

# *Outline of the Examination Guidelines for Patent and Utility Model*

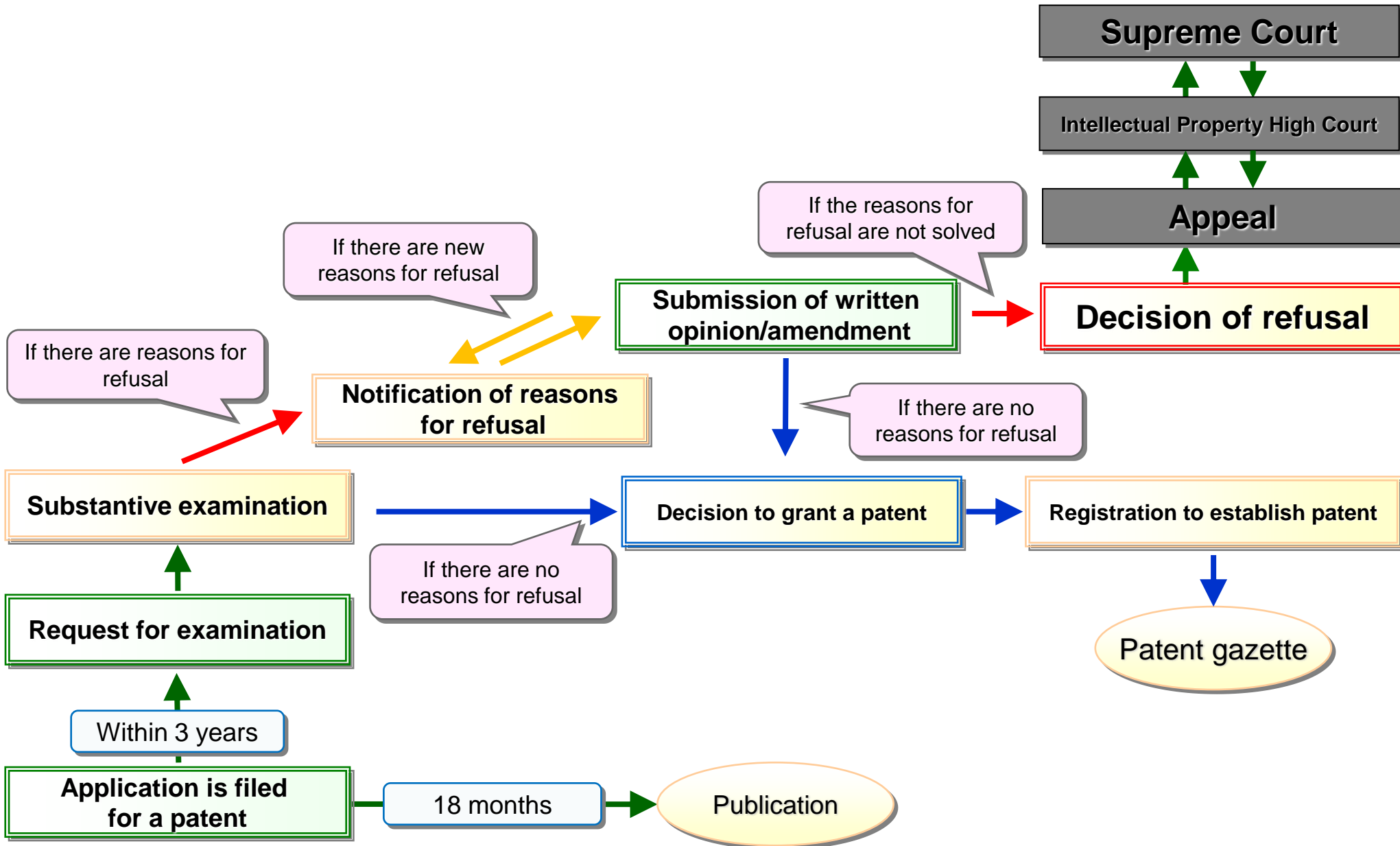
Examination Standards Office

Japan Patent Office

2022.03



# Flow of examination on patent applications (outline)

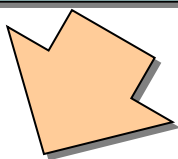


1. Introduction of the Examination Guidelines
2. Novelty and Inventive Step
3. Secret Prior Art
4. Double Patenting
5. Requirements for Description and Claims
6. Unity of Invention
7. Industrially Applicable Inventions  
(Patentable Subject Matter)
8. Amendment
9. Overview of the March 2016 revision

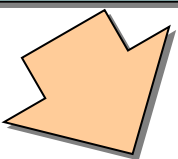
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The Examination Guidelines summarize,  
so as to ensure fairness and transparency,

***Basic ideas of when applying laws***  
such as applying the regulations in the Patent Act  
to patent examinations



Criteria for  
examinations



Indicator for  
managing patents

Examination Guidelines are available at JPO's website:

[https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu\\_kijun/index.html](https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/index.html)

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## ■ Relationship between Examination Guidelines and Examination Handbook

### ➤ **Examination Guidelines:**

Summarize the basic ideas of applying applicable laws such as the Patent Act.

### ➤ **Examination Handbook:**

Summarizes procedures and points to consider when conducting examination.

Provides sufficient case examples, court precedents and application examples useful in understanding of the basic ideas of Examination Guidelines.



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### Art. 29(1): Novelty

Inventions deserving patents should be **novel**.

An invention is novel, except when, prior to the filing, it was:

- (i) **publicly known**;
- (ii) **publicly worked**; or
- (iii) **described in a distributed publication**, or **made publicly available through an electric telecommunications** in Japan or foreign countries.

#### Determination of Novelty

Compare claimed inventions with prior art.

- |                              |   |                                     |
|------------------------------|---|-------------------------------------|
| Existence of any differences | ➡ | The claimed inventions are novel.   |
| Non-existence of differences | ➡ | The claimed inventions lack novelty |

### Art. 29(2): Inventive Step

Subject matter which a person skilled in the art would have easily made



Excluded from the subject to be granted

#### A person skilled in the art (to which the invention pertains)

means a hypothetical person who meets all the following conditions:

- ◆ who has the common general knowledge in the technical field of the claimed invention;
- ◆ who is able to use ordinary technical means for R&D;
- ◆ who is able to exercise ordinary creativity, such as selection of materials, design modifications; and
- ◆ who is able to comprehend all the matter in the state of the art in the technical field, of the claimed invention, and relevant to problems to be solved by the invention.

### Determination of Inventive Step

Determining **whether a person skilled in the art would** easily arrive at the claimed invention based on the prior art

It is determined after acquiring knowledge of claimed inventions.  
Thus, the examiner should take note to avoid hindsight as follows:

- assuming that a person skilled in the art would have easily arrived at the claimed invention.
- understanding that a cited invention is approximate to the claimed invention.

**Primary prior art**

Do NOT regard the combination of two or more independent pieces of prior art as the primary prior art.

Reasoned?

**Claimed subject matter**

- ◆ **Primary prior art:** generally, an art which is **same as or close** to the claimed invention from the aspect of **technical field or problem to be solved**
- ◆ The primary prior art of which technical field or problem to be solved is considerably different from that of the claimed invention is likely to make the reasoning difficult.
- The fact that the problem to be solved is novel and inconceivable by a person skilled in the art may be a factor in support of the existence of an inventive step.

### Reasoning

Facts in support of the non-existence of an inventive step

Facts in support of the existence of an inventive step



Comprehensively assessed

<"Multi-Factor Reasoning" (MFR)>

Facts in support of the  
**non-existence** of an inventive step

#### 1. Motivation for applying other prior arts to primary prior art:

- (1) relation of technical fields;
- (2) similarity of problems to be solved;
- (3) similarity of operations or functions; or
- (4) suggestions shown in the content of the prior art

#### 2. Design variation of primary prior art

#### 3. Mere aggregation of prior arts

Facts in support of the  
**existence** of an inventive step

#### 1. Advantageous effects

#### 2. Obstructive factors

Example: It is contrary to the purpose of the primary prior art to apply other prior art thereto.

Facts in support of the non-existence of an inventive step

### 1. Motivation for applying secondary prior arts to primary prior art

**Would it be reasoned to apply secondary prior arts to the primary prior art?**

**Comprehensively consider the following points of views**, noting that it is not always possible to determine by paying attention to only one of them:

- (1) relation of technical fields;
- (2) similarity of problems to be solved;
- (3) similarity of operations or functions; and
- (4) suggestions shown in the content of prior arts

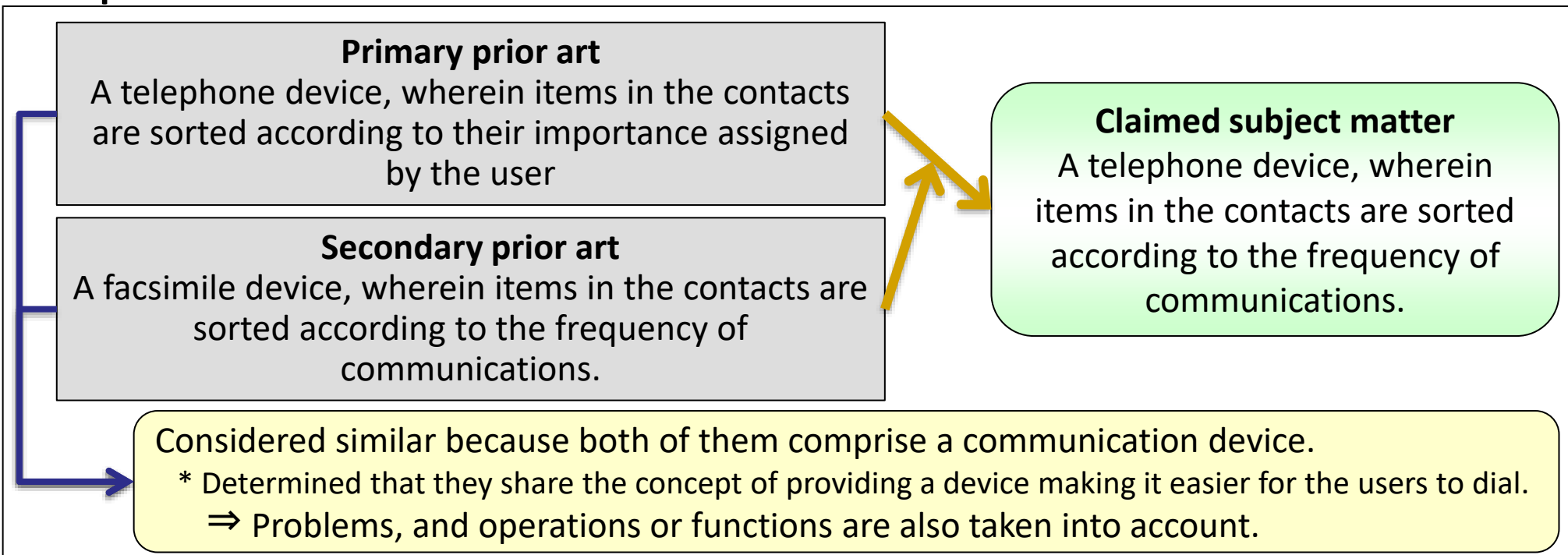
- ✓ Relation and similarity between the primary prior art and secondary prior arts should be determined.
- ✓ Applying secondary prior arts to the primary one includes the application with design variation

### 1. Motivation for applying secondary prior arts to primary prior art

#### (1) Relation of technical fields

- The examiner should consider not only the relation of technical fields, but **also other points of view**.

#### Example:

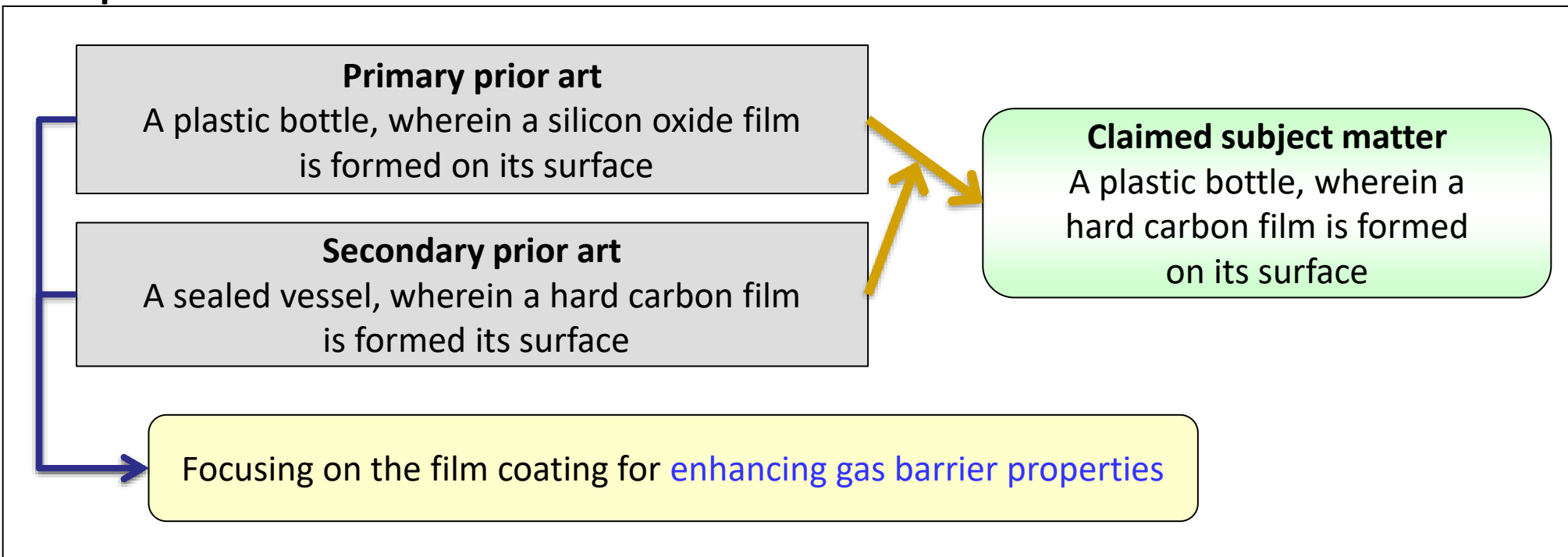


### 1. Motivation for applying secondary prior arts to primary prior art

#### (2) Similarity of problems to be solved

- Even though the problems are **obvious or easily conceivable for a person skilled in the art**, “similarity of problems” may be recognized.
- It may be different from the problem solved by the invention.

