1. Overview

The examiner shall find the claimed invention and the cited invention in determining novelty and inventive step, and compares both. As a result of the comparison, the examiner determines to involve novelty where there are no differences (Section 1), and determines the presence of inventive step where there are differences (Section 2).

Finding of claimed invention  
Finding of cited invention  
Comparison between claimed invention and cited invention  
Determination of presence of novelty and inventive step  
(See Section 1 and Section 2)

2. Finding of Claimed Invention

The examiner shall find the claimed inventions based on the descriptions of the claims. The examiner takes the descriptions of the specifications and drawings and the common general knowledge as of the filing into consideration for the analysis of meaning of words.

Even when an invention identified by the claims does not correspond to the invention described in the specification or drawings, the examiner should not find the claimed invention for subject to examination by the specification or drawings alone without analyzing the claims When technical matters or terms are described in the specifications or drawings but not described in the claims, the examiner shall find the claimed invention without analyzing the technical matters or terms. On the other hand,
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when they are described in the claims, the examiner should always analyze them and should not find the invention without analyzing them. (Reference) Judgment of the Second Petty Bench of the Supreme Court (March 8, 1991, 1988(Gyo-Tsu) No. 3, Page 123 of Minshu No. 45 vol. 3) "Method for measuring triglyceride" (Case of Lipase)

2.1 Where descriptions of the claims are clear

In this case, the examiner interprets as they are to identify the claimed inventions. Also, the examiner interprets terms in the claims as the meanings in the normal sense.

However, when meanings of the terms described in the claims are defined or explained in the specification or drawings, the examiner takes such definition and explanation into consideration to interpret the terms. In addition, examples of more specific concepts developed under the concepts of the terms in the claims, which are merely provided in the detailed description of the inventions or drawings, are not included in the terms defined or explained.

2.2 Where descriptions of the claims are unclear and incomprehensible at first glance

In this case, when the description of the claims could be clear by interpreting the terms in the claims based on the specifications, drawings and common general knowledge as of the filing, the examiner shall take them into consideration to find the invention.

2.3 Where descriptions of the claims are unclear even when specifications, drawings and common general knowledge as of filing are taken into consideration

In this case, the examiner does not find the claimed inventions. Such inventions may be subject to be excluded from the prior art search (see 2.3 in “Part I, Chapter 2, Section 2 Prior Art Search and Determination of Novelty, Inventive Step, etc.”).

3. Finding of Cited Invention

The examiner shall find the cited invention based on evidence for the prior
3.1 Prior art

The prior art corresponds to any one of the cases 3.1.1 to 3.1.4 prior to the filing of the application. It is determined whether or not it is prior to the filing of the application in units of hours, minutes and seconds. When it is well-known in foreign country, it is determined in Japan time translated from that of the country.

3.1.1 Inventions described in distributed publications (Article 29(1)(iii))

"Inventions described in distributed publications" means inventions described in the publications (Note 2) in a situation where unspecified persons could read (Note 1).

(Note 1) It is unnecessary the fact that someone actually accesses such publications.
(Note 2) "Publications include documents, drawings or other similar media for the communication of information, which are duplicated to disclose the content to the public through the distribution of the publications.

(1) Inventions described in publications
a "Inventions described in publications" mean inventions that a person skilled in the art is able to understand based on the descriptions in the publications or equivalents to such descriptions. The examiner finds inventions understood from these descriptions as inventions described in publications. Equivalents to descriptions in the publications mean descriptions that a person skilled in the art could derive from the description in the description in the publications based on the common general knowledge as of the filing.

The examiner cannot find inventions that a person skilled in the art is not able to understand based on the descriptions in publications or equivalents to such descriptions as "cited inventions", because such inventions cannot be regarded as "inventions described in publications".

b The examiner cannot find inventions that a person skilled in the art is able to understand based on the descriptions in publications or equivalents to such descriptions as "cited inventions" where they correspond to the following case (i) or
(ii).

(i) Where it is not clear that an invention of a product is not clearly described enough that person skilled in the art is able to manufacture the product based on the descriptions of the publications and the common general knowledge as of the filing

(ii) Where it is not clear that an invention of a process is not clearly described enough that person skilled in the art is able to use the process based on the descriptions of the publications and the common general knowledge as of the filing

