Requirements for Description

Japan Patent Office

Outline

I. Enablement Requirement
II. Other Requirements

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I. **Enablement Requirement**

II. Other Requirements

I. Enablement Requirement

A. Basic Rule

The patent system promotes protection of inventions by granting an exclusive right under predefined conditions for a predefined period of time to those who have developed and disclosed new technology.

On the other hand, it gives the public an opportunity to gain access to the invention by disclosing technical details of the invention.

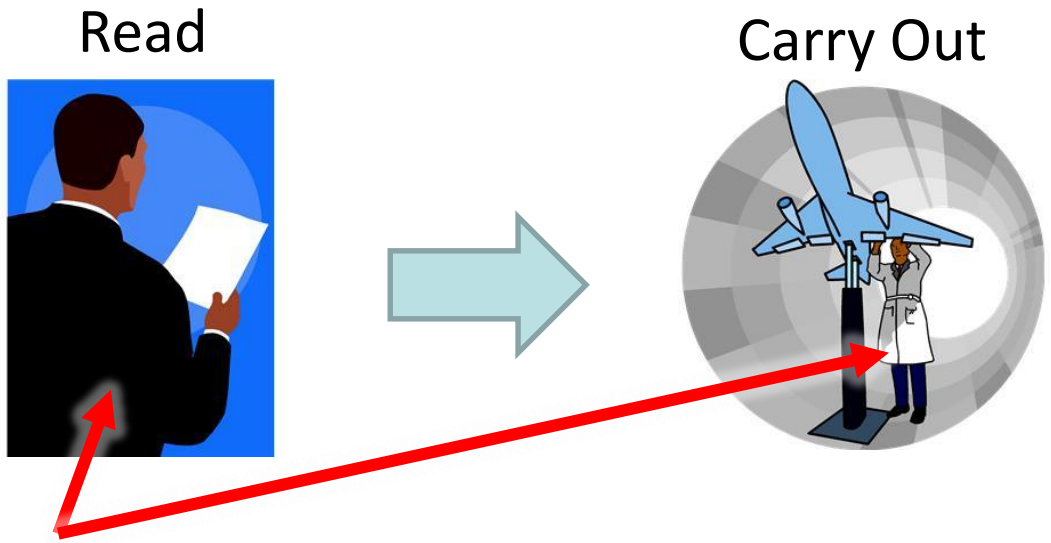
The utilization of an invention as described above are promoted through the description which serves as the technical document.

The description must meet the “Enablement requirement” so as to serve as the technical document.

I. Enablement Requirement

PCT Article 5

The description shall disclose the invention in a manner sufficiently clear and complete for the invention **to be carried out by a person skilled in the art**.

