

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Part III Patentability

Contents

Chapter 1 Eligibility for Patent and Industrial Applicability (Main Paragraph of Article 29(1) of Patent Act).....	- 1 -
3101 Example of a Case in which the Question is whether or not Humans are Included in the Objects of Methods of Surgery, Therapy or Diagnosis	- 1 -
Chapter 2 Novelty and Inventive Step (Patent Act Article 29(1) and (2)).....	- 1 -
3201 Example of cases in which it could be determined that the claimed invention lacks novelty, and that it lacks inventive step	- 1 -
3202 Points to note when choosing main cited invention	- 4 -
3203 Supreme Court decision in the lipase case.....	- 5 -
3204 Example of a determination whether or not the prior art was made public before the filing of the application in question	- 6 -
3205 Points to note in recognizing cited invention, when the matter stated in the publication is stated in Markush form	- 7 -
3206 Example of a case in which an invention disclosed in a publication cannot be used as a cited invention.....	- 8 -
3207 When a password is necessary for access to a web page, etc. or access to the web page, etc. is charged, but the matter posted on the web page, etc. is available for the public	- 9 -
3208 Examples of the case in which the point is whether or not a matter posted on web page, etc. is available for the public.....	- 10 -
3209 Handling of cases in which there is extremely little doubt about alteration of matters posted on web page, etc., or cases in which alteration is doubted	- 11 -
3210 Procedures for citing an invention which became available for the public through an electric telecommunication line	- 12 -
3211 Submission of information for an invention which became available for the public through an electric telecommunication line	- 14 -
3212 Points to note when carrying out a prior art search for unpublished application through Internet, etc.	- 15 -

3213	Examples of publicly worked inventions (Article 29(1)(ii)).....	- 16 -
3214	Points to note concerning recognition of cited invention.....	- 17 -
3215	Example of alternatives	- 18 -
3216	Relation between the determination as to novelty and inventive step of the claimed invention having alternatives, and the end of prior art search	- 19 -
3217	Example of a case in which a statement to specify a product using functions, characteristics, etc. is recognized as having a meaning different from the usual meaning	- 20 -
3218	When it is difficult to compare with the cited invention by statements of functions, characteristics, etc. and exact comparison cannot be made (reason to doubt that novelty is prima facie denied)	- 21 -
3219	When comparison with the cited invention by statements of functions, characteristics, etc. is difficult and exact comparison cannot be made (reason to doubt that inventive step is prima facie denied).....	- 27 -
3220	When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that novelty is prima facie denied)	- 30 -
3221	When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that inventive step is prima facie denied).....	- 31 -
3222	When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally (reason to doubt that novelty is prima facie denied)	- 32 -
3223	When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally (reason to doubt that inventive step is prima facie denied).....	- 34 -
3224	Article 29(1) of the Patent Act applicable to applications filed on or before December 31, 1999	- 36 -
3225	Concrete Example of "Proving Document" in which Contents of the Same Degree as a Those in "Providing Document" according to the Form Exemplified in Examination Guidelines, Part III, Chapter 2, Section 5, 2.3.1 are Stated.....	- 37 -
3226	Concrete Example of a Case in which Applicant's Assertion is Taken into Consideration in Determining on Application of the Provision of Article 30(2).....	- 38 -
3227	Method for Describing the Ground for not Allowing Application of Exceptions to Loss of Novelty of Invention.....	- 39 -
3228	Procedures for Having Exceptions to Loss of Novelty of Invention Applied-	40 -

3229	History of Amendments of Article 30.....	- 41 -
3230	Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable.....	- 42 -
3231	Inventions that were published on or before December 8, 2017 under Article 30 of the Patent Act as amended in 2018 is Applicable.....	- 44 -
3232	Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable.....	- 45 -
3233	Patent Applications to which Article 30 of the Patent Act prior to the Amendment of 2011 is Applicable.....	- 47 -
3234	Application of Article 30 to Patent Applications filed on or before December 31, 1999.....	- 49 -
3299	Others.....	- 50 -
Chapter 3	Secret Prior Art (Patent Act Article 29bis).....	- 1 -
3301	A Case in Which Comparison Between the Claimed Invention and the Cited Invention is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely.....	- 1 -
Chapter 4	Prior Application (Patent Act Article 39).....	- 1 -
3401	Points to Note in a Case in Which Embodiments of the Claimed Invention and the Earlier Application Invention are Identical.....	- 1 -
3402	Reasons to Determine Whether or not the Claimed Invention and the Co-Pending Application Invention Filed on the Same Date are "the Same" as Described in 3.2.2 of "Part III Chapter 4 Earlier Application" of the Examination Guidelines in a Case in Which the Other Application is the Co-Pending Application Filed on the Same Date-	2 -
3403	A Case in Which Matters Specifying the Invention of the Earlier Application Invention or Co-Pending Application Invention Filed on the Same Date Have Alternatives.....	- 4 -
3404	Determination on whether or not the Claimed Invention Having Alternatives cannot be Patented according to the Provisions of Article 39, and Relationship with Termination of the Prior Art Search.....	- 5 -
3405	Notification to the Patentee (the Utility Model Right Holder), Etc. at the time when a Notice of Reasons for Refusal is issued in a Case Where the Invention Related to the Patent Application is the Same as an Invention (Device) Related to the Patent (Utility Models) Filed on the Same Date by a Different Applicant and That Has Already Registered.....	- 6 -

3406	A Case in Which Consultation Shall be Ordered Only for Application Concerned	- 12 -
3407	A Case in Which Comparison Between the Claimed Invention and the Earlier Application Invention or the Co-Pending Application Invention Filed on the Same Date is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely.	- 13 -
3408	Amendment History of Article 39	- 14 -
3499	Others	- 16 -
Chapter 5	Category of Unpatentable Invention (Patent Act Article 32).....	- 1 -
3501	Handling of Cases in Which Matters or Contents That Clearly Damage the Public Order or Morality are Described in the Descriptions or Drawings	- 1 -

Chapter 1 Eligibility for Patent and Industrial Applicability
(Main Paragraph of Article 29(1) of Patent Act)

3101 Example of a Case in which the Question is whether or not Humans are Included in the Objects of Methods of Surgery, Therapy or Diagnosis

Examination guidelines "Part III Chapter 1 Eligibility for Patent and Industrial Applicability," 3.1.1 (Excerpt)

Methods of surgery therapy or diagnosis of humans have been termed "medical activity" and are normally practiced by medical doctors (including those who are directed by medical doctors, hereinafter referred to as "medical doctors").

A method considered as any one of (i) to (iii) shown below is considered as an "invention of methods of surgery, therapy or diagnosis of humans".

- (i) Methods of surgery of humans (see (1))
- (ii) Methods of therapy of humans (see (2))
- (iii) Methods of diagnosis of humans (see (3))

The following methods of (a) and (b) are included in "inventions of methods of surgery, therapy or diagnosis of humans".

- (a) Methods for contraception or delivery
- (b) Methods for processing samples that have been extracted from a human body (e.g., a method of dialyzing blood) or analyzing the samples during the process on the presumption that the samples are to be returned to the same body for therapy (except for the methods described in 3.2.1(4)b)

Even if methods of surgery, therapy or diagnosis are practiced on animals in general, unless it is clear that the methods practiced on humans are explicitly excluded, the methods are deemed as being "inventions of methods of surgery, therapy or diagnosis of humans".

(Example of the case in which it is obvious that humans are excluded from the object of the method of surgery, therapy or diagnosis)

Example 1: In the case in which it is stated in the claim that the object of the method of surgery, therapy or diagnosis is a "non-human mammal"

(Example of the case in which the object of surgery, therapy or diagnosis might include humans

Example 2: In the case in which it is stated in the claim that the object of the method of surgery, therapy or diagnosis is a "mammal"

Chapter 2 Novelty and Inventive Step (Patent Act Article 29(1) and (2))

3201 Example of cases in which it could be determined that the claimed invention lacks novelty, and that it lacks inventive step

Examples of the cases in which it could be determined that the claimed invention lacks novelty, and that it lacks inventive step are as follows:

- (i) When the claimed invention has formal or factual alternatives, and where the invention lacks novelty if the claimed invention is recognized based on one alternative, and the invention lacks inventive step if the claimed invention is recognized based on the other alternative
- (ii) When multiple working examples are stated in the cited document, and where the claimed invention lacks novelty, if the cited invention is recognized on one working example, and the claimed invention lacks inventive step if the cited invention is recognized based on the other working example
- (iii) When the claimed invention is expressed with a generic concept, and the cited invention is expressed with the more specific concept

In this case, the claimed invention lacks novelty due to the reason that the claimed invention contains the cited invention. In addition, if the difference between the generic concept and the more specific concept is taken as the difference between the claimed invention and the cited invention, the claimed invention that is a generic concept is a matter at which a person skilled in the art could have easily arrived from the cited invention expressed with a more specific concept, and the claimed invention lacks inventive step.

Example: When the matter specifying the invention for the claimed invention is "an elastic body," and only "a spring" is disclosed in the cited document

In this case, since the claimed invention includes a spring, it lacks novelty. In addition, as a person skilled in the art could easily arrive at the idea that "an elastic body" of the claimed invention could be an elastic body other than a spring, the claimed invention lacks inventive step.

- (iv) When the claimed invention is expressed using a numerical range, and the cited

invention discloses a specific numerical value which is within the numerical range

In this case, the claimed invention lacks novelty because it includes the cited invention. In addition, if it is easy for a person skilled in the art to take the difference between the numerical range and the specific value as the difference between the claimed invention and the cited invention and to vary the specific value to another value included in the numerical range, the claimed invention lacks inventive step.

Example: When the claimed invention defines the numerical range $a \sim x \sim b$ for a parameter x , and the cited invention discloses only a specific value x_1 , wherein $a < x_1 < b$

In this case, the claimed invention lacks novelty because it includes the cited invention. In addition, if it is easy for a person skilled in the art to vary x_1 to another value included in the numerical range defined by the claim, the claimed invention lacks inventive step.

(v) When the cited invention is an invention in which certain feature is added to the claimed invention

In this case, the claimed invention lacks novelty, because it includes the cited invention. In addition, taking the added feature in the cited invention as the difference between the claimed invention and the cited invention, if a person skilled in the art could have easily arrived at an invention which consists of solely the concept specified by the claim separating the feature in question, the claimed invention lacks inventive step.

