

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

Section 4 Claims Including Specific Expressions

1. Overview

In this Section, the matters which the examiner should take into consideration in addition to the matters explained in the previous sections in examining novelty or an inventive step concerning claimed invention including the following expressions from (i) through (v), and concerning (vi) selection invention.

- (i) an expression specifying the product by its operation, function, characteristics or feature (See 2.)
- (ii) an expression specifying the product by its use (See 3.)
- (iii) an expression specifying the invention of subcombination by elements of other subcombination (See 4.)
- (iv) an expression specifying the product by a manufacturing process (See 5.)
- (v) an expression specifying the invention by numerical limitation (See 6.)
- (vi) selection invention (See 7.)

2. Expression Specifying the Product by Operation, Function, Characteristics or Feature

2.1 Specifying the claimed invention

In case that there is an expression specifying the product by operation, function, characteristics or feature (hereinafter referred to as "a function or characteristics, etc." in 2.) in a claim, the examiner interprets the claim as all products including such function or characteristics, etc. in principle. For example, concerning "wall materials with layers insulating heat", the examiner specifies wall materials with "products" that are "layers with heat insulation as their operation or function" (Note). However, the examiner should keep in mind that, in some cases, the meaning of the expression specifying the product by a function or characteristics, etc. is defined or explained in the description or drawings, and thus the expression should be understood as a meaning different from the regular meaning according to the definition or explanation.

The examiner should also keep in mind that, in some cases, the claimed invention is required to be specified according to the following 2.1.1.

(Note) In some cases, the expression is not interpreted as all products including such function in consideration of the common general knowledge at the time of filing. A claim which states "means for fixing the first wooden member to the second plastic member" is an example. This means obviously does not include a fixing means used for metals or the like, such as welding, in consideration of the common general knowledge at the time of filing even though such a fixing means is not excluded according to the claim's wording.

2.1.1 Cases where function or characteristics, etc. specific to the product is stated in a claim

In these cases, even if there is an expression attempting to specify the product by a function or characteristics, etc. in a claim, the examiner understands that the expression means the product itself. This is because such an expression is meaningless for specifying the product.

Example 1: Chemical compound X having anti-cancer effects

(Explanation)

If anti-cancer effects were inherent in a chemical compound X, the expression of "having anti-cancer effects" would be meaningless for specifying the product. Accordingly, the examiner understands that the expression of Example 1 means "chemical compound X" itself whether the fact that the chemical compound X has anti-cancer effects is known or not.

Example 2: RC integrator cutting high frequency signals and passing low frequency signals

(Explanation)

The feature of "cutting high frequency signals and passing low frequency signals" is the function inherent in "RC integrators." Accordingly, the examiner understands that the expression of Example 2 means general "RC integrators."

However, the claim of "RC integrator cutting high frequency signals with ...Hz or more and passing low frequency signals with ...Hz or less" is not the function inherent in general "RC integrators." In these cases, the examiner understands that such statement means "RC integrator with specific frequency characteristics" because the statement of the claim is meaningful for specifying the product,

2.2 Determination of novelty or inventive steps

If a product having a function or characteristics, etc. stated in a claim is

publicly known, the examiner determines that the product specified by a function or characteristics, etc. in a claim lacks novelty. For example, if wall materials are publicly known which are equipped with such "product" as "layers having a function of heat insulating," the examiner determines that "wall materials with layers insulating heat" lacks novelty. However, the examiner should keep in mind that, in some cases, the claimed invention should be determined as described in 2.2.1.

2.2.1 Cases where function or characteristics, etc. inherent in the product is stated in a claim

In these cases, if the product is publicly known, the examiner determines that the product lacks novelty. This is because a function or characteristics, etc. stated in a claim is meaningless for specifying the product.

Example 1: Chemical compound X having anti-cancer effects (same as Example 1 of 2.1.1)

(Explanation)

The claimed invention is interpreted as "Chemical compound X" itself. Accordingly, if the chemical compound X is publicly known, the claimed invention lacks novelty.