(2) Determining a distributed time

<table>
<thead>
<tr>
<th>Whether or not a publication date is indicated in the publications</th>
<th>Estimated distributed time</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Indicated</strong></td>
<td></td>
</tr>
<tr>
<td>Where only a publication year is indicated</td>
<td>The last day of the year</td>
</tr>
<tr>
<td>Where publication month and year are indicated</td>
<td>The last day of the month of the year</td>
</tr>
<tr>
<td>Where publication day, month and year are indicated</td>
<td>The day, month and year</td>
</tr>
<tr>
<td><strong>Not indicated</strong></td>
<td></td>
</tr>
<tr>
<td>Where foreign publications have an exact date when they were brought from abroad to Japan</td>
<td>The date retrospectively estimated from the date when the publications were brought from abroad to Japan, considering the period normally taken for shipping the publications from abroad to Japan</td>
</tr>
<tr>
<td>Where there are publications compiled with other materials, such as book reviews, excerpts or catalogs</td>
<td>The publication date of the publication estimated from the publication dates of these materials</td>
</tr>
<tr>
<td>Where reprinted publications indicate the initial print date</td>
<td>The indicated initial print date</td>
</tr>
<tr>
<td>Where there is other possible information source</td>
<td>The date estimated or acknowledged from the other possible information source</td>
</tr>
</tbody>
</table>

(Note) If there is other possible information source in addition to the publication date in the publication, the examiner can make an assumption that the distribution date of the
b Determining a distributed time when a filing date and a publication date are the same date

When a filing date and a publication date are the same date, the examiner does not deem a distributed time to be prior to the filing unless the filing is obviously after the publication.

3.1.2 Inventions made publicly available through electric telecommunication line
(Article 29(1)(iii))

"Inventions made publicly available through an electric telecommunication line" means inventions published in webpages etc. (Note 3) in situations where information can be seen by an unspecified person (Note 2) through an electric telecommunication line (Note 1).

(1) Inventions published in webpages etc.

"Inventions published in webpages etc." mean inventions published in webpages etc. and inventions recognized from equivalents to such publications.

The examiner finds inventions published in webpages etc. according to the descriptions in 3.1.1. However, in order to cite the inventions, the inventions are required to have been published in webpages etc. as they are at the published time.

The examiner determines whether or not the time when being made publicly available prior to filing of the application based on the published time indicated in the webpages etc. (Note 4).

(Note 1) A "line" means a two-way transmission line, generally constituted by send and receive channels. Broadcasting, which is only capable of one-way transmission, does not fall under the definition of a "line" (except for cable TV etc. that is capable of two-way transmission).

(Note 2) It does not require the fact that someone has actually accessed. More specifically, it can be said that both of the following cases (i) and (ii) being satisfied correspond to when being made publicly available (situations where an unspecified person can see).

(i) Where a site can be arrived through a link from well-known webpages the site is registered with search engines, or the address (URL) of the site appears in mass media
(Note 3) "Webpages etc." means what provides information on the Internet etc. "Internet etc." means all means that provide information through electric telecommunication lines, including the Internet, commercial databases, and mailing lists.

(Note 4) When the published time is not indicate or the publication year or month only is indicated, and thus it is unclear whether the published time is prior to filing of the application, the examiner can cite such information if the published time is prior to filing of the application by obtaining a certificate on the published time from a person with authority or responsibility for the publication, maintenance etc. of the published information.

(2) Counterargument of applicant on published time and published information
whether or not the information is published at the published time as it is
a Where the counterargument of an applicant against the indicated published time and the published information are not supported by evidence, but are only based on his/her suspicion that there is the possibility of the disclosure through the Internet etc. In this case, the examiner declines the counterargument due to lack of specific grounds.

b Where a counterargument of an applicant with specific grounds raises a doubt for the published time or published information

The examiner requests with the person with the authority or responsibility for the publication, maintenance, etc. of the information to issue a certificate as to the date of publication on the webpages etc. or the content of information thereof.

Where, as a result of examining the counterargument etc. of the applicant, the doubt is maintained, the examiner does not cite the inventions published in the webpages etc.

3.1.3 Inventions that were publicly known (Article 29(1)(i))

"Inventions that were publicly known" mean inventions whose content becomes known to unspecific persons as an art without an obligation of secrecy (Note).

(Note) When persons who have confidentiality disclose an invention to other persons who are not
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aware of its secrecy, that invention is included in "inventions that were publicly known" irrespective of the inventor’s or applicant’s intent to keep it secret.

For example, an invention published in an article, such as in an academic journal, is not included in inventions that are publicly known even after it was submitted to the journal, until the article is publicly disclosed, since such article is hardly disclosed to unspecified persons when submitted.

"Inventions that were publicly known" are often known through lecture, briefing session and so on generally. In this case, the examiner finds the inventions from the factors explained in the lecture, briefing session and so on.

The examiner can use as a base for finding "inventions that were publicly known" based on the matters derived by a person skilled in the art through analyzing the common general knowledge at the time of the lecture, briefing session and so on in interpreting the explained factors.

3.1.4 Inventions that were publicly worked (Article 29(1)(ii)

"Inventions that were publicly worked" mean inventions which have been worked in a situation where the content of the invention is or could be publicly known (Note).