Example: When the claimed invention is an arm for robot having a specific first joint and the cited invention is an arm for robot having a specific first joint and a specific second joint

In this case, the claimed invention lacks novelty, because it includes the cited invention. On the other hand, if a person skilled in the art could have easily arrived at grasping the invention as an independent inventive concept with only the first joint separating the second joint in the cited invention, the claimed invention lacks inventive step.

(vi) When the claimed invention can be interpreted for multiple meanings, and not only lack of novelty but also lack of inventive step can be pointed out

Example: When the claim has a statement "mail" and it cannot be known if it means the "electronic mail" or "mail by post," and, it can be determined that the claimed

invention has novelty when the former meaning is used for interpretation, but does not have inventive step, and that the claimed invention does not have novelty when the latter meaning is used for interpretation

3202 Points to note when choosing main cited invention

Examination guidelines "Part III, Chapter 2, Section 2 Inventive Step," 3.3 (2) (Excerpt)

The examiner selects generally the primary prior art which is same as or close to the claimed invention from the aspect of technical field or problem to be solved.

In order to choose the best suited main cited invention, Examiner should also take into consideration the mode for carrying out the claimed invention and the main cited invention.

3203 Supreme Court decision in the lipase case

"In examining concerning requirements for patentability provided for in Article 29(1) and (2) of the Patent Act, namely novelty and inventive step of the invention pertaining to the patent application, while the gist of invention pertaining to the patent application must be identified as the premise for comparing the invention with the invention provided for in each item of Article 29(1), this identification of the gist should be made, unless the circumstances are exceptional, based on statements in the claims in the descriptions attached to the request. Limited to exceptional cases in which technical meaning of the statement in the claims cannot be unambiguously clearly understood, or it is obvious at a glance that the statement is an error in the light of statements in the detailed description of the invention, it is allowed to take into consideration the statement of the detailed description of the invention of the descriptions."

Shuhei SHIOTSUKI, "*Hankai* (commentary of court cases), civil cases, 1991, page 39
"8 Meaning of 'to take into consideration'

Since matters pertaining the gist of the invention and the scope of the right (constituent features) are stated in condensed form in statements in the claims, in most cases, meaning of content cannot be grasped with through-reading. However, exceptional cases for which the Supreme Court judged that the statement of the detailed description of the invention may be taken into consideration as 'exceptional case in which technical meaning of the statement in the claims cannot be unambiguously clearly understood, or it is obvious at a glance that the statement is an error in the light of the statement of the detailed description of the invention' is not such case. Namely, the decision showed a theory that, in the process of identifying the gist of invention, it is necessary to look through detailed description of the invention and statements of drawings in order to make the technical details of the invention clear, but, in the process of defining the technical matters which constitutes the gist of the invention after understanding technical details, constituent features which are stated only in detailed description of the invention and drawings may not be added exceeding the statements in the claims, and, in this sense, it stated that only in exceptional cases, statement in the detailed description of the invention may be taken into consideration."

3204 Example of a determination whether or not the prior art was made public before the filing of the application in question

For example, for an invention which becomes publicly known before noon in Japan, if a patent application is filed in the afternoon of the same day, the invention publicly known before noon is an invention publicly known in Japan before the filing of the patent application.

3205 Points to note in recognizing cited invention, when the matter stated in the publication is stated in Markush form

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 3.1.1(1)a (Excerpt)

The examiner should not cite what is neither a disclosure of the publications nor the equivalent of the disclosure of the publications because such a matter is not "prior art disclosed in publications."

If a "matter stated in a publication" is stated in Markush form, the Examiner needs to consider whether or not it is possible for a person skilled in the art to identify an invention which has only one of the alternatives as a matter specifying the invention.

3206 Example of a case in which an invention disclosed in a publication cannot be used as a cited invention

Examination guidelines "Part III, Chapter 2, Section 3 Procedure of Determining Novelty and Inventive Step," 3.1.1(1).b

The examiner should not cite a disclosure that a person skilled in the art is able to recognize based on the descriptions in publications or equivalents to such descriptions as "prior art" where it falls into the following case (i) or (ii).

(i) Where it is not clear that a person skilled in the art is able to manufacture a product of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing

(ii) Where it is not clear that a person skilled in the art is able to use the process of the prior art based on the descriptions of the publications and the common general knowledge at the time of filing.

For example, when a chemical compound is shown in a publication with the name or chemical structural formula of the chemical compound, if the chemical compound is not stated, even if the common general knowledge as of the filing is taken into consideration, so that it is obvious that a person skilled in the art could produce the chemical compound, the chemical compound cannot be a "cited invention" (when the publication is a patent document, and has a claim in Markush form in which the chemical compound is a part of the alternatives as the cited invention, it does not mean that the claim does not satisfy enablement requirement of Article 36(4)(i)).

3207 When a password is necessary for access to a web page, etc. or access to the web page, etc. is charged, but the matter posted on the web page, etc. is available for the public

Even when a password is necessary for access to a web page, etc. or access to the web page, etc. is charged, if the posted invention satisfies both of (i) and (ii) below, the invention posted on the web page, etc. can be deemed to have become publicly available.

- (i) Existence of the matter posted on the web page, etc. and the location could be known by the public
- (ii) Unidentified persons could have accessed the matter.

3208 Examples of the case in which the point is whether or not a matter posted on web page, etc. is available for the public

(1) Example of matters which are available for the public

(i) Matters which are registered to a search engine and searchable, or information of which existence or location can be known by the public

(For example, matters linked with relevant academic associations, news, etc., or matters of which address is inserted in means for transmitting information to the public, such as newspapers and magazines).

(ii) Where existence of the matter posted on the web page, etc. and the location could be known by the public, and password is necessary for reading, the web page which is accessible to unspecified persons only by entering a password

(In this case, matters posted on a web page, etc. which, regardless whether or not it is charged, anybody can access by obtaining a password without any discrimination by taking certain procedures can be deemed as available for the public.)

(iii) Where existence of the matter posted on the web page, etc. and the location could be known by the public, and reading of the web page is charged, unspecified persons can access the web page by paying the charge

(In this case, matters posted on web page, etc. which anybody can access without any discrimination by paying the charge can be deemed as available for the public.)

(2) Example of matters which are hard to say as available for the public

Even if posted on web page, etc., matters which fall under any of the items below are hard to be deemed as available for the public.

(i) A matter which is posted on Internet, etc., but, excluding casual access, inaccessible because no address is made public

(ii) Persons who can access the information are limited to members of specific associations or business enterprises, etc., and the information is handled as privileged (for example, internal system which is available only for the employees, etc.)

(iii) Information of which contents are coded so that it cannot be decoded usually

(Excluding the case, regardless of whether it is charged or free, in which any person can obtain a tool for decryption by certain means.)

(iv) Matters which are not open for a period sufficient for the public to see them

(for example, matters opened on the Internet only for a short time period)

3209 Handling of cases in which there is extremely little doubt about alteration of matters posted on web page, etc., or cases in which alteration is doubted

Since matters posted on a web page, etc. are vulnerable to alteration, a doubt could occur whether the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content. The Examiner should handle the cases in which doubt about alteration of matters posted on web page, etc. is extremely little, or cases in which alteration is doubted respectively as shown in (1) and (2) below.

(1) When there is extremely little doubt concerning whether or not the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content

With web pages, etc. as exemplified in (i) to (iv) below, normally, such doubt is extremely little. Concerning such web pages, etc., the Examiner may assume that the content which is posted when the Examiner accesses the web page etc. was posted in the period indicated on the web page, etc.

- (i) Web pages of publishing companies which have been publishing publications, etc. for many years
- (ii) Web pages of academic organizations (academies, universities, etc.)
- (iii) Web pages of international organizations (standardization organizations, etc.)
- (iv) Web pages of public organizations (ministries, etc.)

(2) When there is a doubt about whether or not the matter posted on a web page, etc. which is intended to be cited was posted for the indicated period with the same content

For example, a case in which the invention intended to be cited is posted on a web page, etc. of a private person on which matters obviously different from the fact are enumerated falls under this example. In this case, the Examiner should examine the doubt by inquiring the contact address indicated as an address for inquiries etc. whether or not it has been altered. If the doubt is dismissed as a result of the examination, the Examiner may cite invention posted on the web page, etc. In the case in which the doubt is not dismissed, the Examiner should not cite the invention. In addition, if the address for inquiries is not clear, the Examiner should not cite such invention.

3210 Procedures for citing an invention which became available for the public through an electric telecommunication line

When citing an invention which became available for the public through an electric telecommunication line, the invention should be treated as follows:

(1) If there exists a publication which describes an invention with the same content as that of the invention which became available for the public through an electric telecommunication line, and both the web page, etc. on which the invention is posted and the publication which described the invention can be cited, the preference should be given to the publication.

(2) Handling of cited web page, etc.

Information on a web page, etc. might have been altered or deleted when the applicant or a third party accessed even if the information existed when the Examiner conducted prior art search. In such case, it is difficult for the applicant or third party to take actions sufficiently. Therefore, in order to compile web pages, etc. cited in notices of reasons for refusal, etc. in the database for patent-related documents, the Examiner should take the following procedures.

- a. To print out information of the cited web page, etc.
- b. To record the date and time of access, the name of the accessing Examiner, the application number of the application from which the information is cited, and the address from which the information was obtained, etc. on the print out of a. above.
- c. After that, the cited web pages should be treated in the same manner as computerization of the cited non-patent documents.

(3) Matters to be stated as cited documents, etc. when citing web page, etc.

When citing a web page, etc. retrieved through the Internet, etc., bibliographic items of the ascertained the electronic technical information should be listed in the following order in accordance with WIPO Standard ST.14.

(i) Name of author

(ii) Title

(iii) The relevant part

Specified by page, field, line, item number, chart number, and the index of database or the first and last words.

(iv) Type of media [online]

(v) Date of publication (the date of issuance), name of publisher (the name of issuer), place of publication (place of issuance) and the page on which relevant part is disclosed

(vi) Date of retrieval

Enter in parentheses, the date when the electronic technical information has been retrieved from the electronic media.

(vii) Source and address of information

List the source and address or identification number (Accession No.) of the electronic technical information

(4) Example of statements of the web page, etc. retrieved from Internet

(Example of statements of information obtained from a manual/catalog for products or website)

Corebuilder 3500 Layer 3 High-function Switch. Datasheet. [online]. 3Com Corporation, 1997. [retrieved on 1998-02-24]. Retrieved from the Internet: <URL: <http://www.3com.com/products/dsheets/400347.html>>.