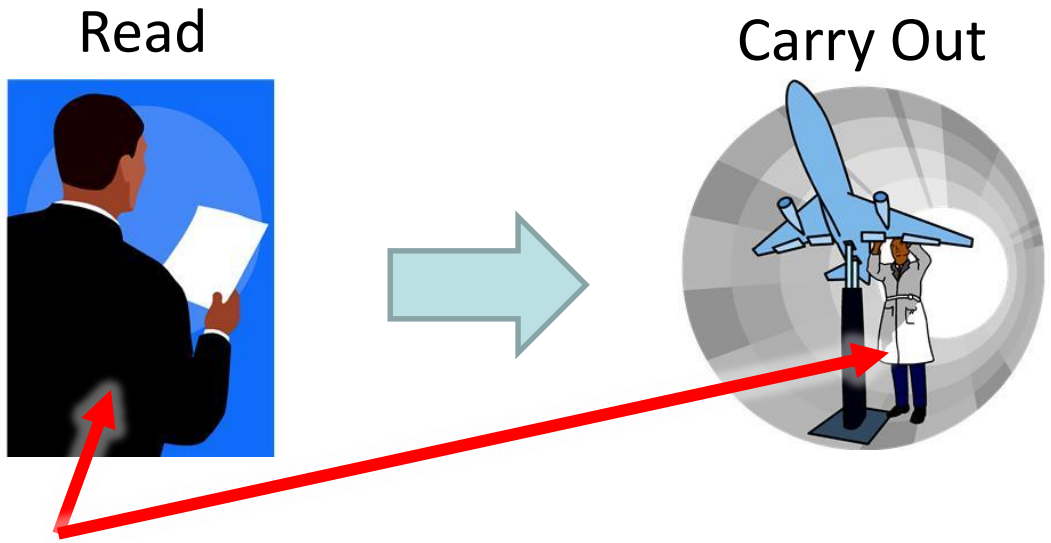


A person skilled in the art: (PCT Guidelines 13.11)
A hypothetical person having ordinary skill in the art, who is aware of common general knowledge in the art at the relevant date, and has access to everything in the prior art.

I. Enablement Requirement

Japanese Patent Act Article 36(4)

The statement in the description must be so clear and sufficient that **a person skilled in the art** can **carry out** the claimed invention.



A person skilled in the art: (JPO Examination Guidelines II.1.1.1.)

i. being capable of using ordinary technical means for research and development; and

ii. being capable of exercising ordinary creativity

B. Legislations for Enablement Requirement

The Enablement Requirement is the requirement that is stated in the patent law of each patent office.

	JPO	EPO	USPTO	SIPO	KIPO	PCT
Enablement Requirement	Art.36(4)(i)	Art.83	Art.112(a)	Art.26	Art.42(3)1	Art.5

C. Examples of Lack of Enablement Requirement

1. Improper Statement of Modes for Carrying Out the Invention

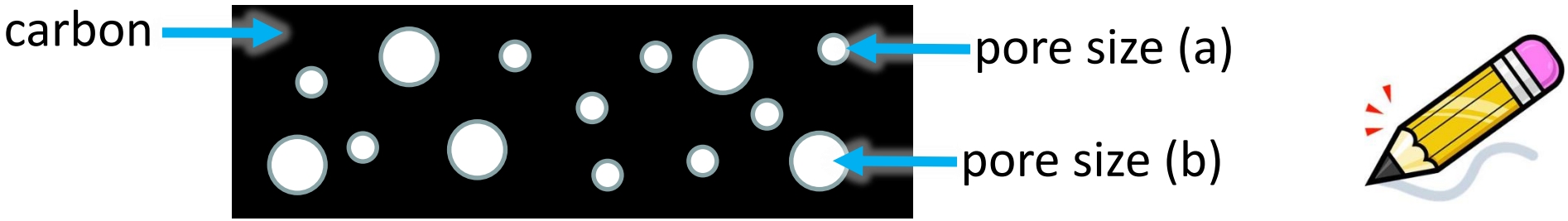
(1) Pencil Lead 1/2

[Claim]

A pencil lead consisting of carbon and pores wherein the relationship between

- the percentage of the volume of pores (A%) of a pore size (a) of $0.002 \leqq a \leqq 0.05$ (μm) and
- the percentage of the volume of pores (B%) of a pore size (b) of $0.05 < b \leqq 0.20$ (μm)

is represented by $1.1 < A/B < 1.3$, $A+B \geqq 80\%$.



C. Examples of Lack of Enablement Requirement

1. Improper Statement of Modes for Carrying Out the Invention

(1) Pencil Lead 2/2

[Outline of the Description]

- The purpose of the present invention is to provide a pencil lead which has proper strength and offers a good writing feel.
- It is found that said purpose can be achieved when the pores in the pencil lead meet certain conditions.
- However, there is no specific statement as to the manufacturing conditions.

