

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

Section 5 Exceptions to Lack of Novelty of Invention (Patent Act Article 30)

1. Overview

Article 29 of the Patent Act provides that an invention which has fallen under any of the items of Article 29(1) prior to the patent application (in this section, hereinafter, referred to as "disclosed invention") shall not be patented in principle. However, even if the inventor files a patent application for his/her own invention after disclosure of the invention, if there is no possibility of the grant of a patent, this may be severe for the inventor. In addition, if a patent is not granted without any exception in this way, this does not match the purpose of Patent Act, which is contribution to industrial progress. Therefore, the Patent Act includes a provision that, in the case where a person having the right to obtain a patent for an invention (in this section, such "a person having the right to obtain a patent" is hereinafter referred to as "right holder") files a patent application after the invention is disclosed under specific conditions, the novelty of the invention shall not be lost for the reason of the disclosure prior to the patent application; that is, a provision of so-called exceptions to lack of novelty of invention (Article 30).

The "disclosed invention" to which the provision of exceptions to lack of novelty of invention is applicable is any of the following inventions, and is an invention for which a patent application was filed within one year from the disclosure of the invention.

- (i) An invention which was disclosed against the will of the right holder (Article 30(1))
- (ii) An invention which was disclosed resulting from an action of the right holder (Article 30(2))

In order to seek the application of the provision of Article 30(2), a document must be submitted within 30 days (Note) from the filing date proving the fact that the "disclosed invention" is an invention to which the provision of Article 30(2) may be applicable (in this section, hereinafter, referred to as "proving document") (Article 30(3)).

(Note) Where, due to reasons beyond the control of the person submitting "proving document," the person is unable to submit "proving document" within 30 days from the date of filing of the patent application, the person may submit "proving document" to the Commissioner of Patent Office within 14 days (where overseas resident, within two months) from the date on

which the reasons cease, but not later than six months following the expiration of the said time limit (Article 30(4)).

Article 30(1) or (2) is a provision about the case where an invention is disclosed against the will of the right holder or resulting from his/her action and where the right holder then files a patent application for the invention. Also in the case where a successor to the right to obtain a patent files a patent application for the invention within one year from the disclosure of the invention, the provision of Article 30(1) or (2) shall be applied.

If the provision of exceptions to lack of novelty of invention is applied to the "disclosed invention," the "disclosed invention" shall not become a cited invention at the time of making a determination on the requirements of novelty and inventive step of an invention claimed in a patent application.

2. Determination on Application of Provision of Article 30(2)

2.1 Application requirements

At the time of making a determination on the application of the provision of Article 30(2), the examiner shall determine whether it is proved that the following two requirements are satisfied, based on the "proving document" submitted in accordance with the provision of Article 30(3) or (4) (in this section, hereinafter, simply referred to as "proving document").

(Requirement 1) A patent application was filed within one year^(Note) from the date of disclosure of the invention.

(Requirement 2) The invention was disclosed resulting from an action of the right holder, and the right holder filed a patent application.

(Note) The provision of Article 30(2) is applicable on the inventions that were published on or before December 8, 2017.

2.2 Determination timing

The "disclosed invention" for which the applicant has tried to prove that the

provision of Article 30(2) is applicable can become evidence for denying novelty and inventive step of the claimed invention, if the provision of Article 30(2) is not applicable to the "disclosed invention." Therefore, the examiner shall determine whether this provision is applicable, at the time of undertaking an examination.

2.3 Determination procedures for the application of the provision of Article 30(2) based on the "proving document"

2.3.1 The case where the "proving document" which is compliant with the following form has been submitted

In principle, the examiner shall determine that it is proved that the Requirements 1 and 2 are satisfied, and shall admit the application of the provision of Article 30(2).

However, if the examiner finds evidence which casts any doubt on the fact that the provision of Article 30(2) is applicable to the invention, the examiner shall not admit the application of the provision.

