

Part II: REQUIREMENTS FOR PATENTABILITY

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Chapter 3 Patent Law Section 29^{bis}

Patent Law Section 29^{bis} reads:

Where an invention claimed in a patent application is identical with an invention or device (excluding an invention or device made by the same person as the inventor of the invention claimed in the patent application) disclosed in the specification or drawings originally attached to the request of another application for a patent (in the case of a foreign language file application referred to in Section 36^{bis}(2) of this Law, the foreign language file referred to in Section 36^{bis}(1) of the said Law) or of an application for a utility model registration which was filed prior to the filing date of the patent application and for which the Patent Gazette which states the matter referred to in each paragraph of Section 66(3) of the said Law (hereinafter referred to as "the Gazette containing the Patent") was published under the said subsection or the laying open for public inspection (Kokai) was effected or the Utility Model Gazette which states the matter referred to in each paragraph of Section 14(3) of Utility Model Law (No. 123 of 1959) (hereinafter referred to as "the Gazette containing the Utility Model") was published under the said subsection after the filing of the patent application, a patent shall not be granted for the invention notwithstanding Section 29(1). However, this provision shall not apply where, at the time of filing of the patent application, the applicant of the patent application and the applicant of another application for a patent or the application for a utility model registration are the same person.

1. Purport of the provision of Patent Law Section 29^{bis}

An invention disclosed in a specification or drawings, if not in claims, is usually laid open to the public in a publication of an examined or unexamined application. A claimed invention of subsequent applications which is identical with an invention disclosed in the specification or drawings of a precedent application, even if the subsequent application is filed prior to the publication of a precedent application examined or unexamined, cannot be an invention of an application filed first to disclose a new technology in its publication to the public. Granting a patent to such an invention is inappropriate and to be rejected in that it is inconsistent with the role of the Patent Law to protect an invention as a reward for the disclosure of a new invention.

2. Patent Law Section 29^{bis}

2.1 Invention Claimed in a Patent Application

An invention claimed in a patent application is referred to as "a claimed invention."

2.2 Another Patent or Utility Model Application, Filed Prior to the Filing Date of a Patent Application, and Published in Examined or Unexamined Publication After Filing the Said Application

(1) Another patent or utility model application (referred to as "another application" hereinafter) to be cited as a reference under Section 29^{bis} is required to have been filed prior to the filing date of the said patent application (or the priority date of the application with a priority claim), and to have been published in an examined or unexamined

publication after the filing of the said application.

(2) In the case where another application is a divisional application, a converted application, or a patent application based on a utility model registration, the critical date of filing as a reference is the actual filing date of filing such an application, not the date of filing the initial application.

(3) In the case where another application is one with a priority claim under the Paris Convention, and filed within the priority period and accompanied by a priority document, it is deemed as filed in Japan on the filing date of filing in the country of origin, for an invention commonly disclosed in the specification, etc. of the original application and in a specification and drawings originally attached to the request in Japan (referred to as an “initial specification, etc.” hereinafter).

(4) An “early application,” which was a basis for a domestic priority claim (under Section 41(1)), or an application with a priority claim thereof (referred to as a “later application” hereinafter) is deemed as another application based on an invention disclosed in the initial specification, etc. as follows:

For the part of an invention commonly disclosed in the initial specifications, etc. of both earlier and later applications, the earlier application is deemed as another application filed on the earlier filing date in the provision of Patent Law Section 29^{bis} which should be applied (Patent Law Section 41(2) and (3)).

However, in the case where the said earlier application also claims a priority right (including one under the Paris Convention), for the part of an invention commonly disclosed in the said earlier and later initial specification, etc. and an initial specification, etc. of another previous application, which had been another basis of a priority claim for the said earlier application, the said early application is not deemed as another application in the provision of Patent Law, Section 29^{bis} which should be applied (Patent Law Section 41(2) and (3)).

For the part of an invention solely disclosed in the initial specification, etc. of a later application but not in that of an earlier application, a later application is deemed as another application under Patent Law, Section 29^{bis} (Patent Law Section 41(2) and (3)).

(5) Even where an earlier application, which was a basis for a domestic priority claim, or a later application with a domestic priority claim thereof is deemed as another application, an invention solely disclosed in an initial specification, etc. of an earlier application but not in that of a later application is not deemed as disclosed in a publication. Thus, Patent Law, Section 29^{bis} does not apply.

