

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

Chapter 3 Article 29bis of the Patent Act

Patent Act Article 29bis

This article refers to an invention claimed in a patent application that is identical to an invention or device (excluding an invention or device made by the inventor of the invention claimed in the said patent application) disclosed in the description, scope of claims, or drawings (in the case of a foreign-language application under Article 36bis(2), foreign language documents as provided in Article 36bis(1)) originally attached to another patent application or registration application of a utility model filed prior to the date that the said patent application was filed and published after the said patent application was filed in the patent gazette under Article 66(3) of the Patent Act (hereinafter referred to as “gazette containing the patent”) or in the utility model bulletin under Article 14(3) of the utility Model Act (Act No. 123 of 1959) (hereinafter referred to as “utility model bulletin”) describing matters provided for in each of the paragraphs of the respective Article or the publication of the patent application. In this case, a patent shall not be granted for the invention notwithstanding Article 29(1). Provided, however, that this shall not apply where, at the time of the filing of the said patent application, the applicant of the said patent application and the applicant of the other application for a patent or for registration of a utility model are the same person.

1. Purpose of Article 29bis

Even if the invention stated in the description or drawings is stated in documents other than the scope of claims, the contents thereof are disclosed to public through issuance of the gazette containing the patent or publication of application. Therefore, even if a later application is filed before issuance of the gazette containing the patent or publication of application of an earlier application, the invention identical to the invention stated in the description or drawings of an earlier application does not disclose any new technology even through the gazette containing the patent or publication of application. As granting a patent to such an invention is not appropriate in view of the purpose of a patent system that intends to protect inventions in compensation for disclosure of a new invention, the later application shall be rejected.

2. Article 29bis

2.1 Invention according to a patent application

The invention claimed in the said patent application refers to “the claimed invention.”

2.2 “Another application for a patent or for a registration of a utility model that has been filed prior to the date of filing of the said patent application and published after the filing of the said patent application in the gazette containing the patent, the publication of the application or the utility model bulletin”

(1) Another application for a patent or for a registration of a utility model (hereinafter referred to “another application”) shall have been filed prior to the day before the date that said patent application was filed (a priority date in case of an application, claiming a priority) and published after said patent application was filed in the gazette containing the patent, the publication of the application or the utility model bulletin.

(2) In cases where another application is a divisional application, a converted application or a patent application based on a utility model registration, the filing date of another application shall be an actual filing date without retroacting.

(3) In cases where another application is claiming priority under the Paris Convention, and the application was filed within a priority term and a priority document has been submitted, the inventions commonly stated in the description, etc. of an application filed in a first country and description, the scope of claims, or drawings attached to an application filed in Japan (hereinafter referred to as “the originally attached description, etc.”) shall be deemed to have been filed in Japan on the filing date in the first country.

(4) As for the invention stated in the originally attached description, etc. of “an earlier application” designated as a base for a claim for a domestic priority (Article 41(1)) or the invention stated in the originally attached description, etc. of an application claiming the priority (hereinafter referred to as “a later application”), determining which one is the earlier application and which is the later application is as follows.

i) As for the inventions stated in the originally attached specifications of both the later application and the earlier application, Article 29bis is applied, assuming that an application filed prior to the filing date of the earlier application is another application (Article 41(2) and (3)). However, if the earlier application is claiming priority (including priority under the Paris Convention) for an invention that was stated in the originally attached description, etc. of an application specified as a basis for a priority claim of an earlier application among inventions stated in the originally attached descriptions, Article 29bis is not applied, assuming that the earlier application is another application (Article 41(2) and (3)).

ii) As for an invention stated only in the originally attached description, etc. of the later application, but not stated in the originally attached description, etc. of the earlier application, Article 29bis is applied, assuming that an application filed on the filing date of the later application is another application (Article 41 (2) and (3)).

(5) If an earlier application is determined as a basis for a domestic priority claim or a later application is designated as another application, an invention stated only in the originally attached description, etc. of the earlier application but not stated in the originally attached description, etc. of the later application shall not be deemed as being laid open (Article 41(3)). Article 29bis is not, therefore, applied.

2.3 Invention or device stated in the originally attached description, etc. of another application

An invention or a device stated in the originally attached description, etc. of another application refers to matter stated in the originally attached description, etc. of another application^(note 1) or an invention or a device understood from matters that are deemed to be stated therein.

