dependent-form claims

#### 2.1 A typical dependent-form claim

A dependent-form claim is used to simplify the description of a claim so as to avoid a duplicate description of text in the claims. However, a description according to the dependent-form claim is possible regardless of whether or not the invention according to the dependent-form claim is the same as an invention according to a claim referring to an invention according to the dependent claim.

A typical example in which a claim can be provided in the dependent-form is a case in which a claim comprising all features of one other preceding claim is provided.

By providing a claim in dependent form in this type of case, it is possible to omit repeated descriptions of text, as well as to clarify differences between a cited claim and a claim which is provided so as to cite the cited claim, and therefore, there are such advantages as reducing burden on the applicant, and facilitating understanding by a third party.

Example: a typical claim in dependent form.

[Claim 1] Construction-use wall material comprising thermal insulation material

[Claim 2] The construction-use wall material according to claim 1, for which the thermal insulation material is polystyrene foam

## 2.2 Dependent-form claims other than the above.

Even in such cases as the following (i) or (ii), unless the statement of the claim becomes unclear, there are cases in which the statement of a claim becomes brief by referring to a statement of another claim so as to perform description as a dependent-form claim.

- (i) when providing a claim in which a portion of matter for identifying an invention of another preceding claim is substituted
- (ii) when providing a claim of a category expression which is different from another preceding claim

Example 1: A dependent-form claim in which a portion of matter for identifying an invention of another preceding claim is substituted

[Claim 1] A transmission device of a specific structure provided with a gear transmission mechanism

[Claim 2] In the transmission device provided in claim 1, a transmission device provided with a belt transmission mechanism instead of the gear transmission mechanism

Example 2: A dependent-form claim described by reference to a statement of a claim expressed using a different category

[Claim 1] A ball bearing of a specific structure.

[Claim 2] A manufacturing method for the ball bearing described in claim 1 using a specific step

Example 3: A dependent-form claim described by reference to a statement of a claim of a subcombination

[Claim 1] A bolt having a thread of a specific structure.

[Claim 2] A nut having a thread of a specific structure engaging the bolt described in claim 1.

### 2.3 Multiple dependent-form claims

A multiple dependent-form claim is a claim described by reference to a description of two or more other claims (regardless of whether they are in dependent-form or independent-form), and is used to simplify the description of all claims of a patent.

A claim in this form, in comparison with separately describing a plurality of claims in ordinary dependent-form, although having merits in aspects of description and fees, is a single unit for waiver or a trial for invalidation, and therefore, also inherently possesses such demerits as being waived or invalidated together. Therefore, the determination of whether to use ordinary dependent-form claims or multiple dependent-form claims should be made after sufficiently comparing and considering such points, and the selection of the same should be entrusted to the determination of the applicant.

In addition, in Patent Law Rules of Practice Form 29bis [Remarks] 14 Ni, it is described that, when describing a claim in multiple dependent-form, descriptions of two or more other claims should be referred to as alternatives to each other, and the same technical limitation should be attached in description thereof (Patent Law Rules of Practice Form 29bis [Remarks] 14).

Example: A description of a claim using a multiple dependent-form claim

[Claim 1] An air-conditioning device having a specific structure

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioning device described in claims 1 or 2 having an air volume adjustment mechanism.

### 3. The relationship between rules of practice form remarks pertaining to described forms for claims and reasons for rejection

In a case of describing using a form referring to multiple clauses, when citations of two or more descriptions of claims are not stated as alternatives to each other (examples 1 and 2), or when the same technical limitation is not attached thereto (examples 3 and 4), there are cases in which there is no match to the instructions pertaining to the described form for a claim within the form remarks of the Patent Law

Rules of Practice (Patent Law Rules of Practice Form 29bis [Remarks] 14 Ni). However, these instructions are not requirements that are legally required, and therefore, this is not a violation of Article 36(6)(iv).

However, the Examiner shall note that there are cases in which an invention may become unclear by citations of statements of two or more other claims not being stated as alternatives to each other, or by the same technical limitation not being attached thereto.

(i) There are cases in which, by way of citations of statements of claims not being stated so as to be alternatives to each other, the description becomes unclear, and as a result, a claimed invention becomes unclear. However, the Examiner shall note that even if the citations are not stated so as to be alternatives to each other, there are cases in which the invention is clear.

Example 1: An example in which an invention becomes unclear as a result of citation of statements of claims not being stated as alternatives to each other:

[Claim 1] An air-conditioning device having a specific structure

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioning device described in claims 1 or 2 having an air volume adjustment mechanism.

(Explanation)

In claim 3, claims 1 and 2 are connected using the conjunction "and," and therefore, the citations are not stated so as to be alternative to each other, and the invention pertaining to claim 3 is unclear (see 2.2(1) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

Example 2: An example in which an invention is clear although citations of statements of claims are not stated as alternatives to each other.

[Claim 1] A bolt having a thread of a specific structure.

[Claim 2] A nut having a screw groove of a specific structure.

[Claim 3] A fastener device comprising the bolt described in claim 1 and the nut described in claim 2.

(Explanation)

In Claim 3, claims 1 and 2 are connected using the conjunction "and." However, it is clear that the fastener device of claim 3 is a fastener device comprising both the bolt of claim 1 and the nut of claim 2, and therefore, the invention is clear.