Example 2: RC integrator cutting high frequency signals and passing low frequency signals (same as Example 2 of 2.1.1)

(Explanation)

The claimed invention is interpreted as a general "RC integrator." Accordingly, because general "RC integrators" are publicly known, the claimed invention lacks novelty.

However, as for the claim of "RC integrator cutting high frequency signals with ...Hz or more and passing low frequency signals with ...Hz or less," the claimed invention is interpreted as a "RC integrator with specific frequency characteristics." Therefore, a general RC integrator does not deny the novelty of the claimed invention.

2.2.2 Cases where comparison with prior art is difficult and strict comparison is impossible due to the expression of a function or characteristics, etc.

In these cases, the examiner issues a notice of reason for refusal on novelty or an inventive step only where he/she has a certain degree of reasonable doubt that the claimed invention lacks novelty or an inventive step. The examiner should explain the reasonable doubt in the notice of reason for refusal.

3. Expression Specifying the Product by its Use Application (Limitation of Use)

3.1 Specifying claimed invention

If there is an expression specifying the product by use application such as "for use in ..." (the limitation of use application) in a claim, the examiner should take into consideration the description and drawings as well as the common general knowledge at the time of filing in interpreting what the limitation of use means as a claimed element.

3.1.1 Basic ideas in cases where there is limitation of use application

If the product with limitation of use means the product specifically suitable for its use, the examiner recognizes that the product has a shape, structure or composition, etc. (hereinafter simply referred to as "structure, etc." in 3.) that the limitation of use means (See Examples 1 and 2). The case where "the product with limitation of use means the product specifically suitable for the use application" is the case where the meaning of the limitation of use application is interpreted as the structure, etc. specifically suitable for the use application in consideration of the description and drawings as well as the common general knowledge at the time of filing.

On the other hand, if the product with limitation of use application does not mean the product specifically suitable for the use application, except for the use application of 3.1.2, the examiner should not interpret the limitation of use application to specify the product.

Example 1: Crane hook with a shape of ...

(Explanation)

In some cases, the meaning of the expression "crane" is interpreted as "hook" having a structure specifically suitable for use in crane from the aspect of its size or intensity or the like. In these cases, the examiner recognizes the claimed invention as the "hook" with such a structure. Accordingly, "a crane hook with a shape of ..." is different in structure, etc. from "a fishing hook (fishhook)" with a similar shape.

Example 2: Fe based alloy for a piano string of composition A

(Explanation)

In some cases, the meaning of the expression “for a piano string” is interpreted as a fine-layered structure for giving high-tension specifically suitable for a piano string. In these cases, the examiner recognizes the claimed invention as "Fe based alloy" with such a structure. Accordingly, "Fe based alloy for a piano string of composition A" is different in structures, etc. from Fe based alloy which does not have such a structure (for example, "Fe based alloy for use in gear wheel of composition A").

3.1.2 Cases where an invention of a product with limitation of use application should be interpreted as a use invention

A use invention is defined as the invention based on (i) discovering an unknown attribute of a product and (ii) finding out that the product is suitable for a novel use application because of such an attribute. The following ideas on the use invention are generally applied to the technical fields (Example: a technical field for use of a composition including chemical substances) where it is relatively difficult to know how to use the product based on the structure or name of the product.

(1) Cases where claimed invention is considered to be a use invention

In these cases, the examiner recognizes that the limitation of use application has a role in specifying the claimed invention, and specifies the claimed invention in consideration of the limitation of use application.

Example 1: Composition for use in anti-fouling ship bottoms comprising a specific quaternary ammonium salt.