2.3 Invention or Device Disclosed in the Initial Specification etc. of Another Application

“An invention or a device disclosed in an initial specification, etc. of another application” means an invention or a device identified by “matters described” (Note 1) or “matters essentially described, though not literally,” in an initial specification, etc. of another application as of the filing.

“Matters essentially described, though not literally” means those directly derivable

from the matters described, taking into consideration the common general knowledge (Note 2) at the time of the filing of another application.

(Note 1) Matters described in an initial specification, etc. of another application, even deleted by a later amendment, do fall within the provision of Patent Law Section 29^{bis}.

(Note 2) “The common general knowledge” means technologies generally known to a person skilled in the art (including well-known or commonly used art) or matters clear from empirical rules.

“Well-known art” means technologies generally known in the relevant technical field, e.g., many prior art documents, those widely known throughout the industry, or those well-known to the extent needless to present examples. “Commonly used art” means well-known art which is used widely.

2.4 A Claimed Invention Identical with an Invention or a Device Disclosed in an Initial Specification etc. of Another Application

“A claimed invention identical with an invention disclosed in an initial specification, etc. of another application” includes a case that there is no difference between matters to define an invention for which a patent is sought and matters to define an invention disclosed in an initial specification, etc. of another application (as referred to “cited invention” hereinafter), and a case that there is a very minor difference in an embodied means to solve a problem (substantially identical).

2.5 The Same Inventors of the Invention or the Device as of the Invention of the Present Patent Application

(1) An inventor of a claimed invention of the present patent application and an inventor of an invention or a device of a specification, etc. of another application are deemed as inventors as indicated in the requests, except for “special conditions” such as an indication of another inventor of a certain invention is stated in a specification.

(2) The sameness of inventors means the complete sameness of all of the indicated inventors in the two requests. If the sameness is incomplete or partial, the finding of the complete sameness is conducted by identifying inventors substantially as a matter of fact.

(3) In order to reverse a finding of incomplete sameness, in addition to an applicant's assertion, evidence supporting such an assertion (such an inventor's affidavit or declaration of another application) is mandatory.

(4) Joint inventors in effect ought to make a useful contribution to a completion of an invention by complementing each other's technical creative activities at least in part in the course of the completion.

2.6 The Same Applicants of the Present Patent Application at the Time of Filing as of Another Application

(1) The finding of the sameness of applicants should be made at the time in effect of filing by identifying applicants indicated in the request of the present and another applications in

comparison.

(2) In the case of plural applicants, the complete sameness of applicants indicated in the two requests is mandatory to find the sameness of applicants.

(3) The sameness of applicants remains effective even in the case of the subsequent discrepancy of applicants caused by a change of name, inheritance or a merger of applicants of the present and another applications.

(4) In the case of the present application, either a divisional or converted application, the applicant of the initial application on the date of retroactive of the initial filing is deemed as the applicant of the present application for the purpose of sameness.

3. Method of Determining the Identity of a Claimed Invention with an Invention or a Device Disclosed in the Initial Specification, etc. of Another Application

When there are two or more claims, the determination of requirements for Patent Law Section 29^{bis} is made for each claim.

3.1 Finding of a Claimed Invention

The method of finding a claimed invention set forth in “Chapter 2. 1.5 Method of Determining Novelty” is also applied to the examination under Section 29^{bis}.

3.2 Finding of an Invention or a Device Disclosed in an Initial Specification etc. of Another Application

(1) “An invention or a device disclosed in an initial specification, etc. of another application” means an invention or a device identified by “matters described in an initial specification, etc. of another application (Note 1)” or “matters essentially described, though not literally, in an initial specification, etc. of another application (those directly derivable from the matters described, taking into consideration the common general technical knowledge at the time of filing of another application).”

Therefore, unless an invention or a device can be identified by a person skilled in the art on the basis of matters either described or essentially described, though not literally, in an initial specification, etc. of another application, neither such an “invention nor a device shall be deemed as “an invention or a device disclosed in an initial specification, etc.” i.e., “a cited invention” or “a cited device” under Section 29^{bis}. For example, when a particular matter is disclosed in the initial specification, etc. of another application as a part of alternatives of Markush-type formula, attention should be drawn to whether or not the disclosed matter itself provides a person skilled in the art with a full basis for identifying an invention (a cited invention).