(Example of statements in Japanese Language)

Jun SHINSAKI, et al. "*Shingijutunodoko* (Trends of new technologies)," [online], April 1, 1998, [retrieved on July 30, 1999], Internet<URL: <http://tokkyo.shinsakijun.com/information/newtech.html>>

(Example of statements of the web page, etc. retrieved from online database)

Dong, X. R. 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements', *Chung Hua Wai Ko Tsa Chih*, May 1993, Vol. 31, No. 5, pages 301-302. (abstract) Medline [online]; United States National Library of Medicine, Bethesda, MD, USA. [retrieved on 24 February 1998] Retrieved from: Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession no. 07736604.

3211 Submission of information for an invention which became available for the public through an electric telecommunication line

When offering information for an invention which became available for the public through an electric telecommunication line, a party who offers information shall provide a printout of the contents of the electronic technical information from the Internet, etc. in order to prove that the offered information is correct.

The submitted printout of the information must contain the address from which the information is obtained and the address for inquiries for the information, together with the contents of the information, and showing the posting times and dates of the information. It is preferable that a certificate issued by an authorized person or a person responsible for posting, conservation, etc. of that information be included.

3212 Points to note when carrying out a prior art search for unpublished application through Internet, etc.

For any application which has not been laid open as of the prior art search, Examiner may carry out search for prior art information through the Internet, etc. If the Internet, etc. is used, however, since there is a possibility of leakage of retrieved information and the invention of the application might leak to a third party from the search formula and the search term, etc. (Note), Examiner must be careful in conducting retrieval.

In addition, for example, if Examiner finds the cited document from a literature list of an academic society on a web page, etc., or has obtained electronic technical information through offering of information, there is no worry that the claimed invention might leak.

Note: In cases shown below, it is highly probable that the invention leaks to third parties.

- (i) When searching with a new combination of generic terms
- (ii) When searching for invention in which a publicly known matter is used for a new use
(using the matter for the use is new)

3213 Examples of publicly worked inventions (Article 29(1)(ii))

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 3.1.4 (Excerpt)

"Publicly worked prior art" means prior art which has been worked in a situation where the prior art is or could be publicly known.

Example 1: Example of an invention worked in a situation in which it becomes publicly known

For example, an invention in a case in which it is allowed in a plant for unspecified persons to observe the manufacturing process of a certain product, when the situation is such that a person skilled in the art could easily know the details of the invention by just viewing the situation of manufacturing

Example 2: Example of an invention worked in a situation in which there is possibility that it becomes publicly known.

For example, an invention related to the manufacture in a case in which it is allowed in a plant for unspecified persons to observe the process of manufacturing a certain product, when the situation is such that satisfies both (i) and (ii) below:

- (i) Situation in which a part of the manufacturing process cannot be known when viewing the outside of the equipment, and the invention as a whole cannot be known unless the part is known
- (ii) Situation in which visitors can (the plant does not refuse) watch the inside of the equipment, or to have the inside explained by plant workers

3214 Points to note concerning recognition of cited invention

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining of Novelty and Inventive Step," 3.3

The examiner should take note of the avoidance of hindsight which brings about a misunderstanding of the evidence which discloses the prior art according to the contexts of the description, claims or drawings of the application subject to the examination after obtaining knowledge of the claimed inventions. The prior art should be understood based on the evidence disclosing the prior art (for publications, along the contexts of the publications).

In addition, the Examiner should note the following points.

- (1) The Examiner should not identify cited inventions only from a part of statement of the publication, etc. without reasonable ground.
- (2) The Examiner should not determine the content of the invention stated in a publication, etc. only from its feature, but should determine taking into consideration points of view of the problem to be solved, technical field, etc.

3215 Example of alternatives

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 4.1.1 (Note 1)(Excerpt)

"Alternatives" means both formal alternatives and substantial alternatives.

"Formal alternatives" means a description of the claim which is understood obviously as alternatives.

For example, claims in Markush form, multiple dependent form claims citing other claims alternatively, etc. fall under claims containing formal alternative.

Examination guidelines "Part III, Chapter 2, Section 3, Procedure of Determining Novelty and Inventive Step," 4.1.1 (Note 1)(Excerpt)

"Substantial alternatives" means a comprehensive expression which is intended to include a limited number of more specific matters substantially.

Whether or not it is "substantial alternative" is determined by taking into consideration the statements of the descriptions and drawings, as well as the common general knowledge as of the filing in addition to the statements of the claim. For example, claims having a statement like "alkyl group with 1 to 10 C (number of carbons)" (this comprehensive expression contains methyl group, ethyl group, etc.), etc. are claims containing substantial alternative.

In contrast to this, the statement "thermoplastic resin," for example, should not be deemed as a statement expressed by comprehensively bracketing concrete matters included in the concept except the case in which it should be interpreted so taking into consideration the statements of the descriptions and drawings as well as the common general knowledge as of the filing as in the case in which definitions of terms are included in the detailed description of the invention. Therefore, the Examiner need to know that such statement does not fall under substantial alternative. Namely, the concept of "thermoplastic resin" includes an unspecified number of concrete matters (for example, polyethylene, polypropylene, etc.), the Examiner should determine that it is a generic concept specified by a common character (in this case, thermal plasticity) of the concrete matters.

3216 Relation between the determination as to novelty and inventive step of the claimed invention having alternatives, and the end of prior art search

Handling of Examination guidelines "Part III, Chapter 2, Paragraph 3, Proceeding of examination of novelty and inventive step," 5.1.1 has no relation with the point in what case prior art search may be terminated. In this regard, refer to Examination guidelines "Part I, Chapter 2, Section 2, Prior Art Search and Determination of Novelty and Inventive Step, etc." 3.1.3.

3217 Example of a case in which a statement to specify a product using functions, characteristics, etc. is recognized as having a meaning different from the usual meaning

Example: Heat-resistant alloy having a composition of ...

(Explanation)

In certain cases, as a result of identification of the claimed invention taking into consideration the statements of the descriptions and drawings, as well as the common general knowledge as of the filing, the statement, "heat-resistant alloy," should be interpreted to mean an "alloy used for a use in which heat resistance is necessary." In this case, the Examiner should follow Examination guidelines "Part III, Chapter 2, Section 4, Claims Including Specific Expressions," 3.

3218 When it is difficult to compare with the cited invention by statements of functions, characteristics, etc. and exact comparison cannot be made (reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

In certain cases, it is difficult to compare with the cited invention a claim which contains a statement to specify a product by functions, characteristics, etc., and falls under (i) and (ii) below.

In such case, without conducting exact comparison of identical features and differences with the product of the cited invention, if the Examiner has a reason to doubt that two of them are prima facie identical, unless there is difference in other parts, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie identical, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

If the applicant refutes or clarifies the reason to doubt that they are prima facie identical with a written opinion, certificate of experimental results, etc., and the Examiner is not convinced that the claimed invention lacks novelty, the reason for refusal dissolves.

When the reason to doubt that they are prima facie identical concerning novelty does not dissolve because of the reason that the refutation, or clarification by the applicant is abstract or generic, etc., and the Examiner is convinced that the claimed invention lacks novelty, the Examiner should make a decision of refusal.

However, the Examiner should not apply such handling using any invention for which the cited matter identifying the invention falls under (i) or (ii) below as a cited invention. In addition, if it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

(i) When stated functions, characteristics, etc., do not fall under any of the followings:

(i-1) Standard one (Note 1)

(i-2) One customarily used by a person skilled in the art in the technical field in question (Note 2)

(i-3) One in the technical field in question; even if it is not customarily used by a person skilled in the art, a person skilled in the art can understand its relation with one customarily used by a person skilled in the art

- (ii) Multiple functions, characteristics, etc. are stated in the claim, and each of them corresponds to any of (i-1) to (i-3) above, but, looked as one in which two or more of such functions, characteristics, etc. are combined, it falls under (i) above as a whole

(Note 1) Standard one means such that has a definition as defined by JIS (Japanese Industrial Standards), ISO Standards (Standards of International Organization of Standardization), or IEC Standards (Standards of International Electrotechnical Commission), and can be quantitatively determined by testing or measuring methods established by those organizations.

(Note 2) One customarily used by a person skilled in the art means such that is customarily used in the technical field in question by a person skilled in the art, and its definition and testing and measuring methods can be understood by a person skilled in the art.

2. Example of cases in which Examiner has a reason to doubt prima facie identical

- (a) When the functions, characteristics, etc. of the claimed invention can be converted to those by other definitions or testing or measuring method, and, a product of the cited invention that can be deemed identical to the claimed invention judging from the result of such conversion is found
- (b) When the claimed invention and the cited invention are identified with identical or similar functions, characteristics, etc., but the measuring conditions or evaluating method are different and fall under both of (i) and (ii) below
 - (i) When there is certain relation between measuring conditions or evaluating method of the claimed invention and the cited invention.
 - (ii) When such probability is high that the functions, characteristics, etc. of the cited invention are included in the functions, characteristics, etc. of the claimed invention, if the functions, characteristics, etc. of the cited invention are measured or evaluated with the measuring conditions or evaluating method for the claimed invention.
- (c) When a structure of a product deemed as identical with the product of the claimed invention becomes clear after the filing, and it is found that the product was publicly known before the filing

(d) When a cited invention is identical or similar to one which is stated in the descriptions or drawings of the application as the mode for carrying out is found

(For example, when a cited invention having the identical manufacturing process with the manufacturing process stated as the mode for carrying out and similar starting material is found, or when a cited invention having a similar manufacturing process to the manufacturing process stated as the mode for carrying out and identical starting material is found, etc.)

(e) When a matter specifying the invention other than matters specifying the invention expressed with functions, characteristics, etc. is common between the cited invention and the claimed invention, and falls under both of (i) and (ii) below

(i) When the cited invention has problems or beneficial effects identical or similar to problems or beneficial effects of matters specifying the invention expressed with the functions, characteristics, etc.

(ii) When such probability is high that functions, characteristics, etc. of the cited invention are included in functions, characteristics, etc. of the claimed invention

3. A notice of reasons for refusal based on a certificate of experimental results, etc. submitted by submission of information by third parties

In order to explain that the claimed invention in which numerical range or mathematical expressions (including inequalities) are used as a statement to identify the product with action, function, etc. is an invention stated in publication, etc. distributed before the filing, generally, it often becomes necessary to prove it by experiments.

In the information system, due to the above necessity, a certificate of experimental results, etc. may be submitted, as a "document" to explain that the claimed invention is the invention published in publication, etc. distributed before the filing. In such case, the submitted certificate of experimental results, etc. should state the matter to be certified, details of the experiments, and experimental results.

