

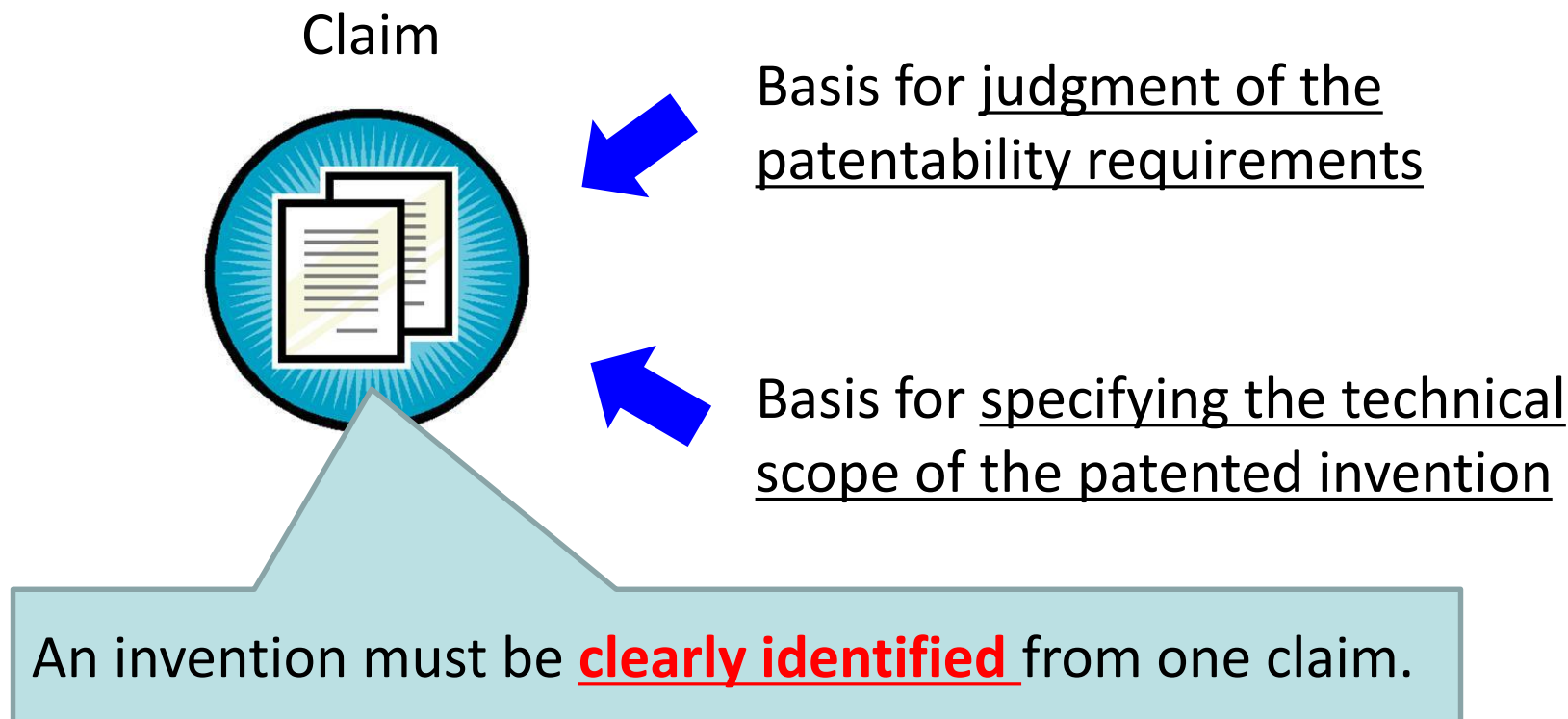
Requirements for Claims

Japan Patent Office

- I. Clarity Requirement
- II. Support Requirement

- I. **Clarity Requirement**
- II. Support Requirement

A. Basic Rule



| | JPO | EPO | USPTO | SIPO | KIPO | PCT |
|---------------------|----------------|---------|-------------|---------|-------------|--------|
| Clarity Requirement | Art. 36(6)(ii) | Art. 84 | Art. 112(b) | Art. 26 | Art. 42(4)2 | Art. 6 |

