

Questions and Answers regarding the Examination Guidelines on the Requirement for Disclosure of Information on Prior Art Documents and Major Changes to the Guidelines

1. Questions and Answers regarding Examination Guidelines on the Requirement for Disclosure of Information on Prior Art Documents

- Prior art documents to be disclosed

[Question 1]

What are the main points of the system for disclosure of information on prior art documents?

[Answer]

As the numbers of patent applications and requests for examination have been increasing year by year, there has been a growing necessity for prompt examination. Under such circumstances, if it is possible to utilize, in the patent examination process, information on prior art documents such as the names of the documents obtained by applicants and inventors through prior art research, that they generally conduct, it will contribute to prompt and precise examinations. Furthermore, as a result of careful consideration of such information on prior art documents, a stronger patent right is expected to be granted. The system for disclosure of information on prior art documents has been established for these purposes. The main points of the system are as follows:

- (1) Where a person applying for a patent knows, at the time of filing a patent application, any prior art, the person must disclose information on the documents in which the art is described (“information on prior art documents”) in the patent specification;
- (2) Where an applicant fails to disclose information on prior art documents such as, the name of documents, in the patent specification, the examiner shall give notice provided in Section 48*septies* of the Patent Law to require the applicant to disclose the information, and where the information remains undisclosed despite the notice, this will be reason for refusal of the application. The examiner shall not give notice provided in Section 48*septies* without exception, but only when he/she considers it necessary; and
- (3) Failure to disclose the information shall not be a reason for opposition to or invalidation of a patent.

[Question 2]

What are the main points of the interim operation of the system for disclosure of information on prior art documents?

[Answer]

Aiming at disseminating the system for disclosure of information on prior art documents as soon as possible, the examiner shall, during a certain period after it is introduced, operate it in the following manner if he/she considers that a patent application fails to satisfy the requirements for disclosure of information on prior art documents.

(1) 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 requirements for disclosure of information on prior art documents, but shall only indicate in addition, when notifying reasons for refusal concerning other requirements, that the requirements for disclosure of information on prior art documents are not met (this additional indication shall not constitute the notice under Section 48*septies*.)

However, in the case of a patent application which contains the contents of prior art in the detailed description of the invention, but does not contain information on 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 determination on novelty or involvement of an inventive step.

(2) When it is considered that an applicant previously filed many patent applications, which failed to satisfy the requirements for disclosure of information on prior art documents based on the fact that the applicant received many notices of reason for refusal indicating in addition that the requirements 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 fails to satisfy the requirements for disclosure of information on prior art documents, give notice under Section 48*septies*.

[Question 3]

It is provided in the Examination Guidelines 3.1(2) “Inventions which are related to the invention for which a patent is sought” that “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 requirements 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.” Is it necessary to indicate information on prior art documents claim by claim? If information on prior art documents is indicated for an independent claim, is there no necessity to indicate information on the invention claimed in dependent claims?

[Answer]

“The invention for which a patent is sought” means “the claimed invention.” Therefore,

irrespective of whether claims are written in independent or dependent form, the applicant who has failed to indicate inventions publicly known through documents which are related to the invention claimed in each claim would not be deemed to have satisfied the requirement provided in Section 36(4)(ii).

However, this does not necessarily require an applicant to indicate information on prior art documents separately claim by claim; the requirements for disclosure of information on prior art documents may be satisfied even if the applicant only indicates information on prior art documents concerning inventions publicly known through documents which are related to the claims in common.

For example, where an invention claimed in a dependent form claim specifies, with a well-known art, the part of the constitution of the invention claimed in an underlying claim, which the dependent form claim depends on if information on prior art documents concerning inventions publicly known through documents that are related to the invention claimed in the underlying claim is properly disclosed, it is not necessary to disclose inventions publicly known through documents concerning the well-known art that is mentioned in the dependent form claim because these inventions are relatively less relevant.