(Explanation)

This composition and "the composition for use in undercoating for electrodeposition comprising certain quaternary ammonium salt" is not different except for their limitation of use. However, the use application such as "use in undercoating for electrodeposition" is, in some cases, derived from an attribute that enables electrodeposition on materials and that improves adherence of overcoat layers. In these cases, the examiner specifies the claimed invention, in consideration of the limitation of use application such as "use in anti-fouling ship bottoms" where both of the following conditions (i) and (ii) are satisfied. (Accordingly, these inventions are different from each other.) That is because this limitation of use application has a role in specifying the "composition."

(i) "The use in anti-fouling ship bottoms" is derived from discovery of an unknown attribute that prevents shells from sticking to ship bottoms.

- (ii) The use application which is derived from the attribute is different from any known uses and novel.

Example 2:

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

[Claim 2] A food composition for use in preventing a hangover according to claim 1, wherein the food composition is a fermented milk product.

[Claim 3] A food composition for use in preventing a hangover according to claim 2, wherein the fermented milk product is yogurt.

(Explanation)

The claimed invention "A food composition for use in preventing a hangover containing an ingredient A as an active ingredient" and the cited invention "a food composition containing an ingredient A" are not different except a limitation of use application. In this case, the examiner specifies the claimed invention in consideration of the limitation of use application such as "for use in preventing a hangover" provided that both of the following conditions (i) and (ii) are satisfied. (Accordingly, these inventions are different from each other.) That is because this limitation of use application has a role in specifying "a food composition. "

(i) "The use in preventing a hangover" is derived from discovering of an unknown attribute that promotes alcohol metabolism by an ingredient A.

(ii) The use application which is derived from the attribute is different from any known uses and novel.

The same way of specifying the claimed invention also applies to a fermented milk product and yogurt which are more specific concept of a food composition.

(2) Cases where claimed invention is not considered to be use invention though there is a limitation of use application in a claim

Where the claimed invention is not considered to provide a novel use as the use of the product in consideration of the common general knowledge in the field at the time of filing, the invention does not fall under the category of use invention even if an unknown attribute was discovered. The examiner specifies the claimed invention with the understanding that the limitation of use does not have a role in specifying the claimed invention. The same applies to the case where the use of the claimed invention and prior art are not distinguishable from each other in consideration of the common general knowledge in the field at the time of filing even if they are different in their wordings.

Example 3: Cosmetic product containing ingredient A as an active ingredient for use in preventing wrinkle.

(Explanation)

"Cosmetic product containing ingredient A as an active ingredient for use in moisture retention of the skin" are derived from an attribute that adjusts the skin by softening the stratum corneum and helping the skin to absorb water. On the other hand, "cosmetic product containing ingredient A as an active ingredient for wrinkle defense" are derived from an unknown attribute that improves the skin condition by promoting the production of substance X in the body. However, both products are used externally for skin as skin-care cosmetics. In addition, if it is common knowledge in the field that the cosmetics with a moisturizing effect improve skin condition by preventing skin wrinkles, etc. with moisture retention and are also used for prevention of skin wrinkles, the use of these two products cannot be distinguished. Therefore, the examiner specifies the claimed invention with the understanding that the limitation of use, the expression "for use in preventing wrinkle," does not have a role in specifying the claimed invention.

(3) Points to note

A claim of use invention can be expressed in the form of drug (example: "cancer treatment drug containing ... as an active ingredient") and the form of method of use as well as the form of limitation of use application. What is described in the above items (1) and (2) is also applicable to use invention expressed in these forms other than limitation of use application only if there is an expression meaning a use application in the claim. (For example, "catalyst comprising ...," "ornamental material composed of alloy ...," "method of killing insects using")

3.1.3 Cases where ideas described in 3.1.1 or 3.1.2 are not applied or generally not applied

(1) Compounds, Microorganisms Animals or Plants

The ideas described in 3.1.1 and 3.1.2 are not applied to a compound with the limitation of use such as an expression "for use in ..." (compound Z for use in Y). The examiner interprets such a compound as the compound itself without limitation of use application (compound Z) (Example). That is because such a limitation of use only indicates the utility of compounds in general. The same also applies to microorganisms, animals and plants.

