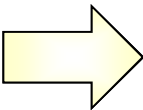


Points of Update of Examination Guidelines and Examination Handbook for Patent and Utility Model

Examination Standards Office
Administrative Affairs Division
Japan Patent Office
September, 2015

Details of Update of Examination Guidelines for Patent and Utility Model

- Overall reviewing on Examination Guidelines is referred to in various plans and policies.
 - “JPO Operational Plan (FY2014 - FY2018)”
(released in June, 2014 and revised in July, 2015)
 - “Intellectual Property Strategic Program 2014” (July, 2014)
and “Intellectual Property Strategic Program 2015” (June, 2015)
- 
- Establish easy-to-understand
Examination Guidelines
- Discussion at the meetings of the Working Group on the Patent Examination Standards supervised by the Patent System Subcommittee under the Intellectual Property Committee of the Industrial Structure Council.
 - Review at WG meetings (6 meetings) (from August, 2014 to July, 2015)
 - Overall policy of update of Examination Guidelines (1st meeting)
 - Establishing new guidelines on Category of Unpatentable Invention and Exceptions to Lack of Novelty of Invention (2nd meeting)
 - Update of the guidelines on Inventive step, Description requirements and Examination procedures (3rd to 5th meetings)
 - Update of the whole guidelines in addition to the above items (6th meeting)
 - Guidelines on Product-by-process Claims (6th meeting)

Details are posted on JPO homepage.

https://www.jpo.go.jp/shiryou/toushin/shingikai/shinsakijyun_menu.htm

- Public comments procedure on a proposal of the update of Examination Guidelines (July 8, 2015 – August 6, 2015)

Revised Examination Guidelines
Released in September, 2015 and Effective in October, 2015

Points of Update of Examination Guidelines for Patent and Utility Model

■ Objectives of Updates

- Making descriptions in the Examination Guidelines clear and concise.
 - It also contributes to a proper English translation.
- Providing enough case examples and court precedents, in order to make the Examination Guidelines easier to understand.
- Making the Examination Guidelines internationally acceptable.

■ Relationship between updated Examination Guidelines and Examination Handbook

- Examination Guidelines:
Summarizing the basic ideas of application of the relevant laws such as Patent Act.
- Examination Handbook:
Summarizing procedural matters and points to consider necessary to perform the examination procedures.
Including enough case examples, court precedents and application examples useful in understanding of the basic ideas of Examination Guidelines.

■ Structure of document and Writing style

- Describing main points ahead of the details (making easier for the examiner to access the descriptions necessary for determination)
- Making a long sentence shorter, clarifying a subject of the sentence and making descriptions clear and concise by using itemized forms and tables.
- Using a writing style suitable for providing in foreign languages.

Contents of Examination Guidelines for Patent and Utility Model

- Part I Outline of Examination
- Part II Description and Claims
- Part III Patentability
- Part IV Amendments of Description, Claims or Drawings
- Part V Priority
- Part VI Special Application
- Part VII Foreign Language Written Application
- Part VIII International Patent Application
- Part IX Extension of Patent Term
- Part X Utility Model

Formerly,
"Procedure for Examination"

(New Chapters) Exceptions to
Lack of Novelty of Invention and
Category of Unpatentable Invention

Contents of Examination Handbook for Patent and Utility Model

- Part I – Part X Same as Examination Guidelines
 - Procedural matters and points to consider related to Examination Guidelines are described.
- Part XI Affairs in General
- Appendix A Case examples of “Examination Guidelines for Patent and Utility Model”

the former “Examination Guidelines for inventions in specific fields”
- Appendix B Application examples of the specific technical fields of “Examination Guidelines for Patent and Utility Model”
- Appendix C Handbook for Preparing Report of the Utility Model Technical Opinion
- Appendix D Court precedents of “Examination Guidelines for Patent and Utility Model”

Outline of Examination

■ Principles of Update of Examination Guidelines

If there is an expectation of granting a patent, the examiner should consider in that direction.

The examiner should search prior art sufficiently at the early stage of the examination.