B. Examples of Lack of Clarity Requirement

1. The statement of the claim itself is unclear.

- (1) Inadequate expression in language
rendering a claimed invention unclear

- Mistake in writing
- Grammatical error



- (2) Incomprehensible term

[Claim]

A process for manufacturing compound X, consisting of process A and process B in the presence of KM-II catalyst.

- Not defined in the description
- Incomprehensible even by taking into account the common general knowledge as of the filing date



The claim is not clear.

B. Examples of Lack of Clarity Requirement

2. A technical defect exists in the matters used to specify the invention.

[Claim]

An alloy comprising;

50 to 60wt% Fe,

40 to 50wt% Cu, and

20 to 30wt% Ni.



The claim includes a technical deficiency.
(50+40+20=110%) ← **Over 100%**

→ The claim is **not clear.**

B. Examples of Lack of Clarity Requirement

3. The category of an invention is unclear. *(See also Chapter IV C.)*

There are two basic kinds of claims (categories of claims).

a. **Physical entity** (Product, Apparatus, System, ...)

b. **Activity** (Method, Process, Use, ...)

[Claim]

A product and method comprising

[Claim]

An anti-cancer effect of chemical compound A.

Product Claim? Method Claim?

➡ The claims are **not clear**.



B. Examples of Lack of Clarity Requirement

4. The scope of the invention is unclear as a result of using the following expressions.

“thin” “wide ” “strong”
“about ” “approximately ”
“when desired” “for example”

- Vague or equivocal forms of wording may leave the reader in doubt as to the scope of the invention.
- In that case, the claim is not clear.

“high-frequency” in the technical field of amplifier

Clear for a person skilled in the art!

B. Examples of Lack of Clarity Requirement

5. Definition by function or characteristics, etc.

When the claim includes the definition by function, characteristics, etc., there are cases where the claim becomes unclear.



(Example 1)

[Claim]

Compounds having the R receptor activating action.

- The description states that the applicant was the first to discover the "R receptor."
- It is common general knowledge as of the filing date that **it is difficult to understand the specific compounds defined only by their action** of activating the newly discovered receptor.

➡ The claim is **not clear.**

*It is noted that, in general, claims may be expressed
by function or characteristics, etc.*

I. Clarity Requirement

B. Examples of Lack of Clarity Requirement

5. Definition by function or characteristics, etc.

(Example 2)

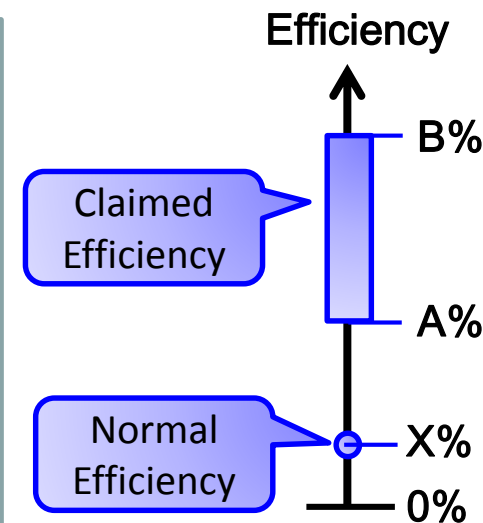


[Claim]

A hybrid car of which energy efficiency during running on electricity is from A to B%.

- In the field of the hybrid car, it is common general knowledge as of the filing date that the energy efficiency is normally about X%, far lower than A%.
- In light of this, **it is difficult to understand the specific hybrid car defined only by such high energy efficiency.**

➡ The claim is **not clear.**



*It is noted that, in general, claims may be expressed
by function or characteristics, etc.*

B. Examples of Lack of Clarity Requirement

6. Product by Process Claims - 1/2

- Product by process (PBP) claim = a claim defining a product in terms of the process by which the product is made.
- Normally, a PBP claim shall be construed to refer to the final product *per se*.