(ii) There are cases in which, as a result of the same technical limitation not being attached to claims to be referred to, the invention is unclear. However, the Examiner shall note that, even if the same technical limitation is attached, there are cases in which the invention may be clear, or that even if the same technical limitation is attached, there are cases in which the invention may be unclear.

Example 3: An example in which the same technical limitation is not attached to a claim to be referred to, and therefore, the invention is unclear:

[Claim 1] An air-conditioning device having a specific air volume adjustment structure A.

[Claim 2] An air-conditioning device having a specific state display structure B.

[Claim 3] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism, or the air-conditioning device described in claim 2 having a timer mechanism.

(Explanation)

To claims 1 and 2 referred to in claim 3, different technical limitations are each attached, and therefore, the invention pertaining to claim 3 is unclear (see 2.2(4) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

Example 4: An example in which the claims that are referred to so as to be alternative to each other do not have the same technical limitation attached thereto, and therefore, do not match instructions for form remarks (see Patent Law Rules of Practice Form 29bis [Remarks] 14 Ni); however, options for claim descriptions have similar properties or functions, and therefore, the requirement for definiteness is not violated.

[Claim 1] An air-conditioning device having a specific structure.

[Claim 2] The air-conditioning device described in claim 1 having a wind direction adjustment mechanism.

[Claim 3] The air-conditioner device described in claim 1 having an air volume adjustment mechanism, or the air-conditioner device described in claim 2 having a timer mechanism.

(Explanation)

In claims 1 and 2 cited in claim 3, a different technical limitation of a "wind direction adjustment mechanism" and a "timer mechanism" is each attached, respectively. However,

both of the options have a similar property or function in the point of being an air-conditioning device having a specific structure.

Example 5: An example in which, even if the same technical limitation is attached to claims to be referred to, inventions pertaining to the claims to be referred to belong to mutually different categories, and therefore, the category of the claimed invention is unclear.

[Claim 1] An artificial heart of a specific structure

[Claim 2] A manufacturing method for an artificial heart of a specific structure by way of a specific step.

[Claim 3] A manufacturing method for the artificial heart described in claim 1, or the artificial heart described in claim 2, provided with a specific safety device.

(Explanation)

To claims 1 and 2 referred to in claim 3, the same technical limitation of a being "provided with a specific safety device" is attached. However, the invention pertaining to claim 1 is an "invention of a product," and the invention pertaining to claim 2 is a "manufacturing method," and therefore, the inventions pertaining to the cited claims 1 and 2 belong to different categories. As a result, the category of the invention related to claim 3 is unclear, and therefore, the invention related to claim 3 is unclear (see 2.2(3) of "Part II, Chapter 2, Section 3: Requirement of Definiteness" of the Examination Guidelines).

## 2203 Points to Note in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product

Examiner shall proceed with the examination while paying attention to the following points when determining whether or not “4.3.2 The case where a claim concerning an invention of a product includes a manufacturing method for a product” of “Part II Chapter 2 Section 3 Clarity Requirement” is relevant, and proceeding with the examination in cases where it is relevant.

- (1) The Examiner shall determine, on the basis of the present handbook, Section 2204, whether or not at least a portion of claims pertaining to an invention of a product corresponds to a "case where a claim concerning an invention of a product includes a manufacturing method for a product".
- (2) The Examiner shall determine, on the basis of the present handbook, Section 2205, whether or not, when a determination is made of correspondence to the "case where a claim includes a manufacturing method for a product" in the above (1), regarding the description, whether or not the description corresponds to a "case of existence of impossible/impractical circumstances<sup>1</sup>." In addition, if a claim and a proof have been made that the circumstances exist in the descriptions, an opinion, etc., a determination is to be made in consideration of the same.
- (3) Subsequent to Final Notification of Reasons for Rejection, after receiving a demand for an Appeal Against Examiner's Decision of Rejection/Refusal or a notification of Article 50bis, regarding an amendment which treats a "description of a manufacturing method for the product" as, simply, a description of such aspects as a structure or characteristics, or an amendment which, if a manufacturing method for the product is provided in the invention for the product, simply treats the invention as an invention of the manufacturing method for the product, then the Examiner, normally, shall find that the amendment is an amendment corresponding to a clarification of an unclear description (Article 17bis(5)(iv)).<sup>2</sup>

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<sup>1</sup> I.e., " circumstances that is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing."

<sup>2</sup> Hypothetically speaking, if the amendment is not performed, then ordinarily, this means that a Notification of Reasons for Rejection for violation of the requirement for definiteness has been notified, and furthermore, in applying the provisions of Article 17bis(5), the legislative intent of the same should be sufficiently taken into consideration so as not to operate any more strictly than necessary. Therefore, this time, the amendment is to be admitted. The provisions of the same paragraph are to be treated as having been provided with the intent of establishing an examination

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procedure which quickly and accurately secures granting of rights while taking into consideration the basic purpose of the patent system, which is to fully achieve protection for an invention, and in this end, an amendment in response to a Final Notification of Reasons for Rejection is to be performed within a scope in which it is possible to effectively utilize the examination results that have already been performed. Furthermore, it is considered that even if the amendment is admitted, the examination results that have already been performed can generally be effectively utilized.

