

# *Revision of Examination Guidelines of the JPO, Description Requirements*

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## Agenda

- 1. Examination Guidelines*
- 2. Description Requirements  
(Requirements for  
Description and Claims)*



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## *1. Examination Guidelines*



## 1. Examination Guidelines

### **Examination Guidelines (Examination Guidelines for Patent and Utility Model in Japan )**

“The Examination Guidelines provide way of thinking regarding applications of related Act, including Patent Act etc., which is the best standard, at present, that examiners can refer to for fair, appropriate and efficient examination. The Examination Guidelines are used not only for standards of decision in examination but also widely used as index for management of patents etc. by applicants.”

(Preamble of the Examination Guidelines)

## 1. Examination Guidelines



The Examination Guidelines are available in English (Provisional translation).  
[http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/1312-002\\_e.htm](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/1312-002_e.htm)

### Review of the English translation (April 2012)

Part II Chapter 2 **Novelty** and **Inventive Step**  
Part II Chapter 3 Patent Act Article 29bis (**Secret prior art**)  
Part II Chapter 4 Patent Act Article 39 (**Earlier applications**)  
Part III Section I **New Matter**  
Part III Section III Amendment of Claims after Final Notice of Reasons for Refusal  
Part III Section IV Examples Concerning Amendments of Description, Claims or Drawings

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## 1. Examination Guidelines



### Revision of Guidelines

What makes us to revise the examination guidelines?

- Revision of Act
- New case law
- Development of new technology
- Opinions from users
- International trend                      etc.

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## 1. Examination Guidelines



### Recent Revisions of Guidelines

- June 2010: Amendment of Description, Claims and Drawings (New Matter)
- October 2011: Requirements for Description and Claims
- December 2011: Patent Term Extension

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## 1. Examination Guidelines



### Process of the Revision of Guidelines

#### **The Committee on Examination Standards**

(established in 2008 )

consists of lawyers, patent attorneys, jurists, economists, scientists and members from industry.

#### Purposes of the Committee

- Transparency in consideration procedures of the Guidelines
- Harmonization of judgment in examination, appeals & trials, and litigation
- Appropriately coping with technological, industrial and international trends.

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## 1. Examination Guidelines



### After the Revision of Guidelines

#### Internal follow up after the revision

- Sample check
- Consultation
- Check lists

#### External follow up after the revision

- Explanatory meetings for practitioners
- Exchange of opinions with users

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## *2. Requirements for Description and Claims*



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## 2. Description Requirements



### Patent Act Article 36(6): Requirements for Claims

The statement of the scope of claims shall comply with each of the following items:

- (i) the invention for which a patent is sought is stated in the detailed explanation of the invention;  
([support requirement](#))
- (ii) the invention for which a patent is sought is clear;  
([clarity requirement](#))
- (iii) the statement for each claim is concise; and
- (iv) the statement is composed in accordance with Ordinance of the Ministry of Economy, Trade and Industry.

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## 2. Description Requirements



### Patent Act Article 36(4): Requirements for Description

The statement of the detailed explanation of the invention shall comply with each of the following items:

- (i) in accordance with Ordinance of the Ministry of Economy, Trade and Industry, the statement shall be clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the invention;  
([enablement requirement](#), ministerial ordinance requirement)

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## 2. Description Requirements



### Revision of Guidelines in Oct. 2011

#### Conclusion of the Committee on Examination Standards

Although the Examination Guidelines should not be drastically revised, certain revisions should be made in order to correct too severe determinations or variations in determinations by supplementing additional information or clarifying insufficient explanation.

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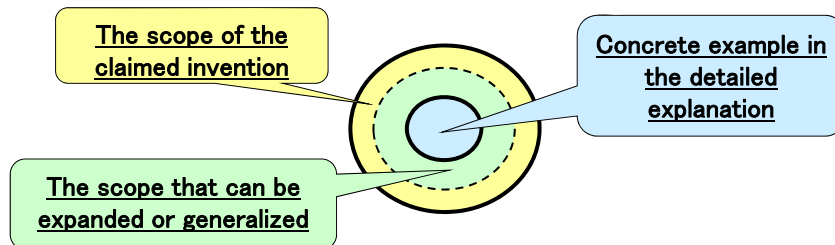
## 2. Description Requirements



### Support Requirements

An example of Violation of Support Requirements

When the content disclosed in the detailed explanation of the invention can **neither be expanded nor generalized** to the scope of the claimed invention even in light of the common general knowledge as of the filing.



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## 2. Description Requirements



### Criticism from applicants

Since examiners do not specify the reasons for the determination, it is difficult to make an argument or clarification.

The new Guidelines require examiners explain the following points

- the specific reasons for the decisions along with the grounds which such decisions were based on (e.g. the part of the statement of the detailed explanation of the invention and the content of the common general knowledge as of the filing that were considered in the process of decision-making).
- the clue for the applicant to understand what and how to be amended in order to avoid a decision of refusal for the reasons, such as not meeting the required level of expansion or generalization, to the possible extent.

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## 2. Description Requirements



### Criticism from applicants

It is not clear for applicants how to react against a notice of reasons for refusal by support requirements, especially in case of rebutting or explaining with the experimental results.

The new Guidelines clarify what is taken into account and what is not in the applicants' response.

- The applicant may, in a written opinion, point out the common general knowledge other than that taken into account by the examiner when making determination, and argue that in light of such common general knowledge, the statement of the claims is not violating the support requirements.
- The applicant may also submit a certificate of experimental results to support such argument presented in the written opinion.

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## 2. Description Requirements



Revisions were made not only for the support requirements but also for clarity requirements and enablement requirements.

Detailed information regarding the Revision is available below

[http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki\\_e/t\\_tokkyo\\_e/description\\_claims\\_rev.htm](http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/description_claims_rev.htm)

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# Thank you

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