

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

Chapter 2 Basic Requirements for Utility Model Registration

1. Purport of Examination of Basic Requirements

Utility Model Act provides that the establishment of a utility model right shall be registered without the substantive examination in terms of early protection for a utility model right. An application for a utility model registration, however, shall meet requirements enough to register the establishment because Utility Model Act adopts formality examination principle that the requirement to grant a right is the registration of the establishment.

Thus, in addition to formality requirements prescribed in Utility Model Act 2bis(4), Utility Model Act 6bis prescribes requirements (referred to as "basic requirements" hereinafter) met by an application for a utility model registration in order that the establishment of a utility model right is registered without the substantive examination. The Commissioner of the Patent Office may invite amendment where an application does not meet these requirements. The Commissioner of the Patent Office may dismiss a procedure when a person whom he has invited to make amendment fails to do so within the time limit designated in accordance with the invitation to amendment (Article 2ter). The procedure of the Commissioner of the Patent Office is subject to the administrative appeal in the Administrative Complaint Review Act. Furthermore, the result of the appeal is subject to the revocation suit in the Administrative Suit Act (Patent Act Article 184bis applied correspondingly in Utility Model Act Article 48bis).

Imposing these basic requirements can prevent inexpediences such that a utility model right of a device which is not a subject of protection is established and that an application which substantively does not have the semblance of an application is registered as it is.

The same is true for the basic requirements after the correction stipulated in Article 14ter (The examination of the basic requirements after the correction is conducted to the applications filed on or after April 1, 2005).

2. What violates Basic Requirements

(1) Violation of Subject of Protection (Article 6bis(i), Article 14ter(i))

The device claimed in the application is not a device that relates to the shape or construction of an article or a combination of articles.

(2) Violation of Public Order and Morality (Article 6bis(ii), Article 14ter(ii), Article 4)

The device claimed in the application is a device that is liable to contravene public order, morality or public health.

(3) Violation of Descriptive Form of Claim (Article 6bis(iii), Article 14ter(iii), Article 5(6)(iv))

The descriptive form of the claims under Regulations under Utility Model Act Article 4 is violated.

(4) Violation of Requirements of Unity (Article 6bis(iii), Article 14ter(iii), Article 6)

There are two or more devices that shall not be the subject of an application for utility model registration in the same request.

(5) Excessive Deficiency in Description, Claims or Drawings (Article 6bis(iv), Article 14ter(iv))

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The description, claims or drawings does not contain the necessary matters or the description is excessively unclear.

3. Concrete Practice

“A device claimed in the application for a utility model registration” stipulated in Article 6bis and “the device identified by the matters stated in the corrected scope of claims” stipulated in Article 14ter are hereinafter referred to as “a claimed device.”

3.1 Violation of Subject of Protection (Article 6bis(i), Article 14ter(i))

(1) It falls under Article 6bis(i) or 14ter(i) where a claimed device is not related to the shape or construction of an article or a combination of articles. And it also falls under these Articles where a thing described in the claim is not “a device.”

(Reference)

(i) Article

Where a thing possesses a certain shape that is fixed spatially, where the thing is merchandise in general which is a freely transportable object for commercial transaction, and where purpose of using the thing is clear, such thing is interpreted as “an article.”

The construction of roads or buildings, etc. is also interpreted as the construction of articles.

If a thing is dealt in separating from the machine or the system, etc. and satisfies the above condition, such thing may be deemed to be “an article.”

(ii) Shape

“Shape” is external figuration expressed in the line, the surface, and so on. For example, they are the shape of the cam, the tooth shape of the gear, or the edge type of the tool, etc.

(iii) Construction

“Construction” is structure constructed spatially and 3-dimensionally. It is expressed not only in the contour of articles but also in the ground plan and the elevation view, in some cases the lateral view or the cross section diagram in addition.

(iv) Combination

Two or more articles are spatially separated respectively when an article is used or not. And, those have independently fixed structure or shape. And, value of use is produced where those relate to each other functionally by using those. In the above circumstances, that is called “combination.” For example, the fastening tools which consists of a bolt and a nut.