(Note) An invention that is publicly known by working of the invention is included in "inventions that were publicly known", which does not comply with Patent Act Article 29(1)(ii).

"Inventions that were publicly worked" are often worked using machinery, device, system and so on generally. In this case the examiner finds the inventions from the factors that the machinery, device, system and so on conduct how operations, processes and so on.

The examiner can use as a base for finding "inventions that were publicly worked" based on the matters derived by a person skilled in the art through analyzing the common general knowledge at the time that the inventions were publicly worked in interpreting the explained factors.

3.2 Inventions described in generic concepts or more specific concepts by evidence indicating prior art
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(1) Where the evidence indicating prior art describes inventions in generic concepts

(Note 1) In this case, since the inventions are not considered to be those providing more specific concepts, the examiner does not find the inventions providing more specific concepts as the cited inventions. However, the examiner can find the inventions providing more specific concepts as the cited inventions when they are derived from the common general knowledge (Note 2).

(Note 1) The term "generic concept" means a comprehensive concept consisting of ideas belonging to the same family or type, or a comprehensive concept integrating a plurality of ideas sharing a common nature.

(Note 2) General knowledge is not considered to be those from (or in) which inventions described in more specific concepts are derived (or described) when more specific concepts are merely included in the generic concepts or more specific concepts could be picked up from the generic concepts.

(2) Where the evidence indicating prior art describes inventions in more specific concepts

In this case, when the evidence indicating the prior art describes the inventions utilizing the same family or type of matters, or common features as the matters for identifying the inventions, the examiner can find the inventions providing generic concepts as the cited inventions. In addition, the determining method of novelty can include determining the presence of novelty of the claimed inventions described in generic concepts in comparing and determining without finding the cited inventions described in generic concepts (see 4. and 5.1, especially see 4.2).

3.3 Points to consider

The examiner should be noted not to obtain afterthought by misunderstanding the descriptions of the specification, claims or drawings according to the contexts of them when understanding the evidence indicating the prior art upon obtaining knowledge of the claimed inventions. The cited inventions should be understood based on the evidence indicating the cited inventions (for publications, along the contexts of the publications).
4. Comparison between Claimed Invention and Cited Invention

4.1 General methods of comparison

The examiner compares the certified claimed invention and the certified cited invention. Comparison between the claimed invention and the cited invention is conducted by examining consistencies and differences between the matters identifying the invention relating to the claimed invention and the matters required to express the cited invention in wording (hereinafter referred to as "matters identifying the cited invention" in this chapter). The examiner shall not compare a combination of two or more independent cited inventions with the claimed invention.

4.1.1 Claimed invention in which the matters identifying the invention include alternatives (Note 1)

The examiner compares the claimed invention in which only one of alternatives is assumed as matters identifying the invention related to the alternative with the cited invention (Note 2).

(Note 1) Alternatives include formal alternatives and substantial alternatives.

"Formal alternatives" mean the description in such a form as understood obviously as alternatives by the statement of the claim.

"Substantial alternatives" mean the description which is intended to include substantially limited number of more specific matters by means of comprehensive expression.

(Note 2) In order to determine whether the claimed inventions have novelty and inventive step, the examiner need to determine on all of the matters in the inventions identified based on the matters described in the claims. Therefore, it should be noted that the determination on novelty and inventive step for the claimed inventions cannot be always achieved by a partial comparison of the inventions.

4.2 Methods for comparing more specific concept of claimed invention with cited invention

The examiner certifies consistencies and differences between the more
specific concept of claimed invention and the cited invention by comparing the two inventions.

The more specific concept of the claimed invention includes such as a mode for carrying out the claimed invention described in detailed description of the invention or in drawings as. Other than such mode can be a subject of comparison, so long as that is a more specific concept of the claimed invention.

Such method of comparison is effective in determination on novelty such as in the following claims.

(i) a claim includes a description intended to specify the product with functions or features or the like
(ii) a claim includes the limitation by numerical range

(Note) See 4.1.1 (Note 2)

4.3 Methods for considering the common general knowledge as of the filing on comparison

The examiner may certify consistencies and differences, when comparing the matters described in prior art documents, etc. with the matters specifying the invention pertaining to the claim, by interpreting both matters in consideration of the common general knowledge as of the filing. The determination results obtained by this method and the methods as mentioned above must not be different

| 5. Determination on Novelty and Inventive Steps, and Procedure of Examination Pertaining to the Determination |

5.1 Determination

The examiner determines whether the claimed invention involves novelty (see “Section 1 Novelty”) or inventive steps (see “Section 2 Inventive Step”) by comparing the claimed invention with the cited invention.

