

# Novelty

Japan Patent Office

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Welcome to the lecture on “Novelty.”

- I. Purpose of Novelty
- II. Procedure of Determining Novelty
- III. Non-prejudicial Disclosures or  
Exceptions to Lack of Novelty

---(Slide 1)---

Here is the outline of this lecture.

1. Purpose of Novelty
2. Procedure of Determining Novelty
3. Non-prejudicial Disclosures or Exceptions to Lack of Novelty

- I. Purpose of Novelty**
- II. Procedure of Determining Novelty
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Exceptions to Lack of Novelty

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First, let's look at the purpose of novelty.

## I. Purpose of Novelty



JPO (Part III, Chapter 2, Section 1, 1. in JPO Examination Guidelines)

The Patent System is provided to grant an exclusive right to the inventor in exchange for disclosing the invention; therefore, the invention which deserves the patent should be novel.

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**This is the purpose of novelty as indicated in the JPO Examination Guidelines.**

**The patent system is provided to grant an exclusive right to a patentee for a specified period under specified conditions in exchange for disclosing the invention; therefore, the invention that deserves the patent should be novel.**

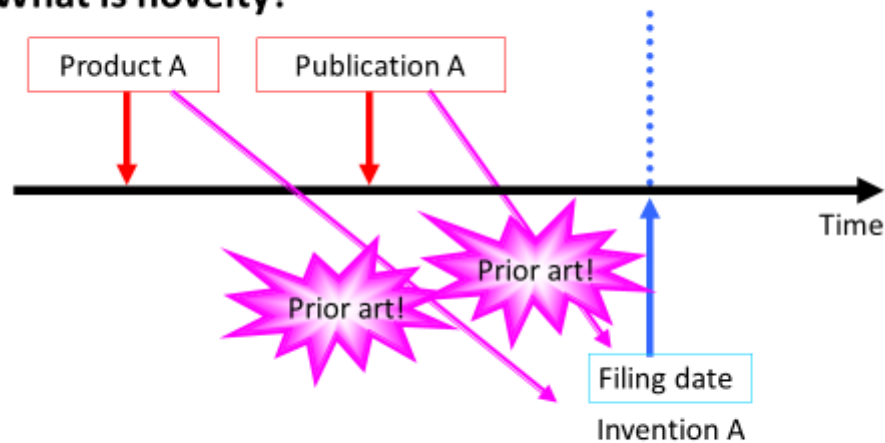
- I. Purpose of Novelty
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Now, let's look at the procedure of determining novelty.

## II. Procedure of Determining Novelty

### What is novelty?



**Invention A is not patentable  
if it was known to the public before the filing date.**

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I will explain the basic concept of novelty and prior art.

“Prior art” means inventions that were made public prior to the filing of the patent application.

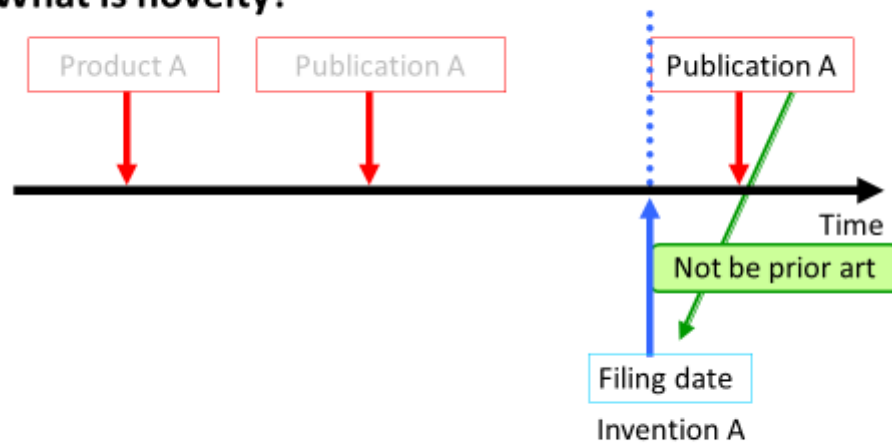
In this slide, capital letter A refers to the same invention. Therefore, Product A and Publication A have the same content as Invention A.

This graph shows that Product A and Publication A that are on the left side of the filing date of Invention A, as indicated with the blue arrow, were disclosed before filing the patent application for Invention A.

In this case, Product A and Publication A are prior art.