“The matters that are deemed to be stated therein” refer to those that can be derived from matters stated, considering common general knowledge^(note 2) at the filing date of another application.

(Note 1) Even if matters stated in the originally attached description, etc. of another are removed, Article 29bis is still applicable.

(Note 2) The common general knowledge refers to art generally known by a person skilled in the art (including well-known art and commonly used art) or matters clear from an empirical rule.

In addition, “the well-known art” refers to art generally known in the technical field. For example, the art is so well-known that there are quite a lot of publicly known documents on it, or it is widely known in the industrial field, or necessity of exemplifying it is eliminated. And “the commonly used art” refers to well-known art and frequently used art.

2.4 The claimed invention is identical to an invention or a device disclosed in the originally attached description, etc. of another application

The phrase “The claimed invention is identical to an invention or a device stated in the originally attached description, etc. of another application” means that the matters used to specify the claimed invention is not different from matters used to specify an invention or device stated in the originally attached description, etc. of another application (hereinafter referred to as “a cited invention”) or there is a difference between them, but it is a minor difference in embodying the means for solving the problem (both are substantially the same).

2.5 A person who made the invention or device is identical to an inventor of an invention claimed in the patent application

(1) An inventor of the claimed invention of the patent application and an inventor of the invention stated in the description, etc. of another application are found to be inventors stated in an application form, unless there are “special circumstances.” “The special circumstances” refer to, for example, a case where another inventor is stated in the description.

(2) The identities of inventors require that indications of all the inventors stated in each application form are exactly the same. If they not the same, they are required to be found exactly the same as a result of substantial determination.

(3) In addition, in order to overcome determination that inventors are not the same, an applicant’s assertion alone is insufficient, and evidence supporting the assertion (an oath of an inventor of another application, etc.) is necessary.

(4) In order to find that inventors are co-inventors, each of the co-inventors is required to perform technical creation activities in a mutually complementary manner and effectively contribute to completion of an invention to at least one to of a process to complete an invention.

2.6 As of the filing date, the same person who filed the patent application has also filed another patent application or a utility model application

(1) Whether applications have been filed by the same person is determined as of the actual filing date of the patent application, based on whether the person who filed the relevant patent application has also filed another application.

(2) If there is a plurality of applicants and all the applicants are exactly the same, the identities of applicants are applied.

(3) Even if the names of applicants of another application and the application itself are changed, or a succession or merger occurs and the indications of names of the applicants become

different, the identities of applicants are applied.

(4) If the application is a divisional application or a converted application, an original applicant at the time to which the filing date of the application retracts shall be an applicant of the application.

3. Method of determining whether the claimed invention and an invention or a device stated in the originally attached description, etc. of another application are identical

If there are two or more claims in the scope of claims, the requirement in Article 29bis is determined for each claim.

3.1 Identifying of the claimed invention

A way of determining the claimed invention is common to “Chapter 2 1.5 Method of Determining Novelty.”

3.2 Identifying of an invention or a device stated in the originally attached description, etc. of another application

(1) “An invention or a device stated in the originally attached description, etc. of another application” refers to an invention or a device that a person skilled in the art may understand from the “matter stated in the originally attached description, etc. of another application^(note 1)” and “matters that are deemed to be stated in the originally attached description, etc. of another application” (matters that can be derived from matters stated in the originally attached description, etc. of another application by a person skilled in the art, considering common general knowledge at the filing date of another application).

Therefore, an invention or a device that a person skilled in the art may not understand from matter stated in the originally attached description, etc. of another application and matters that are deemed to be stated therein cannot be “an invention or a device stated in the originally attached description, etc. of another application,” and cannot be found to be “a cited invention.” If, for example, stated matters are part of the alternatives stated in the originally attached description, etc. of another application in the Markush-type, it is necessary to determine whether a person skilled in the art would understand an invention in which only a single one of the alternatives is determined as a matter for specifying the invention.

(Note 1) Even if matters stated in the originally attached description, etc. of another application are removed subsequently through amendment, Article 29bis is still applicable.

(2) Moreover, if an invention or a device is not stated in the originally attached description, etc. of this other application such that a person skilled in the art may evidently manufacture the product in case of a product invention, or may use the method in case of a method invention based on the statement of the originally attached description, etc. of another application or general technical knowledge at the filing date of another application, the said invention or device cannot be found as “an invention or a device stated in the originally attached description, etc. of another application.”