## 2204 Determination on Whether or Not "When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product" is Relevant

### 1. Basic idea

- (1) The examiner determines whether or not at least a portion of a claim for an invention of a product corresponds to a "case where a claim recites the manufacturing process of the product" by taking into consideration, in addition to the description, the claims, and the drawings, as well as common general knowledge, at the time of the filing of the application, in the technical field to which the invention belongs. (It is necessary to note that even if one of the following types or examples appears to be relevant, there are cases in which different determinations may be made on the basis of common general knowledge in the technical field.)

Particularly, even if a claim corresponds formally to one of the following types or examples showing "where a claim recites the manufacturing process of the product", when it is clear what structure or characteristics of the product are represented by the manufacturing process (Note)<sup>3</sup> considering the description, claims and drawings as well as common general knowledge, at the time of the filing of the application, in the art to which the invention belongs, the examiner does not consider that the claimed invention violates the clarity requirement on the basis that it corresponds to a case "where a claim recites the manufacturing process of the product".

(Note) The Pravastatin Sodium Case decisions (the Supreme. Court of Japan, June 5, 2015, Second Petty Bench, case Nos. 2012 (Ju) 1204 and 2012 (Ju) 2658)

- (2) In view of the fact that the burden of proof for the description requirement, in general, is on the applicant side, the examiner may notify, if he/she considers appropriate, a reason for refusal for the violation of the clarity requirement and thereby provide the applicant with an opportunity to argue and verify that "impossible or impractical circumstances" exist, or an opportunity to submit a written opinion and/or amendment. It is appropriate to avoid, by doing so, the situation where a patent is subsequently granted containing a reason for invalidation.

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<sup>3</sup> An example where it is considered to be clear what structure or characteristics of the product are represented by the manufacturing process, if considering the description, claims and drawings as well as common general knowledge, at the time of the filing of the application, in the art to which the invention belongs, although the case falls under Type (1-1):

"an apparatus having an anchorage formed by inserting a bolt provided with a convex portion into a hole provided with a concave portion so that the concave portion and the convex portion are engaged, and screwing a nut into an end portion of the bolt"

or the interests of third parties are unfairly prejudiced.

2. Types and examples corresponding to "case where a claim recites the manufacturing process of the product"

Type (1-1): Case in which, pertaining to manufacturing, a description of chronological elements exists

Example:

"A compound A sodium salt prepared by a process comprising the steps of:

- a) forming an enriched organic solution of the compound A;
- b) precipitating a compound A as its ammonium salt;
- c) purifying the ammonium salt by recrystallization;
- d) transposing the ammonium salt to sodium salt; and
- e) isolating a compound A sodium salt."

Example of Amendment:

"A manufacturing process for a compound A sodium salt comprising the steps of:

- a) forming an enriched organic solution of the compound A;
- b) precipitating a compound A as its ammonium salt;
- c) purifying the ammonium salt by recrystallization;
- d) transposing the ammonium salt to sodium salt; and
- e) isolating a compound A sodium salt."

Type (1-2): Case in which, pertaining to manufacturing, a description of a technical feature or condition exists

Examples:

"A polymer C acquired by reacting a monomer A with a monomer B at 50°C."

"A fluorescent body formed by sintering under 1 to 1.5 atmospheric pressures."

"A rubber manufactured good in which roughening treatment, in which a particulate substance is caused to collide with the exterior surface, has been applied"

Examples of Amendment:

"A manufacturing method for a polymer C in which a monomer A is reacted with a monomer B at 50°C."

"A manufacturing method for a fluorescent body manufactured via a sintering step under 1 to 1.5 atmospheric pressures."

"A manufacturing method for a rubber manufactured good in which roughening treatment, in which a particulate substance is caused to collide with the exterior surface, has been applied"

Type (1-3): Case of referring to an invention of a manufacturing process

Examples:

"A rubber composition manufactured using any of the manufacturing methods in claims 1 to 8"

"A polymer manufactured using any of the manufacturing methods in claims 1 to 4"

Examples of Amendment:

(Normally, if an invention of a manufacturing method is left as referred to, it is not possible to prevent, by way of an amendment, a "case in which a manufacturing method for a product is described" from being relevant.)

3. Types and examples not corresponding to a "case where a claim recites the manufacturing process of the product"

Type (2): Case in which, by indicating simply a state of the product, a claim recites the structure or characteristics of the product subject to the invention

Examples:

"An item in which a resin composition has been cured"

"An article in which an affixed chip is bonded to a sensor chip"

"An item in which A is formed to be of a different thickness from B"

"A composition formed by combining A with B"

"A tire created using a rubber composition"

"A laminated film formed by placing a layer C between a layer A and a layer B"

"Removably configured"

"A member B welded to a member A"

"A chamfered member"

"A lid caulked to a body"

"Spun twisted yarn using roving A and roving B"

"A pigment coated with a polymer A"

"A polymer polymerized a monomer A and a monomer B"

"A PEGylated protein"

"A modified protein A after translation"

"A humanized antibody"

"A protein having an amino acid sequence represented by SEQ. No. X in which at least one amino acid is deleted, substituted or added"

• In particular, shown below are terms whose concept is established as those specifying the structure or feature (property) of products. (For example, the definition, etc., of such a term can be found in a dictionary, a textbook, or a technical standards document, etc., and in this light, it is considered that the concept of that term has been established as that specifying the structure or feature (property) of a product.)

