

JAPAN PATENT OFFICE
COMMENTS ON DRAFT RULES 5 AND 6
OF THE SUBSTANTIVE PATENT LAW TREATY (SPLT)

I. The Relation between the SPLT, the Patent Law Treaty (PLT), and the Patent Cooperation Treaty (PCT)

The items stipulated in draft Rules 5 and 6 are rather substantive in nature and different from the formal requirements stipulated in the PCT and referenced in the PLT. Accordingly, 1) the SPLT should in principle independently provide regulations which fall under draft Rules 5 and 6, and 2) if there are corresponding regulations in the PCT and they are not referenced in the PLT, it would be appropriate to examine the possibility of referencing them in the SPLT.

Therefore, Japan basically supports placing provisions regarding “contents and order of description” and “details concerning claims” in the SPLT and believes that consideration on such provisions should take place at the Standing Committee on the Law of Patents (SCP).

By placing these types of provisions in the SPLT, there can be some discrepancies between the SPLT and the PCT. For the purpose of getting rid of those differences it is necessary to consider not at first making the SPLT compatible with the PCT but making the PCT compatible with the SPLT.

II. Rule 5

1. The bracketed “technical” in Rule 5(1)(i) and (iii)

The square brackets in Rule 5(1)(i) should be removed. This will make the regulation clearly compatible with the provision of Article 27(1) of the TRIPS Agreement which stipulates that patents shall be available “for any inventions... in all fields of technology.”

On the other hand, the bracketed term “technical” in Rule 5(1)(iii) should be struck since the problems are not necessarily limited to those of a technical nature.

2. Disclosure of Prior Art Documents (Rule 5(1)(ii))

The value of the information regarding prior art documents provided by applicants is growing as the number of applications is rapidly increasing worldwide. Such information will not only reduce workload of searches and examinations and contribute to speeding up of examination at Offices, but will also be useful to accurately evaluate the relationship between prior art and the claimed invention and ensure an appropriate scope of protection.

Since it is applicants who are most likely to possess the information regarding prior art documents related to the claimed inventions of their applications, it is generally required that they should furnish this information as far as is known to them from the viewpoint of fairness.

In order to strongly motivate applicants to disclose information regarding prior art documents, obliging applicants to cite prior art documents as far as is known to them will be most effective. In Japan, Patent Law revision is currently under consideration to introduce such a system.

From the above perspective, Japan believes that the SPLT should clearly stipulate the obligation of applicants to cite prior art documents as far as is known to them. For this purpose, it is necessary that unclear points in the present Rule 5(1)(ii), for example, be clarified. For instance, “and, preferably, cite the documents reflecting such background art” could be rewritten in such a manner as “and cite

the documents reflecting such background art in cases where the applicant knows the documents.”

However, the citation of prior art documents is needed from the perspective of prompt examination. Even if the citation is not appropriate, this does not necessarily mean there is a substantial flaw in the claimed invention. Additionally, invalidation trials and lawsuits can be frequently raised if this is given as a ground for invalidation. In consideration of the above, further study is needed on whether or not inappropriate citation should be grounds for refusal uniformly or grounds for invalidation or revocation.

3. Disclosure of the Mode for Carrying out the Invention (Rule 5(1)(vi))

Japan supports the present draft Rule 5(1)(vi) suggesting the disclosure of at least one mode.

4. Industrial Applicability/Utility

The independent provision in the previous draft regarding industrial applicability/utility has been deleted and the concept of industrial applicability/utility is included in draft Article 12(1) and Rule 13(1). However, industrial applicability/utility should be independently stipulated as in Rule 3(1)(vii) of SCP/5/3 since it is one of the key requirements of patentability.

III. Rule 6

1. The Necessity of Technical Features (Rule 6(2) and (5))

Although descriptions of claims need to be technical by nature as a whole, there are cases in which not only technical features but also non-technical features are included. Also, whether or not an invention should be technical is not an issue to be considered under this item but an issue of patentability requirements.

Accordingly, the terms “technical” in square brackets in Rule 6(2) and Rule 6(5)(a) should be struck.

2. Elements of Claims (Rule 6(3))

In describing the elements of claims, the two terms “element” and “limitation” were put in square brackets as options in Rule 4 of SCP/5/3. On the other hand, the term “limitation” is adopted in the current draft Rule 6(3) and other terms such as “feature” and “step” are used in other items of Rule 6. These differing terms should either be unified or, if necessary, used separately after their differences have been clarified.

3. References in the Claims to the Description and Drawings (Rule 6(5))

Rule 6(5)(a) prohibits reference to the description or drawings in any claim. However, the regulation should be relaxed to allow referencing when necessary by adding a phrase to the same effect of “except where absolutely necessary” of PCT Rule 6(2)(a) since inventions such as compositions of alloys can in some cases be more clearly expressed by referencing drawings.

4. Dependent and Multiple Dependent Claims (Rule 6(6))

Regarding Rule 6(6)(a), claims in other categories as well as claims in the same category can be referenced unless the statement of the claim is unclear so as to simplify the description of the claim.

Regarding Rule 6(6)(b), Japan supports the present draft which allows cumulative referencing of multiple claims as this also simplifies the description of the claim.

The issue of complex referencing, as in Rule 6(6)(c), should be discussed at the Working Group on

multiple invention disclosures and complex applications with other items regarding the description of claims such as the conciseness of claims.

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