If, therefore, the originally attached description, etc. of another application shows a name of a chemical substance or shows a chemical substance using a chemical structure formula, but is not stated such that a person skilled in the art may evidently manufacture said chemical substance

using general technical knowledge at the filing date of another application, then said chemical substance cannot be “an invention stated in the originally attached description, etc. of another application.” (In addition, this does not mean that if said chemical substance is included as part of the alternatives of claims of another application, the said claim does not satisfy enablement provided in Article 36(4)(i) of the Patent Act.)

(3) Handling of an invention expressed as a generic concept and a more specific concept when identifying a cited invention

i) If a cited invention is expressed as a more specific concept, this means that a cited invention already shows an invention using “tribal or allied matters or certain common nature.” Therefore, an invention using a generic concept^(note 2) can be identified. In addition, as a method of determining Article 29bis, even if a cited invention is expressed using a more specific concept, an invention expressed using a generic concept shall not be identified, but the ability to apply Article 29bis to an invention according to a claim expressed using a generic concept may be determined when comparing and determining.

ii) If a cited invention is expressed as a generic concept, this does not mean that an invention expressed using a more specific concept shown, an invention expressed using a more specific concept cannot be identified. (If, however, an invention expressed using a more specific concept may be derived^(note 3), using general technical knowledge, this may be identified.)

(Note 2) “The generic concept” refers to a combined concept by collecting tribal or allied matters or a combined concept of a plurality of matters based on certain common traits.

(Note 3) Conceptually, if a more specific concept is merely included in a generic concept, or the terms of a more specific concept may be merely listed from the terms of a generic concept, it is not found that an invention expressed using a more specific concept may be derived (stated).

3.3 Comparison of a claimed invention and a cited invention

(1) A claimed invention is compared with a cited invention by specifying similarities and differences between the matters used to specify the invention according to the claim and matters used to specify the cited invention.

(2) Moreover, instead of the above-described comparison method in (1), a more specific concept of the invention according to a claim may be compared with a cited invention to find similarities and differences between them.

The more specific concept of the invention according to a claim includes matters stated in the detailed description of the invention or drawings as an embodiment of the invention according to a claim. But one that differs from this embodiment may be also compared so long as it is a more specific concept of the invention according to a claim.

This method is effective for determining applicability of Article 29bis to a claim, including the statement to specify a product using function, feature, etc. or limitation by a numerical range.

(3) In addition, instead of methods in the above-described (1) and 1.5.3(3) in Chapter 2, comparing matters stated in the originally attached description, etc. of another application with matters used to specify the invention according to a claim, the similarities and differences may be found with the use of common general knowledge at the filing date of another application and interpreting stated matters. However, determination results cannot be different from those in the case of the above-described (1) and 1.5.3(3) in Chapter 2.

(4) Two or more independent cited inventions that are combined cannot be compared with the invention according to a claim.

3.4 Determination if a claimed invention is identical to a cited invention

(1) In a claimed invention, if there is no difference between the matter used to define a claimed invention and the matter used to define a cited invention as a comparison, the invention according to the claim is identical to the cited invention.

Even if there is a difference between the matter used to define a claimed invention and the matter defining a cited invention, they are found to be identical if the difference is a minor one in the means for solving the problem (addition, removal, conversion, etc. of well-known art and commonly used art, which does not produce any new effect).

(2) As for the invention according to the claim having a formal or substantial alternative^(Note) for the matters used to specify the invention for which a patent is sought, assuming that only one of the alternatives is the matter for defining the invention is compared with the cited invention and there is no difference between both inventions or there is a difference but they are substantially the same, they are found to be identical.

In this case, this handling is not related, in which case the prior art search may be terminated.

As for this point, see “Part IX: How to Proceed with Examination.”

(Note) As for “formal or substantial alternative,” see Chapter 2, 1.5.5(Note 1).

(3) Handling of claims that include specification of a product using function, feature, etc.

i) A claim that includes a statement to specify the product using function, feature, etc. and that falls under the following (i) or (ii) may be compared with a cited invention with difficulty. In such cases, if the examiner has reason to suspect that the claimed product would be prima facie identical to the cited invention, without comparison of the products between the claimed inventions and the cited inventions for finding the exact corresponding and differing points, he/she notices a reason for refusal pursuant to Article 29bis. If an applicant negates the examiner’s impression so that its authenticity becomes unclear by arguing against this prima-facie reasonable doubt and clarifying this through a written opinion, test report, etc., a reason for refusal is eliminated. If the examiner’s impression is not changed because, for example, the applicant’s counterargument or clarification is abstract or general, he/she renders a decision of rejection pursuant to Article 29bis.

