

Examination Guidelines on
Requirement for Disclosure of Information on Prior Art Documents

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Part I Specification
Chapter 3 Requirement for Disclosure of Information on Prior Art Documents

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Part I Specification

Chapter 3 Requirement for Disclosure of Information on Prior Art Documents

(Applicable to patent applications filed on or after September 1, 2002)

1. Section 36(4)(ii) of the Patent Law

Section 36(4)(ii) of the Patent Law

The detailed description of the invention under paragraph (iii) of the preceding Subsection shall comply with the following:

(i) [Omitted]

(ii) Where a person desiring a patent knows, at the time of filing a patent application, any inventions publicly known through documents (inventions referred to in Section 29(1)(iii); the same meaning shall apply thereunder in this paragraph) which are related to the invention, the detailed description of the invention shall contain the source of information on the invention publicly known through a document such as the title of a publication in which the invention publicly known through a document is described.

Section 48*septies* of the Patent Law

The examiner may, if he/she judges that a patent application fails to satisfy the requirement provided in Section 36(4)(ii), notify the applicant to that effect and give the applicant an opportunity to submit a written argument, designating an adequate time limit.

Section 49(v)

The examiner shall make a decision that a patent application is to be refused where it falls under any of the following paragraphs:

(i) - (iv) [Omitted]

(v) when a notice under the preceding Section was made, and the patent application still fails to satisfy the requirement provided in Section 36(4)(ii), despite the amendment of the specification or the submission of the written argument.

(vi) - (vii) [Omitted]

2. Purport of Requirement for Disclosure of Information on Prior Art Documents

(1) Section 36(4)(ii) of the Patent Law provides that where a person desiring a patent

(applicant for patent) knows, at the time of filing a patent application, any inventions publicly made known through documents (inventions referred to in Section 29(1)(iii)) which are related to the invention for which a patent is sought, the detailed description of the invention shall contain the source of information on the invention publicly known through a document such as the title of a publication in which the invention publicly known through a document is described (hereinafter referred to as “information on prior art documents”) (“requirement for disclosure of information on prior art documents”).

Information on prior art documents is necessary to understand the technical significance that the invention for which a patent is sought has and the technical contribution that the invention has made in comparison with the technical level as of the filing of the patent application, and to determine whether the invention is patentable, e.g. novelty and inventive step. Accordingly, if information on prior art documents is indicated by the applicant in the detailed description of the invention, it will contribute not only to prompt examination but also to stability of a patent right due to precise evaluation on the relationship between the invention for which a patent is sought and prior arts.

Under the system for disclosure of information on prior art documents, the examiner may give notice under Section 48*septies* if he/she considers that the patent application fails to satisfy the requirement for disclosure of information on prior art documents. If the requirement remains unsatisfied despite the notice, it would be a reasons for refusal of the application (Section 49(v)), but not a reason for opposition (Section 113) or invalidation (Section 123(1)). This system is primarily designed to achieve prompt examination process. Failure of a patent application to satisfy the requirement dose not mean that the invention described in the application is substantially defective, and even if the invention is patented as it is, it would not directly harm the benefit of any third party seriously.

(2) Section 48*septies* of the Patent Law provides that the examiner may, if he/she judges that a patent application fails to satisfy the requirement for disclosure of information on prior art documents, notify the applicant to that effect. Thus notice under Section 48*septies* is not issued on every case but is given only when the examiner considers it necessary.

If failure of a patent application to satisfy the requirement for disclosure of information on prior art documents immediately constituted a reasons for refusal of the application, such reasons for refusal would have to be notified without exception to all applications that failed to satisfy these requirement. In this case, a reasons for refusal for not satisfying these requirement should inevitably be notified to patent applications that have no other reasons for refusal with respect to other requirement, which would be against

the purpose of this system which is primarily designed to achieve prompt examination process. Furthermore, if a reasons for refusal for not satisfying these requirement should inevitably be notified to an applicant who is an individual or a small or medium-sized company, despite the possibility that the applicant had, at the time of filing the application, no information on prior art documents which were related to the invention for which a patent was sought, it would not only fail to contribute to prompt examination process but also impose excessive burden on such applicant.

