

❖ INTRODUCTION

If you wish to obtain a patent right in Japan, your claimed invention has to fulfill certain requirements as stipulated in the Japanese Patent Law. The major requirements include:

- [Industrial Applicability] Claimed invention has to be industrially applicable (Japanese Patent Law, Article 29, Paragraph 1, Main Paragraph);
- [Novelty] Claimed invention has not been publicly known in Japan or elsewhere (Japanese Patent Law Article 29, Paragraph 1 (and Article 29bis));
- [Inventive Step] Claimed invention could not have been easily conceived of (Japanese Patent Law, Article 29, Paragraph 2);
- [First-to-File System] Claimed invention has not been filed by third parties (Japanese Patent Law, Article 39 (and Article 29bis))
- [Description Requirements] Description of specification and recitation of claims have to satisfy certain description requirements (Japanese Patent Law, Article 36)

In particular, reasons for rejection about novelty and inventive step are often listed in Office Actions, and they also become issues of contention at the court.

❖ NOVELTY

The judgement regarding novelty is based on the timing of the filing of a patent application (international filing date for PCT-based applications, and priority date for Paris Convention-based applications). Please note that not only the date but also the exact time of filing a patent application is considered to be the subject for the judgement. Therefore, it is very important to conduct a thorough prior art search before filing a patent application.

Inventions which lack novelty include:

1. Those publicly known in Japan or in overseas countries prior to filing (for example, TV broadcasting)
2. Those publicly worked in Japan or in overseas countries prior to filing (for example, in-store sales, factory tour)
3. Those disclosed in a distributed publication or made publicly available through electric communication lines in Japan or elsewhere (for example, patent publications published in Japan or elsewhere, research papers, conference presentations (proceedings), in-house newsletters, books, contents of CD-ROMs, Internet articles)

Most of the reasons for rejection in OAs are due to item 3 above. OAs including the above item 1 or 2 are very rare because it is difficult for examiners to find such disclosures. However, regarding items 1 and 2, the examiner may notice an upcoming facility tour if it is highly publicized on media, a company's website, newspapers, etc. With regard to item 3, all necessary precautions should be taken when a presentation is made at an academic conference. That is because publication dates of proceedings are different among each academic institution. In addition, you have to be aware of information on not only your own company's website, but also information on SNS, word-of-mouth sites, and blogs. The latter information may be uncontrollable. (c.f. In the 2016-Gyoke-10092 case, a blog was considered as one instance of convincing proof.)

❖ REMEDIAL MEASURES (GRACE PERIOD): EXCEPTION TO LOSS OF NOVELTY OF INVENTION (JAPANESE PATENT LAW, ARTICLE 30)

Even if a claimed invention is disclosed for the first time due to certain actions (such as conducting an experiment, announcing in a publication, announcing at a public gathering, academic conference, etc., displaying at an exhibition, selling products, holding a news conference, announcing via radio or TV broadcasting, etc.), the claimed invention will be deemed to not lose novelty by utilizing the exception to loss of novelty system (i.e., grace period system) in Japan. In order to utilize the grace period system in Japan, it is necessary to file, within one year from the disclosure, a "Japanese" patent application (including a Japanese patent application claiming priority based on a Paris Convention application or PCT application).

(For your reference, the period for exception to loss of novelty has been extended from six months to one year in accordance with the revisions of Japanese Patent Law, Article 30 [Effective date: June 9, 2018]. This stipulation covers applications filed on or after June 9, 2018. Please note that a filing date is defined as follows: for a national phase application into Japan based on a PCT application: International filing date; for a direct application in Japan based on the Paris Convention: Filing date of Japanese application).