However, this handling cannot be applied, assuming that an invention in which the matter used to define the cited invention is the following (i) or (ii) is determined as the cited invention.

(i) If said function, feature, etc. are not typical, not commonly used in the technical field, or not commonly used but relate to ones that are commonly used so that they can be understood by a person skilled in the art

(ii) If said function, feature, etc. are typical, or commonly used in the technical field, or not commonly used, but relate to ones that are commonly used so that they can be understood by a person skilled in the art, but a combination of these several function, feature, etc. falls under (i) as a whole

(Note) “Typical” refers to having a definition provided by JIS (Japanese Industrial Standards), IOS Standards (International Organization for Standardization) or IEC (International Electrotechnical Commission) Standards or can be defined quantitatively according to a test and measurement

method provided by these standards. “Ones that are commonly used so that they can be understood by a person skilled in the art” refers to ones that are commonly used by a person skilled in the art in the technical field and whose definition or a test and measurement method may be understood by a person skilled in the art.

ii) Examples in which prima-facie reasonable doubts occur will be shown below.

- When function, feature, etc. of the invention according to a claim may be converted to ones having other definitions or ones that are obtained according to a test and measurement method, and a cited invention deemed as identical in view of conversion results is found
- When the invention according to the claim and the cited invention are specified in view of the same or similar function, feature, etc., but its measurement conditions or evaluation method are different and both have a predetermined relation, and if function, feature, etc. of the cited invention are measured or evaluated according to measurement conditions or evaluation method, etc. of the invention according to the claim, they are likely to be included in function, feature, etc. of the invention according to the claim
- When structure of a product found to be identical to that of the product of the invention according to the claim has been revealed after the filing date, and this has been found to be stated in the originally attached description, etc. of another application
- When a cited invention identical or similar to one stated in the description or drawings of the present application as an embodiment has been found (for example, when a cited invention that has a product process identical to that stated as an embodiment or similar starting material has been found or a cited invention that has a product process similar to that stated as an embodiment or identical starting material has been found)
- When a cited invention and the invention according to the claim are common in the matters used to specify the invention other than those expressed by function, feature, etc., and the cited invention has problems or effects identical or similar to the problem or advantageous effects inherent in the matters used to specify the invention expressed by said function, feature, etc. and function, feature, etc. of the cited invention are likely to be included in function, feature, etc. of the invention according to the claim

In addition, if applicability of Article 29bis may be determined without using this specific method, a normal method is used.

(4) Handling of a claim including specification of a product obtained by a production method
i) It may be extremely difficult to decide on how a product itself is structured in a claim that includes specification of a product obtained by a production method. In that case, similarly to the above (3), if the examiner has reason to suspect that the claimed product would be prima facie similar to the cited invention, without comparison of the products between the claimed inventions and the cited inventions for finding the exact corresponding and differing points, he/she notices a reason for refusal pursuant to Article 29bis.

However, this handling should not be applied if it is assumed that an invention for which the matters defining it specify a product by using a product method is determined as a cited invention.

ii) Examples in which prima-facie doubts occur will be shown below.

- When a cited invention of a product whose starting material is similar to that of the invention according to the claim and which was produced according to a production process identical to that of the invention according to a claim was found
- When a cited invention of a product whose starting material is identical to that of the invention according to the claim and which was produced according to a production process

identical to that of the invention according to a claim was found

- When structure of a product found to be identical to that of the product of the invention according to the claim has been revealed after the filing date, and this has been found to be an invention or a device stated in the originally attached description, etc. of another application
- When a cited invention identical or similar to one stated in the description or drawings of the present application as an embodiment has been found

In addition, if applicability of Article 29bis may be determined without using this specific method, a normal method is used.

4. Notice of reasons for refusal pursuant to Article 29bis

If the examiner has doubts that the invention according to the claim cannot be patented pursuant to Article 29bis, he/she identifies a reason for refusal.

An applicant may argue or clarify against this by filing a written opinion, test report, etc.

