

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

Chapter 1 Basic Requirements for Utility Model Registration

1. Overview

In the interest of early protection of rights on devices, the Utility Model Act provides that registration establishing a utility model right be effected without substantive examination if certain requirements are met by the application (Utility Model Act, Article 14(2) (references in this Part to articles and paragraphs without reference to the name of a law should be taken as references to articles and paragraphs of the Utility Model Act)). Article 6bis specifies these certain requirements (other than formal requirements) (the requirements for Article 6bis are referred to as the "basic requirements" hereafter in this Part).

The Utility Model Act prescribes that a utility model right be granted without substantive examination of the utility model registration application, but such granting is conditional upon the establishment of such right being registered. Therefore, utility model registration applications must meet not only the formal requirements specified in Article 2bis(4), but also certain requirements for the registration of a utility model right. This is why Article 6bis was introduced.

The imposition of these basic requirements works to prevent a utility model right being granted for devices that are not protectable under the Utility Model Act, and the automatic registration of applications which substantially do not qualify as filing documents.

Specifically, applications are judged not to satisfy the basic requirements in any of the cases (i) to (v) below.

- (i) They are not protectable (Articles 6bis(i) and 14ter(i)).
- (ii) They are against public order and morality (Articles 6bis(ii), 14-3(ii) and 4).
- (iii) They do not meet the Ministerial Ordinance requirements pertaining to statements in the claims of the utility model (Articles 6bis(iii), 14-3(iii) and 5(6)(iv), and Regulations under the Utility Model Act, Article 4).
- (iv) The claimed device does not meet the requirement of unity (Articles 6bis(iii), 14-3(iii) and 6).
- (v) The specifications, claims of the utility model, or drawings (referred to as "specifications, etc." hereafter in this Chapter) have a significant material inadequacy (Articles 6bis(iv) and 14ter(iv)).

Even after the establishment of a utility model right is registered, the basic requirements test will be conducted when a written correction is submitted under Article 14bis(1) (Article 14ter).

2. Judgment on the Basic Requirements

Utility model registration applications are judged to meet the basic requirements if they do not come under any of the clauses 2.1 to 2.5 below. On the contrary, they are judged not to satisfy the basic requirements if they fall under any of the clauses 2.1 to 2.5 below.

2.1 Not protectable (Articles 6bis(i) and 14ter(i))

A protectability test covers the claimed device. If what is described in the claims is not a "device" defined in 2.1.1(1), then it is not protectable. Also unprotectable is a claimed device which does not pertain to the "shape or structure of an article or combination of articles."

2.1.1 Definition of "device," "article," "shape," "structure," and "combination"

(1) Device

"Device" means the creation of a technical idea utilizing the laws of nature (Article 2(1)).

(2) Article

"Article" means a product which possesses a certain spatial shape and is generally the subject of commercial transactions, freely portable and clearly intended for a certain purpose.

A part of machinery, equipment, etc., that is traded separately from the whole machinery, equipment, etc. is treated as an "article" if it fits the definition above.

(3) Shape

"Shape" means an external shape expressed with lines or surfaces. Examples include the shape of a cam or gear or the blade of a tool.

(4) Structure

"Structure" means a spatial, three-dimensional structure. It refers not only to the appearance of an article, but also to a structure expressed with plane and elevation views, and, in some cases, side and cross-sectional views. The structure of a road, building, etc., is also treated as the structure of an article.

(5) Combination

"Combination" of articles means that which comes under both (i) and (ii) below.

- (i) Two or more of the articles which constitute such combination are spatially separated at least either at the time when they are used or at the time they are not used.
- (ii) They each possess certain structures or shapes independently, and when in use, functionally relate to each other to produce a use value.

Examples include a fastener composed of a bolt and a nut.

2.1.2 Some of the unprotectable cases

The following is a list of unprotectable cases, though not exhaustive.

(1) What is claimed does not constitute a "device".

Specific examples are the same as given in Clause 2.1 of "Part III Chapter 1 Eligibility for Patent and Industrial Applicability."

