

Operational Guidelines on Treatment of Technical information disclosed on the Internet as Prior Art

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Examination Standards Office
Coordination Division

Section 29(1) of the Japanese Patent Law (JPL)

Any person who has made an invention which is industrially applicable may obtain a patent therefor, except in the case of the following inventions:

<omitted>

(iii) inventions which have been described in a publication distributed in Japan or elsewhere or inventions which became available to the general public through telecommunication lines in such places prior to the filing of the patent application

1. Significance of the legal amendment

Technical information disclosed on the Internet etc. is equivalent in content to technical information published in the form of magazines, books, etc., and it is highly useful on account of the rapidity of its transmission. Thus, an increasing number of researchers have come to use the Internet to present their technical papers for the purpose of publishing their research findings quickly. In this way, technical information disclosed on the Internet etc. contributes to the progress and development of technologies in a similar way to information disclosed in a publication, and already constitutes a technical standard in the industrial world. Therefore, a patent right should not be granted to an invention disclosed on the Internet etc., even if the said invention has not been described in a publication.

In the past, it was possible to cite these inventions under Section 29(1)(i) of the JPL, but due to the difficulty in proving that the inventions had been made publicly known, it was not easy to make disclosure on the Internet etc. a ground for lack of novelty under the former law.

In order to remedy this situation, the law was amended to establish disclosure on the Internet etc. as a ground for lack of novelty, in the same way as disclosure in a distributed publication.

2. Definitions

(1) A "line" means a two-way transmission line, generally constituted by send and receive channels. Broadcasting, which is only capable of one-way transmission, does not fall under the definition of a line (except for cable TV etc. that is capable of two-way transmission).

(2) The "general public" means unspecified persons in general.

(3) "Available to the general public" means that information is in a state where it can be seen by unspecified persons, and does not necessarily imply that it has actually been accessed.

Specifically, information is considered as being available to the general public if it is linked with any other sites on the Internet, registered with any search engines, or the URL of the site is published in a means of providing information to the general public (for example, a widely-known newspaper or magazine), and if, at the same time, public access to the site is not being restricted.

(4) "Internet etc." mentioned in these operational guidelines refers to all means that provide technical information through telecommunication lines, including the Internet, commercial databases, and mailing lists. "Homepages etc." refer to the media through which information is provided on the Internet etc.

3. Time of application

These operational guidelines shall apply to patent applications filed on and after January 1, 2000. (Sections 1 and 2 of Supplementary Provisions of the Law Partially Amending the Japanese Patent Law (Law No. 41 of 1999))

3. Treatment of Technical information disclosed on the Internet in examination procedures

3.1. Information made available to the general public through telecommunication lines that can be cited as prior arts

In order to cite technical information obtainable through telecommunications lines (hereinafter referred to as "electronic technical information") as prior arts in the same way as such information described in publications, the cited electronic technical information needs to have been published with exactly the same content and have been available to the general public before the filing of the patent application.

The question of whether the information became available before the filing of the patent application is judged based on the time of publication indicated in the cited electronic technical information. Therefore, electronic technical information without an indication of the time of publication cannot be cited, in principle. (See 3.1.1.(3) for exceptions of cases where citation can be made)

The following point explains how the cases are treated when the time of publication indicated in the cited electronic technical information is before the filing of the patent application.

3.1.1. Information must have been published with exactly the same content before the filing of the patent application

(1) The problem of the date of publication and alteration of the content of the cited electronic technical information

Since information on the Internet etc. can be altered easily, the issue will always arise of whether the cited electronic technical information was published with exactly the same content at the indicated time of publication.

- Even if the indicated time of publication of the cited electronic technical information was before the filing of the patent application at the time the examiner discovered that information (*1), there is still a slight chance that the indication itself could have been altered at a later date.

, Even if the cited electronic technical information had been published at the time the examiner discovered that information, there is still a slight chance that its content has been altered since.

(*1) The time of publication is determined by converting the time in the country or region where the information on the Internet etc. was published on the respective website etc. into

the Japanese Standard Time.

(2) Addressing the problems of time of publication and alteration of the content of the cited electronic technical information

- With regard to websites etc. where there is an extremely small element of doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication, the examiner cites the information on the presumption that the content of information published at the time of the examiner's access was the content published at the time of publication indicated in the website etc.