#### Example:



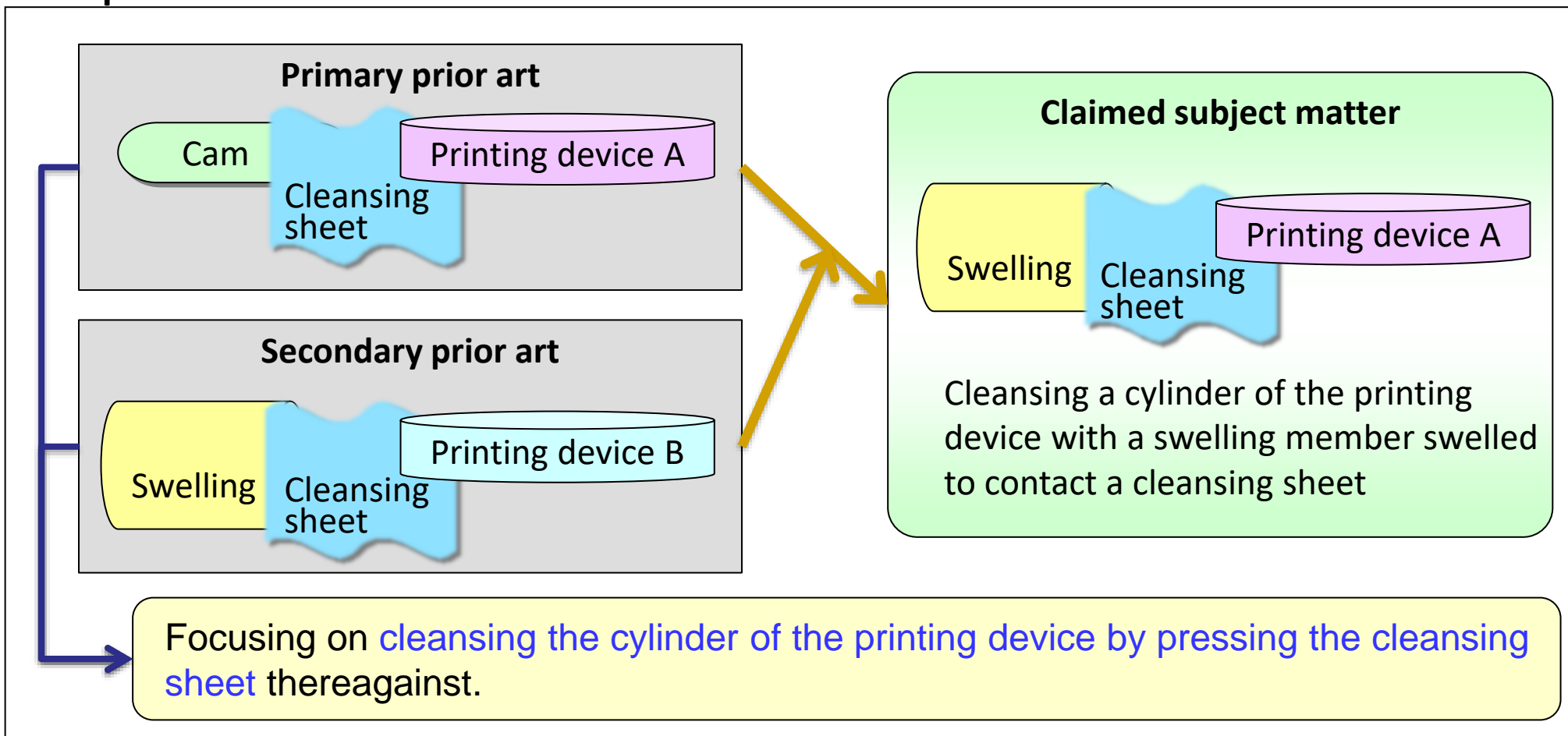


## 2. Inventive Step

### 1. Motivation for applying secondary prior arts to primary prior art

#### (3) Similarity of operations or functions

Example:

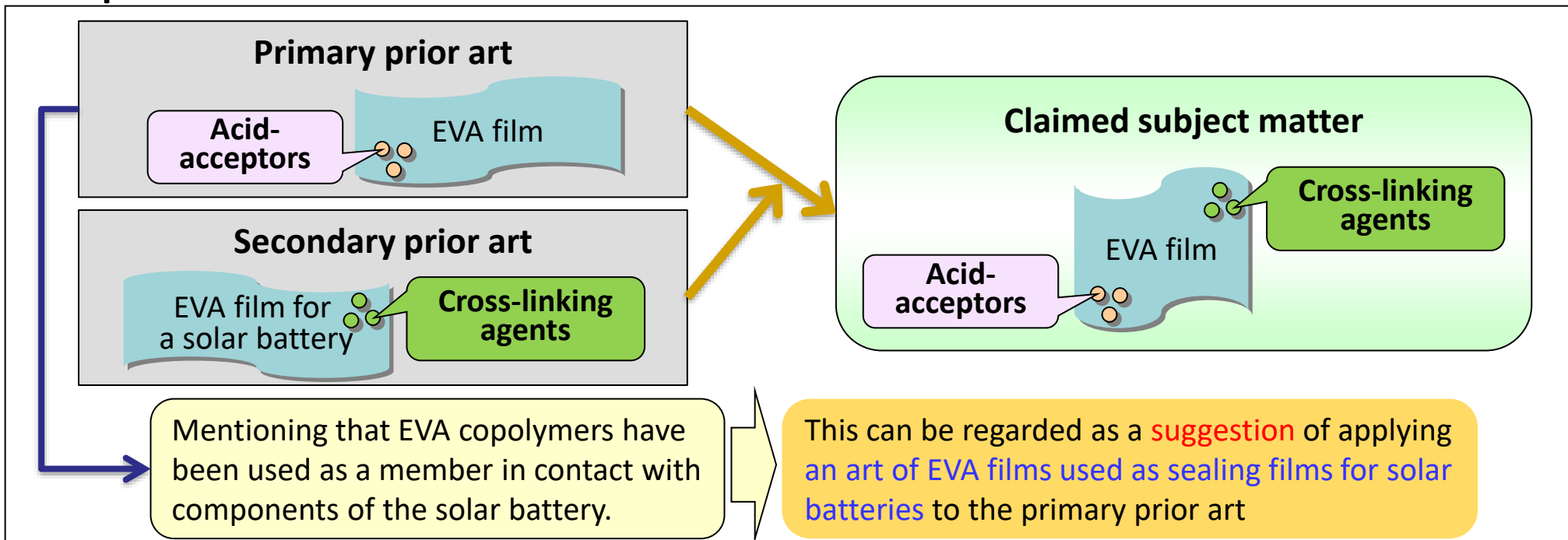


### 1. Motivation for applying secondary prior arts to primary prior art

#### (4) Suggestions shown in the content of the prior art

- **Suggestions** shown in a prior art **with regard to applying a secondary prior art to the primary prior art** may **strongly motivate** a person skilled in the art to derive the claimed subject matter by applying the secondary prior art to the primary prior art.

#### Example:



### Facts in support of the non-existence of an inventive step

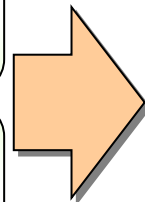
#### 2. Design variation, etc.

Selecting optimum materials

Replacing with equivalents

Optimizing numerical ranges

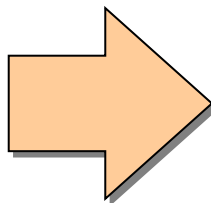
Design variation for applying specific technique



**Ordinary creativity** of a person skilled in the art

#### 3. Mere aggregation of prior arts

Mere aggregation



**Ordinary creativity** of a person skilled in the art

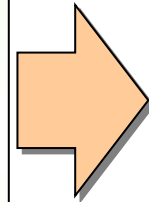
Functions or operations of claimed elements are not related to each other.

### Facts in support of the existence of an inventive step

#### 1. Advantageous effects over prior art

Where effects of the claimed subject matter satisfies following conditions and **exceed what is predictable** based on the state of the art:

- **different** from that of prior art; or
- same nature but **significantly superior**,



Such effects may **support the existence of an inventive step**

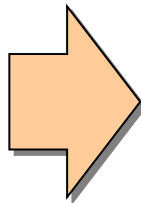
The examiner should consider **the effects argued and proved in the written argument.**

The examiner **should not consider** effects which are **neither stated in the description nor able to speculated** from the statements in the description, even if such effects are stated in the written argument.

### Facts in support of the existence of an inventive step

#### 2. Obstructive factors

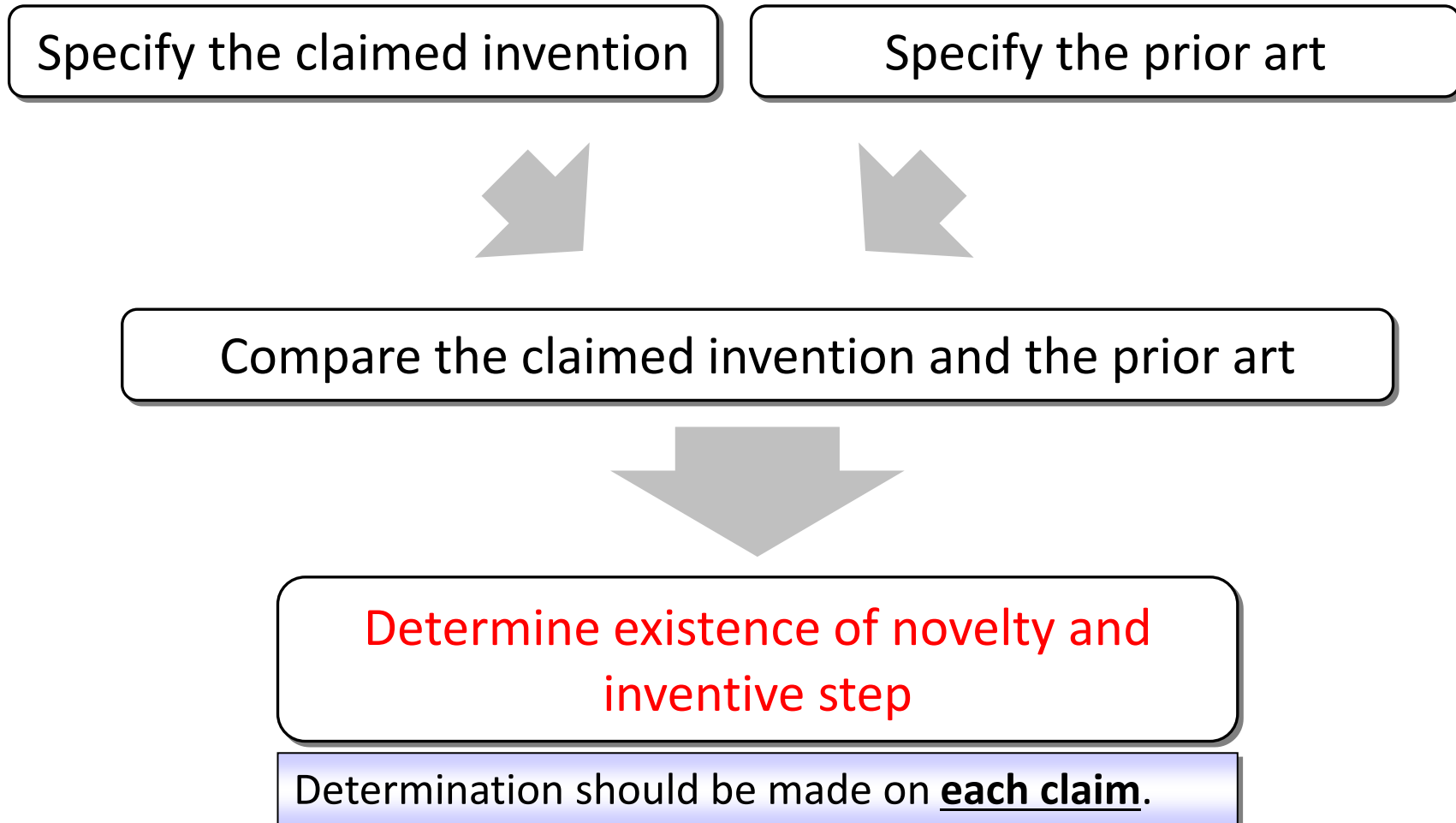
Factors obstructing the application of a secondary prior art to the primary prior art



Such factors may **support the existence of an inventive step**

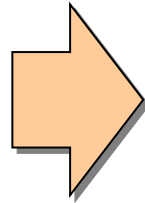
#### <Example cases of such factors>

- when applying the secondary prior art to the primary prior art is **contrary to the purpose of the primary prior art**;
- when applying the secondary prior art **makes the primary prior art unfunctional**;
- when the **application of the secondary prior art is excluded** and unable to be adopted **by the primary prior art**; or
- when a publication discloses that the secondary prior art and other embodiments and that the secondary prior art is inferior to the other embodiments **in respect to operations and effects**, and thus **a person skilled in the art would not apply that prior art** to the primary prior art.