(Note 1) Matters described in an initial specification, etc. of another application, even deleted by a later amendment, do fall under the provision of Patent Law Section 29^{bis}.

(2) Also, unless it is clear that an invention or a device is disclosed in the initial specification of another application in such a manner that a person skilled in the art can make the product in case of a product invention or a device, or can use the process in case of a process invention, taking into consideration the common general knowledge as of another application, then such an invention or a device shall not be deemed as “a cited invention” nor “a cited device” under Section 29^{bis}.

For example, if a chemical substance is expressed merely by a name or chemical formula in an initial specification of another application and if it is not clear that a person skilled in the art can produce the chemical substance on the basis of the description of the specification, even taking into consideration the common general knowledge at the time of filing of another application, then, the chemical substance does not fall under an “invention disclosed in an initial specification of another application” under Section 29^{bis}. (Note that this does not mean that, when another application claims the chemical substance as one of alternatives of Markush-type formula, the claim violates the enablement requirement under Section 36(4).)

(3) The finding of a cited invention expressed in specific concept or generic concept

A cited invention expressed in a specific manner necessarily implies or suggests “a generic invention of which matters defining the invention are the same family or the same genus, or have the common characteristics with the cited invention,” and leads to the finding of an invention expressed in generic concept (Note 2). Without identifying the cited invention expressed in specific concept to its generic invention, the determination under Section 29^{bis} of the claimed generic invention may be conducted at the comparison and determination steps.

A cited invention expressed in generic concept neither implies nor suggests an invention expressed in a specific manner, and does not lead to the finding of the invention expressed in a specific manner (except when an invention expressed in a specific manner can be directly derivable from such a generic invention, taking into consideration the common general knowledge (Note 3)).

(Note 2) “Generic concept” is defined as a concept integrating matters in the same family or the same genus, or a concept integrating a plurality of matters with the common characteristics.

(Note 3) The plain logic that generic concept contains specific disclosure, or a term in generic concept contains specific terms, does not substantiate the necessary derivation (disclosure) of an invention expressed in specific concept.

3.3 Comparison of a Claimed Invention with a Cited Invention

(1) The finding of the identicalness and difference between a claimed invention and a cited invention is conducted by comparing the matters defining the claimed invention and the matters defining the cited invention.

(2) A more specific concept within the concept of the claimed invention may be compared with a cited invention for the purpose of finding the identicalness and difference between a claimed invention and cited invention, instead of the method of comparison mentioned (1).

An example of “a more specific concept within the concept of the claimed

invention” is the invention disclosed in the detailed description of the invention as a mode for carrying out the claimed invention. Inventions other than this may be compared with the claimed invention as far as they are more specific concepts within the concept of the claimed invention.

This alternative method would be helpful for the examination under Section 29^{bis} in terms of claims with statements defining a product by its function, property or characteristics, etc. or of claims with limitation by numerical range, etc.

(3) The matters defining a claimed invention may be directly compared with the matters described in an initial specification of another application, instead of the method of comparison mentioned (1) and “Chapter 2. 1.5.3(3).” In doing so, the finding of the identicalness and difference between the claimed and cited inventions may be conducted by interpreting the matters described in the initial specification, etc. taking into consideration the common general knowledge as of the filing of another application. The result of the determination shall be the same as the result obtained by following the method of comparison mentioned (1) and “Chapter 2. 1.5.3(3).”

(4) The comparison should never be conducted between a claimed invention and a combination of two or more cited inventions.

3.4 Determining the Identity of a Claimed Invention and a Cited Invention

(1) Where there is found no difference between the matters defining the claimed invention and the matters defining the cited inventions as a result of the comparison, the claimed and cited inventions are identical. Even where there is a difference between the two, they are deemed to be identical if the difference is considered as a very minor difference (addition, deletion, or replacing of well-known or commonly used art, generating no new effects) in embodied means to solve a problem (i.e. substantially identical).

(2) If matters defining a claimed invention are expressed by alternatives either in form or de facto (Note), and if any one of inventions each of which is identified by supposing that each of the alternatives is a matter to define each of such inventions has no difference from or is substantially identical with a cited invention, then, the claimed invention shall be deemed identical with the cited invention.

This handling does not relate to the issue of when a prior art search is to be finalized. See “Part : Procedure of Examination” in this regard.