Accordingly, from the perspective of encouraging applicants to cooperate in achieving prompt examination process through disclosure of information on prior art documents, it is appropriate to operate the system in a manner that prompt examination process will be achieved under the overall system, rather than to apply it to all applications without exception.

(3) Section 49(v) of the Patent Law provides that if the patent application still fails to satisfy the requirement despite a notice that a patent application fails to satisfy the requirement for disclosure of information on prior art documents (Section 48septies), it shall be a reasons for refusal of the application.

3. Information on Prior Art Documents To Be Disclosed

3.1 Invention For Which Information on Prior Art Documents Is To Be Disclosed

An applicant for patent shall indicate information on prior art documents in the detailed description of the invention with respect to inventions falling under the following conditions (1) to (4).

(1) Inventions publicly known through documents

“Inventions publicly known through documents” provided in Section 36(4)(ii) of the Patent Law refers to inventions which were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the patent application (Section 29(1)(iii)), excluding inventions which were publicly known (Section 29(1)(i)) and inventions which were publicly worked (Section 29(1)(ii)).

According to the purports of Section 29(1)(iii), Section 29(2) and Section 36(4)(ii), it is appropriate to understand that information on the source should be described with respect to any inventions which are related to the invention for which a patent is sought,

even if such related inventions do not constitute “inventions” provided as creation of technical ideas by which a law of nature is utilized (Section 2) in a strict sense. For example, in the case of an invention for which a patent is sought being a business method-related invention, if the applicant knows any business method which is related to the invention and is publicly known through a document, the applicant should indicate the title of the publication in which the related business method is described.

An invention which was described in a prior application but was not disclosed at the time of filing a patent application is not subject to the requirement for disclosure of information on prior art documents because it is not an invention publicly known through a document. However, if such an invention is related to the invention for which a patent is sought, it is desirable for the applicant to indicate the application number of the prior application.

(2) Inventions which are related to the invention for which a patent is sought

Section 36(4)(ii) stipulates “any inventions publicly known through documents (.....) which are related to the invention.” “The invention” means “the invention for which a patent is sought” or “the claimed invention.” Consequently, if the claimed invention has related inventions publicly known through documents, the applicant should indicate information on prior art documents for the invention claimed in all the claims, and the applicant would not be deemed to have satisfied the requirement for disclosure of information on prior art documents if he/she has only indicated information on prior art documents for the invention claimed in part of the claims.

A determination of whether any invention publicly known through a document is “related” to the invention for which a patent is sought shall be made taking into consideration the following (i) to (iii).

- (i) the relevance of the technical fields of the invention for which a patent is sought and the invention publicly known through documents
- (ii) the relevance of the problems to be solved of the invention for which a patent is sought and the invention publicly known through documents
- (iii) the relevance of the matters defining the invention of the invention for which a patent is sought and the invention publicly known through documents

If the invention for which a patent is sought is directly derived from the invention publicly known through documents (e.g. the invention described in the preamble to a two-part claim), such inventions usually belong to the same technical fields and share common matters defining the invention, and thus the invention publicly known through

documents shall be included in inventions which are related to the invention for which a patent is sought.

Where there is only small amount of accumulated technology which is related to the invention for which a patent is sought and there is no invention which is directly related to the invention for the reason of the same technical field and same problem to be solved, inventions which indicate a general technical level as technical background of the invention for which a patent is sought shall be included in inventions which are related to the invention for which a patent is sought.

The following are concrete examples of inventions publicly known through documents which are related to the invention for which is a patent is sought.

Example 1:

The invention for which a patent is sought relates to “a cellular phone having a housing made of specific magnesium alloy” while the invention publicly known through a document relates to “a cellular phone having a housing made of titanium alloy”; both inventions have the same problem to be solved that is making a lighter cellular phone.

Example 2:

The invention for which a patent is sought relates to “a rear light made of specific acrylic resin composition which has great heat-resistance” while the invention publicly known through a document relates to “a rear light made of another acrylic resin composition which has great shock-resistance,” and the specific acrylic resin composition used for the rear light in the invention for which a patent is sought and the another acrylic resin composition used for the rear light in the invention publicly known through a document are more similar to each other in composition than any other acrylic resin composition used for the rear lights which the applicant knows.