When citing a certificate of experimental results, etc. submitted by such submission of information by third parties in a notice of reasons for refusal, the date of submission, the names of persons that conducted the experiments, etc. of the used certificate of experimental results, etc. should be stated to specify the cited evidence in the notice.

Certificates of experimental results, etc. submitted by submission of information can be browsed.

An example of certificate of experimental results is shown below.

Example of certificate of experimental results

(When certifying that the product stated in a publication is identical with the product of the claimed invention)

<p>Certificate of Experimental Results</p>	
	<p>_____(month) _____(day) _____(year) XXX Corporation YYY Laboratory xxx yyy (seal)</p>
1.	Date of the experiment
2.	Place of the experiment
3.	Person who conducted the experiment XXX Corporation YYY Laboratory xxx yyy
4.	Objectives of the experiment For example, state as follows: "To manufacture polyethylene film disclosed in the working example 1 in JP H xx-xxxxxx, and measure xx and xx of obtained film, and confirm that the polyethylene film of the claimed invention and the polyethylene film stated in the working example 1 of the above laid-open patent are identical product"
5.	Details of the experiment Show manufacturing conditions for the product in question concretely, so that it becomes obvious that the product stated in the publication is replicated faithfully. (In certain cases, merely a statement, "The film was manufactured in accordance with the working example 1 of JP H xx-xxxxxx " might be insufficient.) When any new condition is added in manufacturing the product, or an experiment cannot be conducted under conditions identical with those stated in the publication, state the reason also.) Then, in order to confirm that the product stated in the publication was replicated, measure the properties measured in the publication and state the results.

6. Results of the experiment

In order to confirm that the product stated in the publication is identical with the product of the claimed invention, measure the necessary properties and state the results. In measuring the properties of the product in question, conditions should be shown concretely so that it becomes clear that the conditions are identical with the measuring conditions used in the claimed invention. (In certain cases, merely a statement, "xx and yy were measured under the similar conditions to that of the claimed invention" might be insufficient.) When any new condition is added in the measuring, or an experiment cannot be conducted under conditions identical with those stated in the claimed invention, state the reason also.

3219 When comparison with the cited invention by statements of functions, characteristics, etc. is difficult and exact comparison cannot be made (reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

In certain cases, it is difficult to compare with the cited invention a claim which contains a statement to specify a product by functions, characteristics, etc., and falls under either one of (i) and (ii) below.

In such a case, without making exact comparison of identical features and differences with the product of the cited invention, if the Examiner has a reason to doubt that both of them are prima facie similar products and that inventive step of the claimed invention is denied, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie similar, and, if necessary, state what kind of refutation, or clarification would be effective in the Examiner's opinion.

If the applicant refutes or clarifies the reason to doubt that they are prima facie similar with written opinions, certificates of experimental results, etc., and the Examiner is not convinced that the claimed invention lacks inventive step, the reason for refusal dissolves.

When the reason to doubt that they are prima facie identical concerning inventive step does not dissolve because of the reason that the refutation or clarification by the applicant is abstract or generic, etc., and the Examiner is convinced that the claimed invention lacks inventive step, the Examiner should make a decision of refusal.

However, the Examiner should not apply such handling when using as a cited invention any invention for which the matter identifying the invention falls under (i) or (ii) below. In addition, if it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

(i) When stated functions, characteristics, etc., do not fall under any of the following:

(i-1) Standard one (Note 1)

(i-2) One customarily used by a person skilled in the art in the technical field in question (Note 2)

(i-3) One in the technical field in question; even if it is not customarily used by a person skilled in the art, a person skilled in the art can understand its relation with one customarily used by a person skilled in the art

- (ii) Multiple functions, characteristics, etc. are stated in the claim, and each of them corresponds to any of (i-1) to (i-3) above, but, when looked as one in which two or more of such functions, characteristics, etc. are combined, it falls under (i) above as a whole

(Note 1) Standard one means such that it has a definition as defined by JIS (Japanese Industrial Standards), ISO Standards (Standards of International Organization of Standardization), or IEC Standards (Standards of International Electrotechnical Commission), and can be quantitatively determined by testing or measuring methods established by those organizations.

(Note 2) One customarily used by a person skilled in the art means such that it is customarily used in the technical field in question by a person skilled in the art, and its definition and testing and measuring methods can be understood by a person skilled in the art.

2. Example of cases in which Examiner has a reason to doubt prima facie identical

- (a) When functions, characteristics, etc. of the claimed invention can be converted to those by other definition or testing or measuring method, and, a product of the cited invention that can be the ground for denying inventive step of the claimed invention judging from the result of such conversion is found
- (b) When the claimed invention and the cited invention are identified with identical or similar functions, characteristics, etc., but the measuring conditions or evaluating method are different and fall under both of (i) and (ii) below
 - (i) When there is a certain relation between measuring conditions or evaluating method of the claimed invention and the cited invention
 - (ii) When such probability is high that the functions, characteristics, etc. of the cited invention are similar to the functions, characteristics, etc. of the claimed invention, if the functions, characteristics, etc. of the cited invention are measured or evaluated with the measuring conditions or evaluating method for the claimed invention, and the cited invention becomes the ground to deny inventive step.
- (c) When a structure of a product deemed as identical with the product of the claimed invention becomes clear after the filing, and it is found that the product was such that it

could have been easily invented from a publicly known invention before the filing

- (d) When a cited invention is identical with or similar to one which is stated in the descriptions or drawings of the application as the mode for carrying out is found and the cited invention can be the ground for denying inventive step

(For example, when a cited invention having the identical manufacturing process with the manufacturing process stated as the mode for carrying out and similar starting material is found, or when a cited invention having the similar manufacturing process to the manufacturing process stated as the mode for carrying out and identical starting material is found, etc.)

- (e) When a matter specifying the invention other than matters specifying the invention expressed with functions, characteristics, etc. is common between the cited invention and the claimed invention, or such that causes lack of inventive step, and falls under both of (i) and (ii) below

(i) When the cited invention has problems or beneficial effects identical with or similar to problems or beneficial effects of matters specifying the invention expressed with the functions, characteristics, etc.

(ii) When the cited invention can be the ground for denying inventive step.

3220 When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

There could be a case in which comparison with the cited invention is difficult and exact comparison cannot be made because the claim includes statement on "another sub-combination."

In such case, same as in 3218, if the Examiner has a reason to doubt that two of them are prima facie the same products and novelty of the claimed invention should be denied without making comparison of the exactly identical features and the difference to the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt that they are prima facie identical, and, if necessary, state what kind of refutation, or clarification would be effective in the Examiner's opinion.

If it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

2. Example of a case in which Examiner has a reason to doubt prima facie identical

(a) When the relationship between one sub-combination and another sub-combination is the same or similar between the claimed invention and the cited invention, and the probability that the inventions of the sub-combinations are identical is high, and the cited invention is used as the ground for denying novelty

Example: When the content or nature of information sent/received between the sub-combination and another sub-combination is the same or similar, and the probability that inventions of sub-combinations are identical is high.

3221 When comparison with the cited invention is difficult and exact comparison cannot be made because a statement on "another sub-combination" exists in the claim (reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

There could be a case in which comparison with the cited invention is difficult and exact comparison cannot be made because the claim includes statement on "another sub-combination."

In such a case, same as in 3219, if the Examiner has a reason to doubt that both of them are prima facie the same products and inventive step of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie identical, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

If it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

2. Example of a case in which Examiner has a reason to doubt prima facie identical

(a) When the relationship between one sub-combination and another sub-combination is the same or similar between the claimed invention and the cited invention, and the probability that the inventions of the sub-combinations are similar is high, and the cited invention is used as the ground for denying inventive step

3222 When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally
(reason to doubt that novelty is prima facie denied)

1. Proceeding of examination

Concerning a claim that includes specification of product by the manufacturing method, there could be a case in which it is extremely difficult to determine what the product itself is structurally. In such case, same as in 3218, if the Examiner has a reason to doubt that both of them are prima facie same products and novelty of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of novelty. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie lack of novelty, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

However, this way of handling should not be applied by using an invention in which the matter specifying the invention is such that the product is specified by the manufacturing method as the cited invention.

If it is possible to determine on novelty through means other than this exceptional way, however, a normal way should be used.

2. Examples of cases in which examiner has a reason to doubt prima facie identical

(a) When a cited invention of a product of which starting material is similar to that of the claimed invention and which is manufactured with the same manufacturing process is found

(b) When a cited invention of a product of which starting material is identical with that of the claimed invention and which is manufactured with a similar manufacturing process is found

(c) When the structure of the product that is identified after the filing as identical with the product of the claimed invention becomes clear, and it is found to have been publicly known before the filing

- (d) When a cited invention is identical or similar to what is stated as the mode for carrying out in the descriptions or drawing of the application is found

3223 When comparison with the cited invention is difficult, and exact comparison cannot be made, because it is extremely difficult to determine what the product itself is structurally
(reason to doubt that inventive step is prima facie denied)

1. Proceeding of examination

Concerning claims that include specification of product by manufacturing method, there could be a case in which it is extremely difficult to determine what the product itself is structurally. In such a case, the same as in 3219, if the Examiner has a reason to doubt that both of them are prima facie same products and inventive step of the claimed invention should be denied without making comparison of the exactly identical features and the difference from the product of the cited invention, the Examiner should give a notice of reasons for refusal due to lack of inventive step. In the notice of reasons for refusal, the Examiner should show without fail the ground for the reason to doubt prima facie lack of inventive step, and, if necessary, state what kind of refutation or clarification would be effective in the Examiner's opinion.

However, this way of handling should not be applied by using an invention in which the matter specifying the invention is such that the product is specified by the manufacturing method as the cited invention.

If it is possible to determine on inventive step through means other than this exceptional way, however, a normal way should be used.