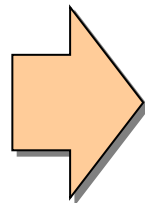
### 1. Specifying of claimed invention

Where a claim is clear



the examiner specifies the claimed invention as stated in the claim.

Where a claims is unclear



the examiner should take into consideration the statements in the description and drawings, and common general knowledge to interpret the terms used in the claim.

\* Where it is still unclear, the examiner does not specify a claimed invention.

- Claimed inventions should not be specified only from the statements in the description and drawings, without considering that in the claims.
- Elements not recited in a claim should not be taken into account for specifying of the claimed invention.
- All elements recited in a claim should be taken into account for specifying of the claimed invention.

### 1. Specifying of claimed invention

## Expression specifying a product by **its operation, function, characteristics or feature**

In principle, the claimed subject matter is construed as **all products having such function, characteristics, etc.** recited.

e.g. “wall materials comprising layers insulating heat” is construed as “all wall materials comprising any ‘layers providing heat insulation as their operation or function’”

### **Exception**

When **the function, characteristics, etc. recited are inherent to the product claimed**, such recitation is **meaningless to specify the product**, the claimed subject matter should be construed as **the product itself**.

e.g. “a chemical compound X which has **anti-cancer effects**” is construed as “compound X” as such.

- ✓ These effects are features inherent in the compound X
- ✓ Such recitation is meaningless to specify the claimed subject matter



### 1. Specifying of claimed invention

## Expression specifying a product by its use

### General principle

When the product, **use of which is recited**, is **construed as one specifically suitable for that use**, that product should be construed as **a product having structures, etc. which are defined by the use recited**

e.g. “A crane **hook** with a shape of ...”

Claimed subject  
matter specified

A hook size or intensity of which is  
specifically suitable for use in a crane

~~“A fishing hook” with a  
similar shape~~

When the product, **use of which is recited**, **does not mean one specifically suitable for that use**, **except when it should be construed as a “use invention”**, such recitation **should not be considered to specify the product claimed**.

### Expression specifying a product by its use

#### Use invention

When subject matter is claimed based on the discovery of **unknown attributes of a product** and the finding of suitability of the product for a novel use due to that attributes, **the use recited should be considered** as a specified claimed element

Even if the product itself is publicly known, the claimed subject matter is **considered as novel as a use invention.**

e.g. “composition for use in anti-fouling ship bottoms comprising a specific quaternary ammonium salt”

Novel use

**Known use:**  
undercoating for electrodeposition

The claimed subject matter may be novel even if the product itself is publicly known.

### Expression specifying a product by its use

#### Use invention

Generally, the concept of “use inventions” may apply to inventions in technical fields where it is relatively difficult to understand how to use a product based on the structure or name thereof

e.g., technical field of “use” of compositions comprising chemical compound

Machines, apparatuses, articles or instruments, etc. are, usually, not treated as “use inventions” since **the products themselves and their use are inseparable.**

#### Exception

e.g. “a compound Z for use in killing insects”

Recitation of “for use in killing insects” only refers to the utility of the compound claimed.

Construed as the compound Z itself, without any limitation by use

### 1. Specifying of claimed invention

#### Expression specifying a product by a manufacturing process

Such an expression is construed as the final product itself.

#### Example:

claim

A protein manufactured by a process P

prior art

A protein Z manufactured by a process Q

If both are the same,  
the product claimed  
**lacks novelty**

### 2. Specifying of prior art

#### Prior art disclosed in a publication

Prior art recognized on the basis of:

- the description of a publication; and
- equivalents of such description

which mean matters that a person skilled in the art can derive from the description in the publication by considering the common general knowledge at the time of filing

Where a person skilled in the art cannot understand:

- ✓ **how to make the product claimed** for an invention of a product; or
- ✓ **how to use the process claimed** for an invention of a process based on the description in the publication and the common general knowledge,

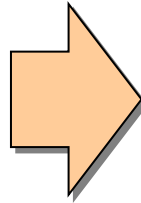
**such a publication should not be cited.**

\* Same applies to **online disclosures**

### 2. Specifying of prior art

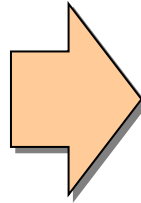
Prior arts disclosed as more generic or specific concepts in the evidence (publication, etc.)

Where the prior art is disclosed as more **specific** concepts,



the examiner may specify the prior art as generic concepts.

Where the prior art is disclosed as more **generic** concepts,



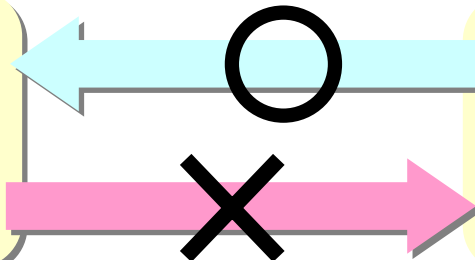
the examiner cannot specify the prior art as more specific concepts.

\* Only when more specific concepts can be derived based on the common general knowledge, the examiner may specify the prior arts as such specific concepts.

Normally, the examiner can specify

**Generic concepts**

e.g. thermoplastic resin



**Specific concepts**

e.g. polyethylene, polypropylene

Normally, the examiner cannot specify

### 3. Comparison with prior art

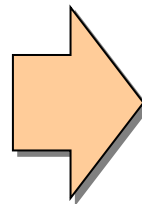
**Claimed elements**

Determine identical  
features and  
differences

**Elements of the  
prior art**

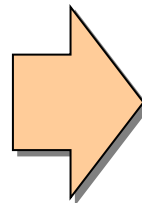
\* Combination of two or more prior arts should not be the subject of the comparison

When there are **no differences**



The claimed subject matter  
**lacks novelty**

When there are any differences but the examiner **has a reason** for denying an inventive step



The claimed subject matter  
**does not involve an inventive step**

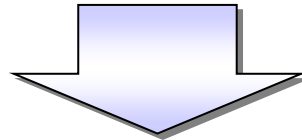
### Art. 30: Exceptions to loss of novelty

Principle

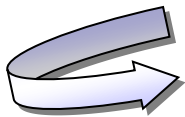
Any subject matter that has been disclosed prior to the filing of an application cannot be patented.

But

In some cases, this may be too severe for inventors. Also, that may be against the purpose of the Patent Act, that is, to contribute to industrial progress.



When an application is filed after being disclosed, under certain conditions, such prior disclosures do not destroy the novelty of the claimed invention.



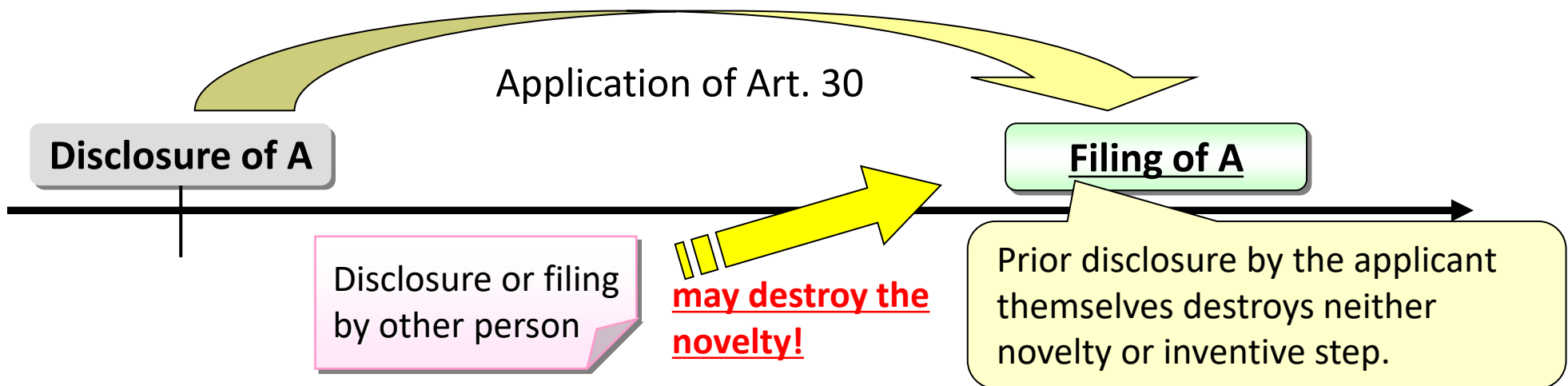
Exceptions to loss of novelty (Art. 30)



## 2. Exceptions to Loss of Novelty

### Effect of applying the exception

Whenever the exception is applied, prior disclosures may not constitute the state of the art for the determination of novelty or inventive step of claimed subject matter.



- ✓ This is not the case when the date of prior disclosure is regarded as the filing date. Therefore, the application may be rejected based on disclosing or filing of the same subject matter between them by third person.
- ✓ Note that each jurisdiction has different laws for these exceptions, called "grace period."

## 2. Requirements for Exception to Loss of Novelty

### Requirement 1 (Art. 30(2))

- ◆ Filed **within 1 year**<sup>(Note)</sup> from the disclosure
- ◆ Disclosure is the result of any action by the right holder who filed the application

### Requirement 2 (Art. 30(1)) \*No declaration is required.

- ◆ Filed **within 1 year**<sup>(Note)</sup> from the disclosure
- ◆ Prior disclosure was made **against the will** of the right holder.

(Note) Filing within 6 months from the publication date of the invention is required for the patent applications that were filed on or before June 8, 2018, or the patent applications for the inventions that were published on or before December 8, 2017.

- “Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention, Corresponding to the Patent Act Article 30 Revised in 2011” which give instructions on procedures with regard to the exception are available on JPO’s website.

Provisional English translation:

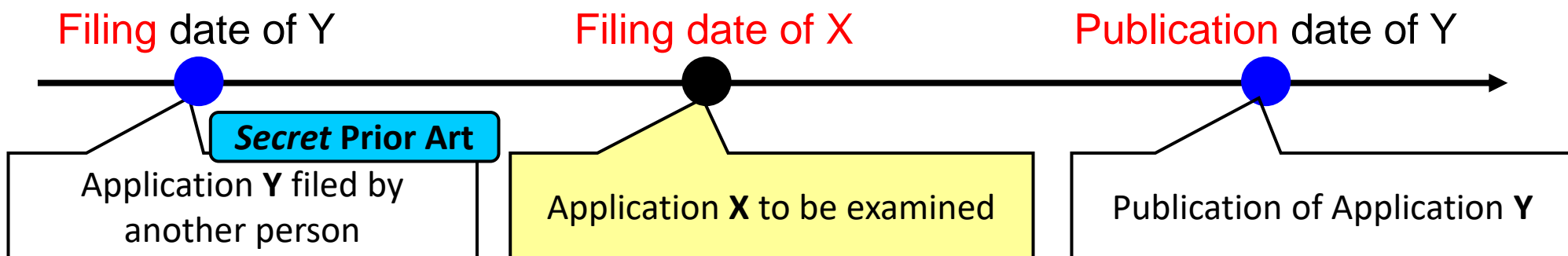
[https://www.jpo.go.jp/e/faq/yokuaru/hatumei\\_reigai.html](https://www.jpo.go.jp/e/faq/yokuaru/hatumei_reigai.html)

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## Art. 29bis: Secret Prior Art

### Basic Ideas


A claimed invention in a patent application X is not entitled to obtain a patent when an earlier application Y discloses the identical invention.



An invention disclosed in an earlier patent application will be usually, **even if it is not claimed therein**, made available to the public by its publication. Thus, publication of a later application, which contains an invention identical to the invention disclosed in the earlier application, does not disclose any new technical matter to the public, even if the later application is filed prior to the publication of the earlier application. Granting a patent for such an invention in the later applications should be avoided, because the Patent Act protects an invention as a compensation for the disclosure of a new invention.

#### Meaning of “Identical” in Art. 29bis

A claimed invention is regarded as identical with secret prior art (an earlier application) when (1) there is **no difference** between claimed elements and elements specifying the secret prior art, or (2) there is **only a minor difference** between claimed elements and elements specifying the secret prior art (**substantially identical**).



Addition to, conversion of, or deletion of well-known or commonly used technology for a prior art which does not produce any new effect

#### Anti-Self Collision

Art. 29bis does not apply to the following cases:

1. **The same inventor** files applications X and Y.
2. **The same applicant** files applications X and Y.

(Art. 29bis stipulates “anti-self collision” for secret prior art.)

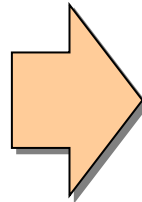
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# Art. 39: Prior Application / Double Patenting

## Basic Ideas

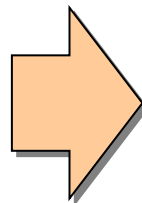
Only a person who filed first can obtain a patent for an invention.

When two or more patent applications **for the same invention** have been filed on **different dates**



Only the applicant who filed the patent application **on the earliest date** shall be entitled to obtain a patent.

Where two or more patent applications **for the same invention** have been filed on **the same date**



Only one applicant, who was **selected based on discussion** among the applicants concerned is entitled to obtain a patent.

When no agreement is reached from the discussion, **none of them** may be entitled to obtain a patent.