[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.

B. Examples of Lack of Clarity Requirement

6. Product by Process Claims - 2/2

When a claim concerning an invention of a product recites a manufacturing method for the product, **the invention is clear only when the invention involves the situation where it is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing.** Otherwise the invention of the product is judged to be not clear.

Examples of the above situations:

- (i) It is technically impossible to analyze its structure or characteristics at the time of filing.
- (ii) It requires an outrageously large economic expenditure or time to carry out the work necessary to identify the structure or property of the product in view of the nature of a patent application which requires speed, etc.

B. Examples of Lack of Clarity Requirement

7. Trademark, etc.

- Trademarks and similar expressions characterize the commercial origin of goods, rather than the properties of the goods relevant to the invention.
- Even though a trademark itself is the same, the goods and those properties indicated by the trademark may be changed from time to time by decisions of the trademark holder.



The examiner should encourage the applicant to remove trademarks and similar expressions in claims, unless their use is unavoidable.

Such words may be allowed, exceptionally, if they are generally recognized as having acquired a precise meaning.

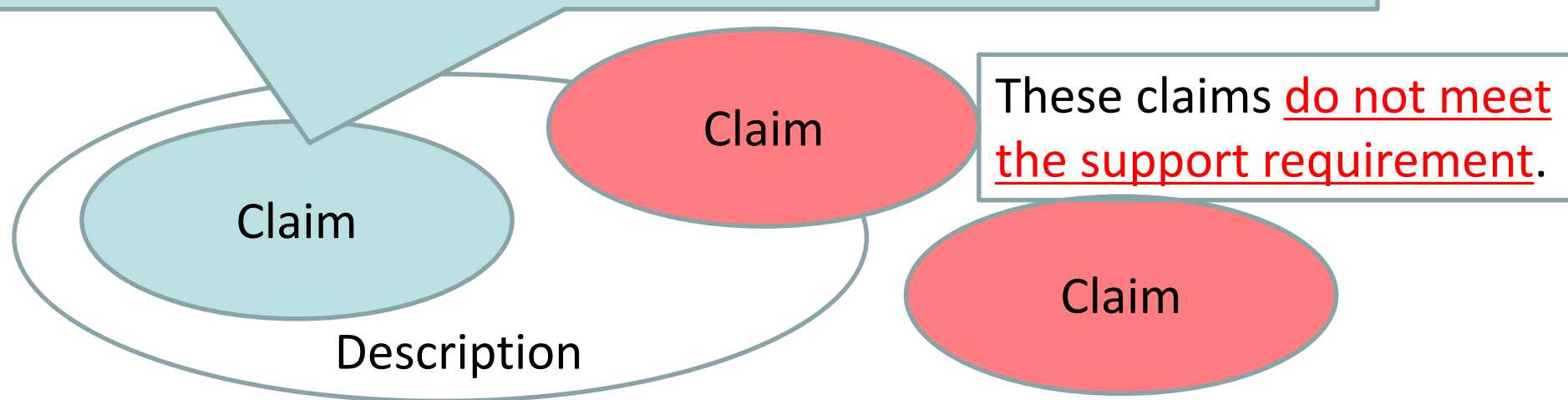


I. Clarity Requirement

II. Support Requirement

A. Basic Rule

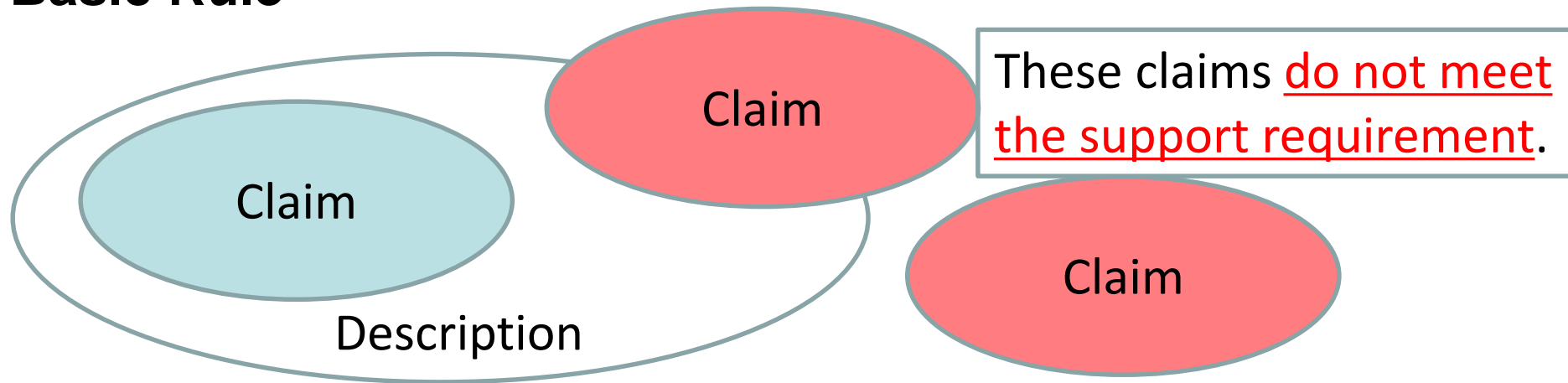
The claimed inventions should not exceed the scope stated in the description.