In order to prepare proper manufacturing conditions, a person skilled in the art would have to make trials and errors or conduct complicated experimentation, **beyond the reasonably-expected extent**. ➡ **Unable**

C. Examples of Lack of Enablement Requirement

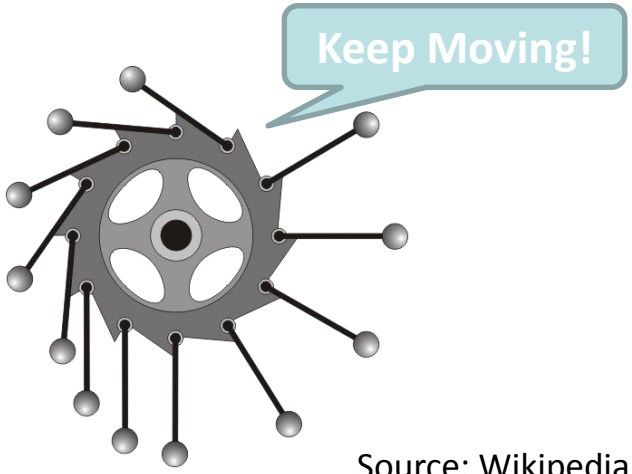
1. Improper Statement of Modes for Carrying Out the Invention

(2) Perpetual Motion Machine

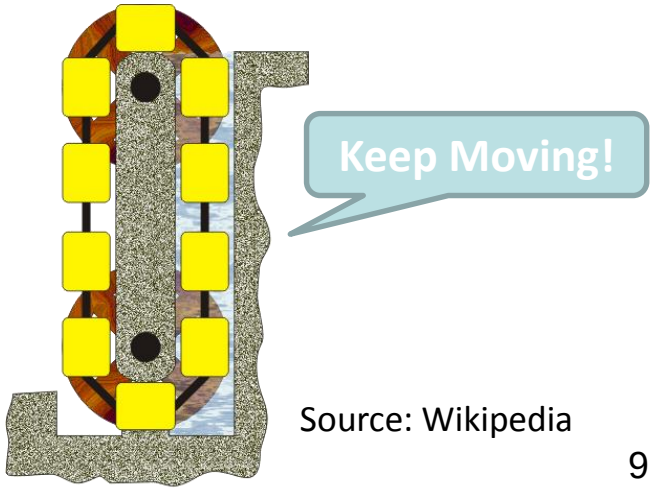
Successful performance of the invention is inherently **impossible,** because it would be contrary to well-established physical laws.

➡ **Unable**

JPO regards a perpetual motion machine as a non-statutory invention.



Source: Wikipedia



Source: Wikipedia

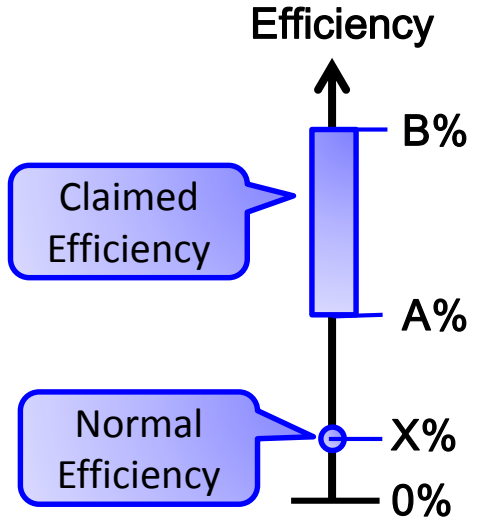
C. Examples of Lack of Enablement Requirement

2. Part of Claim Not Supported by Modes for Carrying Out the Invention

(1) Hybrid Car 1/2

[Claim]
A hybrid car of which energy efficiency during running on electricity is a – b%.

[Description]
Only "Y control" is stated in the description as an embodiment to obtain a – b% efficiency.



C. Examples of Lack of Enablement Requirement

2. Part of Claim Not Supported by Modes for Carrying Out the Invention

(1) Hybrid Car 2/2

- In the technical field of the hybrid car, it is common general knowledge, as of the filing date, that it is difficult to realize higher energy efficiency such as a – b%.
- The statement on the hybrid car equipped with "Y control" does not show the common solving means for realizing the aforesaid high energy efficiency.