2. Examples of cases in which examiner has a reason to doubt prima facie identical

- (a) When a cited invention of a product of which starting material is similar to that of the claimed invention and which is manufactured with the same manufacturing process is found
- (b) When a cited invention of a product of which starting material is identical with that of the claimed invention and which is manufactured with a similar manufacturing process is found
- (c) When the structure of the product that is identified after the filing as identical with the product of the claimed invention becomes clear, and it is found that the product is such that it could be invented easily from the publicly known invention before the filing

- (d) When a cited invention which denies inventive step concerning a product identical with or similar to what is stated as the mode for carrying out in the descriptions or drawing of the application is found

3224 Article 29(1) of the Patent Act applicable to applications filed on or before December 31, 1999

Article 29(1) of the Patent Act

An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the invention, except for the following:

- (i) Inventions that were publicly known in Japan, prior to the filing of the patent application
- (ii) Inventions that were publicly worked in Japan, prior to the filing of the patent application
- (iii) Inventions that were described in a publication distributed in Japan or a foreign country, prior to the filing of the patent application

3225 Concrete Example of "Proving Document" in which Contents of the Same Degree as a Those in "Providing Document" according to the Form Exemplified in Examination Guidelines, Part III, Chapter 2, Section 5, 2.3.1 are Stated

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.2 (Excerpt)

2.3.2 The case where the "proving document" which is not compliant with the form mentioned in 2.3.1 has been submitted

The examiner shall determine whether it is proved that the Requirements 1 and 2 is satisfied on the basis of the submitted "proving document."

For example, if contents equivalent to the "proving document" compliant with the form mentioned in 2.3.1 are stated in the submitted document, in principle, the examiner shall determine that it is proved that Requirements 1 and 2 are satisfied, and shall admit the application of the provision of Article 30(2).

However, even if the "proving document" compliant with the form mentioned in 2.3.1 has been submitted, in the case where the examiner finds evidence which casts any doubt on the fact that the "disclosed invention" is an invention to which the provision of Article 30(2) is applicable, the examiner shall not admit the application of the provision of Article 30(2).

When both of (i) and (ii) below are submitted as "Providing Documents," the Examiner should determine, as a general rule, that it has been proven that Requirements 1 and 2 are satisfied, and allow application of the provision of Article 30(2).

- (i) A copy of publication in which "fact of publication" is stated to the degree that it can be understood that "(Requirement 1) "The patent application was filed within one year from the day on which the invention was made public" is satisfied
- (ii) A document in which "fact of succession of the right to obtain a patent, etc." is stated to the degree that it can be understood that "(Requirement 2) "The invention was made public as a result of an act of the person having the right to obtain a patent and the person filed the patent application for the invention published" is satisfied

3226 Concrete Example of a Case in which Applicant's Assertion is Taken into Consideration in Determining on Application of the Provision of Article 30(2)

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.4 (Excerpt)

With regard to an "disclosed invention" for which "facts of disclosure" are explicitly stated in the "proving document", after the examiner issues a notice of reasons for refusal without admitting the application of the provision of Article 30(2), the applicant may assert that the application of the provision of Article 30(2) should be admitted through a written opinion, a written statement, or other such documents. In this case, the examiner shall determine again whether it is proved that Requirements 1 and 2 are satisfied, in consideration of the assertion of the applicant together with the matters stated in the "proving document".

For example, when "fact of publication" is stated explicitly, but "fact of succession of the right to obtain a patent, etc." is not explicitly stated in the "Providing Document," if the applicant makes an assertion concerning the "fact of succession of the right to obtain a patent, etc.," the Examiner should take such assertion into consideration.

On the other hand, the Examiner should not take into consideration the applicant's assertion concerning "invention made public" for which "fact of publication" is not explicitly stated in the "Providing Document." This is because that, if the applicant's assertion is taken into consideration even for the "invention made public" for which "fact of publication" is not explicitly stated in the "Providing Document," the result in that any invention for which application of the provision of Article 30(2) is sought may be added indefinitely, and which departs from the intention of the provision of Article 30(3) or (4) in which the timing of submitting the "Providing Document" is restricted, and third parties might suffer from unexpected disadvantage.

3227 Method for Describing the Ground for not Allowing Application of Exceptions to Loss of Novelty of Invention

Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 4.1 (Excerpt)

In the case where the application of the provision of exceptions to loss of novelty of invention which is sought is not admitted, the examiner shall clearly state the reasons why the application of the provision is not admitted in a notice of reasons for refusal or a decision of refusal.

When the Examiner uses as a cited invention any invention for which the applicant sought application, the Examiner should state reason why application is not allowed in addition to a reason for refusal concerning novelty or inventive step.

Since the Examiner has determined on applicability when starting examination (Refer to Examination guidelines "Part III Chapter 2 Paragraph 5 Exceptions to loss of novelty of invention," 2.2), the Examiner should add the reason why application is not allowed together with other reason for refusal, even when the invention for which the applicant sought application is not used as a cited invention.

3228 Procedures for Having Exceptions to Loss of Novelty of Invention Applied

The Patent Office has prepared "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention applied" and "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention " and provides them on its website of the Patent Office so that applicants seeking application of exceptions to loss of novelty of invention can take required steps smoothly.

Homepage address: http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/e_pae_paa30.htm

- (1) When seeking application of exceptions to loss of novelty of invention for a patent application to which Article 30 of the Patent Act as amended in 2018 is applicable
 - (i) "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 2018"
 - (ii) "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2018"

- (2) When seeking application of exceptions to loss of novelty of invention for a patent application to which Article 30 of the Patent Act before the amendment in 2011 is applicable
 - (i) "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"
 - (ii) "Compiled Q&A concerning the Exceptions to Loss of Novelty of Invention, corresponding to the Patent Act Article 30 revised in 2011"

3229 History of Amendments of Article 30

Filing date	July 1, 1995 to December 31, 1999	January 1, 2000 to March 31, 2012	April 1, 2012 to March 31, 2015	From April 1, 2015 to June 8, 2018	From June 9, 2018
(1)	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has conducted a test, has made a presentation in a printed publication, or has made a presentation in writing at a study meeting held by an academic group designated by the Commissioner of the Patent Office, such invention shall be deemed not have fallen under any of the items of Article 29(1) in a patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has conducted a test, has made a presentation in a printed publication, has made a presentation through electric telecommunication lines, or has made a presentation in writing at a study meeting held by an academic group designated by the Commissioner of the Patent Office, such invention shall be deemed not have fallen under any of the items of Article 29(1) for the purpose of Article 29(1) and (2) for the invention claimed in a patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29 (1) against the will of the person having the right to obtain a patent, such invention shall be deemed not to have fallen under any of the items of Article 29 (1) for the purpose of Article 29 (1) and (2) for the invention claimed in a patent application which has been filed by the said person within six months from the date on which the invention first fell under any of said items.		In the case of an invention which has fallen under any of the items of Article 29 (1) against the will of the person having the right to obtain a patent, such invention shall be deemed not to have fallen under any of the items of Article 29 (1) for the purpose of Article 29 (1) and (2) for the invention claimed in a patent application which has been filed by the said person within one year from the date on which the invention first fell under any of said items.
(2)	In the case of an invention which has fallen under any of the items of Article 29(1) against the will of the person having the right to obtain a patent, the preceding paragraph shall also apply to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those paragraphs.	In the case of an invention which has fallen under any of the items of Article 29(1) against the will of the person having the right to obtain a patent, the preceding paragraph shall also apply for the purpose of Article 29(1) and (2) to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those paragraphs.	In the case of an invention which has fallen under any of the items of Article 29 (1) as a result of an act of the person having the right to obtain a patent (excluding those which have fallen under any of the items of the preceding paragraph by being contained in gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 29 (1) and (2) the invention claimed in the patent application which has been filed by the said person within six months from the date on which the invention first fell under any of those items.		In the case of an invention which has fallen under any of the items of Article 29 (1) as a result of an act of the person having the right to obtain a patent (excluding those which have fallen under any of the items of the preceding paragraph by being contained in gazette relating to an invention, utility model, design or trademark), the preceding paragraph shall also apply for the purposes of Article 29 (1) and (2) the invention claimed in the patent application which has been filed by the said person within one year from the date on which the invention first fell under any of those items.
(3)	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has exhibited the invention at an exhibition held by the Government or a local public entity (hereinafter referred to as the "Government, etc."), an exhibition held by those who are not the Government, etc. where such exhibition has been designated by the Commissioner of the Patent Office, an international exhibition held in the territory of a member country of the Union of Paris Convention or a member of the World Trade Organization by its Government, etc. or those who are authorized thereby to hold such an exhibition, or an international exhibition held in the territory of a state which is neither of a member country of the Union of the Paris Convention nor a member of the World Trade Organization by its Government, etc. or those who are authorized thereby where such exhibition has been designated by the Commissioner of the Patent Office, paragraph (1) shall also apply to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	In the case of an invention which has fallen under any of the items of Article 29(1) by reason of the fact that the person having the right to obtain a patent has exhibited the invention at an exhibition held by the Government or a local public entity (hereinafter referred to as the "Government, etc."), an exhibition held by those who are not the Government, etc. where such exhibition has been designated by the Commissioner of the Patent Office, an international exhibition held in the territory of a member country of the Union of Paris Convention or a member of the World Trade Organization by its Government, etc. or those who are authorized thereby to hold such an exhibition, or an international exhibition held in the territory of a state which is neither of a member country of the Union of the Paris Convention nor a member of the World Trade Organization by its Government, etc. or those who are authorized thereby where such exhibition has been designated by the Commissioner of the Patent Office, paragraph (1) shall also apply for the purpose of Article 29(1) and (2) to the invention claimed in the patent application which was filed by the person within six months from the date on which the invention first fell under any of those items.	Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph of this Article may be applicable.	Any person seeking the application of the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which the preceding paragraph of this Article may be applicable (in the subsequent paragraph, "Certificate").	
(4)	Any person seeking the application of paragraph (1) or (3) concerning an invention applied for a patent shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention is an invention to which paragraph (1) or (3) of this Article may be applicable.	Any person seeking the application of paragraph (1) or (3) shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating the same and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29(1) is an invention to which paragraph (1) or (3) of this Article may be applicable.			When any person submitting the "Certificate" cannot submit it within the period provided for in the preceding paragraph because of certain reason not attributable to such person, notwithstanding the provision of paragraph (3), such person may submit the "Certificate" within 14 days (two months for any person residing abroad) after the reason disappears and within six months after the period elapses.