To state in a claim an invention that is not stated in the description means to seek a patent protection for an invention which is not disclosed to the public.

| | JPO | EPO | USPTO | SIPO | KIPO | PCT |
|----------------------------|---------------|---------|--------------------------------|---------|-------------|--------|
| Support Requirement | Art. 36(6)(i) | Art. 84 | Art. 112(a) (Specification) | Art. 26 | Art. 42(4)1 | Art. 6 |

A. Basic Rule



The examiner examines a substantial correspondence between the claimed invention and the invention stated in the description.

The consideration of the substantial correspondence done by the examiner is to examine whether or not the claimed invention exceeds "the extent of disclosure in the description to which a person skilled in the art would recognize that a problem to be solved by the invention would be actually solved".

B. Examples of Lack of Support Requirement

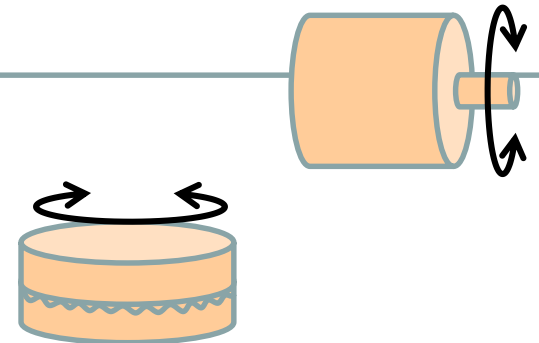
1. The matter neither stated nor implied in the description is stated in the claim.

[Description]

- The inventions using a DC motor are stated.
- The description neither states nor implies anything about using an ultrasonic motor.

[Claim]

..... using an ultrasonic motor.



➡ The claim is not supported by the description.

B. Examples of Lack of Support Requirement

2. The relationship between the claim and the description is unclear.

[Description]

A word processor has means for changing the size of characters and means for changing line spacing.

Inconsistent

[Claim]

A word processor comprising data processing means, and

Relationship between the claim and description is unclear.

➡ The claim is not supported by the description.