"A casting", "A casting product", "A forging"

"A welded part", "A brazed part", "A soldered part", "A fusion-spliced part"

"A machined part", "A cut off part", "A ground surface", "A press-fit surface", "A press-fit structure"

"A sintered object", "A green compact"

"An oriented film", "A blown film"

"Printed parts", "A printed coil", "A printed capacitor"

"A coating film", "A vapor-deposited film", "(as a layer or a film) A coating layer"

"A diffusion layer", "An epitaxial layer", "An epitaxial growth layer";

"Float glass", "A hot-dip zinc-coated steel sheet", "Vulcanized rubber", "An embossed product"

"A welded assembly", "An integrally molded article"

"Isolated cell", "Extract", "Threshed rice", "Spirits", "Plating layer"

(Points to Note)

Even if the wording in a claim differs from that in the operative examples of the above Type (2), it does not mean, thereby, the claim does not fall under Type (2). For example, when there is the wording which is similar to but is different in an expression from one of the operative examples in the above, the relevance to Type (2) is not denied only because of such difference in expression. The Examiner performs the examination based on the above "1. Basic idea".

## 2205 Determination on “Impossible/Impractical Circumstances” in Examination When a Claim for an Invention of a Product Recites the Manufacturing Process of the Product

### 1. Basic idea

- (1) The Examiner shall determine whether there exist "impossible/impractical circumstances" on the basis of claims/proofs by the applicant. At that time, the Examiner shall also take into consideration technical knowledge in the technical field to which the invention belongs (it is necessary for the Examiner to note that even if the following types and operative examples are formally relevant, there are cases in which different determinations may be made on the basis of technical knowledge in the technical field).
- (2) Unless there is reasonable doubt regarding the content of a claim/proof by the applicant regarding the existence of "impossible/impractical circumstances" (normally, unless the Examiner indicates a concrete doubt at the time of a Notification of a Reason for Rejection or the time of a Decision of Rejection), the Examiner shall make a determination that impossible or unrealistic circumstances exist.

### 2. Types and operative examples corresponding to "impossible/unrealistic circumstances"

Type (i): Case in which analyzing the structure or features of an item at application time is technically impossible

Type (ii): Case in which, in view of the fact that, due to the nature of a patent application, rapidity, etc., are required, significantly excessive financial expenditure or time would be required to perform work to identify the structure or properties of the item.

#### Operative Example:

- Cells, etc., created by a new genetic manipulation  
(Judgment of the Second Petty Bench of the Supreme Court (June 15, 2015(Minshu vol. 69 No. 4 Page 700, Minshu vol. 69 No. 4 Page 904)))
- A monoclonal antibody prepared by a hybridoma cell A  
(Reference Decision: Appeal 2014-17732)
- Animal and plant obtained by the breeding method such as crossbreeding  
(Reference Decision: Appeal 2014-10863)

Reference examples are provided at the end of this section, in which applicants of a patent assert or verify cases where a patented invention falls under Type (i) or (ii), or both and "Impossible/Impractical Circumstances" exists.

3. Types and operative examples not corresponding to "impossible/unrealistic circumstances"

Type (iii): Case in which a relationship with the invention of the present application is completely undescribed

Operative Example:

- A case in which, simply, only a claim that time is required for creating the "the claims" has been made
- A case in which, simply, only a claim that performing description using a manufacturing method is easier to understand

● Reference examples of arguments and verification presented by applicants involving "impossible or impractical circumstances" (See 2.)

The followings are reference examples of arguments and verification involving "impossible or impractical circumstances"

(Note) The JPO hereby provides applicants with those examples, for a reference purpose, where the existence of "impossible or impractical circumstances" can be recognized in patent examination<sup>4</sup>, but does not show types of examples in an exhaustive manner. Thus, even if a case does not fall under any of those, it does not necessarily mean that the existence of "impossible or impractical circumstances" for that case cannot be recognized. Conversely, even if the formality of any of the examples below is followed, such circumstances are not always recognized, since, in practice, the existence of "impossible or impractical circumstances" is considered on a case by case basis, taking into account the specific content of arguments and verification.

Regarding claims for products reciting manufacturing processes of the products, when a person skilled in the art cannot understand features of a product (structure, property, etc.) even considering the content of the description and drawings as well as the common general knowledge at the time of the filing of an application, to the extent that patentability

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<sup>4</sup> In procedures in which a third party is involved after a patent is granted, a conclusion on whether the circumstances exist or not may change depending on the contents of arguments and verification presented by the parties.

requirements such as novelty and inventive step cannot be determined, the invention is deemed to be unclear regardless of the existence of “impossible or impractical circumstances”, since the invention cannot be understood from one claim in such a case<sup>5</sup>. The following examples are shown on the premise that an invention does not involve such unclearness.

Furthermore, the following examples do not prejudge whether an invention satisfies the patentability requirements such as novelty and inventive step.

### **Example 1**

#### **(1) Claim**

[Claim 1] An aromatic device comprising:  
 a holder having at least one air vent opening; and  
 an aroma generation source and a heating element disposed in said holder,  
 wherein said aroma generation source includes an activated carbon molding and is heated with said heating element at the temperature in the range from X to Y degrees Celsius,  
 wherein said aroma generation source is produced by heating said activated carbon molding impregnated with a solution of an aromatic ingredient A at the temperature of less than or equal to the heating temperature of said heating element for Z hours or longer.