Example: Compound Z for use in killing insects.

(Explanation)

The examiner interprets "compound Z for use in killing insects" as "compound Z" itself without limitation of use because the expression "for use in killing insects" only indicates the utility of the compounds in consideration of the statements of the description and drawings as well as the common general knowledge at the time of filing. However, the examiner does not interpret "insecticide comprising compound Z as a main ingredient" in the same way as described above.

(2) Machines, apparatuses, articles and instruments, etc.

The ideas on use invention described in 3.1.2 are generally not applied to machines, apparatuses, articles and instruments, etc., because the product and its use are inseparably connected with each other in general.

3.2 Determination of novelty

3.2.1 Cases where the product of the invention stated in a claim has limitation of use application and the limitation means the product specifically suitable for its use application

In these cases, where there are differences in structure, etc. that the limitation of use means, the examiner determines that the claimed invention is different from the cited prior art even if all the claimed elements correspond to all the elements of the cited prior art except for the limitation of use. Therefore, the examiner determines that the claimed invention involves novelty.

Example 1: Crane hook with a shape of ... (same as Example 1 of 3.1.1)

(Explanation)

Where the statement of a claim is interpreted to specify the "hook" having structure specifically suitable for use in crane from the aspect of its size or intensity or the like, the claimed invention involves novelty even if "a fishing hook (fishhook)" with a similar shape is publicly known.

3.2.2 Cases where the product of the invention stated in a claim has limitation of use application, but the use application does not mean the product specifically suitable for its use and the claimed invention does not fall under the use

invention of 3.1.2

In these cases, where all the claimed elements correspond to all the elements of the cited prior art except for the limitation of use, the examiner does not determine that the claimed invention is different from the cited prior art. Therefore, the examiner determines that the claimed invention lacks novelty.

3.2.3 Cases where the claimed invention falls under the use invention of 3.1.2

In these cases, even if the product itself of the claimed invention is publicly known, the claimed invention involves novelty over the product (Note).

(Note) The use invention which involves novelty does not involve an inventive step where it is considered that a person skilled in the art would have easily arrived at such use application based on known attributes or structures of the product.

<h2>4. Expression Specifying the Invention of Sub-combination by Elements of “Another Sub-combination”</h2>

In cases where an invention of overall apparatuses or an invention of method of manufacturing a product (hereinafter referred to as "combination") is formed by combining two or more apparatuses or processes, sub-combination is defined as an invention of each apparatus or each process of the combination.

4.1 Specifying the claimed invention

The examiner should consider elements relevant to "another sub-combination" stated in the claim and not ignore them in specifying the claimed invention. The examiner should also understand the role which the elements have in specifying the sub-combination invention from the aspect of its shape, structure, constituent element, composition, operation, function, property, characteristic, method (an act or action), use, etc. (hereinafter referred to as "a structure, function, etc." in 4.) when he/she specifies the claimed sub-combination invention. In this regard, the examiner takes into account the statements of the description and drawings as well as the common general knowledge at the time of filing.

4.1.1 Cases where an element relevant to "another sub-combination" has a role in specifying a structure, function, etc. of the claimed sub-combination invention

In these cases, the examiner understands that the claimed sub-combination invention has such a structure, function, etc.

Example 1:

A client system which transmits a search word to a search server, receives return information from the search server, decodes the return information by a decoding means, and displays a search result on display means, wherein the search server transmits the return information after encrypting it by means of an encryption scheme A.

(Explanation)

Taking the common general knowledge at the time of filing into consideration, the client system cannot display the search result without using a decoding means compatible with the encryption scheme A. Therefore, the statement that the search server transmits the return information after encrypting it by means of the encryption scheme A specifies the client system in that the decoding means of the client system performs a decoding process corresponding to the encryption scheme A. Consequently, the claimed invention is found on the premise that the client system which is the invention of the sub-combination is specified as such.