B. Examples of Lack of Support Requirement

3. The content disclosed in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge as of the filing date.

◆ Hybrid Car 1/2

[Description]

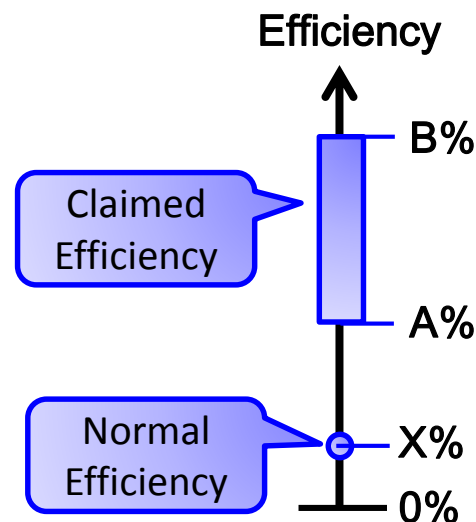
The description only discloses hybrid cars equipped with a control means to perform “Y-control.”

[Claim]

A hybrid car of which energy efficiency during running on electricity is from A to B%.



The claim is **not supported** by the description.



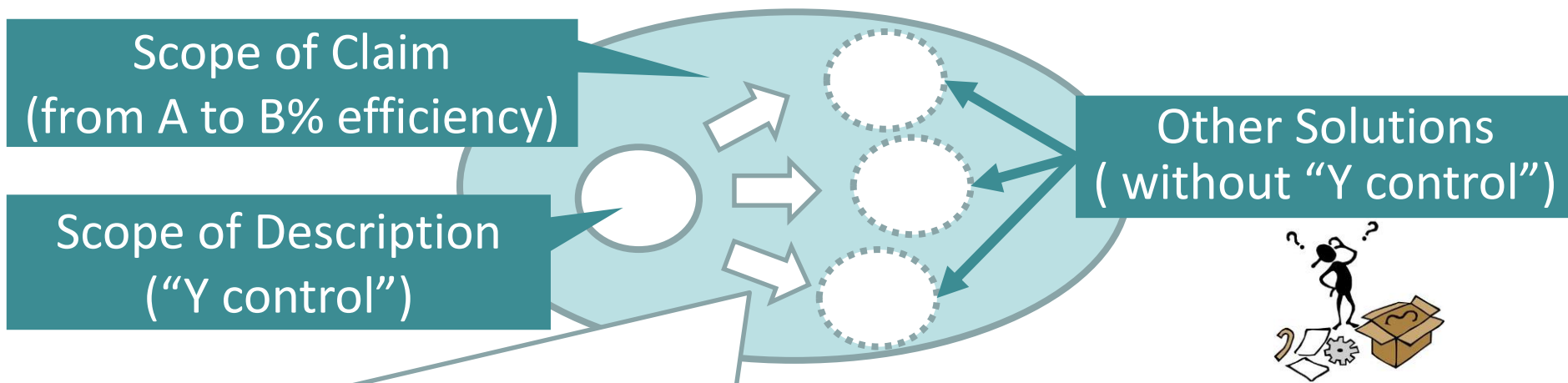
II. Support Requirement

B. Examples of Lack of Support Requirement

3. The content disclosed in the description can neither be expanded nor generalized to the scope of the claimed invention even in light of the common general knowledge as of the filing date.

◆ Hybrid Car 2/2

- It is difficult to realize a high energy efficiency such as from A to B% even in light of the common general knowledge as of the filing date.



No grounds can be found for expanding or generalizing the content disclosed in the description to the scope of the claimed invention.

➡ The claim is **not supported** by the description.

B. Examples of Lack of Support Requirement

4. As a solution for the problem to be solved by the invention is not reflected in the claim, a patent is being claimed beyond the scope stated in the description.

[Description]

- The problem to be solved by the invention is how to prevent excessive automobile speed.
- Only a mechanism which aggressively increases force against stepping on the accelerator pedal as speed increases is disclosed.

[Claim]

A mechanism which varies force against stepping on the accelerator pedal as speed increases.

It is evident that the problem cannot be solved by the claimed invention.

➡ The claim is not supported by the description.