- With regard to cases where there is doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication, the examiner investigates whether the information is citable.

- The examiner does not cite information on websites etc. if there is only a small possibility of resolving the doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication.

(3) Websites etc. where there is an extremely small element of doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication

Information published on the following websites usually indicate places of contact clearly, and are considered to involve the extremely small degree of doubt mentioned above.

- Websites of publishers that have been issuing publications etc. for a long time (Websites with electronic data from newspapers, magazines, etc. offer electronic publications etc. of academic magazines.)

- Websites of academic institutions (Websites of academic societies, universities, etc. publish electronic data (technical papers) of academic societies, universities, etc.)

- Websites of international organizations (Websites of bodies such as standardization organizations, etc. publish information on standard of measure etc.)

- Websites of public organizations (Websites of ministries and agencies publish the details of research activities, outline of research findings, etc. especially on the websites of research institutes.)

Examiners do not cite information on these websites etc., in principle, when the information does not indicate the time of publication, but they can cite such information if they acquire a certificate on the time of its publication on the website as well as its content from a person with authority or responsibility for the publication, maintenance, etc. of the published information.

(4) Treatment of cases where there is doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication

When the examiner judges that the cited electronic technical information is subject to the said doubt, he/she inquires to the place of contact indicated in the website as to whether the information has been altered, and examines the case in doubt.

If the doubt is resolved after the examination, the examiner cites the information, but if the doubt is not resolved, the examiner does not cite the information.

(5) Websites etc. where there is only a small possibility of resolving the doubt as to whether the cited electronic technical information was published with exactly the same content at the indicated time of publication

The examiner does not cite information on websites etc. for which place of contact is not indicated clearly or for which time of publication is not indicated, because there is only a small possibility of resolving the doubt.

3.1.2. The cited electronic technical information must have been made available to the general public before the filing of the patent application

Information on the Internet etc. is usually available to the general public since it may be accessed by unspecified persons and is similar in terms of information transmission to the information described in distributed publications.

Information can be considered as being available to the general public if it is published on the Internet, etc., its presence and location can be found by the general public, and it is accessible by unspecified persons, even if the access to the website etc. requires a password or if there is a charge for access.

(1) Examples of cases where electronic technical information is available to the general public

- Websites that are registered with search engines and that can be searched for, or whose presence and location can be found by the general public (e.g. websites linked from the website of a related academic body or a news site; the URL of the website is indicated in means of providing information to the general public, such as a newspaper or magazine.)
- For websites that require passwords, those that are accessible by unspecified persons merely by inputting the password (The information is considered as being available to the general public if anybody can access the website etc. by acquiring a password through a set, non-discriminating procedure, regardless of whether there is a charge for acquisition of a password).

f For charged websites etc., those that are accessible by unspecified persons by merely paying a fee (In this case, the information is considered as being available to the general public if anybody can access the website etc. by paying a fee).

(2) Examples of cases where electronic technical information is not considered as being available to the general public

Even if the information is published on the Internet etc., information falling under the following is not considered as being available to the general public:

- Websites etc. that are on the Internet, but are only accessible by chance due to the lack of publication of the URL.

- , Websites etc. that are only accessible by members of a specific body or a company and of which information is treated as secrets (e.g. an in-house system only usable by the employees, etc.).

- f* Websites etc. on which information is encoded in such a way that cannot generally be read (excluding cases where a decoding tool is openly available through a set means, with or without a charge).

- „ Information that is not published over a period of time sufficient to allow access by the general public (e.g. information published on the Internet for a short period of time).

3.2. Method of citation

The electronic technical information retrieved from the Internet etc. shall be treated as follows at the time of citation:

(1) When there is a publication describing the same content as the electronic technical information, and when both can be used for citation:

The citation is made from the publication.

(2) Treatment of cited electronic technical information

Even if information on the Internet etc. existed at the time the examiner conducted a prior art search, the information may be altered or deleted by the time the applicant or a third party has access. Since this is a difficult situation for the applicant or a third party, the examiner takes the following procedures to accumulate the electronic technical information on the Internet etc. that were cited in the notice of rejection etc. in patent document databases:

- The examiner prints out the information cited from the website etc.