(2) What is claimed does not constitute the "shape or structure of an article, or combination of articles."

- (i) Device that falls in the category of process
- (ii) Device pertaining to a composition
- (iii) Device pertaining to a chemical compound
- (iv) Article that does not possess a certain shape (e.g., liquid ballast, non-slip grains for roads)
- (v) Animal breed or plant variety
- (vi) Computer program itself

2.2 Offense against public order morality, etc. (Articles 4, 6bis(ii) and 14ter(ii))

A test of public order, morality, etc. covers the claimed device. An offense is judged

to exist if the claimed device is obviously detrimental to public order, morality, or health. A decision as to whether a claimed device is offensive against public order, morality, etc. is made substantially in accordance with 2 of "Part III Chapter 5 Category of Unpatentable Invention."

2.3 Failure to meet the Ministerial Ordinance requirements pertaining to the scope of claims of utility model (Articles 6bis(iii), 14ter(iii) and 5(6)(iv), and Regulations under the Utility Model Act, Article 4)

The claims of a utility model are judged not to meet the relevant Ministerial Ordinance requirements if they come under any of the items (i) to (iv) below.

- (i) Each claim is not stated on a different line and given a different number.
- (ii) The claims are not serially numbered in the order of appearance.
- (iii) A citation of one claim in another is not made by the number assigned to it.
- (iv) Where a claim is cited in another, that other claim appears before the cited one.
- (v) Where, when a claim is stated referring to a statement of two or more other claims in an alternative way, the claim which it refers is the one which refers to a statement of two or more other claims in an alternative way.

2.4 Failure to meet the requirement of unity (Articles 6, 6bis(iii) and 14ter(iii))

A decision as to whether the requirement of unity is satisfied is made substantially in accordance with "Part II Chapter 3 Unity of Invention."

In "Part II, Chapter 3 Unity of Invention," special technical features are examined by comparison with prior art invention that comes under the Patent Act, Article 29(1). However, the examination of utility model registration applications in terms of the basic requirements does not involve prior art search. Therefore, special technical features of a device that define its contribution over prior art are recognized on the basis of the description, scope of claims and drawings, and common general knowledge as of the filing. The same applies to a basic requirements test conducted when a written correction is submitted under Article 14bis(1).

2.5 Material inadequacy in the description, etc. (Articles 6-bis(iv) and 14ter(iv))

The description, etc., are judged to have a material inadequacy if they come

under either (i) or (ii) below.

- (i) A necessary matter is missing from the description, etc. (see 2.5.1(1)(i) and (ii)).
- (ii) The description, etc., are materially ambiguous (see 2.5.1(2)(i) to (iii)).

A material ambiguity is judged to exist if the description, etc., are ambiguous at first glance (e.g., they are judged to be ambiguous before looking into their relationship with other statements).

2.5.1 Claims of the utility model

(1) Some of the cases where a necessary matter is judged to be missing from the claims of the utility model (2.5(i))

- (i) The claims contain only non-technical matters, such as sales regions and purchasers.
- (ii) The claims contain only the purpose, operation, or effect of the device.

(2) Some of the cases where the claims of the utility model are judged to be materially ambiguous (2.5(ii))

- (i) The claims are technically incomprehensible.
- (i) The contents of the claims are not sufficiently clear because they are substituted by a detailed description or drawings.
- (iii) One claim contains two or more sentences separated by a punctuation mark, each of which describes a different device.

2.5.2 Statements other than the claims of the utility model

If description (for example, the title of the device, a brief description of drawings) or statements in drawings are judged to be ambiguous at first glance, this also comes under the category of material inadequacy in the description or drawings.

3. Treatment of Non-conformity with the Basic Requirements

If an application does not meet the basic requirements, the JPO Commissioner may order the applicants to make amendments (Article 6bis). And if the applicants fail to do so within the period specified in the amendment orders, the JPO Commissioner may dismiss the application (Article 2ter).