#### **(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion**

The present invention relates to an aromatic device having an aroma generation source where an aromatic ingredient A existing near the surface of an activated carbon molding is volatilized and the aromatic ingredient existing deeply inside of the activated carbon molding remains. In order to specify the feature of the present invention which cannot be seen in the prior art, claim 1 includes a part stating that said activated carbon molding impregnated with a solution of an aromatic ingredient A is heated at the temperature of less than or equal to the heating temperature of said heating element for Z hours or longer. With that claim element as described, the present invention can obtain an aromatic device which is capable of preventing volatilization of the aromatic ingredient in storage, thereby it can solve the problem of the prior art that the emission efficiency of the aromatic ingredient varies depending on the state of preservation (see paragraphs X-X in the description of the present application).

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<sup>5</sup> Examination Guidelines for Patent and Utility Model, Part II, Chapter 2, Section 3, Clarity Requirement, 4.3.1(2).

However, it is not possible to directly define the feature of the present invention described above by the structure or property of the product.

First, it is impossible to specify the feature of the invention (i.e. the aromatic ingredient exists not near the surface but deeply inside of the activated carbon molding) simply by the wording such as “said aromatic ingredient exists only in the region deeper than XX  $\mu\text{m}$  from the surface”, in light of the fact that each activated carbon molding has a different structure and different properties associated therewith. In addition, there is no other wording clearly specifying the feature described above by structure or property.

Secondly, it is also impossible to specify the structure or property of the aroma generation source having the feature described above by analyzing the results of measurement, even considering the analytical technique at the time of the filing of the application. Specifically, methods of measuring the state of existence of materials in detail include, for example, a scanning electron microscope (SEM), ..., but any of those measuring methods can only measure the state of the surface of samples and thus is not appropriate for analyzing porous material having complicated inside structures such as activated carbon. Even if an analytical technique such as X-ray diffraction (XRD) is used, accurate data cannot be obtained due to volatilization of the aromatic ingredient. As described, there was actually no appropriate means for measurement and analysis.

Assuming that the state of the aromatic ingredient existing inside of the activated carbon molding can be measured by cutting off a sample of the molding to expose the inside thereof, this only reveals a microscopic state of the specific sample. It is utterly impractical to find an index specifying the feature described above through numerous trial-and-error processes by performing difficult operations and measurements repeatedly many times and then utilizing statistical processing methods.

**In Example 1 described above, the written opinion explains in a concrete manner that the wording cannot be found specifying the structure or property concerning the difference between the present invention and the prior art, and that it is impossible or impractical to analyze and specify such structure and property based on the measurement. Therefore, Example 1 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.**

**Example 2****(1) Claim**

[Claim 1] A thin film semiconductor device comprising:  
 a structure of ...; and  
 an oxide semiconductor film consisting of XXX oxide as an active layer,  
 wherein the oxide semiconductor film is formed on a substrate by sputtering, using a target of metal oxide, at the temperature of the surface of the substrate from X to Y degrees Celsius.

**(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion**

An oxide semiconductor film consisting of XXX oxide is formed on a substrate by sputtering under controlling the temperature of the surface of the substrate from X to Y degrees Celsius, so that the resulting oxide semiconductor film has high crystallinity. The present invention provides a thin film semiconductor device having the resulting oxide semiconductor as an active layer, thereby a high performance of switching can be achieved (see the description of the present application, paragraphs X-X).

A conventional thin film semiconductor device using an oxide semiconductor film can be only obtained with a relatively low performance due to low crystallinity of an oxide semiconductor film (see JP YYYY-XXXXXX A). This means when the thin film semiconductor is used for a cellular phone of which battery capacity is limited, available time on one charge is not long, and thereby usability as the cellular phone is impaired (see the description of the present application, paragraphs Y-Y).

Though the difference between the present invention and the prior art is attributed to the difference in crystallinity of an oxide semiconductor film, in light of the non-uniformity of the thin film crystal, it is not possible categorically to specify the structure or property of the difference.

Meanwhile, the difference in crystallinity between them could be measured by X-ray diffraction (XRD) in principle, however, in practice, it is required to produce or purchase the statistically-significant number of thin film semiconductor devices of the present invention and those of the prior art respectively, and to measure a numerical feature of XRD spectrum for statistically processing the feature, and then to find a significant index and its actual value to distinguish between the present invention and the prior art through those processes. Those processes need

enormous time and costs. Furthermore, since the prior art has huge variations, the number to be statistically significant cannot be clearly determined.

Therefore, it is not practical that the feature of the present invention is specified by the structure of property of the product of the invention after the index and its value are found in the way as described above.

**In Example 2 described above, similar to Example 1, the written opinion also explains in a concrete manner that the wording cannot be found specifying the structure or property concerning the difference between the present invention and the prior art, and that it is impossible or impractical to analyze and specify such structure and property based on the measurement. Therefore, Example 2 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.**

### **Example 3**

#### **(1) Claim**

[Claim 1] An oil-in-water type creamy emulsion composition for foods comprising water, an oil component, emulsifiers, a component A and a component B, and having viscosity of X-Y mPa·s ,

wherein said emulsion composition includes an emulsifier X and an emulsifier Y with 10-20/30-40 weight ratio,

and wherein an oil phase containing said emulsifiers, the component A and the component B are prepared in advance by mixing and stirring them and then the resulting product is added to a water phase to obtain said emulsion composition.