NOVELTY AND INVENTIVE STEP

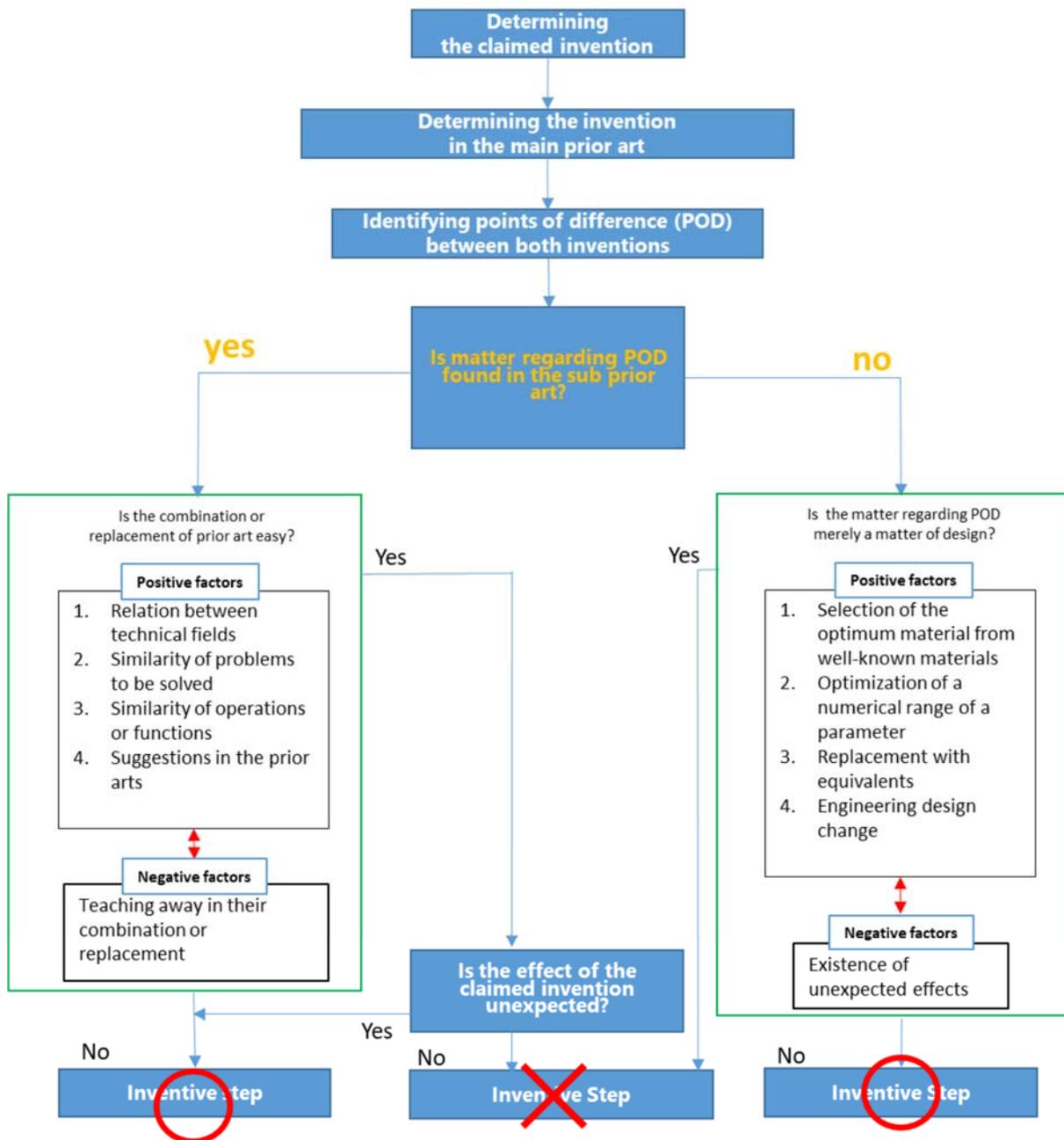
❖ INVENTIVE STEP

The judgement regarding inventive step is the most difficult issue when considering the patentability of the claimed invention. Most reasons for rejection in OAs are related to a lack of inventive step.