## II. Procedure of Determining Novelty

### What is novelty?



**Invention A is not patentable  
if it was known to the public before the filing date.**

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On the other hand, if an invention is disclosed after filing the patent application for Invention A, like Publication A, which is on the right side of the filing date of Invention A, Publication A is not prior art.

## II. Procedure of Determining Novelty



### PCT (PCT Guidelines 12.03)

(i) Evaluate the elements of the claimed invention



(ii) Determine if a document under consideration forms part of the "prior art"



(iii) Assess whether each and every element or step of the claimed invention was explicitly or inherently disclosed in combination by the document, to a person skilled in the art, on the date of publication of the document.

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I will now explain the method for evaluating novelty.

PCT Guidelines 12.03 states that examiners should assess the novelty of an invention after going through steps (i) through (iii) as shown in this slide.

First, evaluate the elements of the claimed invention.

Next, determine if a document under consideration forms part of the prior art.

This means, for example, that a document that was made public before the reference date can be prior art.

Finally, assess whether each and every element or step of the claimed invention has been explicitly or inherently disclosed in combination with the document to a person skilled in the art on the date of publication of the document.



## II. Procedure of Determining Novelty



**PCT**

### **(i) Evaluate the elements of the claimed invention**

In interpreting claims for the consideration of novelty,  
the examiner should have regard to the guidance  
given in Interpretation of Claims  
(PCT Guidelines 5.20 to 5.41)

(PCT Guidelines 5.20)

Each claim should be read giving the words the ordinary meaning  
and scope which would be attributed to them by a person skilled in  
the art, unless in particular cases the description gives the words a  
special meaning, by explicit definition or otherwise.

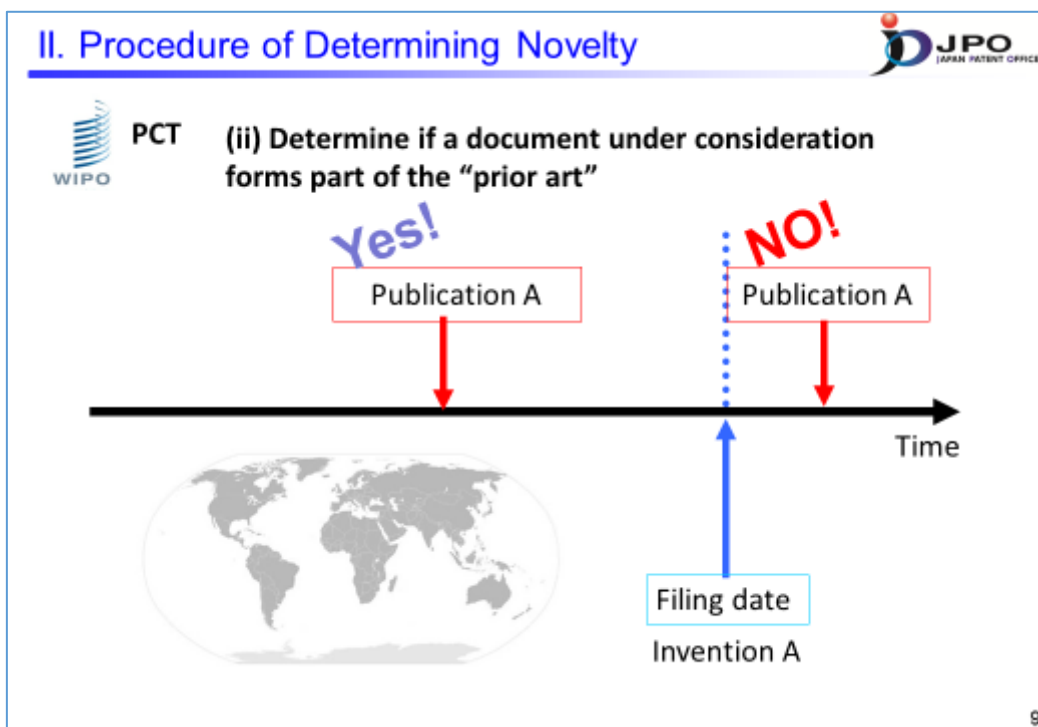
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**I will explain how the claimed invention is interpreted in order to consider its novelty.  
When interpreting the claimed invention, examiners should have regard for the  
guidance on interpretation of claims.**

**It is given in PCT Guidelines, 5.20 through 5.41.**

**In concrete terms, each claim should be read giving the words the ordinary meaning  
and scope which would be attributed to them by a person skilled in the art, unless in  
particular cases the description gives the words a special meaning, by explicit  
definition or otherwise.**