Part I, Chapter 1, 1.
in Examination Guidelines

■ Basic Policy of Examination

- On the premise that it is primarily the burden of the applicant, etc. to proceed with the prescribed procedures to obtain the patent right taking his/her own initiatives, the examiner should take into account the purport of establishment of high-quality patent right. (see Quality Policy on Patent Examination)

Part I, Chapter 2, Section 2, 2.2
in Examination Guidelines

■ Prior Art Search

- The examiner takes into consideration the matters reasonably expected to be added to claims by an amendment together with the working examples of the claimed inventions as the subject of search.

(This revision is aiming at the international harmonization. The basic idea is not changed.)

Outline of Examination

Part I, Chapter 2, Section 2, 2.3
in Examination Guidelines

- Invention that may be excluded from the subject of search
 - No change in the types described in the previous guidelines.
 - The examiner should give due consideration such that the least number of inventions are excluded from the subject of the prior art search.

(Points to note)

- (1) Even when the invention falls under the subject of exclusion from the prior art search due to clerical errors or minor deficiencies in the claim, the examiner should conduct the prior art search on the basis of the recognized invention as long as the invention that is not the subject of the exclusion can be recognized in light of the description, etc., or the common general knowledge at the time of filing of the application.

(For example, the case where the invention that is not the subject of the exclusion can be recognized in light of the description, etc. even when the invention falls under the violation of support requirement as a result of clerical errors in the claim.)

- (2) Even when the invention falls under the subject of exclusion from the prior art search, the examiner should conduct the prior art search on the basis of the reasonably expected invention when it is reasonably expected that the invention will not be excluded from the subject of search as a result of an amendment changing the categories of invention or a minor amendment of the statement in the claim.

(For example, the case where the invention does not comply with the requirements of eligibility for patent and industrial applicability, but can be reasonably expected that they will satisfy those requirements by a minor amendment of the statement in the claim.)

- (3) The examiner must not apply the type of clarity requirement to a case where the invention can be clearly recognized in light of the description, drawings or the common general knowledge at the time of filing of the application.

Requirements for the description and the claims

Part II, Chapter 1, Section 1, 4.1.2 in Examination Guidelines

■ Relation between enablement requirement and support requirement

- The examiner should take note that they are different.

■ Notice of reason for refusal of enablement requirement and support requirement

Part II, Chapter 1, Section 1, 4.1.1 and
Part II, Chapter 2, Section 2, 3.1.1
in Examination Guidelines

- The examiner should not reject the invention solely relying upon the common belief that “it is difficult to predict in the relevant technical field”.

■ Determination of clarity requirement in the case where a claim includes an expression which may make the scope of an invention ambiguous.

Part II, Chapter 2, Section 3,
2.2(5) in Examination Guidelines

- The examiner do not immediately determine that the scope of an invention is unclear even when a certain expression may make the scope of an invention ambiguous.
- The examiner evaluates whether a person skilled in the art can understand the scope of a claimed element including the relevant expression by considering the description and drawings as well as the common general knowledge at the time of filing of an application.
- The following type is added in this update: “Expressions which make the scope of an invention ambiguous (e.g. “about”, “approximately”, “substantially”, “essentially”) result in making the scope of the invention unclear.”

Requirements for the claims

- Expression specifying the invention of a sub-combination by elements of “another sub-combination”

Part II, Chapter 2, Section 3, 4.2.
in Examination Guidelines

Two types in determining that the invention is unclear

- (1) When a person skilled in the art cannot understand elements of “another sub-combination” from the matter stated in a claim even by considering the statements of the description and drawings as well as the common general knowledge at the time of filing of an application.
- (2) When a person skilled in the art cannot clearly understand whether or how an invention of a sub-combination is specified by elements of “another sub-combination” even by considering the statements of the description and drawings as well as the common general knowledge at the time of filing of an application.