3230 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable

(*) Concerning patent applications filed on or before December 8, 2017, refer to "3231 Inventions that were published on or before December 8, 2017 under Article 30 of the Patent Act as amended in 2018 is Applicable"

(1) Normal applications

Patent applications filed on or after June 9, 2018

(2) Patent applications according to divisional applications, converted applications and utility model registrations

Patent applications of which original applications were filed on or after June 9, 2018

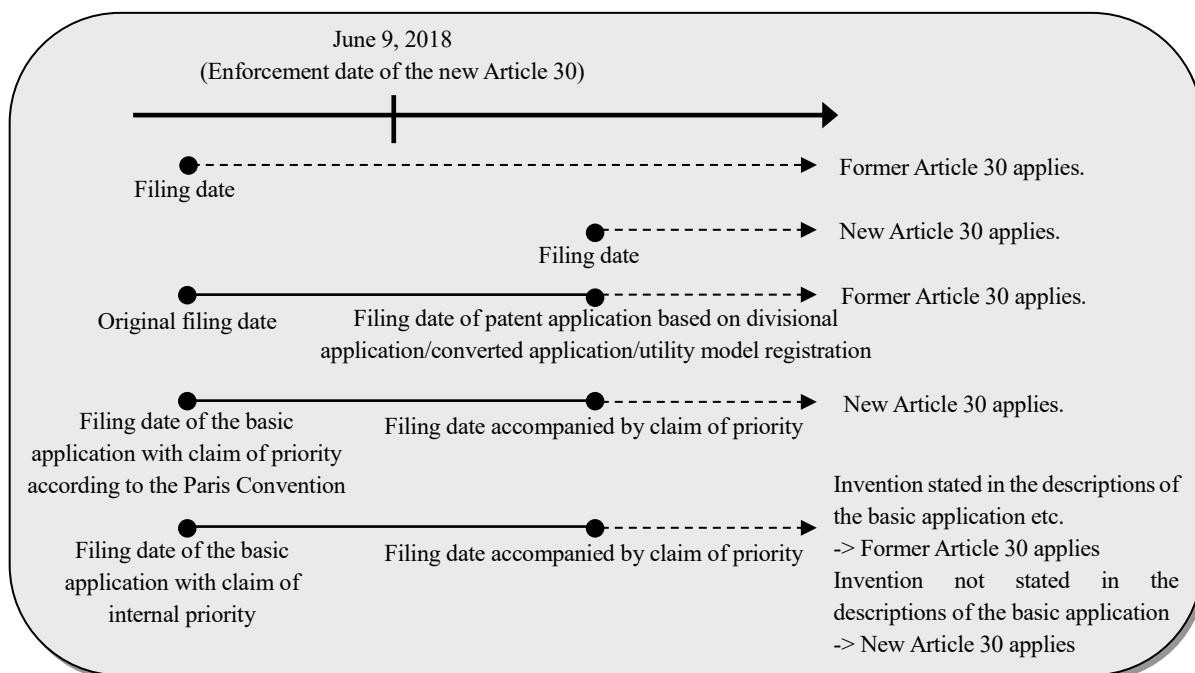
(3) Applications with claim of priority according to the Paris Convention

Patent applications of which applications with claim of priority were filed on or after June 9, 2018

(4) Applications with claim of internal priority

As a general rule ^(Note), applications for which basic application for claimed priority were filed on or after June 9, 2018

(Note) For inventions not stated in the descriptions, the claims or the drawing (descriptions, etc.) originally attached to the basic application, inventions accompanying claim of internal priority filed on or after June 9, 2018

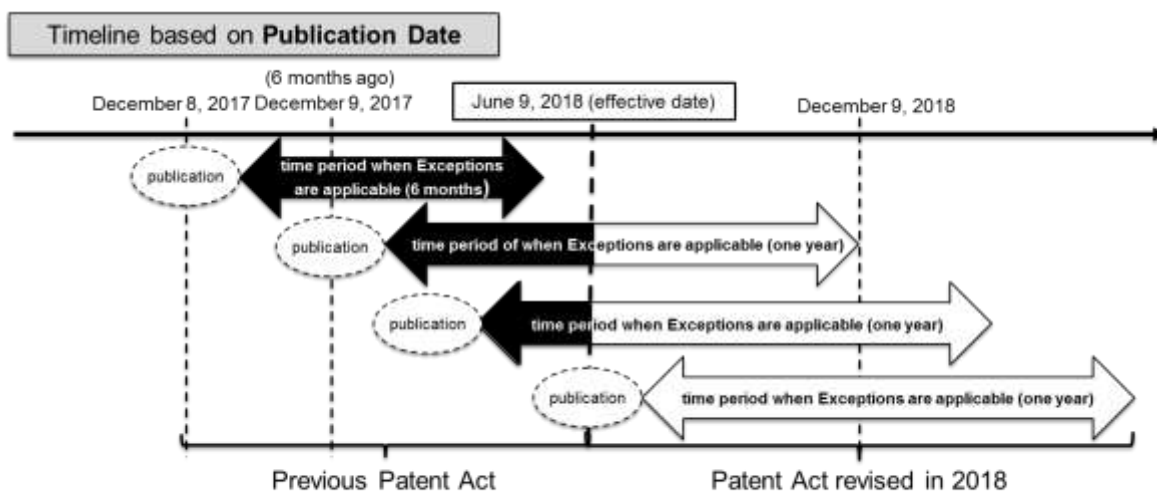


Former Article 30: Article 30 of the Patent Act before amendment of 2018

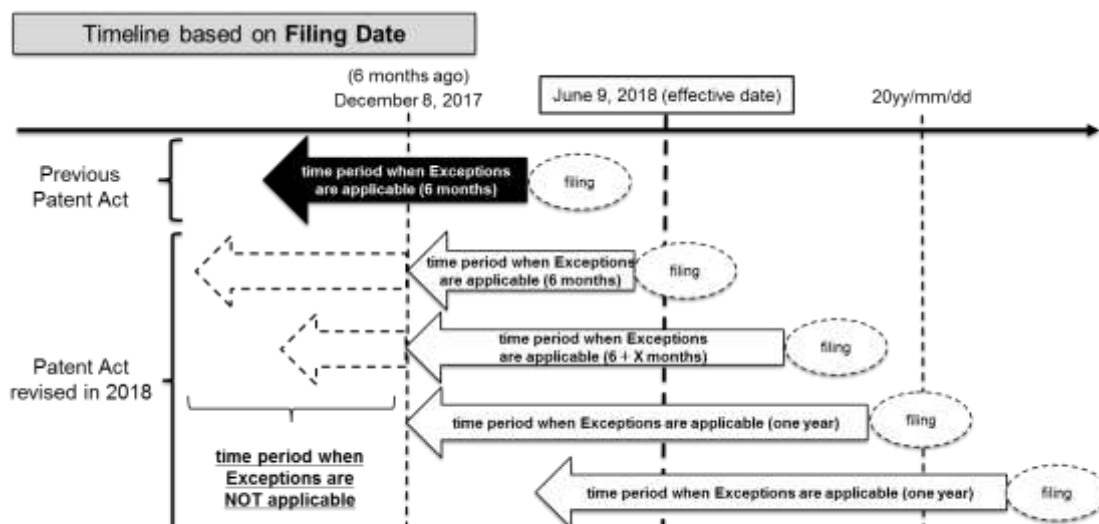
New Article 30: Article 30 of the Patent Act amended in 2018

3231 Inventions that were published on or before December 8, 2017 under Article 30 of the Patent Act as amended in 2018 is Applicable

The provision of Article 30(1) or Article 30(2) of the Patent Act is not applicable on the inventions that were published on or before December 8, 2017, even if their patent applications are filed on or after June 9, 2018. Further, the provision of exceptions to loss of novelty of invention is not applicable on the inventions unless the inventions should be filed within 6 month form the date when the invention was published.



※ Publication Date: The date when an invention is published.
 ※ Time Period when Exceptions are applicable: The provision as in Article 30(1) or Article 30(2) may be applied as long as a patent application is filed within the period.



※ Time Period when Exceptions are Applicable: The provision as in Article 30(1) or Article 30(2) may be applied as long as the publication date of an invention is within the period.

3232 Patent Applications to which Article 30 of the Patent Act as amended in 2018 is Applicable

(1) Normal applications

Patent applications filed between April 1, 2012 and June 8, 2018.

(2) Patent applications according to divisional applications, converted applications and utility model registrations

Patent applications of which original applications were filed between April 1, 2012 and June 8, 2018.

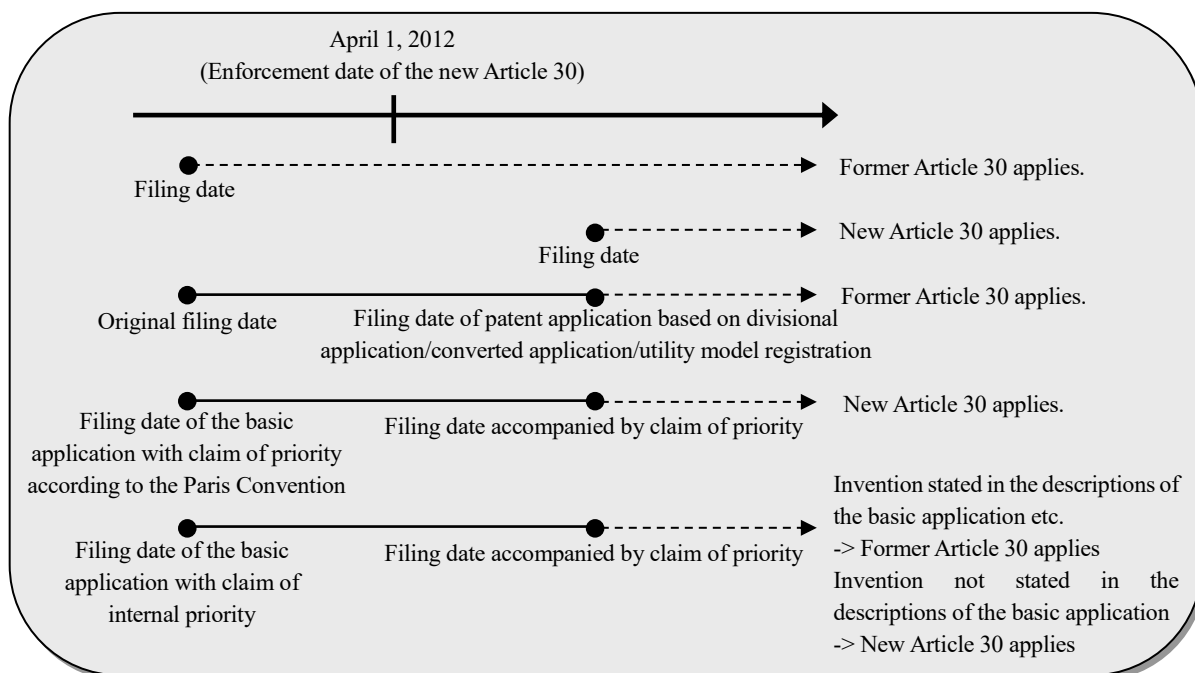
(3) Applications with claim of priority according to the Paris Convention

Patent applications of which applications with claim of priority were filed between April 1, 2012 and June 8, 2018.