#### **(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion**

The present invention prepares in advance an oil solution in which the prescribed emulsifiers, component A and component B are dispersed in the solution, and then the oil solution is added to a water phase for emulsion. The present invention provides an oil-in-water type creamy emulsion composition for foods having a good foam stability compared to one obtained by a conventional method in which a water phase dissolving an emulsion, a component A and a component B is added to an oil phase for emulsion (see the description of the present application, paragraphs X-X).

As described, compared to the prior art, the good foam stability achieved by the present invention is caused by the microscopic difference in a dispersed state of the components provided by the different manufacturing process. The microscopic difference in the dispersed state cannot be identified by the general index such as a composition or viscosity.

Even if it is attempted to express the property of foam stability itself in a numerical range, a microscopic dispersed state in an oil-in-water type creamy emulsion composition for foods varies depending on a composition of a raw material, a temperature, a stirring speed and other manufacturing conditions. Then, if a microscopic dispersed state is different, a numerical value of foam stability naturally changes. Thus, manufacturing the product with raw materials constituting various compositions under various manufacturing conditions such as the temperature and the stirring speed and measuring the foam stability of each resulting product requires impractical numbers of experiments and drastically huge economic expenses. Furthermore, the result cannot be expressed in a claim comprehensively.

Therefore, it is utterly impractical to “specify a product directly by structure or property at the time of the filing of an application” with regard to the present invention.

**Example 3 as described falls under the case where the concrete aspects of the structure or property of the product vary depending on various concrete modes of the manufacturing method recited in the claim, and those concrete aspects cannot be expressed comprehensively, thus it is impossible or impractical to specify the product directly by its structure or property. The written opinion explains the situation concretely. Therefore, Example 3 is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.**

**Example 4**

**(1) Claim**

[Claim 1] A flavor improving agent prepared by the successive steps of:

obtaining a concentrated solution by heating and concentrating sugar cane juice at the temperature of 120-130 degrees Celsius until an indicator of a sugar refractometer becomes 70-80 degrees with a Brix scale; and collecting distillation by collecting and cooling vapor which can be obtained by distilling said concentrated solution at the temperature of 120-130 degrees Celsius.

**(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion**

The present invention relates to a flavor improving agent obtained by collecting the distillation of sugar cane juice through each manufacturing process described in claim 1 of the present invention. The flavor improving agent of the present invention is manufactured by heating and concentrating the sugar cane juice at the temperature of 120-130 degrees Celsius until an indicator of a sugar refractometer becomes 70-80 degrees with a Brix scale before distillation, thereby the flavor improving agent of the present invention can have an effect of adding an agreeable natural flavor of brown sugar on foods compared to the conventional flavor improving agent produced by simply distilling and purifying concentrated sugar cane juice without heating and concentrating the juice which can bring such high sugar content. This comparison is clearly shown in Examples X-X and Comparative examples Y-Y in the present description.

First, the description “an agreeable and natural flavor” cannot be expressed quantitatively such as in the numerical range because it is an index relying on a subjective preference of people.

It is the common general knowledge at the time of the filing of the present application that a flavor improving agent derived from a natural product such as sugar cane juice is a composition containing various different chemical substances, and the flavor becomes different from an interaction of the each chemical substance. The flavor improving agent of the present invention and the conventional flavor improving agent as described above have 99.99 wt% of the same composition, as described in Table X in the present description. From this fact, it is apparent that very small amount of a component (a trace component) contributes to giving a good effect of the flavor improving agent of the present invention as described above. However, there are a very large number of such components which constitute the flavor improving agent of the present invention, and some of those components are less than the detection limit of analytical instruments.

Therefore, it is impossible to analyze and specify which chemical substance in trace components contributes to giving an effect of adding a good flavor among a very large number of trace components constituting the flavor improving agent of the present invention. This is because there are a large number of types of chemical substances contained in the analysis objects and the components less than the detection limit cannot be analyzed.

Assuming that an analyzer which has a quite low detection limit of concentration is used and thereby the trace components constituting the flavor improving agent can be all specified, a chemical substance which generates “an agreeable and natural flavor” of the present invention cannot be specified just by identifying a flavor of each trace component because a flavor in the

flavor improving agent is generated by blending flavors of a plurality of chemical substances. Therefore, in order to specify the chemical substance, it is required to try all the combination of all chemical substances constituting the flavor improving agent of the present invention including a large number of trace components and to identify the flavor generated by each combination one by one, which needs an enormous number of trials. In addition, for these trials, a large number of all trace components should be purified until they reach to a high purity respectively since an influence of a chemical substance other than a chemical substance used for a trial should be completely eliminated.

In conclusion, it would have to be said for “a flavor improving agent” of claim 1 of the present invention that it is utterly impractical to specify “a flavor improving agent” directly by its structure or property, by means of clearly specifying component(s) contributing to the effect of the present invention.

**In Example 4 as described above, the written opinion concretely explains that it is impossible or impractical to specify the product directly by its structure or property since the product is derived from a natural product. Therefore, the present example is deemed to be the case where “impossible or impractical circumstances” exist.**

#### **Example 5**

##### **(1) Claim**

[Claim 1] A polymerized composition prepared by the steps of:

reacting preliminarily a compound having three or more mercapto groups in one molecule and a compound having two or more isocyanate groups in one molecule for 5 to 10 minutes at the temperature of 40-50 degrees Celsius; and then

reacting a reaction solution containing the oligomer obtained by the reaction described above, a compound having two mercapto groups in one molecule and ...