On the other hand, where an invention claimed in a dependent form claim externally adds a new matter that specifies an invention claimed in a underlying claim which the dependent form claim depends on, and technical matters which are related to the new matter are contained in an invention publicly known through documents, it is necessary to indicate information on prior art documents concerning the invention publicly known through documents, because such an invention is more relevant to the invention claimed in the dependent form claim.

[Question 4]

It is provided in 3.1(3) “*Inventions which a person desiring a patent knows*” of the Examination Guidelines that, where different departments in a company make inventions and file patent applications designating the company as applicant, it is sometimes hard to know all prior applications filed by various departments in the company. In this case, would the company designated as applicant be deemed to “know” information on all applications filed by its own departments?

[Answer]

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

In the case where an applicant is a corporation, the applicant shall be deemed to know inventions that are related to the acts performed by the applicant in the past in the name of the corporation. These inventions include those claimed in patent applications that were filed in the past by the company as applicant, those obtained through prior art research that was conducted by employees of the company in the course of their duties, and those published by employees of the company in the name of the company in academic papers or other publications.

Consequently, a company as applicant of a patent application shall always be deemed to know inventions publicly known through documents that were claimed in prior patent applications filed in the name of the same applicant, even if the inventors who had made the inventions claimed in these prior applications belong to different departments in the company from the department to which the inventor for the present application belongs.

[Question 5]

It is provided in the Examination Guidelines 3.2(3) “Where there is no information on prior art documents to be indicated” that “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.” In this case, what should be stated as the “reason” and how should the validity of the “reason” be determined?

[Answer]

In stating the reason for the fact that there is no information on prior art documents to be indicated, it is appropriate to specifically explain the facts that there is no information on prior art documents which satisfy the requirements provided in the Examination Guidelines 3.1(1) to (4).

A typical reason stated is the fact that “prior arts which the applicant knows are not relevant to inventions publicly known through documents,” as shown in 3.2 (3) of the Examination Guidelines. More specifically, this reason applies to the case where the applicant has filed an application for the invention that was developed based upon publicly known or publicly used arts (e.g. an invention that improved an existing device) without conducting prior art research.

Under these Examination Guidelines, if there is no invention that is directly related to the invention for which a patent is sought, 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 (*see* Examination Guideline 3.1(2)). Accordingly, if the applicant has conducted any prior art research at the stages of research and development or filing of the patent application for the invention for which a patent is sought, it is rarely the case that there is no information on prior art documents to be indicated.

Where any reasons are stated for the fact that there is no information on prior art

documents to be indicated, the examiner shall determine the likeliness that the applicant knows any inventions publicly known through documents, which are related to the invention for which a patent is sought. (*see* Examination Guideline 4 (2)).

- **Determination on the Requirements for Disclosure of Information on Prior Art Documents**

[Question 6]

It is provided in the Examination Guidelines Chapter 3 4. “*Determination on the Requirement for Disclosure of Information on Prior Art Documents*” that “where 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”. How shall the likeliness be determined?

[Answer]

In the cases shown in Examination Guidelines 4(2) and (4), it seems highly likely that the applicant knew inventions publicly known through documents.

For example, the applicant is judged to be highly likely to have known such inventions in the following cases:

(1) Where it is obvious that the applicant has cited extremely old prior arts, though he/she has indicated information on prior art documents, such as the name of document, and the contents thereof (e.g. where a patent is sought for an invention concerning an automatic control device while a manual control device is cited as prior art);

(2) Where the applicant has indicated no information on prior art documents, such as the name of documents, though he/she has been continuously engaged in technical development in the field of the invention for which a patent is sought.

If the contents of prior arts are indicated in the specification or drawings of the application for a patent as well as in the claims in the expression of “...wherein...” but information on prior art documents which corresponds to the prior art (described in the claims in the expression of “...wherein...”) is not indicated without any reason, the application shall be deemed to fail to satisfy the requirements for disclosure of information on prior art documents.

