

Response to C.8403 (Japan)

Inventive Step

(i) the definition of a person skilled in the art

- National/regional legislation:

Patent Act

Article 29 (2) Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

- Patent examination manuals and guidelines

See the Examination Guidelines Chapter 2 (2.2(2), page.16)

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/2_2.pdf

- Court decisions

- Other information

(ii) methodologies employed for evaluating the inventive step

- National/regional legislation:

Patent Act

Article 29 (2) Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

Above “the preceding paragraph” is Patent Act Article 29 (1).

Article 29 (1) An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention, except for the following cases:

(i) inventions that were publicly known in Japan or a foreign country prior to the filing of the patent application;

(ii) inventions that were publicly worked in Japan or a foreign country prior to the filing of the patent application; or

(iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country prior to the filing of the patent application.

- Patent examination manuals and guidelines

See the Examination Guidelines Chapter 2 (2.3, 2.4, 2.6, 2.7, pages. 16, 17, 24-26)

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- Court decisions

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(iii) having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement

- National/regional legislation:

Patent Act

Article 29 (2) Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

- Patent examination manuals and guidelines

See the Examination Guidelines Chapter 2 (2.5, 2.8, pages.17-24, 26-28)

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/2_2.pdf

- Court decisions

There are some examples on the pages 17-24, 26-28 of the Examination Guidelines. The examples refer to court decisions.

- Other information

Sufficiency of Disclosure

(i) enabling disclosure requirement

- National/regional legislation:

Patent Act

Article 36 (4) The statement of the detailed explanation of the invention as provided in item (iii) of the preceding paragraph 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; and

Regulations under the Patent Act Article 24bis (Ordinance of the Ministry of Economy, Trade and Industry)

The statement of the detailed explanation of the invention which is to be in accordance with Ordinance of the Ministry of Economy, Trade and Industry under the Patent Act, Article 36(4) (i) shall be made by stating the problem to be solved by the invention and its solution, and other matters necessary for a person ordinarily skilled in the art to which the invention pertains to understand the technical significance of the invention.

- Patent examination manuals and guidelines

See the Examination Guidelines Chapter 1 (3.2, pages. 27-35)

http://www.ipa.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/1_1.pdf

- Court decisions

- Other information

(ii) support requirement

- National/regional legislation:

Patent Act

Article 36 (6) The statement of the scope of claims as provided in paragraph (2) 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.

- Patent examination manuals and guidelines

See the Examination Guidelines Chapter 1 (2.2.1, pages. 2-9)

http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/1_1.pdf

- Court decisions

(1)

Intellectual Property High Court Decision dated September 29, 2009 (Hei 20 (Gyo-Ke),
No. 10484

http://www.ip.courts.go.jp/app/files/hanrei_en/425/001425.pdf

(2)

Intellectual Property High Court Decision dated November 11, 2005 (Hei 17 (Gyo-Ke),
No. 10042

http://www.ip.courts.go.jp/app/files/hanrei_en/309/000309.pdf

- Other information

(iii) written description requirement

We consider that “written description requirement” is the same meaning as “support requirement”.