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### Overview of Requirements

#### Requirements for Description

- **Enablement Requirement (Art. 36(4)(i))**
- Ministerial Ordinance Requirement (Art. 36(4)(i))

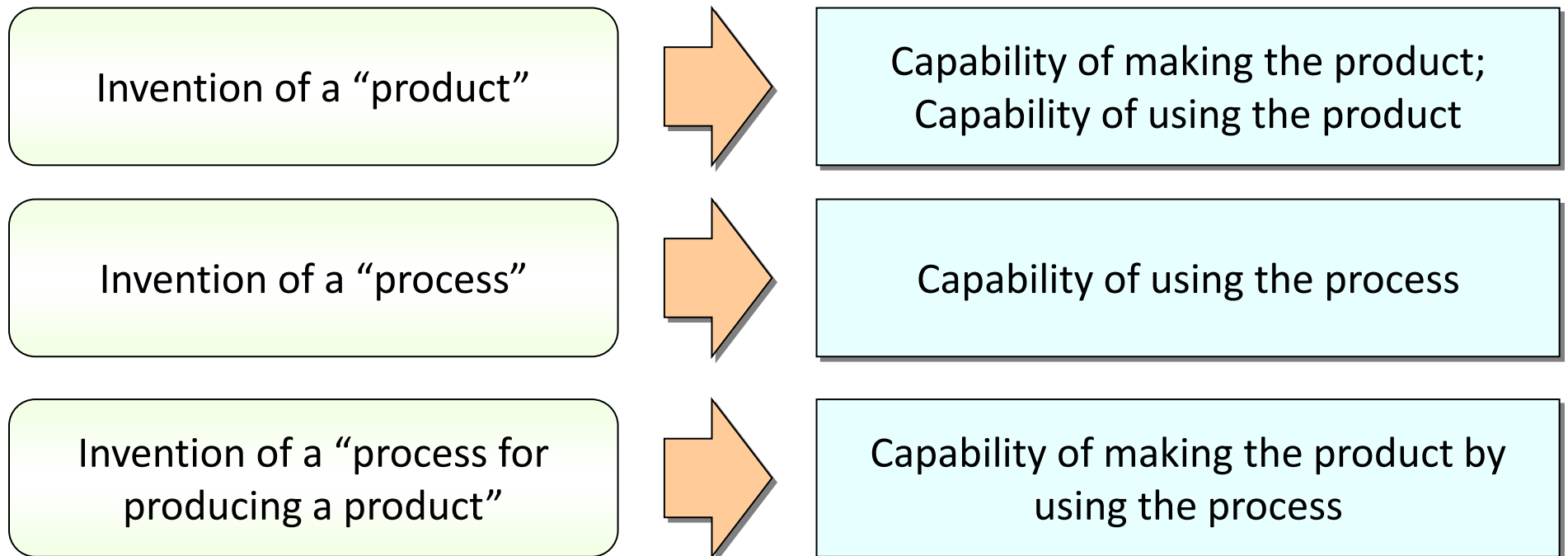
#### Requirements for Claims

- **Support Requirement (Art. 36(6)(i))**
- **Clarity Requirement (Art. 36(6)(ii))**
- Conciseness Requirement (Art. 36(6)(iii))
- Formality Requirements for Claims (Art. 36(6)(iv))

# Art. 36(4)(i): Enablement Requirement

## Basic Ideas

Statements in the **description** must be so clear and sufficient that a person skilled in the art can carry out the claimed invention in light of the common general knowledge at the time of filing.



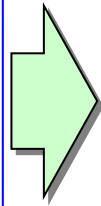
## 5. Requirements for Description

### Concrete Outline of Enablement Requirement

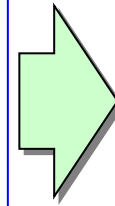
#### Invention of a “product”

#### (1) Capability of making the product

In technical fields where it is difficult to understand the structure of the claimed product based on its operations or functions



where a person skilled in the art cannot understand how to make products other than ones of which the manufacturing process is specifically described,

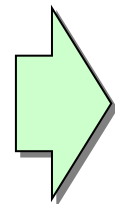


**Failure in complying with this requirement**

e.g. When it is necessary to conduct **trials and errors, complicated/advanced experiments, etc. that exceed what can be expected from a person skilled in the art**, in order to make such a product.

#### (2) Capability of using the product

In cases of an invention of a chemical agent



it is necessary to describe at least one specific use, which is technically significant, of the product.

## 5. Requirements for Description

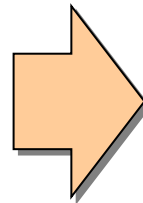
Extent to which details should be disclosed

Where it is required for a person skilled in the art to carry out the invention, **working example(s)**, i.e., detailed embodiment(s) of the claimed invention, need to be described.



e.g., how to use and make the claimed product (for an invention of a product)

For “use inventions” that utilize characteristics etc. of the product (e.g., medicines)



it is usually required to provide examples **supporting** that use

**Not required when, without working examples,** a person skilled in the art can understand how to carry out the invention based on the description, drawings, as well as in light of common general knowledge.

### Types of Violations of Enablement Requirement

#### (1) Improper statement of embodiments

The description does not satisfy the enablement requirement when **no numerical values such as manufacturing conditions is stated** and a person skilled in the art cannot understand them even in light of **the common general knowledge at the time of filing**, and thus such a person cannot carry out the claimed invention.

e.g. “pencil lead comprised of carbon which is produced by kneading and firing graphite and bonding material, wherein the pencil lead has a specific rate of holes, size of holes, and distribution of holes.”

The description does **not disclose** how to select materials and conditions for manufacturing the pencil lead claimed.

It was the **common general knowledge at the time of filing**, with regard to the rate, size and distribution of holes in pencil lead, that it would be difficult to control them and materials and conditions for kneading, extruding and firing etc. would be closely related to them.

To select materials and manufacturing conditions, a person skilled in the art needs to make trials and errors, or complicated and sophisticated experimentation beyond the reasonably expected extent.

### Types of Violations of Enablement Requirement

#### (2) Incapability of carrying out a part of the claimed invention other than embodiments

Cases where a claim recites the definition of a product based on a **result to be achieved** and only a part of the claimed invention is stated so as to be carried out as an embodiment but the other parts are not.

e.g. “a hybrid car, energy efficiency of which while running on electricity is a% to b%, as measured by an X test method”

##### Claimed Invention

**Any hybrid car** the energy efficiency of which is a% - b%

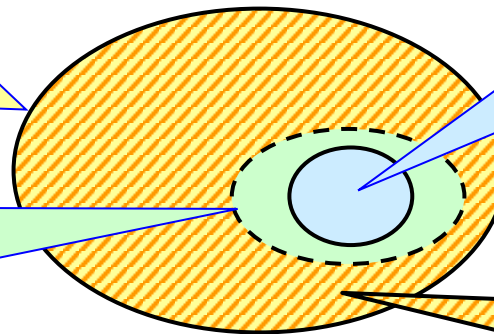
##### Part capable of being carried out

A hybrid car comprising **a control means Y** (which is a generalized concept of y)

##### Working example

A hybrid car comprising **a specific control means y**

##### Part incapable of being carried out



### Notice of Reasons for Refusal Regarding Enablement Requirement

The examiner explains  
**specific reasons**

Grounds for determination

- Relevant part in the description
- Details of the common general knowledge, etc.

Example:

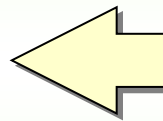
- The description discloses only a hybrid car comprising the control means y as an embodiment of a hybrid car achieving such an energy efficiency.
- In technical fields related to hybrid cars, it is the common general knowledge that the energy efficiency measured by the test method X is usually around x%, that is much lower than a%, and it is difficult to achieve higher efficiency such as a% - b%.
- A person skilled in the art cannot understand how to carry out the claimed subject matter except when the control means Y is adopted.

## 5. Requirements for Description

### Applicants' Response to Notice Regarding Enablement Requirement

#### Example 1:

Arguing that the enable requirement is satisfied in a written argument



Common general knowledge different from one presented by the examiner, etc.

\* The applicant may submit certificates of experimental result to support the argument.

#### Example 2:

Amending the claim concerned by limiting the scope of the claimed invention so as to satisfy the enablement requirement

\* It is not required to limit up to the working example.

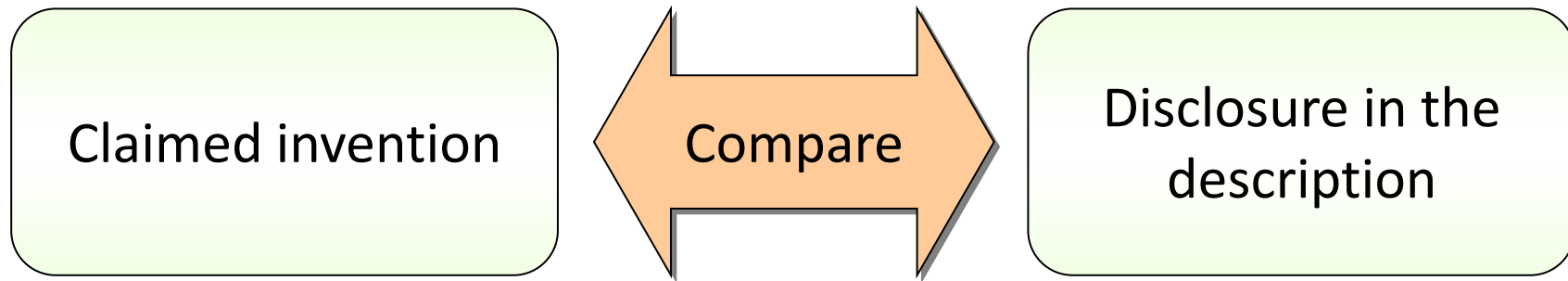
e.g. “a hybrid car comprising a control means Y” (more generic than y)



# Art. 36(6)(i): Support Requirement

## Basic Ideas

Claimed invention shall not go beyond the scope of disclosure in the description.



Examination should be conducted to determine 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.

### Types of Violations of Support Requirement

- (1) A **claimed element is neither stated nor implied** in the description
- (2) Due to the **inconsistency of terms** used in the claim and the description, the correspondence between them is unclear
- (3) Details provided in the description can be **neither expanded nor generalized** to the scope of the invention claimed even in light of the common general knowledge
- (4) Due to **no recitation**, in a claim, **of any solutions for the problem** stated in the description, the scope of the claimed invention goes beyond the scope of disclosure in the description

### Types of Violations of Enablement Requirement

#### Example of Type (3) of Violations of Support Requirement

Details provided in the description can be **neither expanded nor generalized** to the scope of the invention claimed even in light of the common general knowledge

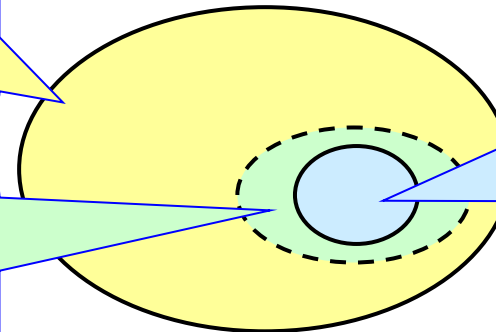
e.g. “a hybrid car, energy efficiency of which while running on electricity is a% to b%, as measured by an X test method”

##### Claimed Invention

Any **hybrid car** the energy efficiency of which is a% - b%

##### The extent to which a skilled person can expand or generalize

A hybrid car comprising **a control means Y** (which is a generalized concept of y)



##### Details provided in the description

A hybrid car comprising **a specific control means y**

### Notice of Reasons for Refusal Regarding Support Requirement

The examiner explains  
**specific reasons**

Grounds for determination

- Relevant part in the description
- Details of the common general knowledge, etc.

Example:

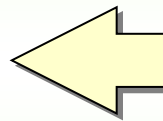
- The description discloses only a hybrid car comprising the control means y as an embodiment of a hybrid car achieving such an energy efficiency.
- In technical fields related to hybrid cars, it is the common general knowledge that the energy efficiency measured by the test method X is usually around x%, that is much lower than a%, and it is difficult to achieve higher efficiency such as a% - b%.
- There are no grounds for motivating a person skilled in the art to expand or generalize the details provided in the description up to the scope of the claimed invention defined only by the energy efficiency.

## 5. Requirements for Claims

### Applicants' Response to Notice Regarding Support Requirement

#### Example 1:

Arguing that the support requirement is satisfied in a written argument



Common general knowledge different from one presented by the examiner, etc.

\* The applicant may submit certificates of experimental result to support the argument.

#### Example 2:

Amending the claim concerned by limiting the scope of the claimed invention so as to satisfy the support requirement

\* It is not required to limit up to the working example.

e.g. “a hybrid car comprising a control means Y” (more generic than y)

# Art. 36(6)(ii): Clarity Requirement

## Basic Ideas

Subject matter should be clearly specified from each claim

### For clearly understanding inventions

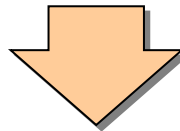
It is necessary for the scope of the invention to be clear, that is, the claim must be clear enough for a person skilled in the art to determine whether or not a specific product or process falls within the scope of the invention.

## Types of Violations of Clarity Requirement

- (1) The **statement** in a claim itself is **unclear**, and thus the claimed invention is unclear.
- (2) Claimed element has **technical defects**, and thus the claimed invention is unclear.
- (3) The **category** of the claimed invention is unclear or the invention does not fall within one of the statutory categories, and thus, the invention is unclear.
- (4) Claimed element is expressed by **alternatives which do not share similar features or functions**, and thus the claimed invention is unclear.
- (5) Expression which **may introduce ambiguity** is recited in a claim, and thus the scope of the claimed invention is unclear.