- **Handling of International Patent Applications (DO Applications)**

[Question 7]

When an international patent application under the Patent Cooperation Treaty (PCT) enters into the national phase in Japan, should it be subject to the requirements for

disclosure of information on prior art documents?

[Answer]

An international patent application, which designates Japan as a designated State and has a valid international filing date, shall be deemed to be a domestic application. Consequently, such international patent applications that have been filed on and after the effective date of the amendment of the Patent Law concerning the requirements for disclosure of information on prior art documents (i.e. September 1, 2002) shall be subject to these requirements.

[Question 8]

Will it be consistent with the PCT to apply the requirements for disclosure of information on prior art documents to PCT applications?

[Answer]

Article 27(6) of the PCT provides “the national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.” Thus, the PCT secures the discretion to require applicants to disclose information on prior art documents as evidence necessary for determining the novelty or involvement of inventive steps of inventions.

In Germany, there is a statutory system for disclosure of information on prior art documents as in Japan, and it has not been considered to be against the provisions of the PCT.

[Question 9]

In the case of an international patent application, international search reports and international preliminary examination reports are prepared. In this case, if the applicant fails to indicate information on prior art documents, shall the examiner give notice under Section 48septies?

[Answer]

In the actual examination process, information on prior art documents is disclosed in most international patent applications. In addition, information on prior art documents searched by an international searching authority is generally indicated in the international search report. Accordingly, even though the applicant fails to disclose information on prior art documents, it is not very necessary in the examination process to require the applicant to disclose such information, and therefore it seems extremely rare that the examiner gives notice under Section 48septies.

However, such determination on the necessity of disclosure is made on a case-by-case basis and there may be cases where it is necessary to require applicants to disclose information on

prior arts documents even with respect to international patent applications. Therefore, no special measure shall be taken for operating the system, such as providing that notice under Section 48septies shall not be given to any international patent application without exception.

- **How to Indicate Information on Prior Art Documents in the Specification**

[Question 10]

In indicating information on prior art documents, is it necessary to comply with the Reference “How to Indicate Information on Prior Art Documents in the Specification” attached to the Examination Guidelines?

[Answer]

In indicating information on prior art documents, it is necessary to comply with Form 29 of Article 24 of the Regulations under the Patent Law that will come into force on September 1, 2002. In order to prepare a patent specification that is consistent and easy to understand, applicants are recommended to follow the matters mentioned in the Reference as best as they can, even with respect to matters other than those provided in the Regulations.

In indicating information on prior art documents in translations for international patent applications, it is necessary to comply with Forms 51 or 51*bis* of Article 38*bis* of the Regulations under the Patent Law, instead of Form 29 of Article 24 of the Regulations. In this case, applicants are also recommended to follow the matters in the Reference as best as they can in the same manner as ordinary applications.

2. Major Changes to the Examination Guidelines on the Requirement for Disclosure of Information on Prior Art Documents

Examination Guidelines on the requirement for disclosure of information on prior art documents, which will be published this time, contain changes to the draft examination guidelines that were published on June 19, 2002 with respect to the following points:

(1) In the section “3.1 Inventions For Which Information on Prior Art Documents Is To Be Disclosed; (2) Inventions which are related to the invention for which a patent is sought”, examples of inventions publicly known through documents which are related to the invention for which a patent is sought have been added.

(2) In the section “Determination on the Requirements for Disclosure of Information on Prior Art

Documents”, examples corresponding to the cases mentioned in (2) have been added.

(3) In the section “5.1 Notice under Section 48septies; (1) Notice under Section 48septies”, the designated time limit under Section 48septies has been stipulated, and the statement, “careful consideration shall be required to give both notices because procedures, such as those concerning the designated time limit, would be complicated” has been deleted.

(4) It has been clearly mentioned that the amendment for “Part III, Chapter 1, 4.2 (3) Addition of the prior art document” in the Examination Guidelines for Patent and Utility Model shall apply to applications filed on or before August 31, 2002.