Requirements for the claims

Part II, Chapter 2, Section 3, 4.3.2
In Examination Guidelines

- Clarity Requirement: a case where a claim includes a statement which specifies a product by a manufacturing method.
 - Revision of Examination Guidelines based on the Judgment of the Second Petty Bench of the Supreme Court on June 5, 2015.
 - When a claim concerning an invention of a product recites a manufacturing method for the product. (4.3.2)
 - When a claim concerning an invention of a product recites a manufacturing method for the product, the statement of claim complies with the clarity requirement only when the invention involves circumstances in which it is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing of an application. Otherwise the invention of the product is judged to be not clear.
(Reference) Judgment of the Second Petty Bench of the Supreme Court (June 5, 2015), 2012(Ju) No. 1204, 2658. Case of “Pravastatin sodium”.
- * “Interim Handling Procedures for Examinations and Appeals/Trials involving Product-by-Process Claims” issued on July 6, 2015
⇒ Examination Handbook 2203-2205

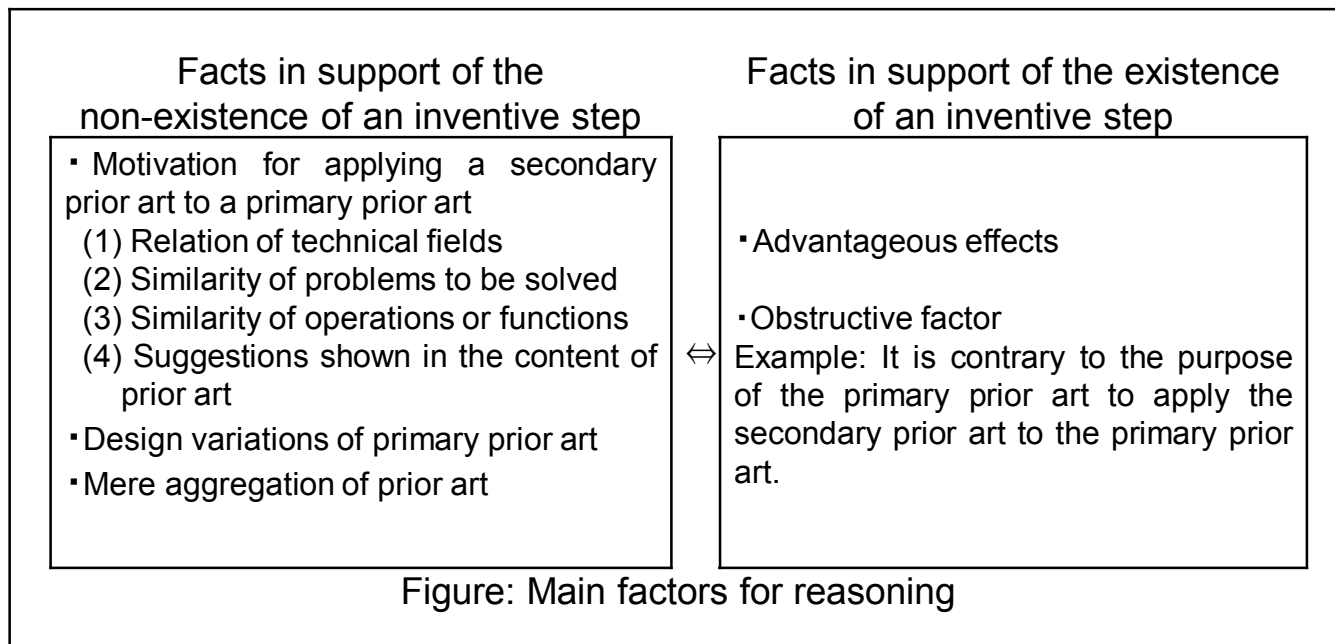
Novelty and Inventive Step

When an invention does not involve novelty → the examiner may consider the invention also does not involve an inventive step.

■ Basic practice of determination of an inventive step

Part III, Chapter 2, Section 2, 2.
In Examination Guidelines

- The examiner considers whether or not it could be reasoned that a person skilled in the art easily arrives at the claimed invention based on the prior art.
- The examiner assesses comprehensively various facts in support of the existence or non-existence of an inventive step.




Novelty and Inventive Step

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

■ Motivation for applying a secondary prior art to a primary prior art

- (1) “Relation” of technical fields (2) “Similarity” of problems to be solved (Note1)
(3) “Similarity” of operations or functions → Relation or similarity between a primary prior art and a secondary prior art

(Note 1) Similarly to the previous edition of the guidelines, a problem to be solved obvious to a person skilled in the art is also included.