(4) Applications with claim of internal priority

As a general rule (Note), applications for which basic application for claimed priority were filed between April 1, 2012 and June 8, 2018.

(Note) For inventions not stated in the descriptions, the claims or the drawing (descriptions, etc.) originally attached to the basic application, inventions accompanying claim of internal priority filed between April 1, 2012 and June 8, 2018.



Former Article 30: Article 30 of the Patent Act before amendment of 2011

New Article 30: Article 30 of the Patent Act amended in 2011

3233 Patent Applications to which Article 30 of the Patent Act prior to the Amendment of 2011 is Applicable

(*) Concerning patent applications filed on or before December 31, 1999, refer to "3234 Application of Article 30 to Patent Applications filed on or before December 31, 1999."

(1) Conditions for application for the provision of Article 30(1) or (3) of the Patent Act

The following requirements 1 to 3 are the conditions for application of Article 30(1) or (3) of the Patent Act. The Examiner should determine whether or not the "Providing Document" under the provision of Article 30(4) of the Patent Act has proven that the following Requirements 1 to 3 are satisfied.

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The event that caused lack of novelty of the invention corresponds to the publication as provided for in Article 30(1) or (3) of the Patent Act.

(Requirement 3) The invention was made public by the person having the right to obtain a patent and the person filed the patent application.

(2) Determination as to applicability of the provision of Article 30(1) or (3) of the Patent Act

(i) Timing of determination

The invention made public, for which the applicant attempted to prove that the invention in question is eligible for application of the provision of Article 30(1) or (3) of the Patent Act, may also serve as evidence denying novelty and inventive step of the claimed invention, so long as the same provision is not applicable to the invention made public. In view of this, the applicability of this provision should be determined in principle prior to starting the examination.

(ii) Procedure of determination

When a "Providing Document" prepared in accordance with the form shown in Examination guidelines, "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 is submitted within 30 days from the filing date of the patent application, the Examiner should, as a general rule, determine that it has been proven that Requirements

1 to 3 are satisfied.

However, even if a "Providing Document" prepared in accordance with the form shown in Examination guidelines, "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 has been submitted, the Examiner should not allow application of the provision of Paragraph 1 or 3, if Examiner finds any evidence that causes any doubt about applicability of the provision of paragraph 1 or 3 to the invention.

After a notice of reasons for refusal is issued without admission of the application of the provision of paragraph 1 or 3, if the applicant asserts in the written opinion, a written statement, etc. that application of the provision of paragraph 1 or 3 should be allowed, the Examiner should refer to Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Lack of Novelty of invention," 2.4 and Examination handbook "3226 Concrete Example of a Case in which Applicant's Assertion is Taken into Consideration in Determining on Application of the Provision of Article 30(2)."

"Providing Document" prepared in accordance with the form under Examination guidelines "Part III Chapter 2 Section 5 Exceptions to Loss of Novelty of Invention," 2.3.1 means Document A stated in "Operational Guidelines for Applicants to Seek the Application of Exceptions to Loss of Novelty of Invention " (Revised edition published in March 2010) (Certificate by applicant in accordance with prescribed form).

(3) Conditions for application for the provision of Article 30(2) of the Patent Act

The Examiner should determine whether or not it is reasonably explained by the written opinion, written statement etc. submitted by the application that the following two requirements are satisfied

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The invention was made public against the will of the person having the right to obtain a patent.

(4) Points to note

Refer to Examination handbook "Part I Chapter 2 Procedures of Examination," 2. for notes in drafting a decision to grant a patent.

3234 Application of Article 30 to Patent Applications filed on or before
December 31, 1999

(1) Conditions for application of the provision of Article 30(1) or (3) of the Patent Act

The following Requirements 1 to 4 are the conditions for application of the provision of Article 30(1) or (3) of the Patent Act. Examiner should determine whether or not the "Providing Document" provided for in Article 30(4) proves that the "Providing Document" provided for in Article 30(4) of the Patent Act satisfied all of the following requirements 1 to 4.

(Requirement 1) A patent application was filed within six months from the date of disclosure of the invention.

(Requirement 2) The event that caused lack of novelty of the invention corresponds to the publication as provided for in Article 30(1) or (3) of the Patent Act.

(Requirement 3) The invention was made public by the person having the right to obtain a patent and the person filed the patent application.

(Requirement 4) The invention made public is the invention of the patent application.

(2) Conditions for application of the provision of Article 30(2) of the Patent Act

The Examiner should determine whether or not written opinion, written statement, etc. submitted by the applicant have reasonably explained that the following three requirements are satisfied.

(Requirement 1) The patent application was filed within six months from the day on which the invention was made public

(Requirement 2) The invention was made public against the will of the person having the right to obtain a patent

(Requirement 3) The invention made public is the invention of the patent application

3299 Others

Concerning matters in the left columns of the following table below, refer to Reference in the columns on the right.

	Reference
Procedure of describing for publication, etc. cited in a reason for refusal due to lack of novelty, or inventive step	"1207 Matters to Be Stated in the Publications, etc. Which is Cited in the Reasons for Refusal of the Patent Application " in "Part I Chapter 2 Procedures of Examination"
Preparation of Memorandum of Patent and contents to be described	"1212 Memorandum of Patent" in "Part I Chapter 2 Procedures of Examination"
Handling of the case of "anticancer drug comprising compound X"	Appendix B, "Chapter 3 Medical invention"
Points to note in a decision to grant when steps to seek application of the provision of Article 30 are taken	2. in "1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent " in "Part I Chapter 2 Procedures of Examination"

Chapter 3 Secret Prior Art (Patent Act Article 29bis)

3301 A Case in Which Comparison Between the Claimed Invention and the Cited Invention is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely

This case conforms to 3218 to 3223 of "Part III Chapter 2 Novelty and Inventive Step".

Chapter 4 Prior Application (Patent Act Article 39)

3401 Points to Note in a Case in Which Embodiments of the Claimed Invention and the Earlier Application Invention are Identical

The examiner shall not determine that the claimed invention and the earlier application invention are "the same" simply because one embodiment related to the claimed invention and one embodiment related to the earlier application invention are identical. Because the claimed invention and the earlier application invention are creation of technical ideas utilizing the law of nature (Article 2(1) of Patent Act, Article 2(1) of Utility Model Act), determination on whether or not the claimed invention and the earlier application invention are "the same" should be carried out by determining not embodiments but identity of technical ideas.

3402 Reasons to Determine Whether or not the Claimed Invention and the Co-Pending Application Invention Filed on the Same Date are "the Same" as Described in 3.2.2 of "Part III Chapter 4 Earlier Application" of the Examination Guidelines in a Case in Which the Other Application is the Co-Pending Application Filed on the Same Date

Examination guidelines "Part III Chapter 4 Prior Application" 3.2.2 (Excerpt)

When an invention A and an invention B are applied on the same day and are the same (means "same" referred to in 3.2.1. This shall apply to corresponding counterparts in this paragraph hereunder) in the both cases of (i) and (ii) provided below, the examiner shall identify that the claimed invention and inventions claimed in the claims of the co-pending applications filed on the same date (hereinafter referred to as "co-pending inventions" in this chapter).

- (i) Where the invention A is presumed to be an earlier application and where the invention B is presumed to be a later application**
- (ii) Where the invention B is presumed to be an earlier application and where the invention A is presumed to be a later application**

In the meantime, even in a case where the invention B of the later application and the invention A of the earlier application are the same provided that the invention A is taken as an earlier application and that the invention B is taken as a later application, when the invention A of the later application and the invention B of the earlier application are not the same provided that the invention B is taken as an earlier application and that the invention A is taken as a later application, the examiner shall interpret that the claimed invention and the co-pending inventions are not the "same" (e.g., the invention A is a "spring," and the invention B is an "elastic member").

For example, with respect to such inventions A and B that the invention A is a more specific concept invention and the invention B is a generic concept invention, in a case where both are respectively filed on the same date (e.g., in a case where the invention A is "a spring" and the invention B is "an elastic body", and both inventions are respectively filed on the same date), it is not proper that both inventions are considered to be the same. It is because that, in consideration that it is not determined that the claimed invention A and the earlier application invention B are considered to be the same in a case where the filing date of the application concerned and the filing date of the other application are different from each other, it is not proper that the invention A and the invention B are considered to be the same and there are the reasons for refusal in both of the application concerned and

the other application filed on the same date.

3403 A Case in Which Matters Specifying the Invention of the Earlier Application Invention or Co-Pending Application Invention Filed on the Same Date Have Alternatives

In this case, on the basis of descriptions and drawings of the earlier application or the co-pending application filed on the same date and the common general knowledge as of the filing of the earlier application or the co-pending application filed on the same date, the invention at the time when only any one of the alternatives is supposed to be the matters specifying the invention must be recognized by a person skilled in the art from the claim(s). Accordingly, for the claim(s) in the Markush form, for example, it is required to examine whether or not one might say that a part of the alternatives is an invention that can be recognized singly by a person skilled in the art.

3404 Determination on whether or not the Claimed Invention Having Alternatives cannot be Patented according to the Provisions of Article 39, and Relationship with Termination of the Prior Art Search

Handling of 4.3 of "Part III Chapter 4 Prior Application" of the examination guidelines is not related to whether or not the prior art search can be terminated in what case. For this point, refer to 3.1.3 of "Part I Chapter 2 Section 2 Prior Art Search and Determination of Novelty, Inventive Step etc." of the examination guidelines.

3405 Notification to the Patentee (the Utility Model Right Holder), Etc. at the time when a Notice of Reasons for Refusal is issued in a Case Where the Invention Related to the Patent Application is the Same as an Invention (Device) Related to the Patent (Utility Models) Filed on the Same Date by a Different Applicant and That Has Already Registered

1. Cases where the patentee (the utility model right holder), etc. is notified

In a case where an invention related to the patent application is the same as an invention (device) related to a patent (utility models) filed on the same date by a different applicant and that has already registered, the patentee (the utility model right holder), etc. is notified of the fact when the applicant is notified of the reason for refusal based on the provision of Article 39(2) or (4) of Patent Act.