Example 2:

A portable phone having a power charge terminal capable of being recharged with a charger which has a power feed terminal on one of four interior side surfaces of an accommodation indentation and which has light-receiving means on a side surface opposite to the side surface with the power feed terminal, wherein the charger ceases charging upon detection of a color of a lamp showing completion of charging of the portable phone by using the light-receiving means.

(Explanation)

A positional relationship between the power feed terminal and the light-receiving means of the charger specifies a positional relationship on the portable phone between its charge terminal and the lamp provided on the side surface opposite to the side surface with the charge terminal. Therefore, in connection with the portable phone that is the invention of the sub-combination, the claimed invention is found to be specified as such.

4.1.2 Cases where an element relevant to "another sub-combination" specifies only

"another sub-combination" and does not specify a structure, function, etc. of the claimed sub-combination invention at all .

In these cases, 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.

Example 1:

A client server capable of transmitting a search word to a search server, receiving return information, and displaying a search result on display means, wherein the search server changes a search method on the basis of a frequency in search of the search word.

(Explanation)

The statement that the search server changes the search method on the basis of a frequency in search of a search word specifies what the search server is. In the meantime, the statement does not specify at all a structure, function, etc. of the client system. Therefore, the claimed invention is found on the premise that the search server changing the search method on the basis of the frequency in search of the search word does not have a role in specifying the client system that is the invention of the sub-combination.

Example 2:

A liquid ink storage container capable of being attached to an image forming apparatus with a humidity sensor, wherein pressure with which the image forming apparatus squirts ink toward a sheet member is controlled according to humidity detected by the humidity sensor.

(Explanation)

The statement that the image forming apparatus controlling pressure for squirting ink in accordance with detected humidity specifies what the image forming apparatus is. In the meantime, the statement does not specify at all a structure, function, etc. of the liquid ink storage container. Therefore, the claimed invention is found on the premise that the image forming apparatus has a humidity sensor and controls the pressure for squirting ink in accordance with humidity detected by the humidity sensor do not have a role in specifying the liquid ink storage container that is the invention of the sub-combination.

Example 3:

A key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring, wherein a security buzzer which emits an alarm sound when actuated is attached to the key ring.

(Explanation)

The statement that the security buzzer is attached to the key ring specifies what the key ring is. In the meantime, the statement does not specify at all a structure, function, etc. of the key. Therefore, the claimed invention is found on the premise that the security buzzer attached to the key ring does not have a role in specifying the key which is an invention of the sub-combination.

However, the examiner should make it a point to avoid focusing only on the fact that the sub-combination and another one are different from each other and misunderstanding that the "element relevant to another sub-combination" does not have a role in specifying the sub-combination invention.

4.2 Determination of novelty or an inventive step

4.2.1 Cases where an element relevant to “another sub-combination” stated in a claim 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. However, in case that the difference relates to an operation, function, property, characteristic, method (an act or action), use, etc., see Clauses 2., 3., and 5. as to an determination of novelty.

Example 1:

A client system which transmits a search word to a search server, receives return information from the search server, decodes the return information by a decoding means, and displays a search result on display means, wherein the search server transmits the return information after encrypting it by means of an encryption scheme A. (identical to Example 1 of 4.1.1)

(Explanation)

In relation to the client system that transmits a search word to the search server, receives return information, and displays a search result on the display means, the claimed invention has novelty unless the client system with decoding means compatible with the encryption scheme A is well known.

Example 2:

Portable phone capable having a power charge terminal of being recharged with a charger which has a power feed terminal on one of four interior side surfaces of an accommodation indentation and which has light-receiving means on a side surface opposite the side surface with the power feed terminal, wherein the charger ceases charging upon detection of a color of a lamp showing completion of charging of the portable phone by using the light-receiving means. (identical to Example 2 of 4.1.1)

(Explanation)

In relation to the portable phone with the charge terminal and the lamp showing completion of recharging operation, the claimed invention has novelty unless a portable phone with a lamp on a side surface opposite a side surface with the charge terminal is well known.