[Criteria for Judgement of Inventive Step]

The examiner first conducts a prior art search to find related prior art, selects the most suitable prior art (main prior art) among them, and then considers whether or not a person skilled in the art could have easily conceived of the claimed invention based on the prior art. If the examiner determines it is possible, the claimed invention is deemed to lack inventive step. If not, the examiner admits the inventive step of the claimed invention.

Flowchart for Judging Inventive step (excerpted from JPO data)



❖ DETERMINATION OF INVENTIVE STEP

The JPO's Examination Guidelines describe the following process to determine whether a person skilled in the art could have easily conceived of the claimed invention.

- Identifying point(s) of difference (POD) between the claimed invention and the main prior art;
- Determining whether or not the POD is merely a matter of design, such as optimization of a numerical range;
- Determining whether or not there is any motivation in the prior art for a person skilled in the art to make the claimed invention;
- Determining whether or not the claimed invention results in any advantageous effects.

❖ POSITIVE FACTORS FOR DENYING INVENTIVE STEP BY COMBINING THE CITED PRIOR ARTS)

1. Relation between technical fields

A "relation between technical fields" means there are many similarities in the problems to be solved and similarities in the purposes of the invention. That is to say, once a "relation between technical fields" has been found in the cited prior art documents, it is easy to combine those cited prior art documents.

2. Similarity of problems to be solved

Inventions may arise from problems to be solved, and it is therefore easy to combine cited prior art documents which have similar problems.

3. Similarity of operation or function

It is common for a person skilled in the art to replace one component with another while maintaining a similar operation or function.

4. Suggestions in the content of prior arts

A suggestion in the contents of prior art documents may give hints for conceiving of the claimed invention.

Furthermore, if the claimed invention has an advantageous effect over the prior art, the examiner will consider it. For cases in which all of the matters specifying the claimed invention are described in the prior art document as broader concepts (the claimed invention specifies them in subordinate concepts), but the claimed invention results in an advantageous effect, the examiner may admit the inventive step for the case when the invention produces the remarkable effect. In response to an OA including a lack of inventive step rejection, the following counterarguments are worthy of consideration.

1) Counterargument regarding Relation between Technical Fields

Generally, a counterargument merely which argues the difference in technical fields between the main prior art and the sub prior art is not enough to deny their combination. Therefore, this counterargument is generally combined with other arguments.

In this regard, please be careful about the definition of the sub prior art as "well-known technology" under patent practice in Japan. For example, if the examiner refers to a sub prior art as a publication showing well-known technology in an OA, it generally implies that the sub prior art can be combined with the main prior art without any specific motivation.

2) Counterargument regarding Similarity between Problems to be Solved

An effective counterargument may be that there is no motivation for a person skilled in the art to apply the sub prior art to the main prior art if the problem to be solved by the claimed invention is not described in both the main prior art and the sub prior art. The Examination Guidelines revised in October 2017 seem to emphasize the importance of the problem to be solved.

3) Arguing Advantageous Effect

As described the above, the argument regarding an advantageous effect of the claimed invention may be strongly taken into account under Japanese patent practice. Therefore, if the main prior art and the sub prior art do not describe the effect of the claimed invention, the argument regarding the advantageous effect of the claimed invention can be effective.

4) Arguing Teaching Away

If there is any “teaching away” when applying the sub prior art to the main prior art, arguing that teaching may be effective. Teaching away includes the case where the invention resulting from combining the invention of the main prior art and the sub prior art(s) does not appropriately work; the case where the invention resulting from combining the invention of the main prior art and the sub prior art(s) can no longer achieve the effects of the main prior art.

5) Arguing Hindsight

An argument about hindsight may also be effective. However, please be careful about the use of the term “hindsight” in the response. This term may give quite a bad impression to the examiner. For example, if an applicant argues hindsight in a disrespectful way, there is a risk that the examiner may thoroughly conduct an additional prior art search with full force.