Form of "Proving Document"

Proving Document for seeking Application of Provision of Exceptions to Lack of Novelty of Invention

1. Facts of Disclosure

- 1) Disclosure date
- 2) Disclosure site
- 3) Discloser
- 4) Contents of disclosed invention (the subject to be proved needs to be stated in an identifiable manner)

2. Facts of Succession to Right to Obtain Patent, etc.

- 1) Inventor of disclosed invention
- 2) Person having right to obtain patent as of action leading to disclosure of invention (the right holder as of the action)
- 3) Patent applicant (the person stated in the application form)
- 4) Discloser
- 5) About succession to right to obtain patent (succession to the right from the person in 1) to the person in 3) through the person in 2))
- 6) About relation, etc. between right holder as of action and discloser (for example, the fact that the person in 4) disclosed the invention resulting from the action of the person in 2) needs to be stated)

I hereby certify that the above statements are true.

YYYY/MM/DD
Applicant Name (Signature)

In this section, the facts corresponding to the contents of "1. Facts of Disclosure" and "2. Facts of Succession to Right to Obtain Patent, etc." are hereinafter referred to as "facts of disclosure" and "facts of succession to right to obtain patent, etc.," respectively.

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).

2.4 Determination procedures after a notice of reasons for refusal is issued without admission of the application of the provision of Article 30(2)

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".

3. Determination on Application of Provision of Article 30(1)

3.1 Application requirements

The examiner shall determine whether it is reasonably explained that the following two requirements are satisfied through a written opinion, a written statement, or other such documents submitted by the applicant.

(Requirement 1) A patent application was filed within one year^(Note) from the date of disclosure of the invention.

(Requirement 2) The invention was disclosed against the will of the right holder.

(Note) The provision of Article 30(1) is applicable on the inventions that were published on or before December 8, 2017.

· The expression that "(Requirement 2) the invention was disclosed against the will of the right holder" is "reasonably explained" means that specific situations are explained in the following cases, for example.

- (i) The case where the discloser disclosed the invention in spite of a non-disclosure obligation by an agreement made between the right holder and the discloser
- (ii) The case where someone other than the right holder disclosed the invention through theft, fraud, a threat, or other unjust measure

4. Points to Note Regarding Determination on Application of Provision of Article 30(1) and (2)

4.1 Points to note at the time of issuing a notice of reasons for refusal and a decision of refusal

In the case where the application of the provision of exceptions to lack 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.

4.2 With regard to an invention to which the provision of Article 30(2) is applicable

even if the "proving document" has not been submitted in the case where the number of inventions disclosed resulting from an action of the right holder is more than one

In the case where the number of inventions disclosed resulting from an action of the right holder is more than one; for example, in the case where the right holder has published an invention in different magazines, in order to seek the application of the provision of Article 30(2), in principle, the "proving document" for each "disclosed invention" must be submitted within thirty days from the filing date. However, in the case where the applicant proves that each "disclosed invention" satisfies all the following conditions (i) to (iii), even if the "proving document" has not been submitted, the application of the provision of Article 30(2) shall be admitted.

- (i) The "disclosed invention" is the same or can be regarded as the same as an invention for which the application of the provision of Article 30(2) has been admitted based on the "proving document" (in this section, hereinafter, simply referred to as "the invention for which the application of the provision of Article 30(2) has been admitted").
- (ii) The "disclosed invention" is an invention disclosed through a disclosure action closely related to a disclosure action of "the invention for which the application of the provision of Article 30(2) has been admitted," or the "disclosed invention" is an invention disclosed by a person who is neither the right holder nor a person who was requested by the right holder to disclose the invention.
- (iii) The "disclosed invention" is an invention disclosed after the disclosure of "the invention for which the application of the provision of Article 30(2) has been admitted."

The examiner may use inventions other than "disclosed inventions" for which "facts of disclosure" are explicitly stated in the "proving document," as cited inventions in a notice of reasons for refusal. Then, in the case where it is proved that the "disclosed invention" satisfies all the conditions (i) to (iii) in consideration of the assertion of the applicant in a written opinion, a written statement, or other such documents, the examiner shall admit the application of the provision of Article 30(2) to the cited invention.