### Claims Including Specific Expressions Regarding Clarity Requirement

- Expression specifying a product by its **function, characteristics, etc.**
- Expression specifying a product **by a manufacturing process**



Applicants may use such expressions in their discretion.  
However, there are some cases where, due to such expressions, the claimed invention is unclear. Such cases will be explained.

## 5. Requirements for Claims

Expression specifying a product by its function, characteristics, etc.

### Types of unclear inventions

- (1) Cases where, even considering the description, drawings and common general knowledge, the **meaning** (definition, method of testing/measuring, etc.) of the functions, characteristics, etc. recited in a claim cannot be understood, and thus the claimed invention is unclear.
- (2) Cases where **it is obvious that elements specified by functions, characteristics, etc. are not sufficiently specified technically** while taking into consideration the common general knowledge, and a person skilled in the art cannot understand the claimed invention from the statements in a claim even taking into consideration the description and drawings.

e.g. “a compound which has an R receptor activating effect” (R receptor is newly found by the applicant)

It is the **common general knowledge at the time of filing** that it is difficult to understand how and what the compound **only** specified by its function specifically is.

It is **obvious** that specifying by only such a function without its chemical structure required to have that function is **not sufficient** to define the compound **from the technical perspective**.

The claimed invention cannot be specified by a claim.



## 5. Requirements for Claims

### Claims defining a product by a manufacturing process of the product – part1

For determination of novelty and inventive step, such a claim should be construed as **the product itself** produced by the process.

### Types of unclear inventions

- (1) Cases where a person skilled in the art cannot understand **a manufacturing process (starting material, steps of the process, etc.)** of the product based on the statements in the description and drawings as well as the common general knowledge at the time of filing, and thus the claimed subject matter is unclear.
- (2) Cases where, even taking into consideration the description, drawings and the common general knowledge, a person skilled in the art cannot understand **the features of the product (structure or characteristics, etc.)**, and thus the claimed subject matter is unclear.

e.g. “Wash-free rice produced by a manufacturing process A”

\* Claimed invention of a product is defined only by a manufacturing process

Description stated that they can **efficiently produce wash-free rice** by using a manufacturing process A.

Even in light of the common general knowledge, a person skilled in the art **cannot understand the features of wash-free rice produced** by the process A

Cannot specify an invention by a claim

Only features not reflected on the product are described.

Claims defining a product by a manufacturing process of the product – part2

### Product-by-process claims (PBP Claims)

(Claims for inventions of products reciting manufacturing processes of the products)

When a claim for an invention of a product recites the manufacturing process of the product, the claim satisfies the clarity requirement only if **circumstances exist under which it is impossible or utterly impractical**, at the time of filing, to directly define the product based on its structure or characteristics.

( Supreme Court Judgments on June 5, 2015 (Case Nos. 2012 (Ju) 1204 and 2658), Cases of “Pravastatin Sodium” )

Examples of such circumstances are as follows:

- (i) it would be **technically impossible** to analyze the structure or characteristics of the product at the time of filing; or
- (ii) it would require **significantly excessive spending or time** to define the structure or characteristics of the product, from the perspective of the nature of patent applications.

# 5. Procedures for Examinations involving PBP Claims

See Examination Handbook 2203-2205 for details

Does a claim recite (at least partially) a manufacturing process of a product? <sup>\*1</sup>

YES

NO

Claim is clear

Examples **NOT** corresponding to PBP Claims:

"An item in which a resin composition has been cured"

"A laminated film formed by placing a layer C between a layer A and B"

"Plating layer"

Is it a case where the existence of "impossible or impractical circumstances" <sup>\*2</sup> is recognized?

NO

YES

Claim is clear

Examples where it is **impossible/unrealistic circumstances** to define a product based on structure, characteristics, etc.:

"A cell created by a novel genetic manipulation"

"A monoclonal antibody prepared by a hybridoma cell A"

"Animal and plant obtained by the breeding method such as crossbreeding"

Notification of reasons for refusal (claim is **not clear**)

## Applicants' Possible Actions

Presenting **arguments and verification as to the existence of the "impossible or impractical circumstances"** in written arguments, etc.

### Amendments:

- **manufacturing process;**
- **product not reciting the process** (i.e., deleting recitation of the process);
- **deleting claims concerned.**

**Arguments** that a manufacturing process is **NOT** recited in a claim.

**Any reasonable doubt** against the applicant's argument

**No reasonable doubts** <sup>\*3</sup> against the applicant's argument

Claim still **recites a process**

Claim does **not recite any process**

The arguments **not acceptable**

The arguments **acceptable**

Decision of refusal

Claim is clear

Decision of refusal

Claim is clear

Decision of refusal

Claim is clear

<sup>\*1</sup> when it is clear what structure or characteristics of the product are represented by the manufacturing process considering the description etc. as well as common general knowledge, the examiner does not consider that the claimed invention violates the clarity requirement because it corresponds to the case.

<sup>\*2</sup> any circumstances in which it is impossible or utterly impractical to define the product directly based on its structure or characteristics.

<sup>\*3</sup> the examiner will, normally, conclude "No reasonable doubts" unless the examiner has doubts based on a tangible reason.

1. Introduction of the Examination Guidelines
2. Novelty and Inventive Step
3. Secret Prior Art
4. Double Patenting
5. Requirements for Description and Claims
- 6. Unity of Invention**
7. Industrially Applicable Inventions  
(Patentable Subject Matter)
8. Amendment
9. Overview of the March 2016 revision

# Art. 37 : Unity of Invention

### Basic Ideas

Two or more inventions may be the subject of a single patent application. These **inventions should be a group** recognized as fulfilling the requirements of unity of invention **based on their technical relationship**.

### Rule 25octies (Regulations under the Patent Act)

- (1) The technical relationship...two or more inventions must be linked so as to form a single, general inventive concept by having the same or corresponding **special technical features** among them.
- (2) The special technical feature provided in the former paragraph means any technical feature that defines the contribution made by an invention over the prior art.

### Special Technical Feature (STF)

- An STF is any technical feature that clearly indicates the contribution over any prior arts.
  - An STF is identified based on the content of the description, claims, drawings, and the common general knowledge at the time of filing.
- Any feature that does not make a contribution over prior art is not an STF.

#### Typical Cases

- Features found in the prior art.
- Addition to, conversion of, or deletion of well-known or commonly used technology for a prior art which does not produce any new effect

### Subject of examinations

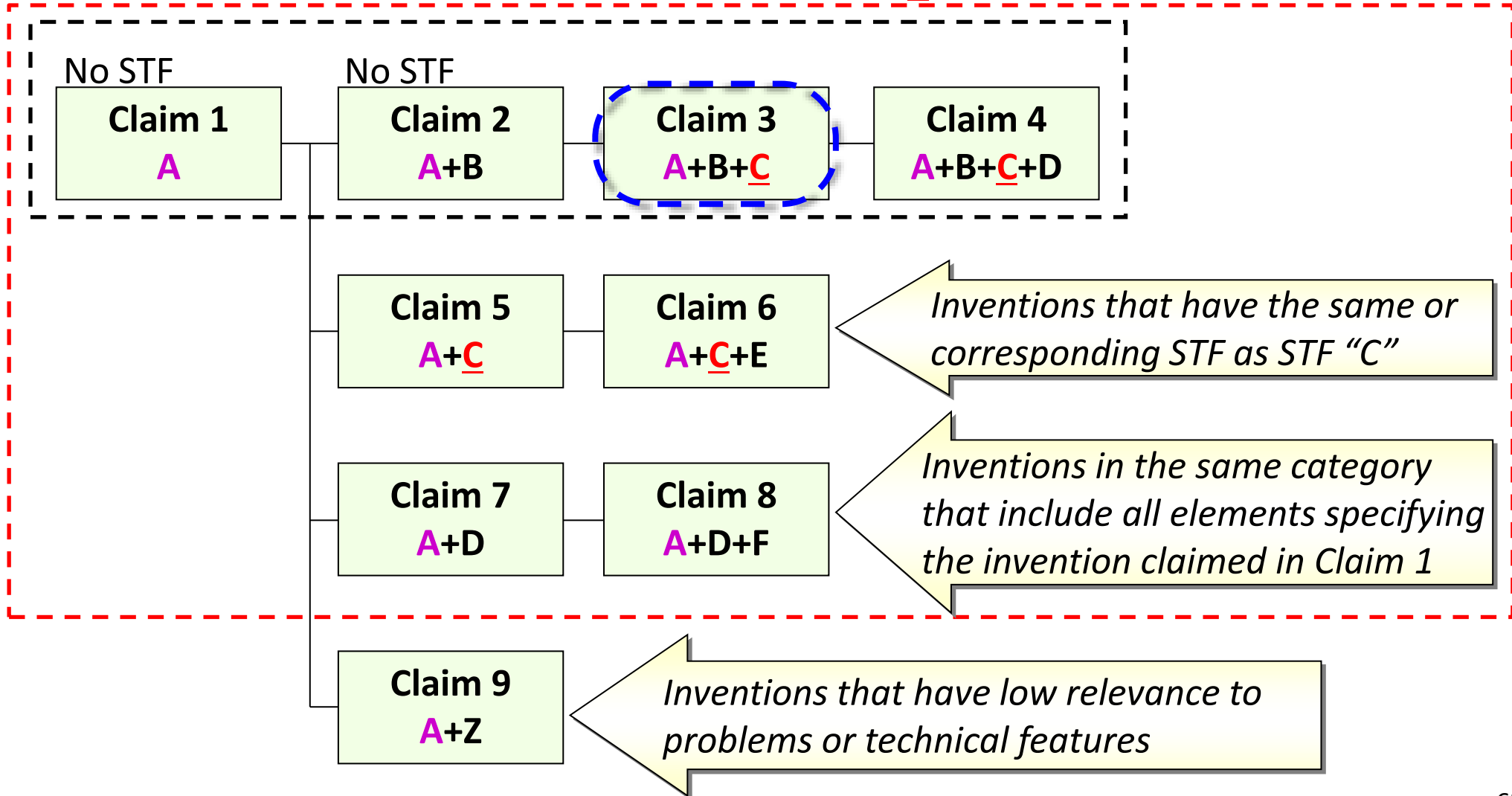
Regardless of whether or not the invention claimed in Claim 1 has an STF, the following inventions are the subject of examinations:

- (1) Inventions that will be the subject of examinations based on STF:
  - a. Inventions that have the **same or corresponding STF**, as the STF that has been found
  - b. Inventions for which the existence of an **STF has already been determined**
- (2) Inventions found to be efficient to examine together with the inventions mentioned in (1) above
  - c. Inventions in the **same category that include all claimed elements in Claim 1**  
(excluding those with low relevance to inventions claimed in claim 1 in terms of problems to be solved or technical features)
  - d. Inventions that **can be substantially examined without conducting additional prior art searches** or making additional determinations, etc.

## 6. Unity of Invention

### Examination Flow

Technical Feature “C” is an STF





1. Introduction of the Examination Guidelines
2. Novelty and Inventive Step
3. Secret Prior Art
4. Double Patenting
5. Requirements for Description and Claims
6. Unity of Invention
- 7. Industrially Applicable Inventions  
(Patentable Subject Matter)**
8. Amendment
9. Overview of the March 2016 revision

# 1. Statutory Invention

## Basic Ideas

“Invention” is an advanced creation of technical ideas utilizing the laws of nature

Utilizing the laws  
of nature



Technical idea



Creation



Advancement

**(NG) Laws of nature per se**  
**(NG) Anything going against laws of nature**  
**(NG) Artificial arrangement in addition to not utilizing laws of nature**



Study method

Not patentable  
if an invention  
is a human  
mental activity

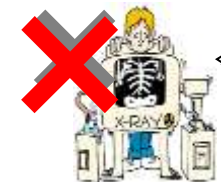
**(NG) Personal skills (such as those acquired through personal experience and which cannot be shared with others as knowledge due to lack of objectivity)**



Method of throwing fork ball

A personal  
skill is not  
patentable

**(NG) A mere discovery of a microorganism in nature**  
**(OK) A microorganism that is artificially isolated from a natural product**



Discovery of X-ray

Mere discovery  
of X-ray is not  
enough

This is used just to differentiate "invention" from "device" under the Utility Model Act, and is disregarded in determination.