(Note) As for “by alternatives either in form or de facto,” see “Chapter 2. 1.5.5 (Note 1)”

(3) Handling of a claim with statements defining a product by its function or characteristics, etc.

Where a claim includes statements defining a product by its function or characteristics, etc., and it falls under either the following (i) or (ii), there may be cases where it is difficult to compare the claimed invention with the cited invention. In the above circumstances, if the examiner has a reason to suspect that they would be prima facie identical with the product of the cited invention, the examiner may send the notice of reasons for refusal under Section 29^{bis} without making a strict comparison of the claimed product with the product of

cited invention. Then an applicant may argue or clarify by putting forth a written argument or a certificate of experimental results, etc. against the notice of reasons for refusal. The reason for refusal is to be dissolved if the applicant's argument succeeds in changing the examiner's evaluation at least to the extent that truth or falsity becomes unclear. Where the applicant's argument does not change the examiner's evaluation to that extent, the examiner may make a decision of refusal on the ground of the notice of reasons for refusal which is earlier notified.

The examiner, however, shall not cite a reference under this handling if matters defining a cited invention include a statement defining a product by its function or characteristics, etc. and fall under either the following (i) or (ii):

- (i) a case where the function or characteristics, etc. is neither standard, commonly-used nor comprehensible to a person skilled in the art; or
- (ii) a case where plural of functions or characteristics, etc., each of which is either standard, commonly-used, or comprehensible to a person skilled in the art, are combined in a claim so that the claim statements as a whole fall under (i).

(Note) Function, property or characteristics should be deemed standard if it is either defined by JIS, ISO-standard or IEC-standard, or it can be determined by a method for testing or measuring which is provided in those standards. Function, property or characteristics should be deemed commonly used if it is commonly used by a person skilled in the particular art as well as its definition or the method for testing or measuring can be understood.

Examples where the examiner has a reason to suspect the prima facie identity are the followings:

- (s)he reveals that a prior art product is identical with the product of the claimed invention as a result of the converting the function or characteristics, etc. into a different definition with the same meaning or a different method for testing or measuring the same;
- where both the claimed invention and cited invention are defined by identical or similar function or characteristic, etc. which are measured or evaluated under different measuring conditions or different evaluation methods and there is a certain relationship between them, there is a high probability that the function or characteristic, etc. defining the cited invention, if measured or evaluated under the same measuring conditions or evaluation method as the claimed invention, is included in the function or characteristic, etc. defining the claimed invention;
- a product of the claimed invention has been revealed identical in structure with a certain product after the filing and (s)he discovers the particular product is disclosed in the initial specification of another application;
- (s)he discovers a prior art product which is identical with or similar to a mode for carrying out the claimed invention (for example, (s)he discovers a prior art product of which starting material is similar to and of which manufacturing process is identical with those of the mode for carrying out the claimed invention, or (s)he discovers a prior art product of which starting material is identical with and of which manufacturing process is similar to those of the mode for carrying out the claimed invention, etc.); and
- the claimed invention and a cited invention have common matters defining the invention

other than those defining a product by its function or characteristic, etc., and the cited invention has the same objective or effect as the one which the matters defining a product by its function or characteristic, etc. have, and there is a high probability that the function or characteristic, etc. defining the cited invention is included in the function or characteristic, etc. defining the claimed invention.

The examiner should follow the ordinary method when the requirement under Section 29^{bis} can be examined without using this exceptional handling.

(4) Handling of a claim with statements defining a product by its manufacturing process

Where a part or all of claim statements are those which define a product by its manufacturing process, there may be cases where embodying the structure of such a product per se is difficult. In such cases, the examiner may send the notice of reasons for refusal under Section 29^{bis} without making a strict comparison between the claimed product and the product of cited invention and may wait for the applicant's argument against the notice, if the examiner has a reason to suspect that they would be prima facie identical.

The examiner, however, shall not cite a reference under this handling if matters defining a cited invention include a statement defining a product by its manufacturing process.

Examples where the examiner has a reason to suspect the prima facie identity are the followings:

- (s)he discovers a prior art product of which starting materials is similar to and of which manufacturing process is identical with those of the product of the claimed invention;
- (s)he discovers a prior art product of which starting materials is identical with and of which manufacturing process is similar to those of the product of the claimed invention;
- a product of the claimed invention has been revealed identical in structure with a certain product after the filing, and (s)he discovers the particular product is disclosed in the initial specification of another application; and
- (s)he discovers a prior art product which is identical with or similar to a mode for carrying out the claimed invention.