For example, in the case where a precedingly disclosed "invention for which

the application of the provision of Article 30(2) has been admitted" and an invention disclosed resulting from an action of the right holder after the disclosure of the precedingly disclosed invention have any of the following relations, even if the "proving document" concerning the invention disclosed after the disclosure of the precedingly disclosed invention has not been submitted, the application of the provision of Article 30(2) shall be admitted.

Example 1: In the case where the right holder delivers cyclic lectures having the same contents in the same academic conference several times, the invention disclosed in the first lecture and the inventions disclosed in the second and subsequent lectures

Example 2: In the case where an article is precedingly published on a website of a publishing company and where the article is then published in a magazine issued by the publishing company, the invention published on the website and the invention published in the magazine

Example 3: The invention disclosed in an academic conference presentation and the invention disclosed thereafter by issuing the proceedings in which the contents of the academic conference presentation are summarized (Note)

(Note) In the case of the relation between the invention disclosed by issuing the proceedings in which the contents of an academic conference presentation are summarized and the invention disclosed thereafter in the academic conference presentation, condition (a) "the 'disclosed invention' is the same or can be regarded as the same" is not satisfied in many cases. Therefore, even if the application of the provision of Article 30(2) is admitted for the invention disclosed by issuing the proceedings, usually, the application of the provision of Article 30(2) shall not be admitted for the invention disclosed thereafter in the academic conference presentation unless the "proving document" concerning the latter invention has not been submitted within thirty days from the filing date.

Example 4: In the case where the right holder delivers the same products to the same customer several times, the invention disclosed in the first delivery and the invention disclosed in the second and subsequent deliveries

Example 5: The invention disclosed in television or radio broadcasting and the invention disclosed in rebroadcasting of the same contents

Example 6: The invention disclosed by selling a product by the right holder and the invention disclosed by publishing the product on a website by a third party who procures the product

Example 7: The invention disclosed at a press conference by the right holder and the invention disclosed by publishing the contents of the press conference in a journal

4.3 Points to note in various patent applications

For determining whether "(Requirement 1) a patent application was filed within one year from the date of disclosure of the invention" is satisfied, the date "on which the patent application was filed" of each of various patent applications shall be handled as follows.

4.3.1 Patent application with a claim of internal priority

In the case where an invention claimed in a patent application with a claim of internal priority is stated in the originally filed description, claims or drawings (in this section, hereinafter, referred to as "originally attached description, etc.") of an earlier patent application, the date "on which the patent application was filed" shall be the priority date (the filing date of the earlier patent application on which the claim of internal priority is based.)

However, in the case where the "proving document" has not been submitted, the date "on which the patent application was filed" shall be the filing date of the patent application with the claim of internal priority.

Also in the case where the invention claimed in the patent application with the claim of internal priority is not stated in the originally attached description, etc. of the earlier patent application, the date "on which the patent application was filed" shall be the filing date of the patent application with the claim of internal priority.

4.3.2 Patent application with a claim of priority under the Paris Convention

In the case of a patent application with a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the filing date in Japan.

4.3.3 International patent application under the Patent Cooperation Treaty (in this

section, hereinafter, referred to as "international patent application")

In the case where an invention claimed in an international patent application with a claim of internal priority is stated in the originally attached description, etc. of an earlier patent application, the date "on which the patent application was filed" shall be the priority date.

However, in the case where the "proving document" has not been submitted, the date "on which the patent application was filed" shall be the international filing date of the international patent application with the claim of internal priority.

Also in the case where the invention claimed in the international patent application with the claim of internal priority is not stated in the originally attached description, etc. of the earlier patent application, the date "on which the patent application was filed" shall be the international filing date.

In the case of an international patent application with a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the international filing date.

In the case of an international patent application without a claim of priority under the Paris Convention, the date "on which the patent application was filed" shall be the international filing date.

4.3.4 Divisional application, converted application, patent application based on utility model registration

In the case of a divisional application, a converted application, a patent application based on utility model registration, the date "on which the patent application was filed" shall be the filing date of the original application.

However, in the case where the "proving document" has not been submitted for the original application, the date "on which the patent application was filed" shall be the actual filing date.