Example 3:

The invention for which a patent is sought relates to “a refrigerator of a door having hinges of specific structures which can be opened and closed both from the right side and the left side” while the invention publicly known through a document relates to “a microwave oven of a door having hinges of another structures which can be opened and closed both from the right side and the left side”, and the hinges of the door of a refrigerator in the invention for which a patent is sought and the hinges of the door of a microwave oven in the invention publicly known through a document have more similar structures to each other than any other hinges which the applicant knows.

(3) Inventions which a person desiring a patent knows

Section 36(4)(ii) stipulates "...a person desiring a patent knows..." Inventions which a person desiring a patent (applicant for patent) "knows" include:

- ① Inventions which the applicant has obtained in the prior art research conducted at the stages of research and development or filing of the patent application for the invention for which a patent is sought;
- ② Inventions described in papers or works which were published by the applicant before the filing of the application; and
- ③ Inventions described in the specification or drawings of prior applications filed by the applicant.

As the applicant generally seems to grasp the information which the inventor knows concerning the invention for which a patent is sought, the applicant is presumed to know the inventions which the inventor knows.

In the case of two or more applicants concerned, "a person desiring a patent knows" does not only refer to the case where all the applicants know the related inventions; it would suffice if at least one of the applicants knows the related inventions.

(4) Inventions which a person desiring a patent knows at the time of filing a patent application

Section 36(4)(ii) stipulates "a person desiring a patent knows, at the time of filing a patent application." The applicant who knows, "at the time of filing a patent application", any inventions publicly known through documents should indicate information on prior art documents concerning the inventions.

Section 36(4)(ii) shall not require an applicant who knows, at the time of filing a patent application, no invention publicly known through a document to conduct additional prior art research.

Section 36(4)(ii) shall not require an applicant to include, in the detailed description of the invention through amendment, information on any invention publicly known through a document which he/she has come to know after filing a patent application. However, if the applicant considers that such invention publicly known through a document which he/she has come to know after filing the application would be helpful for prompt and precise examination, it is desirable for the applicant to add information on prior art

documents for such invention through amendment or present it in the written statement.

With respect to any of the applications indicated in the left column below, if the applicant knows any invention publicly known through a document at the corresponding times indicated in the right column, the applicant should indicate relevant information on prior art documents. Where a divisional application or converted application fails to satisfy the requirement for division or conversion and it is deemed to have been filed as a new patent application, inventions publicly known through documents at the time of filing which the applicant knew are those at the time of filing the new application under this provision.

Types of applications	Times of “filing a patent application”
Divisional application or converted application	Time of filing the original application
Application containing a domestic priority claim	Time of filing the application (later application)
Application containing a priority claim under the Paris Convention	Time of filing the application (application in Japan)
International patent application	Time of filing the international patent application

3.2 Indication of Information on Prior Art Documents in the Initial Specification

(1) Indication of information on prior art documents

“The source of information on the invention publicly known through a document such as the title of a publication in which the invention publicly known through a document is described” stipulated in Section 36(4)(ii) refers to bibliographic data on technical information and other information which can be obtained from a publication in which the invention publicly known through a document is described or through electric telecommunication lines. Accordingly, it is sufficient for the applicant to indicate bibliographic data on the publication, etc. in which the invention publicly known through a document is described, without necessity of submitting the original or duplicate copy of the publication. If it is difficult to obtain the publication, etc., the examiner may give notice under the provision of Section 194(1) (submission of documents, etc.) and require the applicant, etc. concerned to submit documents or other evidence necessary for the examination.

As Section 36(4)(ii) provides for the description requirement for the specification, information on prior art documents should be indicated in the detailed description of the invention in the specification. The requirement for disclosure of information on prior art documents may not be satisfied by submitting a written argument or written statement containing the information on prior art documents.

If it is possible to identify the location at which the relevant inventions publicly known through documents are described in the publication, it should be identified by indicating the page number, line number, paragraph number, or figure number in the section in which information on prior art documents is to be indicated. Information on prior art documents shall be indicated according to the “(Reference) How to Indicate Information on Prior Art Documents in the Specification (This Reference is omitted in this English version.)” attached to the end of this chapter.

