Requirements for Description and Claims

1. Introduction
The description and claims of a patent application must comply with the description requirements specified by Japanese Patent Law. Patent applications which do not comply with the requirements will be rejected (Japanese Patent Law, Article 49(4)). In case such applications are registered by mistake, it will be a grounds for invalidation (Article 123(1) (iv)). The description requirements in Japan tend to be examined more strictly compared to other countries.

2. Requirements under the examination system of JPO
The description requirements of a patent application are provided under Japanese Patent Law, Article 36. The following three requirements are the most important in a substantive examination.

(1) The Detailed Description of the Invention shall be stated in a manner to be clear and sufficient as to enable any person skilled in the art to which the invention pertains to work the invention on the basis of the description, drawings and the common general knowledge at the time of filing (Article 36(4)(i) : enablement requirement).

(2) The invention for which a patent is sought is stated in the Detailed Description of the Invention (Article 36(6)(i) : support requirement).

(3) The invention for which a patent is sought is clear (Article 36(6)(ii) : clarity requirement).

These requirements are based on the idea of Japanese Patent Law that “a patent right, which is an exclusive right to work the invention for certain period of time, is obtained in return for disclosure of the invention”. This idea leads directly to the purpose of the patent system which is to “encourage inventions and contribute to the growth of industry by protecting and utilizing inventions”. Furthermore, another purpose of these requirements is to avoid unnecessary battles between patentees and third parties.

3. Practice in Each Requirement
(1) Enable Requirement
Each invention is classified into three categories such as “invention of a product”, “invention of a process”, or a “process for producing a product” under the Japanese Patent Law. The definition of “carrying out the invention” in each category is as below.

For an invention of a product, the definition of carrying out the invention is to make and use the product. Therefore, it is required that (i) the “Invention of a product” is clearly explained,
(ii) can be made, (iii) and can be used.

For an invention of a process, the definition of carrying out the invention is to use the process. Therefore, it is required that (i) the “Invention of a process” is clearly explained and (ii) the “Process can be used”.

For an invention for producing a product, carrying out the invention means that the product can be produced by the process. Therefore, it is required that (i) the “Invention of a process for producing a product” is clearly explained and (ii) the product can be manufactured by the process.

(2) Support Requirements

A determination on whether the statement of a claim complies with the support requirement shall be made based on a comparison of the claimed invention and the invention stated in the Detailed Description of the Invention. It is performed by looking into whether or not the claimed invention exceeds the scope stated in the Detailed Description of the Invention in such a way that a person skilled in the art could recognize that the problem to be solved by the invention would actually be solved. In the case that the claimed invention is determined to exceed the scope, stated in the Detailed Description of the Invention, wherein a person skilled in the art could recognize that the problem to be solved by the invention would actually be solved, it is deemed that the application doesn’t satisfy the support requirement. Also, it is not deemed to comply with the support requirement in the case where the content disclosed in the Detailed Description of the Invention can neither be expanded nor generalized to the scope of the claimed invention even in light of the common technical knowledge.

(3) Clarity Requirement

Whether or not the scope of the claimed invention stated in a claim is clear, and whether or not the matters used to specify the invention are clear is determined. When interpreting the meanings of the matters used to specify the invention, not only the statement of the claim but also the statements of the description and drawings, as well as the common technical knowledge at the time of filing, shall be taken into account.

When the recitation of a claim is deemed clear in and of itself, the Examiner should examine whether the terms in the claim are defined or explained in the description or drawings, and evaluate whether such a definition or explanation, if any, makes the recitation of the claim unclear.

When the recitation of a claim is unclear in and of itself, the Examiner should evaluate whether the definition or explanation of a term in the claim in the description or drawings makes the recitation of the claim clear by considering the common technical knowledge at the time of filing.
4. Relations among Each Requirement

The above three requirements relate to each other closely. For example, when the recitation of the claim is unclear, a connection between the matters specifying the invention stated in the claim and the members of the embodiment stated in the Detailed Description of the Invention is unclear. Therefore, such an invention stated in the claim is deemed not to comply with the enablement requirement. Simultaneously, the invention relating to such an unclearly stated claim is deemed not to comply with the support requirement, since such an invention is not stated in the Detailed Description of the Invention.

5. Response to the Notice of Reasons for Rejection due to Violation of Requirements

In the case of a Notice of Reasons for Rejection due to a violation of requirements at the examination stage, the reason for rejection can be overcome by amendments. However, addition of embodiments in order to comply with the support requirement and amendments of the disclosure of the Detailed Description of the Invention in order to comply with enablement requirements are considered to be addition of new matter. The scope of the claims must be reduced in such a case.

Therefore, in order to avoid violation of the enablement requirement and the support requirement, it is necessary to state as many embodiments as possible in the specification of the application as originally filed and to disclose the Detailed Description of the Invention in as much detail as possible.

6. Conclusion

The requirements for the Detailed Description of the Invention and Claims are as important as novelty or inventive step since they are directly linked to the purpose of the Patent Law. It is necessary and effective to consider them before filing the application since it may be difficult to overcome the violation of these requirements after filing. Moreover, it is advantageous to get advice from Japanese attorneys since there are many cases where a statement could be rejected in Japan even though it is acceptable in other countries.