# 2. Industrial Applicability

### Types of Violation of Industrial Applicability

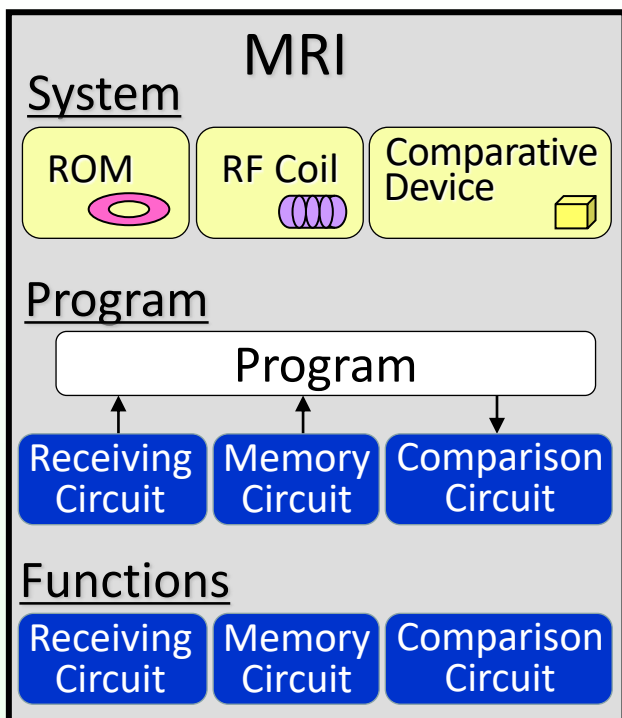
- ✓ **Methods of treatment of the human body** by surgery or therapy, and diagnostic methods practiced on the human body
- ✓ **Commercially inapplicable** inventions  
(Anything made or used only for personal use, or academic or experimental purposes.)
- ✓ Inventions that are **not practical**

## 7. Special Features

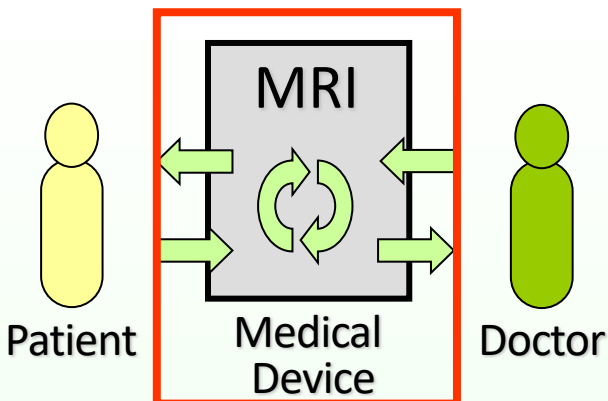
### Methods for Operating Medical Machines

#### Patentable

##### Medical Device



##### Methods of Operating

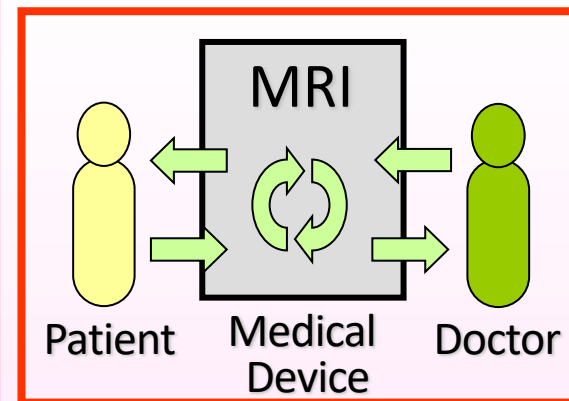


**Functions that the device itself has is described.**

Operations performed by doctors and any direct operations performed by machines on the human body are excluded.

#### Unpatentable

##### Methods for treating the human body



### Computer Program

Computer programs may be patentable as an invention of a product if information processing by software cooperates with hardware.

1. Introduction of the Examination Guidelines
2. Novelty and Inventive Step
3. Secret Prior Art
4. Double Patenting
5. Requirements for Description and Claims
6. Unity of Invention
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(Patentable Subject Matter)
- 8. Amendment**
9. Overview of the March 2016 revision

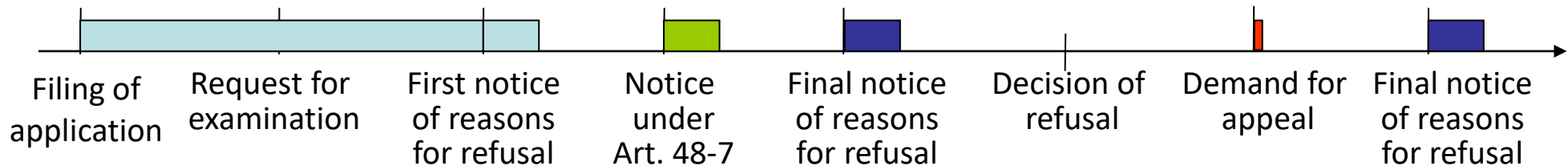
### Art. 17bis: Amendment

#### Basic Ideas

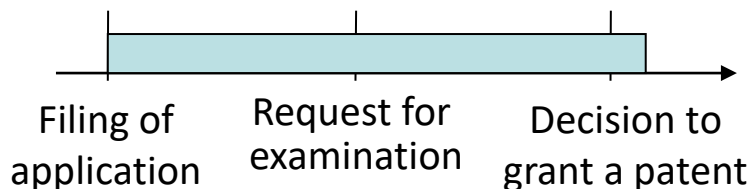
Amendments shall be made within the scope disclosed in the original application.

Time restriction has been set in order to avoid irregular circumstances from occurring, such as delays in conducting the prescribed procedures, which could result if applicants could make amendment at any time.

#### Case of decision for refusal



#### Case of decision to grant a patent without any notices



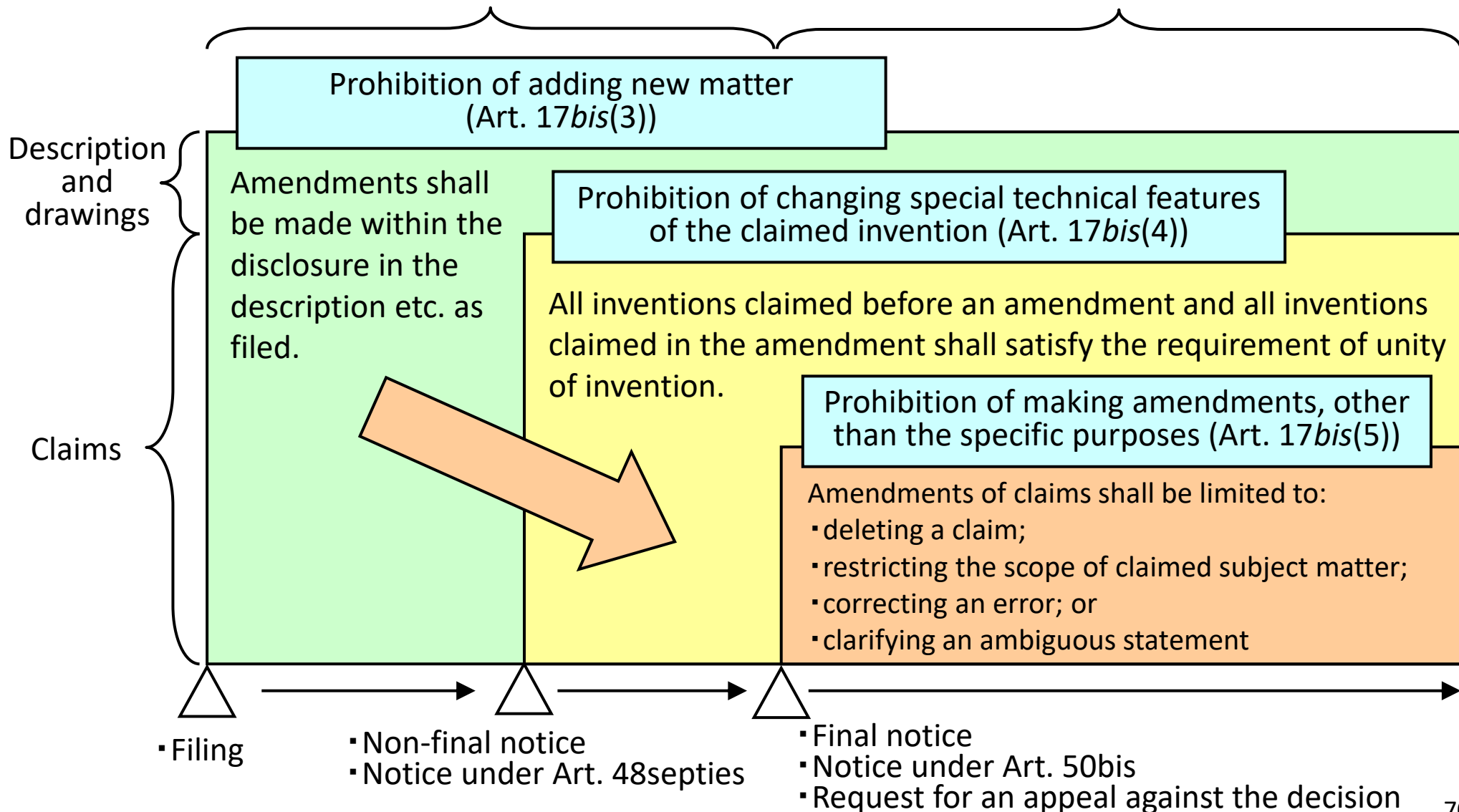
If it is necessary to correct after the decision to grant a patent...

- request a trial for correction (Art. 126);
- request for correction in a trial for invalidation (Art. 134bis)

## 8. Requirements for Amendments – Substantive Requirements

Non-compliance with substantive requirements **constitutes reasons for refusal.**

Non-compliance with substantive requirements constitutes a reason for **dismissal of the amendment**





### Procedure of determination

The examiner determines whether or not an amendment adds new matters by determining **whether or not it introduces any new technical matters** in relation to the matters stated in the description etc. as filed (\*).

(\*) “Matters stated in the description etc. as filed” mean technical matters derived from all the statements in the description etc. as filed by a person skilled in the art who fully considers the statements.

Amendments into matters:

- ① **explicitly stated** in the description etc. as filed ⇒  allowable
- ② **obvious** from the statements in the description etc. as filed ⇒  allowable
- ③ Even in cases not falling within cases above, amendments may be allowed. The examiner should determine the acceptability of amendments **with taking into consideration cases allowable and unallowable** shown in 3.3 of the Chapter of the Examination Guidelines for Patent and Utility Model in Japan.

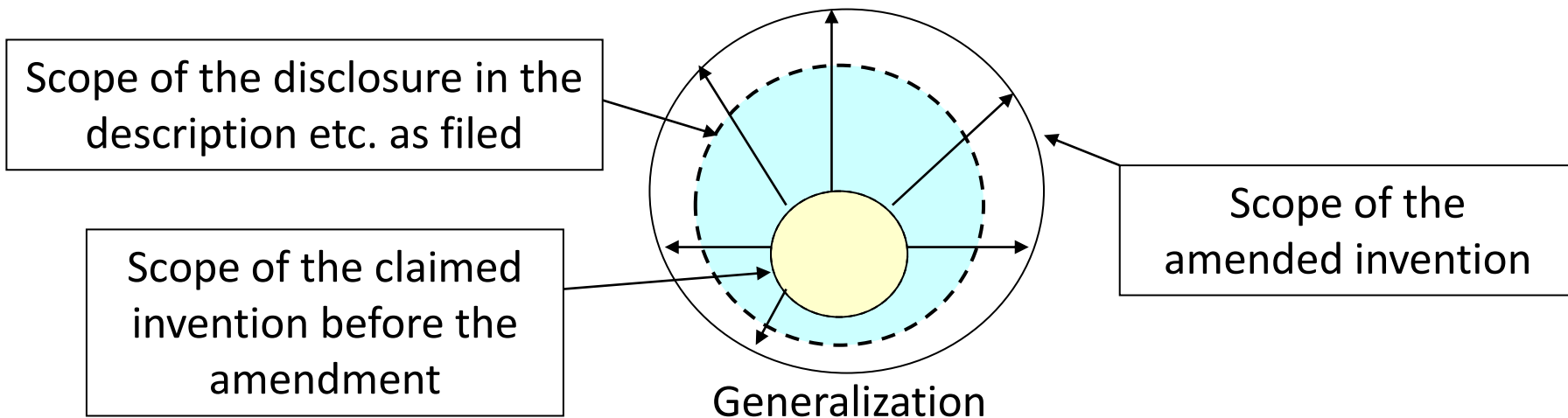


## 8. Prohibition of Addition of New Matter

### (1) Generalizing, deleting, or changing elements

- ① Amendments which introduce new technical matters by generalizing, deleting, or changing elements claimed are

➡  unallowable



- ② When an amendment deletes a part of claimed elements and it is **obvious that no technical significance is newly added** to the claimed invention by the amendment, such an amendment is

➡  allowable

In cases, for example, where the deleted elements are irrelevant to the problem to be solved by the claimed invention and optional and additional one, the deletion may fall under this type.

### (1) Generalizing, deleting, or changing elements

Description etc. before amendment

#### Title of Invention

Pachinko machine

#### Claim 1

A pachinko machine comprising a variable display ...

#### Overview of the description

A pachinko machine ...

(The description states only the pachinko machine in a consist way.)

Description etc. after amendment

#### Title of Invention


Amusement machine

#### Claim 1

An amusement machine comprising a variable display ...

#### Overview of the description

An amusement machine ...

[Determination]  The amendment adds new matter.

[Explanation] The description etc. as filed does **neither provide statements** from which a person skilled in the art can recognize that the pachinko machine is an example of amusement machines **nor imply** that “a variable display” is commonly used for amusement machines. Since there are no clues to understanding that the variable display is commonly used for amusement machines, “an amusement machine comprising [the] variable display” **cannot be regarded, by such a person, as the same as stated in the description etc. as filed.** Further, there are no exceptional circumstances where the amendment does not introduce any new technical matters.