(2) Where there is a lot of information on prior art documents

Where there are a lot of inventions publicly known through documents which are related to the invention for which a patent is sought, if information on all such inventions is indicated in the specification, it would make it difficult on the contrary to understand the invention for which a patent is sought, which is against the purport of the system for disclosure of information on prior art documents. Therefore, it is desirable to indicate information on an appropriate number of inventions publicly known through documents which are more relevant to the invention for which a patent is sought. Furthermore, it should not be to indicate inventions publicly known through documents which are not related to the invention for which a patent is sought.

(3) Where there is no information on prior art documents to be indicated

If there is no information on prior art documents to be indicated at the time of filing a patent application, it is desirable to indicate to that effect in the detailed description of the invention, stating the reason. For example, if prior arts which the applicant knows are not inventions publicly known through documents, he/she shall indicate to that effect. Furthermore, the applicant may produce to that effect that there is no information on prior art documents to be indicated and the reason of that by a written statement.

3.3 Addition of Information on Prior Art Documents through Amendment

(1) Amendment to add information on prior art documents

The amendment to add information on prior art documents to the specification shall not constitute addition of new matters.

On the other hand, the amendment to add to the specification or drawings the

contents of inventions publicly known through documents according to information on prior art documents shall constitute addition of new matters and therefore shall not be allowable.

For more detailed information, see “Part III Amendment of Specification and Drawings; Chapter 1, 4.2 (3) Addition of the prior art document”, “Part III Amendment of Specification and Drawings; Chapter 1, 6 (2) Amendment of the specification with quotations from a literature” and “Example 52 for determination on new matters.”

(2) Where it is necessary to add information on prior art documents through amendment

Where a claimed invention fails to correspond to information on prior art documents which is indicated in the specification by amending the scope of claim and the applicant knew, at the time of filing the application, any invention publicly known through a document which was related to the claimed invention, the applicant shall add through amendment information on prior art documents concerning the invention publicly known through a document.

4. Determination on Requirement for Disclosure of Information on Prior Art Documents

The examiner makes a determination on whether the requirement for disclosure of information on prior art documents provided in Section 36(4)(ii) is satisfied, considering whether information on prior art documents which are related to the invention for which a patent is sought is properly indicated in the detailed description of the invention.

The examiner may give notice under Section 48*septies* in the following typical cases on the ground that the requirement for disclosure of information on prior art documents is not satisfied.

(1) Where information on prior art documents is not indicated without any reason.

(2) Where information on prior art documents is not indicated and it seems highly likely that the applicant knew, at the time of filing the application, inventions publicly known through documents which were related to the invention for which a patent was sought, though the reason for not indicating the information is described.

Example:

Where information on prior art documents is not indicated and the reason that the

applicant only knows prior arts which do not fall within inventions publicly known through documents is described, although the applicant have filed a number of patent applications in the technical field which relates to the invention for which a patent is sought.

(3) Where prior arts are indicated in the specification or drawings of the application for patent but information on prior art documents corresponding to the prior arts is not indicated without any reason.

(Note: Inventions indicated as prior arts in the specification or drawings of the application for patent shall be treated as inventions which the person desiring a patent knows at the time of filing the application.)

(4) Where information on prior art documents is indicated only with respect to inventions publicly known through documents which are not related to the invention for which a patent is sought, and it seems highly likely that the applicant knew, at the time of filing the application, inventions publicly known through documents which were related to the invention for which a patent was sought.

Example 1:

Where information on prior art documents is indicated only with respect to inventions of which the technical field or the problem to be solved is different from the invention for which a patent is sought and which are not related to the invention for which a patent is sought, although inventions publicly known through documents of which the technical field and the problem to be solved are the same as those of the invention for which a patent is sought are widely known to the public.

Example 2:

Where information on prior art documents is indicated with respect to old inventions which are hardly related to the invention for which a patent is sought, although new inventions publicly known through documents which are more relevant to the invention for which a patent is sought are widely known to the public.

5. Procedure of Examination

(For the interim operation of the system, see “(Exhibit) Interim Operation of the System for Disclosure of Information on Prior Art Documents.”)