4.2.2 Cases where 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

In these cases, if no differences exist except for a difference between elements relevant to "another sub-combination" and elements specifying a cited prior art in view of a description or an expression, there are no differences between the claimed sub-combination invention and the cited prior art in terms of a structure, function, etc.

Therefore, the examiner determines that the sub-combination invention does not involve novelty.

Example 1:

A client server capable of transmitting a search word to a search server, receiving return information, and displaying a search result on display means, wherein the search server changes a search method on the basis of a frequency in search of the search word. (identical to Example 1 of 4.1.2)

(Explanation)

If the client system capable of transmitting a search word to the search server, receiving return information, and displaying a search result on display means is well known, the claimed invention lacks novelty. In that the search server changes the search method according to the frequency in search of a search word, the well-known client systems and the client system of the claimed invention differ from each other in view of a description and an expression but have no difference in terms of a structure, function, etc.

Example 2:

A liquid ink storage container capable of being attached to an image forming apparatus with a humidity sensor, wherein pressure with which the image forming apparatus squirts ink toward a sheet member is controlled according to humidity detected by the humidity sensor.

(identical to Example 2 of 4.1.2)

(Explanation)

If a liquid ink storage device capable of being attached to an image forming apparatus is well known, the claimed invention lacks novelty. In that the image forming apparatus has a humidity sensor and controls pressure for squirting ink in accordance with the humidity detected by the humidity sensor, the well-known liquid ink storage device and the liquid ink storage device of the claimed invention are different from each other in view of a description and an expression but have no differences in terms of a structure, function, etc.

Example 3:

A key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring, wherein a security buzzer which emits an alarm sound when actuated is attached to the key ring. (identical to Example 3 of 4.1.2)

(Explanation)

If a key with a hole formed so as to enable the key to be suspended on a holder ring of a key ring is well known, the claimed invention lacks novelty. In that the security buzzer which emits an alarm sound when actuated is attached to the key ring, the well-known keys and the key of the claimed invention are different from each other in view of a description and an expression but have no differences in terms of a structure, function, etc.

4.2.3 Cases where it is difficult to compare a claimed invention and a cited prior art, and the examiner is not able to compare them strictly due to an element relevant to "another sub-combination" in a claim

In these cases, the examiner may issue a notice of reasons for refusal on novelty or an inventive step only if he/she conceived a reasonable prima facie doubt that the claimed invention does not involve novelty or an inventive step. However, the examiner should explain about the reasonable doubt in the notice of reasons for refusal.

5. Expression Specifying a Product by a Manufacturing Process

5.1 Specifying the claimed invention

Where a claim includes a statement which specifies a product by a manufacturing process, the examiner construes the statement as a finally-obtained product itself. Therefore, even when the applicant obviously attempts to limit the invention solely to a substance manufactured by a specific process with his/her own will, such as "Z manufactured solely by a process A," the examiner construes the statement as the product itself (Z) and specifies the claimed invention.

5.2 Determination of novelty or an inventive step

5.2.1 Cases where a product manufactured by a manufacturing process stated in a claim is identical with a product of a cited prior art

In these cases, a claimed invention lacks novelty caused by the matters of manufacturing process regardless of whether or not the manufacturing process stated in a claim has novelty.

Example 1: Protein manufactured by a manufacturing process P (processes p1, p2, ... and pn)
(Explanation)

When protein manufactured by a manufacturing process P is identical with well-known specific protein Z manufactured by a manufacturing process Q, the claimed invention lacks novelty regardless of whether or not the process P has novelty.

5.2.2 Cases where a comparison and a strict contradistinction between a claimed invention and a cited prior art cannot be made because it is extremely difficult to structurally determine what a product itself is.

In these cases, the examiner issues a notice of reasons for refusal on novelty or an inventive step only when having a reasonable prima facie doubt that novelty or an inventive step of the claimed invention is negated. However, the examiner must provide explanations about the reasonable doubt in the notice of reasons for refusal.