## 8. Prohibition of Addition of New Matter

### (1) Generalizing, deleting, or changing elements

Description etc. before amendment

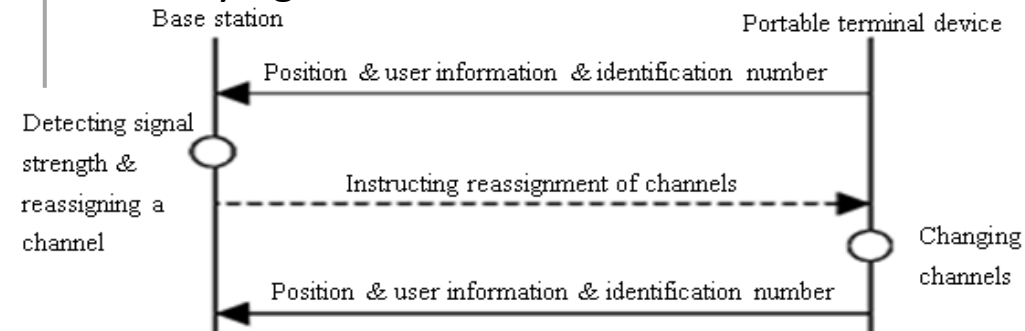
#### Claim 1

A mobile communication system comprising a portable device and a base station communicating with the portable device; wherein the device transmits coordinates of the location and **the user information** of the device as well as an identification number used for identifying the device through an unoccupied channel selected from a plurality of dedicated physical channels, ...

Description etc. after amendment

#### Claim 1

... wherein the device transmits coordinates of the location **[((deleted))]** of the device as well as an identification number used for identifying the device are ...



[Determination]  The amendment does not add new matter.

[Explanation]

Transmitting only “coordinates of the location” and “identification” to the base station is not stated in any parts of the description etc. as filed. The problem to be solved by the claimed invention is, however, to provide information depending of the location regardless of the status of communication in each dedicated channel and the solution therefor is to transmit the “signal for reallocation” and switch channels in response to the signal. In addition, the **“user information” is irrelevant to the problem and an optional and additional matter, and thus, the amendment does not introduce any new technical matters.**

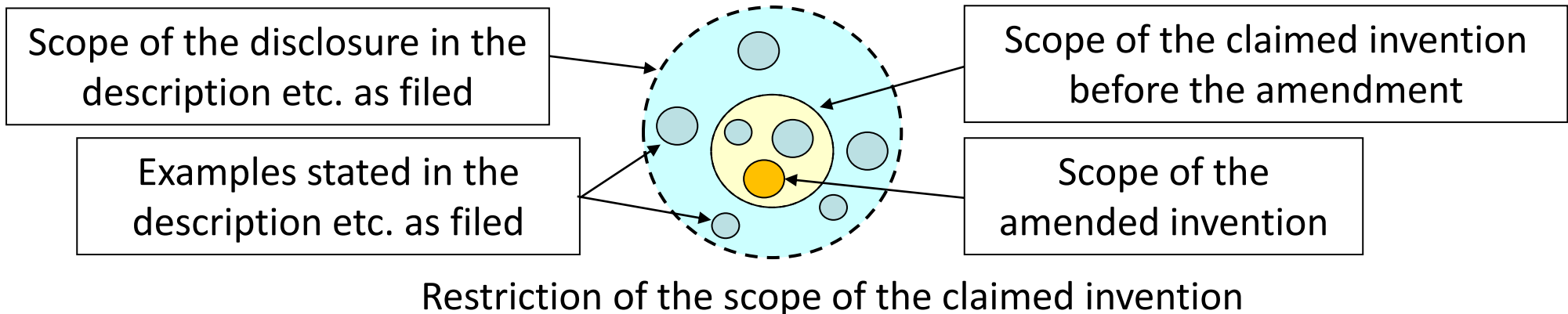
### (2) Limiting or adding elements

- ① Amendments which limit claimed elements and restrict the scope of the claimed invention up to the matters explicitly stated or obvious from the statements, or
- ② amendments which limit the scope of the claimed invention not to those matters, but by which it is obvious that no technical significance is newly added to the invention

➡ ○ are allowable.

- ③ Amendments which restrict the scope of the claimed invention, but by which matters other than what stated in the description etc. as filed are individualized

➡ ✖ are unallowable.



### (2) Limiting or adding elements

Description etc. before amendment


#### Claim 1

A device for recoding and reproducing information, wherein ...

Description etc. after amendment

#### Claim 1

A device for recording on a disc and reproducing from the disc, wherein ...

[Determination]  The amendment does not add new matter.

[Explanation]

Even though, in the description etc. as filed, only a reproducing device intending CD-ROMs is stated as an example, it is evident, in light of other statements in the description etc. as filed as well as the common general knowledge, that the solution of the problem stated in the application (configuration of power supply when the device does not receive the instruction to reduce power consumption) may be applied to any recoding/reproducing device intending any disc-type media.

### (2) Limiting or adding elements

Description etc. before amendment

#### Title of Invention

Therapeutic agents for digestive system diseases

#### Claim 1

A therapeutic agent for digestive system diseases comprising a chemical compound A as an active ingredient.

#### Overview of the description

The present invention relates to an agent which has an effect of protecting alimentary canal mucosa.

Description etc. after amendment

#### Title of Invention


...

#### Claim 1

A therapeutic agent for pancreatitis comprising a chemical compound A as an active ingredient.

#### Overview of the description

...

[Determination]  The amendment adds new matter.

[Explanation] Any parts in the description etc. as filed do **not state** a therapeutic agent for pancreatitis, and, even taking into consideration all the statements in the description etc. as filed and the common general knowledge at the time of filing, it is **not obvious for a person skilled in the art** that a therapeutic agent for digestive system diseases which has an effect of protecting alimentary canal mucosa may mean that for pancreatitis. Further, there are no exceptional circumstances where the amendment does not introduce any new technical matters.

### (3) Adding or changing numerical limitation

- ① Amendments which do not introduce any new technical matters by adding numerical limitations



Example: Even though the existence of working examples at 24 and 25 degrees does not immediately imply an amendment which adds a numerical limitation such as “at 24–25 degrees” may be allowable. There are, however, cases where it can be recognized, based on all the statements in the description etc. as filed, that a specific range between 24 and 25 degrees has been referred to and thus such amendments are allowable. (E.g., cases where the indications of 24 and 25 degrees are regarded as boundary values, i.e., max. or min. values, within a continuous numerical range based on statements of problems, functions etc.)

- ② Amendments which change the boundary value(s) of a claimed numerical range and satisfy both of the following conditions (i) and (ii):

- (i) the amended value(s) are stated in the description etc. as filed; and
- (ii) the amended range falls within a numerical range stated in the description etc. as filed



### (4) Disclaimer

“Disclaimer” refers to explicitly excluding a part of claimed elements from the scope of the claimed invention with keeping the original statement in the claim unchanged

Amendments which exclude the claimed element(s) with keeping the original statement in the claim unchanged and by which no technical matters are newly added to the scope of the “disclaimed” invention

 are allowable.

In the following cases (i) and (ii), disclaimers may be allowable as amendments because they do not introduce any new technical matters:

- (i) where a claimed invention **overlaps with a prior art** and thus is likely to lack novelty, double patenting, etc. and an **amendment excludes only the overlap**; or
- (ii) where a claimed invention **relates to “human beings”** and thus does not comply with the requirements provided in Arts. 29(1) (main paragraph; industrial applicability) or 32 (unpatentable inventions), and an **amendment excludes only “human beings.”**



### (5) Others

#### Adding details of prior art

- ① Amendments which add bibliographic information of prior arts into the description, and
- ② amendments which add details disclosed by prior arts into “Background” section in the description

→ ○ are allowable.

- ③ Amendments which add information related to the technical contribution of the invention disclosed in the application or the way how to carry out that invention, or
- ④ amendments which add details of prior arts in order to resolve the reason for refusal under Art. 36(4)(i)

→ ✗ are unallowable.

#### Adding technical effect

→ ✗ Normally, unallowable

However, in cases where the structure, function, etc. of the invention is explicitly stated in the description etc. as filed and it is obvious that the invention has a claimed effect based on the statements, an amendment adding such an effect may be **allowable**.

### (5) Others

#### Eliminating inconsistency

Amendments which make two or more statements consistent with each other by matching statements to the one obviously correct for a person skilled in the art

→  are allowable

#### Clarifying ambiguous statements

Amendments which clarify the meaning of statements that themselves are ambiguous, but the intended meaning of that is obvious for a person skilled in the art

→  are allowable

#### Adding specific examples

→  Generally, unallowable

#### Adding matters irrelevant or conflicting

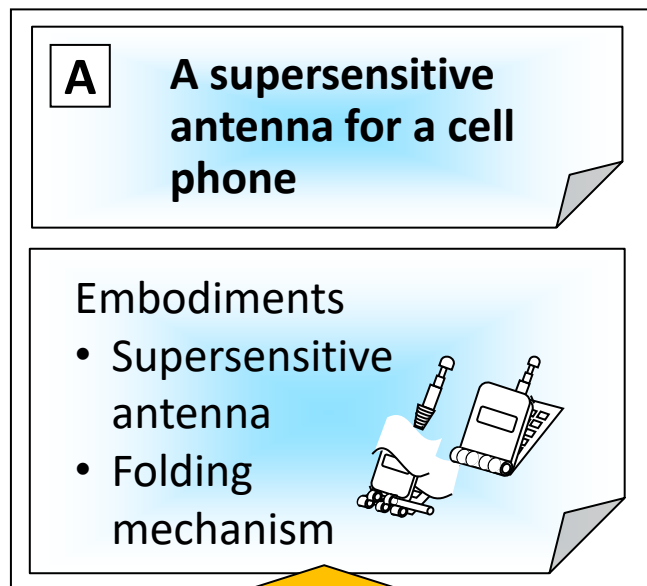
→  Unallowable

### Art. 17bis(4): Shift Amendment

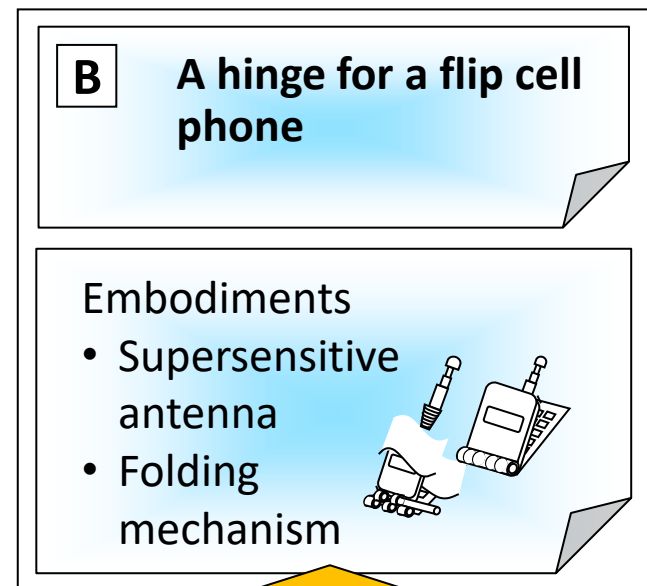
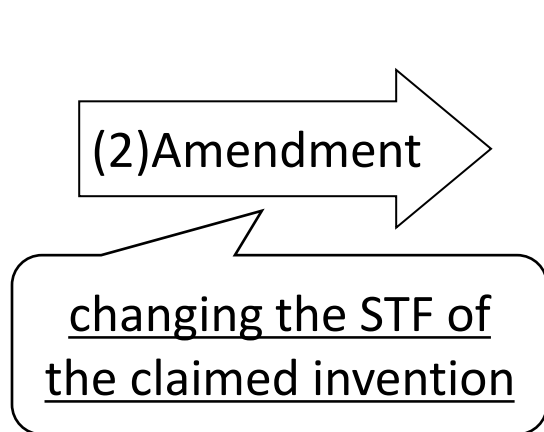
#### Basic Ideas

Amendments must not change a special technical feature (STF) of a claimed invention.

**Example** (A and B are different inventions that do not satisfy the requirement of the unity of invention if both of them are claimed at the same time)



(1) Non-final notice of reasons for refusal



(3) Final notice of reasons for refusal

The inventions before and after the amendment must fulfill the requirement of unity of invention

# Art. 17bis(4): Prescribed Purposes of Amendments

## Basic Ideas

[After the receipt of a final notice of reasons for refusal,] “the amendment of the scope of claims shall be limited to those for the following purposes:”

- (i) deleting a claim;
- (ii) restricting the scope of claimed subject matter;
- (iii) correcting an error; or
- (iv) clarifying an ambiguous statement.

To establish examination procedures ensuring that the rights are granted quickly and properly, purposes of amendments after the receipt of “final” notices are **limited to the extent to which the results of examinations already performed may be efficiently utilized**.

The examiner should respect the purpose of this provision mentioned above and should **not apply the provision more strictly than necessary** to cases where the examiner can efficiently conduct the examination, by utilizing the results of examinations, of an amended invention that is supposed to be protected.

## 8. Restricting the scope of claimed subject matter

### (1) Restricting the scope of claimed subject matter

#### Requirements for the restriction

- (i) Amendments **restrict** the scope of claimed subject matter.  
e.g. deleting an alternative, adding an element serially
- (ii) Amendments **limit an element which has been recited in a claim**.  
e.g. changing one or more claimed elements recited in a generalized form into elements recited in a limited form
- (iii) **Technical fields** to which the inventions before and after the amendment and **problems to be solved** by those inventions are identical.



“Identical” refers to the cases where:

- ① technical fields or problems to be solved are the same; or
- ② those are closely related to each other.

### (1) Restricting the scope of claimed subject matter

Description etc. before amendment

#### Title of Invention

Gearbox

#### Claim 1

A gearbox, which is made of a light alloy, comprising an output shaft, a reinforcement ring, and a bearing which keeps the output shaft rotatable; wherein the bearing is attached to the wall of the gearbox, and the ring is cast into the wall.

#### Excerpt from the description

...the gearbox is made of an aluminum alloy,  
... the ring is made of steel ...

Description etc. after amendment

#### Title of Invention


...