5.1 Notice under Section 48*septies*

(1) Notice under Section 48*septies*

The examiner may, if he/she judges that a patent application fails to satisfy the requirement for disclosure of information on prior art documents provided in Section 36(4)(ii), notify the applicant to that effect.

As the notice under Section 48*septies* is basically made in order to obtain information on prior art documents which is useful for the examination, it is appropriate that the notice is made before the first notice of reasons for refusal of the application. Although the notice under Section 48*septies* and the notice of reasons for refusal, which does not cite the invention publicly known through documents described in information on prior art documents, may be made simultaneously, that is inappropriate since the former is basically made in order to obtain information on prior art documents which is useful for the examination in advance.

For example, if prior arts are described in the specification and drawings of the application for which a patent is sought without information on prior art documents concerning the prior arts and if the examiner considers that the information on prior art documents is necessary for determination on novelty or inventive step, etc., he/she may give notice under Section 48*septies* and the first notice of reasons for refusal simultaneously or notice under Section 48*septies* after the first notice of reasons for refusal.

Where the description in a patent application is so unclear that it is difficult to carry out examination on the requirement for patentability such as novelty or inventive step for the invention for which a patent is sought, the examiner may also give notice under Section 48*septies* concurrently with a notice of reasons for refusal of the application only concerning the description requirement for the specification.

It should be noted that where, after notice under Section 48*septies* and notice of reasons for refusal were given simultaneously, another notice of reasons for refusal is given concerning the requirement for disclosure of information on prior art documents, the later notice shall be the first notice of reasons for refusal because the reasons for refusal concerning the requirement for disclosure of information on prior art documents is a new reasons for refusal, except falling under "Part IX Procedure of Examination 5.2.1 Cases where a Final Notice of Reasons for Refusal should be notified."

Upon giving notice under Section 48*septies*, the examiner shall concretely state the reason for such determination as (1) to (4) of "4. Determination on Requirement for Disclosure of Information on Prior Art Documents" of this chapter, and identify claims if he/she judges a part of claims as failing to satisfy the requirement for disclosure of information on prior art documents.

(Note) The time limit for response under Section 48*septies* is 60 days for residents abroad and 30 days for others (when notice under Section 48*septies* accompanies notice of reasons for refusal, 3 months for residents abroad and 60 days for others). This time limit cannot be extended by request.

(2) Response to the Notice under Section 48*septies*

In response to the notice under Section 48*septies*, the applicant may add information on prior art documents through amendment or submit a written argument that he/she has no knowledge of relevant inventions publicly known through documents. Upon making amendment to add information on prior art documents, it is desirable that the applicant submits a written argument explaining the contents of inventions publicly known through documents as well as the identicalness and difference between the invention for which a patent is sought and the inventions publicly known through documents. The amendment to add the contents of inventions publicly known through documents to the specification or drawings shall constitute addition of new matters and therefore shall not be allowable. (See 3.3 (1) of this chapter)

Where the examiner becomes convinced that the requirement for disclosure of information on prior art documents is satisfied by these submitted written amendment or argument, the examiner proceeds to the examination process on prior art research or other requirements.

On the other hand, in the case where the written amendment or argument does not change the examiner's conviction that the requirement for disclosure of information on prior art documents is not satisfied, such as (i) where information on prior art documents remains undisclosed and the written argument fails to give reasonable explanation that there is no invention publicly known through a document which he/she knows, or (ii) where disclosure of information on prior art documents through the amendment is not sufficient, the examiner shall, according to the provision under the next Subsection 5.2, notify a reasons for refusal for not satisfying the requirement for disclosure of information on prior art documents.

5.2 Notice of Reasons for Refusal for Not Satisfying Requirement for Disclosure of Information on Prior Art Documents

Where a notice under Section 48*septies* made, and the patent application still fails to satisfy the requirement provided in Section 36(4)(ii) despite the submission of the written

amendment or argument, the examiner shall give a notice of reasons for refusal for not satisfying the requirement for disclosure of information on prior art documents. (Section 49(v))

Section 49(v) provides for the case where the patent application still fails to satisfy the requirement for disclosure of information on prior art documents despite a notice under Section 48setpties; therefore, a notice of reasons for refusal for not satisfying the requirement for disclosure of information on prior art documents shall not be given before a notice under Section 48septies is given.