- The examiner considers comprehensively four points of view which can be a motivation of invention (the above (1)-(3) and (4) (Suggestions shown in the content of prior art)), and determines whether or not motivation involves.
→ It is not always possible for the examiner to determine whether or not motivation is supported by paying attention to only one of these points of view.
-  The examiner considers the design variation, etc in applying a secondary prior art to a primary prior art.
- ✗ The examiner should not combine two or more prior arts to make a primary prior art.

Novelty and Inventive Step

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

Part III, Chapter 2, Section 2, 3.1.1 (1)
in Examination Guidelines

- Motivation for applying a secondary prior art to a primary prior art
 - ~ Relation of technical fields ~
 - The examiner should consider other points of view such as “Similarity of problems to be solved” at the same time when considering “Relation of technical fields”.
 - However, when the understanding of "technical field" involves consideration of the points of view for problems to be solved, operations and functions as well as the point of view for products to which the prior art is applied. ⇨ The determination based on the "relation of technical fields" also involves the consideration of "similarity of problems to be solved" and the "similarity of operations or functions". It is not necessary for the examiner to consider the "similarity of problems to be solved" and the "similarity of operations or functions" in determining whether or not motivation involves.

Novelty and Inventive Step

<Facts in support of the existence of an inventive step>

Part III, Chapter 2, Section 2, 3.2.2 in
Examination Guidelines

■ Obstructive Factors

- For example, the situations showing below which obstruct application of a secondary prior art to a primary prior art are regarded as the factors which prevent reasoning (obstructive factor) and support an inventive step.
 - (i) The secondary prior art applied to the primary prior art cannot achieve the purpose of the primary prior art.
 - (ii) The secondary prior art applied to the primary prior art cannot adequately function.
 - (iii) The secondary prior art which is considered to be excluded from application and unable to be adopted by the primary prior art.
 - (iv) The secondary prior art which a person skilled in the art would not apply due to a publication disclosing that the secondary prior art is inferior to the other embodiment in respect of operations and effects of the prior art.

Novelty and Inventive Step

■ Notes for determining an inventive step (1)

Part III, Chapter 2, Section 2, 3.3(1) in Examination Guidelines

- The examiner should take note of the avoidance of hindsight such as below:
 - (i) The examiner assumes that a person skilled in the art would have easily arrived at the claimed invention.
 - (ii) The examiner understands that a cited prior art is approximate to the claimed invention.

Part III, Chapter 2, Section 2, 3.3(2) in Examination Guidelines

■ Notes for determining an inventive step (2)

- Primary prior art

The examiner usually selects a primary prior art which is same or close to the claimed invention in respect of the technical fields or the problems to be solved.

- When the technical field or problem to be solved of the selected primary prior art is considerably different from that of the claimed invention, \Rightarrow The examiner should take note that it is likely to make the reasoning difficult.

The examiner needs to reason more deliberately for the fact that a person skilled in the art can easily arrive at the claimed invention starting from the primary prior art.

- The claimed invention is novel and inconceivable by a person skilled in the art may be a factor in support of the existence of an inventive step.

Novelty and Inventive Step

■ Notes for determining an inventive step (3)

Part III, Chapter 2, Section 2, 3.3 (3) in Examination Guidelines

- The examiner should not omit to consider the reasoning (considering such as whether or not there is a factor teaching away from applying the well-known art) only because the cited prior art is well-known.

■ Notes for determining an inventive step (4)

Part III, Chapter 2, Section 2, 3.3 (6) in Examination Guidelines

- The examiner may consider commercial success and the fact that the invention had been desired to achieve for a long time as a secondary consideration for supporting an inventive step.
 - Only if the examiner is convinced that these facts are not derived from other factors such as sales promotion techniques or advertisements but from the technical features of the claimed inventions on the basis of the applicant's arguments and evidences.