##### **(2) Arguments and verification regarding “impossible or impractical circumstances” presented by the applicant in a written opinion**

... A polymerized composition defined in claim 1 comprises a compound having three or more mercapto groups in one molecule as a raw material, and further comprises an oligomer obtained under the reaction condition that the compound is preliminary reacted at the temperature of 40-50 degrees Celsius for 5-10 minutes. Therefore, a structure of the resulting polymerized composition becomes absolutely too complicated to express by a general formula (a structural formula), which

is the common general knowledge for a person skilled in the art. It is also impossible to express the polymerized composition by the property because a property of a substance cannot be easily understood until a structure thereof is specified, as the property can be determined accordingly, and also because a property of a resulting polymerized composition obtained by a reaction of multiple different kinds of monomers varies depending on a compounding ratio of monomers or a reaction condition. Namely, a polymerized composition defined in claim 1 of the present invention cannot be specified directly by the structure or property of the product, but can be specified only by a process (manufacturing process) for preparation of the product.

Therefore, the invention of the polymerized composition defined in claim 1 is deemed to be the case where impossible or utterly impractical circumstances to “specify the product directly by its structure or property at the time of the filing of an application” exist.

**In Example 5 as described above, the written opinion concretely explains that it is impossible or impractical to specify the product directly by its structure or property since the product is a polymer having complicated and a wide variety of structures. Therefore, the present example is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.**

## 2299 Miscellaneous

Regarding matters in the left column of the lower table, see the referenced location in the right column.

	Referenced Location
Handling when "(deleted)" is described for a claim by way of an amendment at the international phase	"8003 Handling in Cases Where Amendment of "Deletion" of Claims is Indicated at an International Phase" of "Part VIII International Patent Application"

## Chapter 3 Unity of Invention (Patent Act Article 37)

## 2301 Regarding Procedure for Determining Subject of Examination on the Basis of Special Technical Features When a Plurality of Invention Groups Containing the Original Invention Exist

The following case example is provided for describing the procedure for decision of the subject of examination in a case where two or more technical features that may serve as the special technical feature are found in one single invention for which the presence or absence of the special technical feature is to be determined, in the context of "4.1 Decision of subject of the examination based on special technical features"<sup>6</sup> in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines<sup>7</sup>.

## Case Study:

Claim 1:  $X + Y$

Claim 2:  $X + \alpha$

Claim 3:  $Y + \beta$

In the above case, the same "technical feature X" is found in both the invention according to claim 1 " $X + Y$ " and the invention according to claim 2 " $X + \alpha$ " and the same "technical feature Y" is found in both the invention according to claim 1 " $X + Y$ " and the invention according to claim 3 " $Y + \beta$ ."

Suppose that the descriptions, etc. state that the "technical feature X" and the "technical feature Y" are both novel, both of them may apparently be found to be "the special technical feature," and at least either of them is subsequently proved to be in fact "the special technical feature."

In such a case, the Examiner first selects the technical feature (for example, X), which is likely to achieve contributions over the prior art with regard to the first invention (the invention according to claim 1). Further, the Examiner identifies the other invention (claim 2:  $X + \alpha$ ), which is associated in terms of the technical feature (X) with the invention according to claim 1 ( $X + Y$ ), as the subject of examination. If it has been found, after examination is started for the invention first identified as the subject of

<sup>6</sup> See (Note 5) of 4.1(4) in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines.

<sup>7</sup> This example is similar to case 16 of "2. Case Studies related to Unity of Invention" of Attached Document A.

examination, that the technical feature X does not constitute the special technical feature, then the subject of examination is changed to the invention (claim 3:  $Y + \beta$ ) associated in terms of the other technical feature (Y) with the invention according to claim 1 ( $X + Y$ ).<sup>8</sup>

(Points to Note)

If, in a case where two or more technical features that may serve as the special technical feature are found in one single invention for which the presence or absence of the special technical feature is to be determined, selection of a certain technical feature results in the existence of any claimed invention that is not identified as the subject of examination and selection of the other technical feature ensures that all of the claimed inventions are identified as the subject of examination, then the latter technical feature is to be selected in preference to the former technical feature.

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<sup>8</sup> In this case, the invention of claim 2 is not treated as the "invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining inventions that were identified as the subject of the examination based on their special technical features" on the ground that the examination for the invention of claim 2 has been already started.

## 2302 Regarding "An Invention for Which an Examination may be Made without Substantially Conducting Additional Prior Art Searches and Making a Determination as a Result of Examining Inventions that is Decided the Subject of the Examination"

Section 4.2(2) in "Part II Chapter 3 Unity of Invention" of Examination Guidelines states to add to the subject of examination "An invention for which an examination may be made without substantially conducting additional prior art searches and making a determination as a result of examining inventions<sup>9</sup> that is decided the subject of the examination based on 4.1 and 4.2(1)" (hereinafter, "inventions for which examination has substantially completed") as inventions for which it is efficient to perform examination together with inventions treated as subjects of examination on the basis of 4.1 and 4.2(1).

Therefore, regarding "an invention for which examination has substantially completed," a description is provided below.

### 1. Basic idea

Whether or not it is possible to perform examination without requiring a substantially additional prior art searches and making a determination (whether an examination has substantially completed) is determined, in accordance with the technical field to which an application belongs, for each case, in consideration of the substantial effort required for searches for prior art, and determination of description requirements or patent requirements, that shall additionally be performed.