6. Expression Specifying the Invention by Numerical Limitation
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6.1 Specifying the claimed invention

Even when there is a statement about specifying an invention by use of a numerical limitation in a claim, a claimed invention is found in the same manner as in a usual case (see 2 in “Section 3 Procedure of Determining Novelty and Inventive Step”)

6.2 Determination of an inventive step

Where there is a statement about specifying an invention by use of a numerical limitation in a claim, the claimed invention usually has no inventive step when a point of difference between a main cited prior art and the claimed invention lies solely in the numerical limitation. The reason for this is that experimentally optimizing a range of numerals or making the same appropriate can be said to be exercise of ordinary creative activity of a person skilled in the art.

However, when the claimed invention yields an effect of comparison with the cited prior art fulfilling all requirements (i) to (iii) provided below, the examiner determines that such an invention for limiting numerical values has an inventive step.

- (i) The effect is advantageous within a limited range of numerical values although it is not disclosed in evidence of the prior art.
- (ii) The effect is different in nature from an effect yielded by the prior art, or remarkably superior although it is the same as the effect of the prior art (namely, the advantageous effect exhibits prominence).
- (iii) The effect is not one which can be predicted by a person skilled in the art from the state of the art as of filing.

In order to say that an advantageous effect exhibits prominence, prominence must be said to exist in an overall range of numerical values.

In addition, where a difference between the claimed invention and the main cited prior art lies only in presence/absence of a numerical limitation and where a common problem exists, a remarkable quantitative difference of the effect must exist outside and inside the boundary of numerical limitations in order that the distinctiveness of the advantageous effect shall be admitted as critical significance of numerical limitations. On the other hand, where a difference between the claimed invention and the primary cited prior art lies only in presence/absence of a numerical limitation, and where a problem is not common and an advantageous effect is different in nature, it is not required that numerical limitations have the critical significance.

7. Selection Invention

7.1 Specifying the claimed invention

A selection invention is an invention that belongs to a technical field where an effect, which would be yielded by a structure of an article, is difficult to predict and fulfills the following items (i) or (ii).

- (i) An invention (b) which is selected from invention (a) expressed in a broader concept in publications, etc. and which is expressed in a narrower concept embraced within the broader concept, wherein novelty of the invention (b) is not denied by the invention (a) expressed in the broader concept in publications, etc.
- (ii) An invention (b) which is selected from invention (a) expressed by multiple choices (Note) in publications, etc. and which has a part of the choices as invention elements, wherein novelty of the invention (b) is not denied by the invention (a) expressed by the multiple choices in publications, etc.

Therefore, an invention which cannot be said to be stated in prior art documents can be a selection invention.

Even in connection with a selection invention, a claimed invention is specified in the same manner as in an ordinary case (see 2 in “Section 3 Procedure of Determining Novelty and Inventive Step”.)

(Note) see 4.1.1(note1) in "Section 3 Procedure of Determining Novelty and Inventive Step" for "choices."

7.2 Determination of an inventive step

When effects of a selection invention fulfill all of the following items (i) to (iii), the examiner determines that the selection invention involves an inventive step.

- (i) The effect of the selection invention is an advantageous effect which is not stated in prior art documents, etc.
- (ii) The selection invention yields an effect which is different from, or identical but prominently superior to an effect yielded by an invention expressed in a broader concept or multiple choices.

(iii) The effect of the selection invention cannot be predicted by a person skilled in the art from the state of the art.

Example:

Compounds expressed by a certain general formula have been known to have insecticidal property. A claimed invention is included in the general formula.

However, the claimed invention is based on a finding that a certain specific compound, which is not specifically well-known about its insecticidal property, is remarkably less poisonous to human beings than the other compounds expressed by the general formula, and is conceived by selecting the specific compound as an active ingredient of an insecticide. There is no evidence from which the compound is predictable.

In this case, the claimed invention involves an inventive step as a selection invention.