Novelty and Inventive Step

Part III, Chapter 2, Section 4, 4.
In Examination Guidelines

- An expression specifying the invention of sub-combination by elements of “another sub-combination”

(1) Specifying the claimed invention

Part III, Chapter 2, Section 4, 4.1
in Examination Guidelines

- The examiner should also understand the role which the elements of “another sub-combination” have in specifying the sub-combination invention from the aspect of its structure, function, etc., and specify the claimed sub-combination invention. ←The examiner should take into consideration of the statements of the description and drawings as well as the common general knowledge at the time of filing.
- (i) when an element relevant to "another sub-combination" has a role in specifying a structure, function, etc. of the claimed sub-combination invention
 - The examiner specifies that the claimed sub-combination invention has such a structure, function, etc.
- (ii) when an element relevant to "another sub-combination" does not have a role in specifying a structure, function, etc. of the claimed sub-combination invention at all
 - The examiner specifies the invention on the premise that the element relevant to "another sub-combination" does not have a role in specifying the claimed sub-combination invention.

Novelty and Inventive Step

- An expression specifying the invention of sub-combination by elements of “another sub-combination”

Part III, Chapter 2, Section 4, 4.
In Examination Guidelines

(2) Determination of Novelty

- When an element relevant to "another sub-combination" has a role in specifying a structure, function, etc. of the claimed sub-combination invention
 - Where there is a difference between a sub-combination invention and a cited prior art, the examiner determines that the sub-combination invention involves novelty.
- When an element relevant to "another sub-combination" stated in a claim does not at all specify a structure, function, etc. of the claimed sub-combination invention
 - If no differences exist other than a difference between elements relevant to "another sub-combination" and elements specifying a cited prior art in view of a description or an expression, the examiner determines that the sub-combination invention does not involve novelty.

Category of Unpatentable Invention (Patent Act Article 32)

- The examiner determines that the claimed invention falls under the category of unpatentable invention only in the case where the claimed invention obviously injures the public order, morality, etc.

Part III, Chapter 5, 2(2) in Examination Guidelines

- ☐ Example 1: Human beings themselves produced through genetic manipulation.
- ☐ Example 2: Methods used only to brutally massacre human beings.

- The examiner should not determine that the claimed invention falls under the category of unpatentable invention merely because the claimed invention can be carried out in such a manner that may injure the public order, morality, etc.

Part III, Chapter 5, 2(2)
in Examination Guidelines

- The examiner should not determine that the claimed invention falls under the category of unpatentable invention merely because its exploitation is prohibited by a Japanese law (the proviso in Article 27(2) of the TRIPS Agreement).

Part III, Chapter 5, 2(3)
in Examination Guidelines

Outlines of Revised Examination Guidelines and Handbook

Clearly stating the fundamental principles of examination.
For example,

“The examiner should take into account the significance of establishing high-quality patent rights.”
“The examiner is to take into consideration any matters reasonably expected to be added to claims based on amendments as the subject of searches”

Clearly stating the practices and procedures of the clarity requirement and novelty for the invention of a sub-combination.

Adding more case examples and court precedents including patented cases.

After revision

Before revision

256 case examples

372 case examples
193 court precedents

Contents of Revised Edition

* Total number of pages are about 500 after the revision. (About 780 pages before the revision.)

Examination Guidelines for Patent and Utility Model

- Part I Outline of Examination
- Part II Description and Claims
- Part III Patentability
- Part IV Amendments of Description, Claims or Drawings
- Part V Priority
- Part VI Special Application
- Part VII Foreign Language Written Application
- Part VIII International Patent Application
- Part IX Extension of Patent Term
- Part X Utility Model

Amending a description on the clarity requirement for Product-by-Process Claims based on the judgment by the Supreme Court on June 5, 2015.

Creating a new section called “Exceptions to Lack of Novelty of Invention” (Grace Period).

Creating a new chapter called “Category of Unpatentable Invention” (Violation of Public Order and Morality, etc.)

Clearly stating “the examiner should comprehensively assess various facts which support the existence or non-existence of an inventive step”.

Examination Handbook for Patent and Utility Model

- Part I – Part X (Procedural matters and points to consider related to Examination Guidelines)
- Part XI Affairs in General
- Appendix A Case examples
- Appendix B Application examples of the specific technical fields
- Appendix C Handbook for Preparing Report of the Utility Model Technical Opinion
- Appendix D Court precedents

Relocating the former “Part VII: Examination Guidelines for Invention in Specific Fields (computer software inventions, biological inventions and medical inventions)” to the “Examination Handbook”, and adding more case examples.

*Total number of pages are about 2000 after the revision. (About 140 pages before the revision.)