And the invention according to the claim cannot be patented pursuant to Article 29bis. If the examiner's impression may be negated so that its authenticity becomes unclear, a reason for refusal is eliminated. If the examiner's impression is not changed, he/she renders a decision of rejection based on a reason for refusal pursuant to Article 29bis.

Referential trial and court decisions

(1) Identifying of an invention stated in the earlier application description, etc.

Decision by the Tokyo High Court, September 30, 1985 [Showa 58 (Gyo Ke) 95]

When interpreting the description, considering the publicly known art or the publicly known fact prior to the filing date is not permitted, but this should be interpreted to be limited to only when it relates to concrete contents that can be understood from said description. And introducing such interpretation method to an extremely abstract statement as cited in "III, 2" allows a technically wide abstract statement, which means an unduly advantageous handling in connection with the applicant of a later application and cannot be appropriate. Therefore, the above statement of the description filed by Kanebo should not be considered when determining applicability of Article 29(2) of the Patent Act to the present application invention and additionally determining identity with an earlier application invention under Article 29bis(1) of the same act.

Decision by the Tokyo High Court, January 28, 1987 [Showa 62 (Gyo Ke) 43]

Accordingly, the cited reference states that nylon 66/6 copolymer is an example of polyamide resin as described above, even if a composition ratio is not explicitly stated. In view of the technical standard at the filing date of the present application, a person skilled in the art may immediately expect nylon 66/6 copolymer to have a composition ratio within the range limited to the present application invention. It is thus appropriate to find that the cited reference substantially discloses the above-described composition ratio of the present application invention.

Decision by the Tokyo High Court, June 28, 1988 [Showa 63 (Gyo Ke) 176]

... the cited reference is different in terms of not explicitly stating means for writing information (in other words, existence and nonexistence of technical means of using two information lines and two bit lines together used for reading information) and both inventions are the same in other configurations.

... Considering the above-described usual measure for writing and reading information, it is interpreted that two information lines connected to two bit lines ... stated in the cited reference

that is also used for writing information is substantially stated.

Decision by the Tokyo High Court, September 29, 1986 [Showa 61 (Gyo Ke) 29]

The plaintiff alleges that the identicalness of both should be determined only by comparing them; but invoking common general knowledge based on other evidence is prohibited. However, the description does not explain an invention by covering all technology for the invention, but is ordinarily prepared on the assumption of common general knowledge of a person skilled in the art at the filing date. Therefore, even if the description is especially precise, there is no reason for finding common general knowledge inherent in a person skilled in the art when looking at the invention based on evidence and considering it are prohibited.

(2) Comparison and determination

Decision by the Tokyo High Court, September 29, 1986 [Showa 61 (Gyo Ke) 29]

Alternatively, the plaintiff takes note of a trial decision determining both inventions as “substantially the same” and alleges that determining their identicalness using the term “substantially” not used in Article 29bis is not permitted. However, when comparing inventions, it is not enough for the structures thereof and the effects produced thereby to all almost correspond formally. The point is that even if two or more inventions are formally different, the inventions may be determined to be identical as creations of a technical idea if the difference is merely an expression or a minor difference in design, or if the effects produced are not remarkably different. In this case, both inventions are considered to be substantially the same and it is to be interpreted that Article 29bis intends that if an earlier application invention provided in the same article and a later application invention are substantially the same in terms of the above-described meaning, the later application invention cannot be patented.

Decision by the Tokyo High Court, September 20, 1990 [Heisei 1 (Gyo Ke) 226]

As described above, considering that E structure of the present application invention is totally different form e structure of the earlier application invention, and additionally, E structure relates to characteristics of the present application invention, in order to find that both are substantially the same because their technical means with different structures have commonly used means, and as the premise thereof, it is to be interpreted that all of the technical means according to the structures of both, being frequently used in the technical field under which both inventions fall, are required. ...

Moreover, the defendant alleges that employing structure relating to pressing means in the present application invention is merely a conversion of equivalent means. However, as described above, as long as both are basically different in structure, it is difficult to determine that working effects produced thereby have no difference as alleged by the defendant. Additionally, as long as both are basically different in structure as described above, and their technical means according to their structures are not found to be commonly used, even if both have no special difference in effects produced by both structures, it is not appropriate to assume that both have merely a relation of equivalent means and affirm the substantial identity of structures by this reason.