- , The examiner writes the time of access, the name of the examiner who made the access, the application number of the patent application for which the information was cited, and the URL of the website on the printed out sheet(s) mentioned in .

f Other aspects follow the treatment of the digitization of cited non-patent documents.

(3) Specific method for describing electronic technical information as a cited document etc.

Electronic technical information retrieved from the Internet etc. must be cited in compliance with WIPO Standard ST.14, with the description of the bibliographical items known about the electronic technical information listed in the following order:

- Name of the author

- , Title

f Relevant part

Indicate the page, column, line, item number, drawing number, index within a database, or the first and the last phrases of the cited part.

- „ Type of medium [online]

- ... Date of publication, name of publisher, location of publication, and the page(s) in which the relevant information is disclosed

- † Date of retrieval

Describe the date on which the electronic technical information was retrieved from the electronic media in parenthesis.

- ‡ Source of information and URL of the relevant website

Describe the source of electronic technical information and the URL of the website or the accession number.

Examples of the description of electronic technical information retrieved from the Internet

(Example of the description of information obtained from a product manual/catalog or a website)

Corebuilder 3500 Layer 3 High-function Switch. Datasheet. [online]. 3Com Corporation, 1997. [retrieved on 1998-02-24]. Retrieved from the Internet: <URL: <http://www.3com.com/products/dsheets/400347.html>>.

(Example of description in Japanese)

Jun Shinzaki and 3 others, "Trends of New Technology," [online], April 1, 1998, Tokkyo Gakkai, [retrieved on July 30, 1998] Retrieved from the Internet: <URL: <http://iij.sinsakijun.com/information/newtech.html>>.

Example of the description of electronic technical information retrieved from an online database

Dong, X.R. 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements', Chung Hua Wai Ko Tsa Chih, May 1993,

Vol.31, No.5, pages 301-302. (abstract) Medline [online]; United States National Library of Medicine, Bethesda, MD, USA. [retrieved on 24 February 1998] Retrieved from: Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession no. 07736604.

3.3. Provision of information

Electronic technical information on the Internet etc. can be used to provide information, similar to publications. The provider of the information must submit a printout of the electronic technical information on the Internet etc., in order to prove that the provided information is correct. The submitted printout of the information must include the content of information, the indication of the time of publication, the URL at which the information was obtained, and the place of contact for the information. In this case, it is desirable to attach a certificate by the person with authority or responsibility for the publication, maintenance etc. of the information.

3.4. Counterargument of the applicant

(1) Where the counterargument of an applicant against the indicated time of publication and the content of information is not proved by evidence, but only based on his/her suspicion toward the disclosure through the Internet etc., the counterargument is not adopted due to lack of specific grounds.

(2) Where a counterargument of an applicant raises suspicion against the fact that the electronic technical information was published with exactly the same content or was available to the general public before the filing of the patent application, the fact shall be confirmed with the person with the authority or responsibility for the publication, maintenance, etc. of the information. In such a case, the person with authority or responsibility is asked to issue a certificate as to the date of publication on the website etc. and the content of information.

(3) Where, as a result of examining the counterargument etc. of the applicant, the examiner becomes convinced of the doubtfulness of the electronic technical information in question having been published with the same content before the filing of the patent application, the said information is not cited as prior art information.

3.5. Treatment of applications that are yet to be published

The search of prior art information can be conducted on the Internet, even for applications that are still yet to be published at the time of the prior art search. However, on the Internet, the search information may be divulged at the time of the search, and the invention claimed in the application may be leaked to a third party through the search formula, search keys, etc. (*2), thus, it is necessary that sufficient care be taken.

However, in cases where the cited document was found in a document list on the

website etc. of a scientific society etc., or where the electronic technical information was obtained from information that had been provided, there would be no possibility for leakage of the invention claimed in the patent application.

(*2) The following search formulas are likely to lead to leakage of the invention to a third party:

- Search using new combinations of general terms
- Where a publicly known art is used for a novel purpose (the use of a certain article for a certain purpose is novel).