2. Form and procedure of the notification

The examiner enters necessary items in the notice to the patentee (the utility model right holder) (Annex 1) and the notice to the patent applicant¹ (Annex 2), signs the examiner's name, and then, submits a copy of each notice to an approval person together with a draft. After the approval is finished, each notice is submitted to the Coordination Division. The Coordination Division scans the notice as an internal document, and then, mails it in sealed covers.

Since the notice is not the consultation invitation (In a case where one application is patented or registered as a utility model, no consultation is permitted.), there might be no response from the applicant to the notice.

(Points to Note at Entry)

- (1) A drafting date of a notice of reasons for refusal is entered in the date field.
- (2) An address and a name of an agent (of the patent applicant in a case where there is no agent) are entered in a destination field of the notice to the patent applicant.
- (3) In a destination field of the notice to the patentee (the utility model right holder),
 - (i) in a case where the patentee (the utility model right holder) is not a foreign resident, an address and a name of the patentee (the utility model right holder)

¹ The patent applicant is also notified for a reason that both the applicant and the patentee (the utility model right holder) are notified of the notification of reasons for refusal almost simultaneously.

are entered.

- (ii) in a case where the patentee (the utility model right holder) is a foreign resident,
 - (i-1) in a case where a patent (utility models) administrator is nominated, an address and a name of the patent (utility models) administrator are entered.
 - (i-2) in a case where no patent (utility models) administrator is nominated, an address and a name of the patent (utility models) administrator at the registration of establishment are entered.

Annex 1

-

To.

Notice (For Patentee)

H , ,

Examiner _____ ()
(Signature) Author Code

To. Patentee

Please be informed of the following respect related to a patent that you are the patentee :

Japanese Patent No.
(Japanese Application No. -).

NOTE

A notice of reasons for refusal based on the provision of Article 39(2) of Patent Act is issued to the undermentioned application because it is recognized that an invention related to Claim () of the undermentioned application is identical to an invention related to Claim () of the abovementioned patent that was filed on the same date and has been already registered.

Japanese Patent Application No. -
(JP - A)

Applicant

Address

Name

Agent

Address

Name

In a case where there is a joint owner, an exclusive licensee, and a non-exclusive

licensee for the abovementioned patent right, please inform the joint owner, the exclusive licensee, and the non-exclusive licensee of the contents of this notification.

Although no consultation of Article 39(6) of Patent Act can be held in a case where one of the applications has been patented, this notification is issued because it is valuable to have a chance of substantial consultation between the patent applicant and the patentee for the purpose of avoiding reasons for refusal or grounds for invalidation and of obtaining appropriate protection.

The abovementioned patent applicant is also notified of this notification.

-

To.

Notice (For Patent Applicant)

H , ,

Examiner _____ ()
(Signature) Author Code

To. Applicant

Please be informed of the following respect related to an application that you are the applicant :

Japanese Patent Application No. -
(JP - A).

NOTE

A notice of reasons for refusal based on the provision of Article 39(2) of Patent Act is issued to the abovementioned application because it is recognized that an invention related to Claim () of the abovementioned application is identical to an invention related to Claim () of the undermentioned patent that is filed on the same date and has been already registered.

Japanese Patent No.
(Japanese Patent Application No. -)

Patentee
Address
Name

Patent administrator
Address
Name

For details of the patentee and the exclusive licensee, please confirm the registry.

Although no consultation of Article 39(6) of Patent Act can be held in a case where one of the applications has been patented, this notification is issued because it is valuable to have a chance of substantial consultation between the patent applicant and the patentee for the purpose of avoiding reasons for refusal or grounds for invalidation and of obtaining appropriate protection.

The abovementioned patentee is also notified of this notification.

3406 A Case in Which Consultation Shall be Ordered Only for Application Concerned

In a case where the applicant of the application concerned and the applicant of the other application are the same, and the application concerned and the other application satisfy any one relationship of the following (i) to (iii), the examiner can invite the consultation only for the application concerned.

- (i) Cases where the application concerned is one patent application of the divisional application group based on the other patent application (Note).
- (ii) Cases where the other patent application is one patent application of the divisional application group based on the application concerned.
- (iii) Cases where both the application concerned and the other patent application are one patent application of the divisional application group based on the same patent application.

(Note) The divisional application group based on the patent application refers to a series of divisional applications deriving from one patent application. This includes divisional applications based on one patent application, as well as divisional applications (grandchild applications) based on the divisional application (child applications).

3407 A Case in Which Comparison Between the Claimed Invention and the Earlier Application Invention or the Co-Pending Application Invention Filed on the Same Date is Difficult Due to the Descriptions Etc. of Function, Feature, Etc., and Cannot be Carried Out Precisely.

This case conforms to 3218 to 3223 of "Part III Chapter 2 Novelty and Inventive Step" of this handbook.

3408 Amendment History of Article 39

Application Date	July 1, 1995 - March 31, 1997	April 1, 1997 - December 31, 1998	January 1, 1999 - March 31, 2005	April 1, 2005 - March 31, 2012	April 1, 2012 -
(1)	Where two or more patent applications claiming identical inventions 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 for the invention claimed.				
(2)	Where two or more patent applications claiming identical inventions have been filed on the same date, only one applicant, who was selected by consultations between the applicants who filed the applications, shall be entitled to obtain a patent for the invention claimed. Where no agreement is reached by consultations or consultations are unable to be held, none of the applicants shall be entitled to obtain a patent for the invention claimed.				
(3)	Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on different dates, the applicant for a patent may obtain a patent for the invention claimed therein, only if the application for a patent is filed prior to the application for a utility model registration.				
(4)	Where an invention and a device claimed in applications for a patent and a utility model registration are identical and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.			Where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of the patent application under Article 44(2) (including its mutatis mutandis application under Article 46(6)) and a device relating to the utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.	
(5)	Where an application for a patent or a utility model registration has been withdrawn or invalidated, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be	Where an application for a patent or a utility model registration has been withdrawn or dismissed, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be	Where an application for a patent or a utility model registration has been waived, withdrawn or dismissed, or where the examiner's decision or trial decision to the effect that a patent application is to be refused has become final and binding, the application for a patent or a utility model registration shall, for the purpose of paragraphs (1) to (4), be deemed never to have been filed; provided, however, that this shall not apply to the case where the examiner's decision or trial decision to the effect that the patent application is to be refused has become final and binding on the basis that the latter sentence of paragraph (2) or (4) is applicable to the patent application.		

	deemed never to have been filed.	deemed never to have been filed.	
(6)	An application for a patent or a utility model registration filed by a person who is neither the inventor nor designer nor the successor in title to the right to obtain a patent or a utility model registration shall, for the purpose of application of paragraphs (1) to (4), be deemed to be neither an application for a patent nor an application for a utility model registration. (deleted after April 1, 2012)		The JPO Commissioner shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, designating an adequate time limit. ((7) before March 31, 2012)
(7)	The JPO Commissioner shall, in the case of paragraph (2) or (4), order the applicant to hold consultations as specified under paragraph (2) or (4) and to report the result thereof, designating an adequate time limit.		Where no report under the preceding paragraph is submitted within the time limit designated under the paragraph, the JPO Commissioner may deem that no agreement under paragraph (2) or (4) has been reached. ((8) before March 31, 2012)
(8)	Where no report under the preceding paragraph is submitted within the time limit designated under the paragraph, the JPO Commissioner may deem that no agreement under paragraph (2) or (4) has been reached.		

* For applications from April 1, 2015, the wording "Article 46(5)" is changed to "Article 46(6)".

3499 Others

Concerning matters in the left columns of the following table below, refer to Reference in the columns on the right.

	Reference
Request for submission of a document explaining that the invention related to the divisional application is not the same as the invention related to the original application and the invention related to the other divisional application	1.(4) in "1218 Cases Where the Examiner Requests to Submit the Documents or Other Materials under the Provision of Article 194(1) " in "Part I Chapter 2 Procedures of Examination"
Points to note in a case where decision to grant a patent is issued for an application of one applicant defined by the consultation	1. in "1210 Points to which Attention Should be Paid when Drafting Decision to Grant a Patent " in "Part I Chapter 2 Procedures of Examination"
Points to note in a case where decision of refusal based on <u>Article 39</u> is drafted	2. in "1213 Points to Which Attention Should be Paid When Drafting Decision of Refusal " in "Part I Chapter 2 Procedures of Examination"

Chapter 5 Category of Unpatentable Invention (Patent Act Article 32)

3501 Handling of Cases in Which Matters or Contents That Clearly Damage the Public Order or Morality are Described in the Descriptions or Drawings

In a case where the JPO Commissioner recognizes that publication in the patent official gazettes, of the matters described in the descriptions and the claims and the contents of the drawings may damage the public order or the morality (hereinafter, referred to as "public order and morality"), such matters or contents are not published in the publication of unexamined patent applications (Article 64(2) proviso). On the other hand, with respect to the gazette containing the patent after the decision to grant a patent, there are no provisions related to unpublication of such matters or contents by the JPO Commissioner (Refer to Article 66(3)).

In a case where the matters and contents that clearly damage the public order and morality are described in the descriptions or the drawings (hereinafter, referred to as "descriptions etc."), the reason for refusal of violation of Article 32 cannot be notified for only that reason. The reason for refusal of violation of Article 32 is issued to the claimed invention (Article 49-2).

Accordingly, even when the matters or contents that clearly damage the public order and morality are described in the descriptions etc., in a case where the examiner takes no reaction, such a case that the matters or contents that are not published in the publication of unexamined patent applications at publication of unexamined application is published in the gazette containing the patent occurs.

Thus, in a case where the matters or contents that clearly damage the public order and morality are described in the descriptions etc., handling is performed as follows.

1. When a reason for refusal is found, the examiner notifies of the reason for refusal to point out a part where the matters or contents that clearly damage the public order and morality in the descriptions etc., in the "proviso" of the notice of reasons for refusal, and suggests amendment that can resolve the matters.
2. In a case where it is determined that the decision to grant a patent is possible because no reasons for refusal are found, the examiner deals with the cases as follows.

- (1) Before the first notice of reasons for refusal, the examiner contacts the applicant or the agent by telephone to facilitate getting rid of the matters or the contents that clearly damage the public order and morality in the descriptions etc. by voluntary amendment.
- (2) If not before the first notice of reasons for refusal, the examiner contacts the applicant or the agent by telephone to correct the descriptions etc. by ex officio with acknowledgement if at all possible (Refer to 2.2 of 2002 of "Part II Chapter 1 Description Requirement for Detailed Description of the Invention"). The examiner performs the minimum correction by ex officio after consultation with a person in an administrative position.