

(3) Precise examination to meet expectations

With regard to the granting of rights, in order to promote innovative technological development, to prevent mere excessive competition in applications and not to interfere with fair exploitation and management by third parties, examination must respect the requirements of novelty, inventive step and the like. This obligation reflects the demand of Japanese industry for more stringent judgment of inventive step referred to in Section 1.

These demands express the expectation of precise examination, which is an imperative duty of patent administration. To respond to this expectation, in December 2000 the JPO drastically revised the "Examination Guidelines for Patents and Utility Models" which define the criteria for novelty and inventive step. Including the revision of the Examination Guidelines, the following measures have been taken for the furtherance of precise examination.

① Revision of examination guidelines

It had been said that the old Examination Guidelines imposed excessive responsibilities of proof and examination on examiners. Based on this opinion, as well as on recent court decisions, in December 2000 the standard concerning "theorization" was revised to allow more flexible judgment on inventive step. Taking this opportunity, the standard concerning the requirements of description in the specification was also revised to be more specific in allowing adequate responses to diverse expressions of diverse inventions.

② Precise protection of cutting edge technology (computer, software, and gene-related inventions)

Interest in inventions relating to new business methods utilizing general-use computers and the like is on the rise, and the distribution forms of digital information have changed. As a result, in December 2000 the Examination Guidelines concerning computer software-related inventions were revised to harmonize with international practices. Furthermore, in October 1999, for DNA (fragments and complete lengths) and SNPs (single nucleotide polymorphisms causing individual differences) related inventions, "Examples of examinations on the inventions related to genes" was published. This publication shows particular judgment cases concerning enabling requirements, inventive step and other matters related to those inventions.

③ Improvement of the prior art search environment

To respond to new technical fields such as business method-related patents and gene-related patents, and to efficiently carry out international prior art searches, the JPO database has been enriched and the search functions have been improved, while the use of fee-based online databases has been expanded.

④ Cooperation with foreign patent Offices examiner exchanges

With a view to mutually sharing the results of prior art searches and examinations with the patent Offices of other countries, examiners are exchanged for the purpose of establishing the veracity of each other's examinations. In FY 2000, examiners were exchanged with the European Patent Office, UK Patent Office, German Patent and Trade Mark Office and Korean Patent Office.

⑤ Use of technical trend survey

Patent application trends as regard both technology in general as well as that of particular industrial fields are surveyed and analyzed with the goal of precise examination practices.

⑥ Preparation of search strategy files

To conserve the knowledge of individual examiners as the knowledge of the entire organization, "search strategy files" which systematically contain the information and expertise necessary for precisely searching prior art are being prepared for respective technical fields.

⑦ Initiating a study on the obligatory prior art document disclosure system

To avoid double prior art searches by applicants and examiners, and to clarify the constitution of features in comparison with the prior art, and furthermore to facilitate mutual understanding for promoting the efficient disposal of examinations, the introduction of an obligatory prior art document disclosure system is being studied. This obliges each applicant to describe any prior art documents relating to the invention desired to be patented which are known to the applicant before filing. The introduction of the obligatory prior art document disclosure system was discussed and proposed at the Legislation Sub-committee established under the Intellectual Property Policy Committee of the Industrial Structure Council.