Operational Guidelines on Treatment of Exceptions to Lack of Novelty of Invention

December 10, 1999
Examination Standards Office
Coordination Division

Relevant provisions concerning exceptions to lack of novelty of invention (Sections 30 and 184^{quater decies} of the JPL)

Section 30 of the JPL

(1) In the case of an invention which has fallen under any of the paragraphs of Section 29(1) by reason of the fact that the person having the right to obtain a patent has conducted an experiment, has made a presentation in a printed publication, has made a presentation through telecommunication lines, or has made a presentation in writing at a study meeting held by a scientific body designated by the Commissioner of the Patent Office, application of the provisions under Section 29(1) and (2) on the invention claimed in a patent application filed by such a person within six months from the date on which the invention first fell under those paragraphs shall be deemed not to have fallen under any of the paragraphs of Section 29(1).

<omitted>

(4) Any person who desires the application of Subsection (1) or the preceding subsection shall submit a written statement to that effect to the Commissioner of the Patent Office simultaneous to the patent application. Within 30 days of the filing of the patent application, the said person shall also submit to the Commissioner of the Patent Office a document proving that the invention which fell under any of the paragraphs of Section 29(1) is an invention that can fall under Subsection (1) or the preceding subsection.

184^{quater decies} of the JPL

Notwithstanding Section 30(4), any applicant for an international patent application who desires the application of Section 30(1) or (3) may submit to the Commissioner of the Patent Office a written statement to that effect and a document providing that the invention that fell under any of the paragraphs of Section 29(1) is an invention that can fall under Section 30(1) or (3) during the period prescribed in an ordinance of the Ministry of International Trade and Industry in which the relevant time for the national processing occurs, regardless of the provisions under Section 30(4).

1. Significance of the legal amendment

Since Section 29(1)(iii) of the JPL was amended to incorporate inventions that became available to the general public through telecommunication lines as a ground for lack of novelty in the same way as inventions described in distributed publications, Section 30(1) was also amended to exempt presentation through telecommunication lines from lack of novelty in the same way as for presentation in publications.

In the past, the exception to lack of novelty was only applicable to cases where an invention that fell under any of the paragraphs of Section 29(1) due to the applicant's own act (conducted an experiment, made a presentation in a printed publication, made a presentation in writing at study meeting, or exhibited at an exhibition) and the invention claimed in the patent application were the same. If those two inventions were different, the exception to lack of novelty was not applicable, and thus, the invention claimed in the patent application was sometimes rejected as an invention that could easily have been made on the basis of the invention published by the applicant himself/herself (Section 29(2)). Presentations at study meetings usually emphasized scientific significance or achievement, and the content of the presented document often did not coincide with the content of the patent application that emphasized the scope of the right or description requirements. Therefore, such a situation could serve as a certain hindrance in acquiring patents to those who placed importance on presentation at study meetings or presentation of technical papers.

In order to remedy this situation, the exception to lack of novelty was made applicable also to cases where an invention published due to the applicant's own act and the invention claimed in the patent application were not the same.

2. Invention described in Section 30(4) of the JPL

(1) An "invention that fell under any of the paragraphs of Section 29(1)" refers to an invention that fell under any of the paragraphs of Section 29(1) by making a presentation etc. of the invention.

(2) An "invention that can fall under Section 30(1) or the preceding paragraph" refers to an invention that was presented etc. under Section 30(1) or (3).

3. Document proving the act of presentation through telecommunication lines

(1) The document proving the act of presentation through telecommunication lines need to include the content of the information (printout etc. of the website etc. in which the information was presented), the indication of the time of publication of the information, the name of the presenter, and the URL of the website in which the information was published.

In this case, it is desirable to attach a certificate by a person with authority or responsibility for the publication, maintenance, etc. of the information concerned.

(2) If the examiner judges that there is any suspicion with regard to the submitted document proving the act of presentation through telecommunication lines, he/she inquires to the indicated contact on whether the information has been altered. If the suspicion is not resolved, the examiner notifies this to the applicant with a notice of rejection etc.

4. Application of the provisions under Section 29(1) and (2)

If the exception to lack of novelty is applicable to a patent application due to the

information indicated by the submitted document of proof, the said information shall not be treated as prior art information in determining each subsection of Section 29 concerning the patent application.

5. Time of application

These operational guidelines shall apply to patent applications filed on and after January 1, 2000. (Sections 1 and 2 of Supplementary Provisions of the Law Partially Amending the Japanese Patent Law (Law No. 41 of 1999))