### 2. Regarding examples corresponding to "inventions for which examination has substantially completed"

In Section 4.2(2) in "Part II Chapter 3 Unity of Invention" of Examination Guidelines, inventions corresponding to the following (i) through (v) are, normally, treated as "inventions for which examination has substantially been completed." For

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<sup>9</sup> Inventions that are deemed to be examined at "4.1 Decision of subject of the examination based on special technical features " and "(1) Claimed inventions in the same category that include all matters specifying the invention of the invention first claimed in the claims" of "4.2 Decision of subject of the examination based on examination efficiency" in "Part II Chapter 3 Unity of Invention" of the Examination Guidelines,

inventions corresponding to these, if examination regarding an invention treated as a subject of examination on the basis of 4.1 and 4.2(1) is performed, normally, it can be concluded that examination (novelty, inventive step, etc.) regarding the relationship with prior art has been substantially completed, and therefore, if examination (description requirements, etc.) for other than the relationship with the prior art has also been substantially completed, then it can be concluded to be "an invention for which examination has substantially completed." Moreover, if the examination (description requirements, etc.) for other than the relationship with the prior art regarding the invention to be a subject of examination is performed on the basis of 4.1 and 4.2(1), then regarding the inventions corresponding to the following (i) through (v) as well, examination (description requirements, etc.) of other than the relationship with the prior art can usually be treated as having been substantially completed.

(i) Other inventions that differ only in terms of expression from inventions that is decided the subject of the examination based on 4.1 and 4.2(1)

"Other inventions that differ only in terms of expression from inventions that were identified as the subject of the examination based on the 4.1 and 4.2(1)" includes not only "other inventions that differ only in terms of category expression with respect to the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)," but also inventions that pertain to the same category and only differ in their expression with respect to the invention identified as the subject of examination on the basis of 4.1 and 4.2(1).

For example, the invention according to claim 7 of Case 28 in the Attached Document A "2. Case Studies related to Unity of Invention" is the other invention that pertains to the same category and only differs in their expression with respect to the invention according to claim 1.

(ii) Other inventions which added, deleted or replaced well-known or commonly used art with respect to inventions that is decided the subject of the examination based on 4.1 and 4.2(1), which do not produce any new effects

For example, the invention according to claim 4 in Case 28 and the portions referring to claim 1 of the inventions according to claims 3, 4 in Case 26 of the Attached Document A, "2. Case Studies related Unity of Invention" are other inventions which added, deleted or replaced well-known or commonly used art with respect to the

invention according to claim 1, and do not produce any new effects.

(iii) Other inventions whose difference from inventions that is decided the subject of the examination based on 4.1 and 4.2(1) is a "designs modified along specific application of techniques" or "optimally or preferably modified numerical ranges" and it is easily determined said change does not produce any advantageous effects in comparison with the prior art

For example, if it has been found that "the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)" does not have novelty or involve an inventive step over the prior art, and if it is readily determined that the invention whose difference from "the invention identified as the subject of examination on the basis of 4.1 and 4.2(1)" is a "modification of design in applying specific techniques" or "optimization or suitable reduction of numerical ranges" which does not produce any advantageous effects in comparison with the prior art, then the result of examination to the effect that the invention does not involve an inventive step can be obtained substantially without the need of additional prior art searches and making a determination. Accordingly, it can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) is substantially completed for the invention.

(iv) In cases where it has been found that an invention has no novelty or inventive step as a result of examining inventions that is decided the subject of the examination based on 4.1 and 4.2(1), other inventions which have wider concept that covers said invention

When it has been found that an invention does not have novelty or involve an inventive step as a result of examining invention "X + Y" that was identified as the subject of the examination based on 4.1 and 4.2(1), the result of examination to the effect that the invention "X" that has a wider concept covering the invention does not have novelty or involve an inventive step will be usually obtained on the basis of this result of examination substantially without the need of additional prior art searches and making a determination. It can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) has been substantially completed for the invention "X."

(v) In cases where a point having some matters specifying the invention has been found out to have novelty and inventive step as a result of examining inventions that is decided the subject of the examination based on 4.1 and 4.2(1), other inventions that include said

matters specifying the invention

Example:

Claim 1: A bicycle comprising a structure A and a structure B

(\* The claimed invention has the special technical feature of "a bicycle comprising a structure A and a structure B.")

Claim 2: A bicycle comprising a structure A, a structure B, and a structure C.

Claim 3: A bicycle comprising a structure A and a structure C.

(Explanation)

The special technical feature of "bicycle comprising a structure A and structure B" is found in the invention according to claim 1. Moreover, suppose that Document 1 describes "a bicycle comprising a structure A" and Document 2 describes "a bicycle comprising a structure B," and inventive step of the invention according to claim 1 has been denied based on the combination of Document 1 and Document 2.

Subsequently, it has been found as a result of examination of the invention according to claim 2 having this special technical feature that the novelty or inventive step consists in the fact that the invention has the matters defining the invention of "a bicycle comprising a structure C." In this case, the result of examination to the effect that the invention of claim 3 has novelty or inventive step will be obtained substantially without the need of additional prior art searches and making a determinations. Accordingly, it can be said that the examination regarding the relationship with prior art (novelty, inventive step, etc.) has been substantially completed for the invention according to claim 3.