The examiner should follow the ordinary method when the requirement under Section 29^{bis} can be examined without using this exceptional handling.

4. Notice of Reasons for Refusal under Patent Law Section 29^{bis}

Where the examiner has a reason to suspect that inventions would be unpatentable under Section 29^{bis}, (s)he should send a notice of reasons for refusal.

Against the notice of reasons for refusal, an applicant may argue or clarify by putting forth a written argument or a certificate of experimental results, etc.

The reason for refusal is to be dissolved if the applicant's argument succeeds in changing the examiner's evaluation at least to the extent that truth or falsity becomes unclear. Where the applicant's argument does not change the examiner's evaluation to that extent, the examiner may make a decision of refusal on the ground of the notice of reasons for refusal which is earlier notified.

[Case Law for Reference]

(1) Finding of an invention disclosed in the specification, etc. of a precedent application.

Sho 58 (Gyo Ke) 95, (Judgement: Sept. 30, 1985)

A known art may be taken into consideration in construing descriptions in a specification, but this is to the extent that the subject matter concerned is described in the specification.

However, if this rule were to be applied to the present case in which the description concerned is at a very abstract level, then what the specification is deemed as disclosing would be far reaching beyond a reasonable extent.

Therefore, in judging the identity of inventions under Patent Law Section 29^{bis} (1), it is improper, though admissible in judging on an inventive step, to take into consideration the teaching of other reference in construing the description of the present specification which was expressed in a very abstract way.

Sho 60 (Gyo Ke) 43, (Judgement: Jan. 28, 1987)

The cited reference describes nylon 66/6 copolymer as one of the examples of polyamide resin. However taken into account the common general knowledge at the time of filing, it is found that the cited reference essentially, although not literally with respect to the proportion of the composition, discloses nylon 66/6 copolymer having a composition within a range limited in the claim, because a person skilled in the art would have immediately conceived it based on the description.

Sho 59 (Gyo Ke) 176, (Judgement: June. 28, 1988)

...The cited reference does not give an express explanation to the means of writing data, therefore, the present invention and the cited prior art seemingly differ in whether two data lines and two bit lines for reading data are also used for writing data. Otherwise the two inventions have common features.

...However, in light of the common general knowledge concerning the data writing and reading as mentioned above, it is construed that the cited reference essentially discloses the art to use for writing data the two data lines connected to the two bit lines.

Sho 61 (Gyo Ke) 29, (Judgement: Sept. 29, 1986)

The plaintiff argues that the identity of the two shall be judged by the sole comparison therebetween and common general knowledge is not allowed to be considered.

However, an applicant is not required to cover in a specification all the arts related to an invention; rather, most specifications are prepared assuming common general knowledge.

Thus, it should be allowed to refer to common general knowledge in understanding an invention disclosed.

(2) Comparison and Judgement

Sho 61 (Gyo Ke) 29, (Judgement: Sept. 29, 1986)

The plaintiff further argues that the Patent Law Section 29^{bis} does not mention

“substantially identical” on which the appeal board decision relies and thus the board decision is against the law.

However, the case rarely happens in which two inventions become literally identical including their constitutions and effects described, and it should be allowed to find that the two inventions are identical, if the differences resides merely in expressional or very minor design variations and there is no significant difference in effects. Thus, a later invention shall be excluded from patentability under the Patent Law Section 29^{bis} when it is substantially identical with an earlier invention in the meaning above.

Hei 1 (Gyo Ke) 226, (Judgement: Sept. 20, 1990)

The feature E of the present invention is quite different from the feature e of the cited invention. Since the feature E is a constituent element of the present invention, it can not be found the two inventions are substantially identical, unless it is shown that the features E and e are commonly or widely used in the technical fields to which those inventions pertain.

The defendant argues that the holding means adopted in the present invention is merely a conversion of an equivalent means. However, the structures of the two features are too different to find that there is no difference in their works and effects, and yet the defendant failed to show that the two features are commonly or widely used in the relevant technical field. Consequently, only the facts that the two features are equivalent, and that there is no significant difference in their effects do not constitute a ground for the two inventions being deemed as substantially identical.