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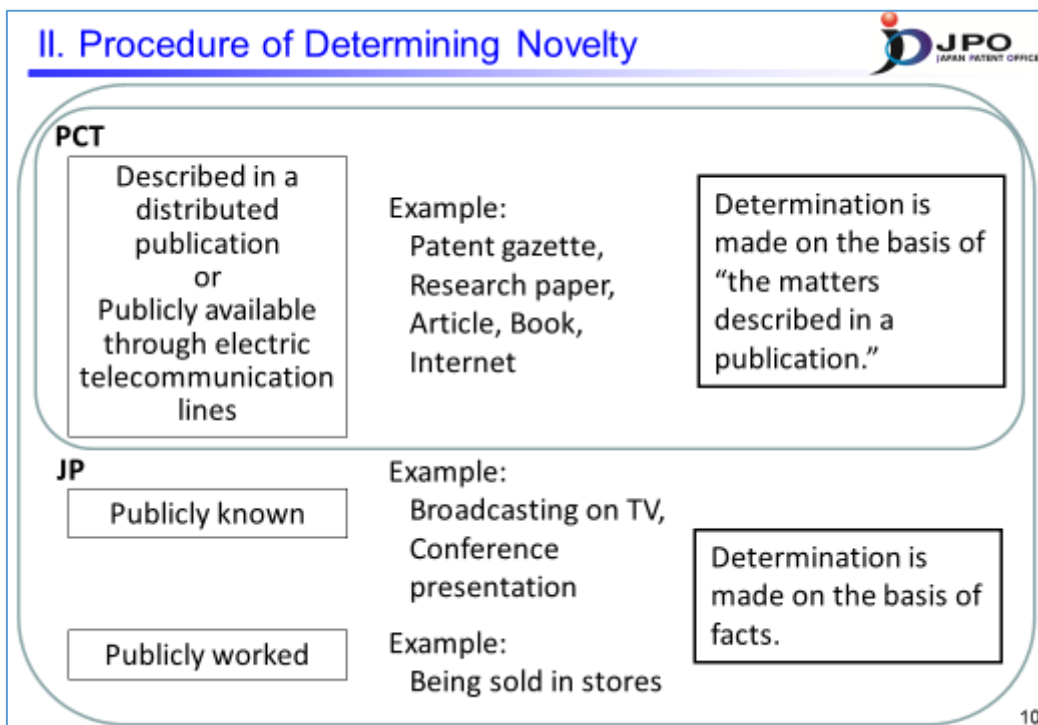
In the second step, determine if a document under consideration can be prior art or not.

“Prior art” is defined as everything (1) made available to the public anywhere in the world by means of written disclosure, and (2) before the “relevant date.”

Written disclosures include drawings and other illustrations.

For example, Publication A which was disclosed before the filing date of Invention A is prior art.

On the other hand, Publication A which was disclosed after the filing date of Invention A is not prior art.



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In this slide, I will explain what can be prior art.

Under PCT, prior art can be something such as an invention described in a distributed publication or an invention that was made publicly available through electronic telecommunication lines.

Examples of where an invention can be described in a distributed publication are patent gazettes, research papers, articles, and books; and an example of how an invention can be made publicly available through electronic telecommunication lines is information disclosed on the Internet.

In Japan, publicly known inventions and publicly worked inventions can be prior art in addition to these.

Examples of publicly known inventions are those broadcast on TV or presented in a conference; and an example of a publicly worked invention is one that is sold in stores.

An invention described in a publication is determined based on the matters described in the publication.

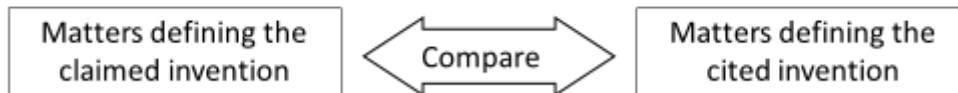
On the other hand, publicly known or worked inventions are determined based on facts.

## II. Procedure of Determining Novelty



PCT

(iii) Assessment



Determining the identicalness and the difference



If there is a difference, the claimed invention is novel.