(v) Device

“Device” means the creation of technical ideas utilizing the law of nature. (Article 2)

(2) For example, types which fall under Article 6bis (i) or Article 14ter(i) are as follows.

(I) What does not fall under “the shape or construction of an article or a combination of articles”

(i) A device of which the category is a process

(ii) A device of a composition

(iii) A device of chemical material

(iv) A thing which is not fixed in a certain shape (Example: liquid ballast, nonskid dispersion powder for the road)

- (v) Animal variety, plant variety
- (vi) Computer program per se

(II) What does not fall under “a device”

- (i) The perpetual motion (a thing which is contrary to the second law of thermodynamics)
- (ii) An audio compact disc (where the feature resides solely in music recorded thereon)
- (iii) Simple Aesthetic creations like paintings, carvings, etc.
- (iv) Computer program language itself

3.2 Violation of Public Order and Morality (Article 6bis(ii), Article 14ter(ii), Article 4)

- (1) It falls under Article 6bis (ii), Article 14ter(ii) or Article 4 where a device is liable to contravene public order, morality or public health.
- (2) Though the description in the detailed description of the device is liable to contravene public order, morality or public health, if a claimed device is not liable to contravene them, appropriate measures are allowed to be done at the time of the publication.

3.3 Violation of Descriptive Form of Claim (Article 6bis(iii), Article 14ter(iii), Article 5(6)(iv))

It falls under Article 6bis(iii), Article 14ter(iii) or Article 5(6)(iv) where the descriptive form of claims under Regulations under Utility Model Act Article 4 is violated.

Regulations under Utility Model Act Article 4

Description of the claims under Utility Model Act Article 5(6)(iv) which are to be in accordance with an ordinance of the Ministry of Economy, Trade and Industry shall be as provided in each of the following items:

- (i) for each claim, the statements shall start on a new line with one number being assigned thereto;
- (ii) claims shall be numbered consecutively;
- (iii) in the description in a claim, reference to statement of other claims shall be made by the numbers assigned thereto; and
- (iv) when a claim refers to statement of another claim, the claim shall not precede the other claim to which it refers.

3.4 Violation of Requirements of Unity (Article 6bis(iii), Article 14ter(iii), Article 6)

- (1) Basically, an examiner judges in accordance with the criteria in “Part I, Chapter 2, Requirements of Unity of Invention.”
- (2) The determination of the special technical feature in the criteria is eventually conducted by comparing the claimed device with the prior art which falls under the invention of each item of Patent Act Article 29(1). The examination of the basic requirements of the utility model registration, however, is made without the prior art search and the comparison with the prior art found by the search. Thus, the special technical feature defining a contribution made by a device over the prior art is determined in light of the description, claims, drawings and the common general technical knowledge as of the filing. The same

is true for the basic requirements after the correction.

3.5 Excessive Deficiency in Description, Claims or Drawings (Article 6bis(iv), Article 14ter(iv))

- (1) It falls under Article 6bis(iv) or Article 14ter(iv) where the description, claims or drawings does not contain the necessary matters or the description, claims or drawings is excessively unclear.
- (2) “The description, claims or drawings is excessively unclear” means that the case where an examiner can judge that the description is prima facie unclear. For example, an examiner can judge that the description is unclear without closely examining the relationship to another description.
- (3) The judgment on the claims
 - (I) Types which fall under “not contain the necessary matters” are as follows.

Example:

 - (i) There is nothing but matters such as selling areas or customers which are not technical matters in a claim.
 - (ii) There are nothing more than the objective, operation or effect of a device in a claim.
 - (II) Types which fall under “the description in the description, claims or drawings is excessively unclear” are as follows.

Example:

 - (i) The description in a claim cannot be able to technically understood.
 - (ii) The description in the description or drawings is substituted for the description in a claim.
 - (iii) Two or more “devices claimed for a utility model registration” are described in one claim.
- (4) The judgment on parts except the claims and the detailed description of the device (the title of the device, the brief description of the drawings and the drawings)

It falls under Article 6bis(iv) or Article 14ter(iv) where an examiner can judge that the description of the title of the device, the brief description of the drawings or the drawings is prima facie unclear.