(1) Notice of Reasons for Refusal

Upon notifying a reasons for refusal for not satisfying the requirement for disclosure of information on prior art documents provide in Section 36(4)(ii), the examiner shall concretely state the reason for such determination as (1) to (4) of “4. Determination on Requirement for Disclosure of Information on Prior Art Documents” of this chapter, and identify claims if he/she judges a part of claims as failing to satisfy the requirement.

Upon notifying a reasons for refusal for not satisfying the requirement for disclosure of information on prior art documents, without carrying out the examination on patentability such as novelty and inventive step, the examiner shall describe in the notice to that effect.

(3) Response to Notice of Reasons for Refusal

In response to the notice of reasons for refusal, the applicant may add information on prior art documents through amendment or submit a written argument that he/she has no knowledge of relevant inventions publicly known through documents. Upon making amendment to add information on prior art documents, it is desirable that the applicant submits a written argument explaining the contents of inventions publicly known through documents as well as the identicalness and difference between the invention for which a patent is sought and the inventions publicly known through documents. The amendment to add the contents of inventions publicly known through documents to the specification or drawings shall constitute addition of new matters and therefore shall not be allowable. (See 3.3 (1) of this chapter)

Where the examiner becomes convinced that the requirement for disclosure of information on prior art documents is satisfied by these submitted written amendment or argument, the reason for refusal shall be deemed overcome.

On the other hand, in the case where the written amendment or argument does not change the examiner's conviction that the requirement for disclosure of information on prior art documents is not satisfied, such as (1) where information on prior art documents remains undisclosed and the written argument fails to give reasonable explanation that there is no invention publicly known through a document which he/she knows, or (2) where disclosure of information on prior art documents through the amendment is not sufficient, the examiner shall make a decision of refusal for such reason.

(Exhibit) Interim Operation of the System for Disclosure of Information on Prior Art Documents

This system provides that failing to satisfy the requirement for disclosure of information on prior art immediately becomes a reason for refusal, but that the examiner may give a notice for not satisfying the requirement if he/she considers that the requirement is not satisfied. Also, It is the most important that prompt examination is achieved as a whole by promoting this system at the beginning.

From the above perspective, during a certain period after the system for disclosure of information on prior art documents is introduced, the examiner shall operate the system in the following manner if he/she considers that a patent application fails to satisfy the requirement for disclosure of information on prior art documents.

1. Treatment of patent applications which fail to satisfy the requirement for disclosure of information on prior art documents

In principle, the examiner shall not give notice under Section 48*septies* even if he/she considers that a patent application fails to satisfy the requirement for disclosure of information on prior art documents, but shall only indicate in an additional statement that the requirement for disclosure of information on prior art documents is not satisfied when notifying first reasons for refusal concerning other requirements with respect to such patent applications which he/she considers as failing to satisfy the requirement for disclosure of information on prior art documents. The additional statement shall not constitute the notice under Section 48*septies*.

However, in the case of a patent application which contains the contents of a prior art in the detailed description of the invention but does not contain information on prior art documents corresponding to the prior art, the examiner may give notice under Section 48*septies* if information on prior art documents is still necessary for making final determination on patentability such as novelty or involvement of an inventive step even though the prior art research has been conducted. In this case, the examiner may give notice under Section 48*septies* and notice of reasons for refusal simultaneously if there is any other reason for refusal.

2. Treatment of patent applications filed by an applicant who has previously filed many patent applications which failed to satisfy the requirement for disclosure of information on prior art documents

When it is considered that an applicant previously filed many patent applications which failed to satisfy the requirement for disclosure of information on prior art documents based on the fact that the applicant received many notices of reasons for refusal indicated in an additional statement that the requirement for disclosure of information on prior art documents were not satisfied, the examiner shall, if he/she considers that any patent application which was filed by the applicant and has later entered the examination process fails to satisfy the requirement for disclosure of information on prior art documents, give notice under Section 48*septies* prior to the first notice of reasons for refusal for the application.