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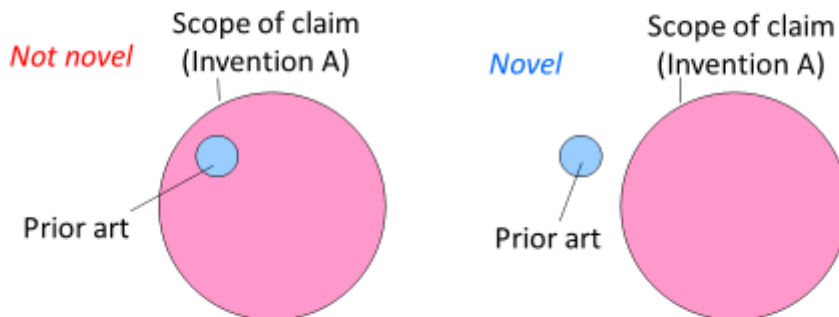
The third step is to compare the claimed invention and cited invention.

Examiners compare the matters defining the claimed invention with the matters defining the cited invention, and determine the points of identical features and differences.

If there is a difference, the claimed invention is novel.

## II. Procedure of Determining Novelty

Is the claimed invention A novel or not ?



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I will explain this using figures so that you can easily understand.

As shown in the left figure, if the prior art that was found by the search is involved in the scope of the claimed invention, the claimed invention is not novel.

On the other hand, as shown in the right figure, if the prior art is not involved in the scope of the claimed invention, the claimed invention is novel.

In the previous slide, I explained the difference between PCT and JPO. The scope of prior art under the patent act is defined by each country. Please check the scope of prior art in your country.

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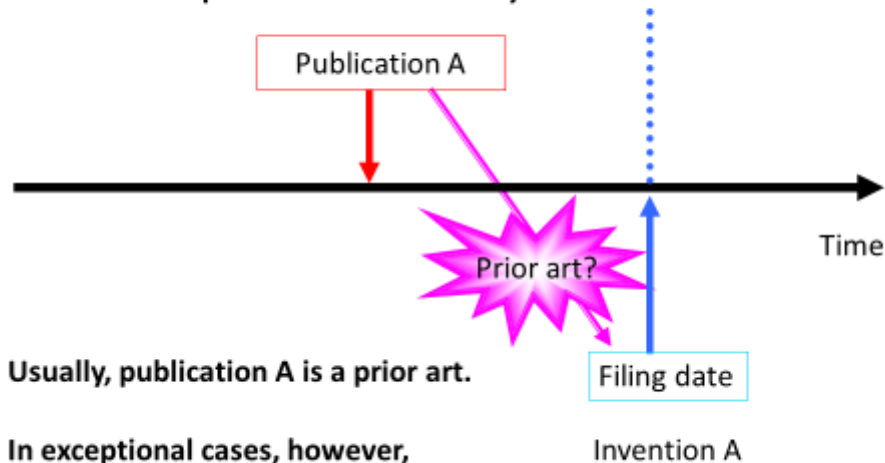
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Speaking of novelty, there are many countries that have exceptions to lack of novelty.  
I will explain these exceptions as the third topic.

### III. Non-prejudicial Disclosures or Exceptions to Lack of Novelty



What is “non-prejudicial disclosure”  
or “exceptions to lack of novelty” ?



Usually, publication A is a prior art.

In exceptional cases, however,  
publication A **cannot** be a prior art.

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The exceptions to novelty are called “non-prejudicial disclosure” or “exceptions to lack of novelty.”

What are “non-prejudicial disclosure” and “exceptions to lack of novelty”?

In this example, Publication A was disclosed before the filing date and the technology described in Publication A is involved in the scope of the claimed invention.

Usually, Publication A is a document of prior art and novelty would be denied.

However, in exceptional cases, Publication A cannot be a prior art.

What the exceptional cases are differs from one country to another.

### III. Non-prejudicial Disclosures or Exceptions to Lack of Novelty



#### Exception to lack of novelty of invention (Japanese Patent Act Article 30)

Against the will of or as a result of an act of a person having the right to obtain a patent



Filed by the said person within six months from the date on which the invention first fell under any of the items of Article 29 (1).



Shall be deemed not to have fallen under any of said items.

A declaration at the time of filing is necessary, in case where the invention is opened as a result of an act of the person having the right to obtain a patent.

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For your information, let me introduce exceptions to lack of novelty of invention in Japan.

Under the Japanese Patent Act, exceptions to lack of novelty of invention are defined in Article 30. There are two requirements.

The first requirement is that it is against the will of a person having the right to obtain a patent or it is as a result of an act of a person having the right to obtain a patent.

The second is that it is a patent application filed by the said person within six months from the date on which the invention first fell under any of said items.

Additionally, if the invention is opened as a result of an act of a person having the right to obtain a patent, it is necessary to submit a declaration at the time of filing to apply the provision of exception to lack of novelty of invention.