5.1.1 Claimed Invention in Which the Matters Specifying the Invention Include Alternatives
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The examiner determines that the claimed invention does not involve novelty, in a case where there is no difference between the claimed invention in which only one of alternatives is assumed as the matters identifying the invention related to the alternative and the cited invention as a result of comparison between the two inventions.

In addition, the examiner determines that the claimed invention does not involve an inventive step, in a case where the reasoning can be made as a result of comparison and reasoning between the claimed invention in which only one of alternatives is assumed as the matters identifying the invention related to the alternative and the cited invention.

5.2 Procedure of Examination pertaining to Determination on Novelty

The examiner issues the notice of reason for refusal to the effect that the claimed invention is not patentable under the provision of Article 29(1), when convinced that the claimed invention does not involve novelty based on 2. in “Section 1 Novelty.”

Against the notice of reason for refusal due to the absence of novelty, the applicant may amend the claims by submitting a written amendment of proceedings, or may respond or clarify with written opinion or certificate of experimental results, etc.

The notice of reason for refusal is cancelled when amendment, response, or clarification results in the situation where the examiner is not convinced that the claimed invention does not involve novelty. Otherwise, when the examiner's conviction does not change, the examiner issues a decision of refusal based on the reason for refusal to the effect that the claimed invention falls under any of items of Article 29 (1) and thus is not patentable.

5.3 Procedure of Examination pertaining to Determination on Inventive Steps

(1) The examiner issues the notice of reason for refusal to the effect that the claimed invention is not patentable under the provision of Article 29 (2), when convinced that the claimed invention does not involve an inventive step based on 2 and 3 in “Section 2 Inventive Step.” The examiner prepares the notice of reason for refusal so that the applicant may answer or clarify such notice. To be specific, the reasoning is described so that a person skilled in the art can easily arrive at the claimed invention from the main cited invention, while clarifying the differences between the claimed invention and the main cited invention.
Against the notice of reason for refusal due to the absence of inventive step, the applicant may amend the scope of claims by submitting a written amendment of proceedings, or may respond or clarify with written opinion or certificate of experimental results, etc.

Circumstances pertaining to the element taking effect for affirming inventive step (see 3.2 in “Section 2 Inventive Step”) are often clarified with a written opinion, etc. In such circumstances, the examiner should try to conduct reasoning while accessing such fact in a comprehensive manner.

(2) The reason for refusal is cancelled when the amendment, response, or clarification results in the situation where the reason for refusal in the notice is not maintained and the examiner is not convinced that the claimed invention does not involve an inventive step. The examiner issues a decision of refusal based on the reason for refusal to the effect that the claimed invention is not patentable under the provision of Article 29 (2) 1, when the reason for refusal in the notice is maintained and the conviction that the claimed invention does not involve an inventive step remains unchanged.

Example: example in cases where the reason for refusal is not maintained

The examiner determines that the reason for refusal in the notice is not maintained, when reasoning cannot be conducted without citing new evidence additionally, except that, although there is no defect in the reasoning, the evidence indicating well-known art or commonly used art is newly cited in order to supplement the reasoning already shown.

(3) The examiner indicates the evidence on the grounds of well-known art or commonly used art, when using well-known art or commonly used art for reasoning in the notice of reason for refusal or decision of refusal, except that no example is required. The above matter is applied, regardless of using well-known art or commonly used art as the cited invention, as a basis for modification of design, or as a basis for accreditation of the knowledge (Note 1) or ability (Note 2) of a person skilled in the art.

(Note 1) The knowledge of a person skilled in the art means the knowledge of state of the art including common general knowledge or the like.

(Note 2) The ability of a person skilled in the art means the ability for using ordinary technical means for research and development, and normal creative ability.

Criterial timing (timing of filing) for determining on novelty and inventive steps are treated as shown in the below table.

<table>
<thead>
<tr>
<th>Types of application</th>
<th>Timing of filing</th>
</tr>
</thead>
<tbody>
<tr>
<td>Divisional application, converted application or the patent application based on registration of utility model</td>
<td>As of filing of the original application (Article 44(2), Article 46(6) or Article 46bis(2))</td>
</tr>
<tr>
<td>Application claiming internal priority</td>
<td>As of filing of previous application(Article 41(2))</td>
</tr>
<tr>
<td>Application claiming priority under the Paris Convention (or priority declared as governed by the Paris Convention)</td>
<td>Filing date of the first application (Article 4B of the Paris Convention) (Note)</td>
</tr>
<tr>
<td>International patent application</td>
<td>Filing date of international application (Article 184ter (1)) (Note),provided that, as indicated in the above column if claiming priority</td>
</tr>
</tbody>
</table>

(Note) Exceptionally, novelty and inventive steps are not determined based on "as of filing" but based on "filing date."