#### Claim 1

A gearbox, which is made of an aluminum alloy, comprising an output shaft, a reinforcement ring made of steel, and a bearing which keeps the output shaft rotatable; wherein the bearing is attached to the wall of the gearbox, and the ring is cast into the wall.

#### Excerpt from the description

...

[Determination]  The amendment falls under restriction of the scope of the claimed invention.

[Explanation] By the amendments, materials for the gearbox and reinforcement ring are specified. This amendment **limits claimed elements**, “gearbox ... made of a light alloy” and “a reinforcement ring” **to subordinate elements thereof**. Furthermore, **the problems to be solved**, i.e., to provide a lighter gearbox with increasing the intensity at the point of the bearing, **and the technical fields**, i.e., gearbox, **are the same**.

## 8. Restricting the scope of claimed subject matter

### (1) Restricting the scope of claimed subject matter

Description etc. before amendment

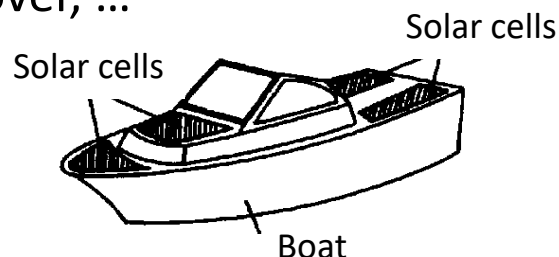
#### Title of Invention

Boat cover

#### Claim 1

A boat cover made of a translucent material; wherein solar cells connected to a rechargeable battery are attached to the top surface of the cover, ...

#### Drawings



Description etc. after amendment

#### Title of Invention


Boat cover

#### Claim 1

A boat cover made of a translucent material except parts attaching to solar panels which are made of a light shielding material; ...

#### Drawings

...

[Determination]  The amendment does not fall under restriction of the scope of the claimed invention.

[Explanation] The problem to be solved by the claimed invention as filed was to prevent the battery from running out as well as to protect solar cells from wind and rain. On the other hand, as to the amended invention, a new problem, to protect the boat's body from ultra violet, is added. This problem is irrelevant to the original problems since it is **neither the subordinated one nor the like**. Therefore, the amendment **changes the problem to be solved**.

## 8. Restricting the scope of claimed subject matter

### (1) Restricting the scope of claimed subject matter

#### Requirements to be patented independently

Even when the purpose of an amendment is to restrict the scope of claimed subject matter, the **amendment will be dismissed** if the requirements to be patented independently are not satisfied. (For the efficiency of examinations and fairness among applications)

\* **Only the claims amended by restricting the scope of claimed subject matter** therein are the subject of determination of those requirements.

#### ◆Provisions to be determined:

- (i) patent eligibility and industrial applicability (main paragraph of Art.29(1));
- (ii) novelty (Art. 29(1));
- (iii) inventive step (Art 29(2));
- (iv) secret prior art (Art 29bis);
- (v) unpatentable inventions (Art. 32);
- (vi) requirements for description and claims (Art.36(4)(i) and (6)(i)-(iii)); and
- (vii) prior applications (Art. 39(1)—(4)).



### (2) Deleting a claim

Purposes of following amendments is also to delete claims under Art. 17bis(5):

- **amendments necessitated by those deleting claims**

e.g.1: Replacing the reference to the claim deleted by an amendment in other claims

e.g.2: Changing a dependent claim to an independent one

### (3) Correcting an error

Correction of errors refers to

correcting erroneous statements the intended meaning of which is obvious based on the description etc. by replacing with statements giving that meaning.

### (4) Clarifying an ambiguous statement

Amendments which:

- (i) **clarify ambiguous statements**; and

“Ambiguous statements” refer to statements containing deficiency, such as those unclear in meaning.

“Clarifying” refers to correcting the unclarity of the statements and making clear the intended meaning.

- (ii) are **made to matters stated in a reason for refusal** raised by the examiner.

Amendments “made to matters stated in a reason for refusal” refer to amendments which are made for resolving deficiencies in the statements pointed out by the examiner in the notice of reasons for refusal under Art. 36.

1. Introduction of the Examination Guidelines
2. Novelty and Inventive Step
3. Secret Prior Art
4. Double Patenting
5. Requirements for Description and Claims
6. Unity of Invention
7. Industrially Applicable Inventions  
(Patentable Subject Matter)
8. Amendment
- 9. Overview of the March 2016 revision**

## 9. Overview of the March 2016 revision (Use invention of Foods)

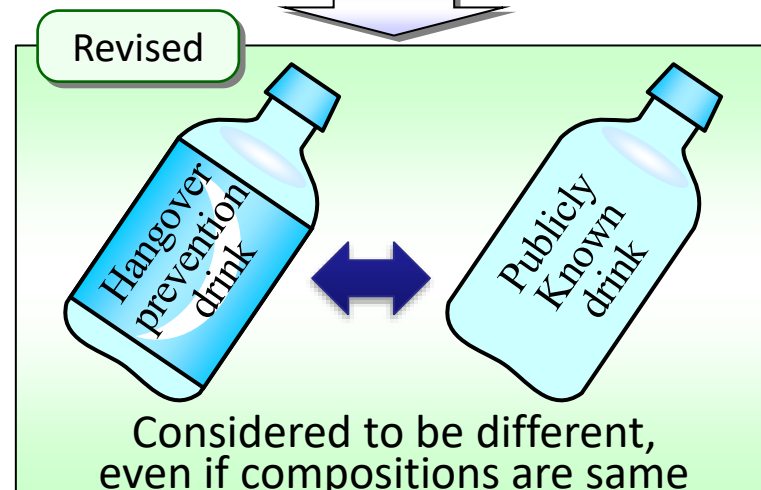
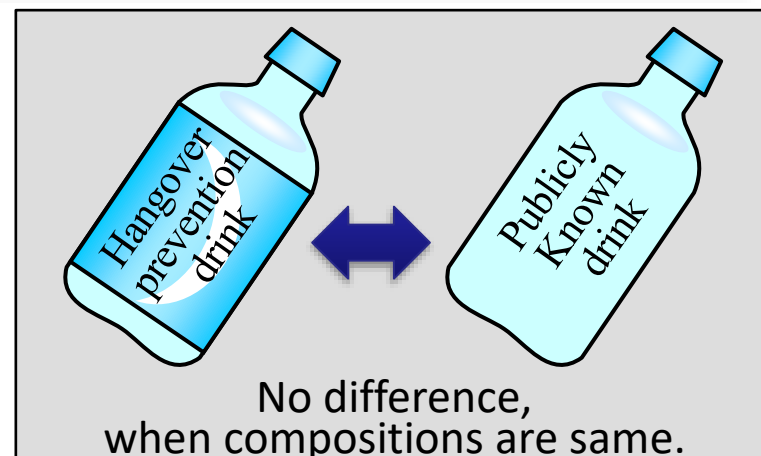
Use invention is an invention that is specified in consideration of the limitation of new use, even if the product itself is known.

Foods were not regarded as use invention, because they usually do not provide a novel use that is distinguishable from known foods, even if these known foods provide any discovered novel attributes.



However, R&D of food function has recently increased in accordance with health trend etc. Therefore, JPO implemented questionnaire to companies, judicial precedent survey, and deliberations in experts committee. As a result, the Examination Guidelines has been revised in order to promote the protection and the utilization of inventions applied as food function.

Only if the limitation of use is provided to animals and plants, the claim is to be interpreted including no limitation of use. Such a limitation represents only availability of animals and plants.



The revised Examination Guidelines have been applied to examinations on or after April 1, 2016.  
( See Part III, Chapter 2, Section 4, 3. Expression Specifying the Product by its Use Application )

## 9. Overview of the March 2016 revision (Use invention of Foods)

### Example

\* The claimed invention and the prior art are not different except a limitation of use application.

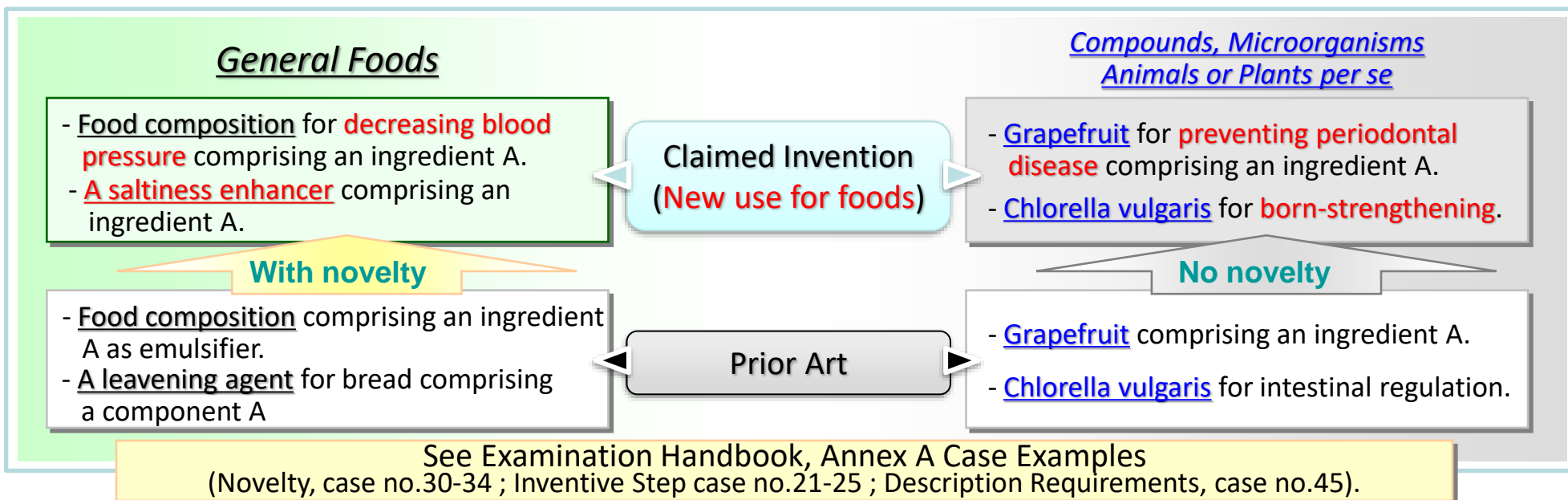
**Claim 1:** A food composition for use in preventing a hangover containing an ingredient A as an active ingredient.

**Claim 2:** A food composition for use in preventing a hangover according to claim 1, wherein the food composition is a drink.

**Claim 3:** A food composition for use in preventing a hangover according to claim 2, wherein the drink is carbonated soft drink.

When both of the following conditions (i) and (ii) are satisfied, claimed invention is considered to be different from prior art.

- (i) "The use in preventing a hangover" is derived from discovering of an unknown attribute that promotes alcohol metabolism by an ingredient A.
- (ii) The use application which is derived from the attribute is different from any known uses and novel.



## 9. Overview of the March 2016 revision (Extension of patent term)

When there has been a period during which the patented invention was not able to be worked because it is necessary to obtain a disposition designated in Cabinet Order<sup>(\*)</sup>, it has been made possible to extend the period of duration of patent right by an application for registration of extension concerned with limits of five years (Article 67(2)).

(\*) Registration related to agricultural chemicals based on the Agricultural Chemicals Regulation Law, and Approval and certification based on the Pharmaceutical and Medical Device Law concerning drug products.

Supreme court decision (2014 (Gyo-hi) 356) was made on the request for rescission of the JPO appeal trial decision of refusal, related to extension of patent term which claims an anti-cancer drug, on Nov. 17, 2015.

Supreme court made a judgment that when an approval of drug with new dosage and administration opens a way for working of patent in terms of that dosage and administration, the extension of patent term shall be granted. In other words, even though present approval of drug is the same as prior one in terms of active ingredient and effect, when the both differ from each other in terms of dosage and administration, extension of patent term shall be granted.

The Examination Guidelines have been revised in accordance with the supreme court decision.

The revised Examination Guidelines have been applied to examinations on or after April 1, 2016.  
( See Examination Guidelines, Part IX Extension of Patent Term; Examination Handbook, Annex A Case Examples. )

## 9. Overview of the March 2016 revision

*(The revision associated with a legislative amendment of the Patent Act for accession to PLT)*

Patent Law Treaty (PLT) is an international treaty that aims to harmonize and streamline formal procedures of patent applications and patents.

### (1) Establishment of “Reference Filing” chapter

New chapter of “Reference Filing” has been established and describes the overview of the system, the requirements and effects for reference filing, the determination on the substantive requirements (whether or not matters stated in the description or drawing(s) of a reference filing remain within matters stated in the claims, description or drawing(s) of an earlier patent application) and the procedure of the examination on the substantive requirements. (See Examination Guidelines, Part VI, Chapter 4 Reference Filing. )

→ This “Reference Filing” chapter have been applied to patent applications filed on or after April 1, 2016.

### (2) Others

The Examination Guidelines have been formally revised to conform to the Patent Act revised on 2015.

## ■ Useful Links:

- Examination Guidelines for Patent and Utility Model in Japan  
[https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu\\_kijun/index.html](https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/index.html)
- Examination Handbook for Patent and Utility Model in Japan  
[https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/handbook\\_shinsa/index.html](https://www.jpo.go.jp/e/system/laws/rule/guideline/patent/handbook_shinsa/index.html)
- Handbook for PCT International Search and Preliminary Examination in the JPO  
[https://www.jpo.go.jp/e/system/patent/pct/chosa-shinsa/pct\\_handbook.html](https://www.jpo.go.jp/e/system/patent/pct/chosa-shinsa/pct_handbook.html)

***Thank you!***