Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

First Name:

[redacted]

Last Name:

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Country:

Japan

IP Office

JPO

Job title

Assistant Director

Email address:

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

Anything which, prior to the filing of the patent application, was publicly known or worked, published, or made available to the public through electric telecommunication lines. (Article 29(1), Patent Act)

2. Against which date is prior art assessed under the applicable law?

At the time of filing the application

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Prior art includes "Prior art disclosed in a distributed publication," "Prior art made publicly available through electric telecommunications lines,"" Publicly known prior art," and "Publicly worked prior art" (within Japan or in a foreign country).
"Prior art disclosed in a distributed publication" refers to prior art described in the publications which anyone can read. The fact that someone actually accessed such publications is not necessary.
"Prior art made publicly available through electric telecommunications lines" refers to prior art published on a website or a similar platform which can be read by anyone via electric telecommunications lines. It does not require the fact that someone has actually accessed the website.
"Publicly known prior art" refers to prior art whose content is known to anyone as art without an obligation of secrecy. Prior art disclosed by a person on whom obligation of secrecy is imposed to another person who are not aware of its secrecy is "publicly known prior art"
""Publicly worked prior art" refers to prior art that has been worked in a situation where its content is publicly known or could be publicly known.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as “secret prior art”)?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : Secret prior art applies when the invention claimed in the application concerned is identical with an invention described in the originally-filed description of another application which was filed on or before the day preceding the filing date of the application concerned; the other application was published on a gazette or otherwise disclosed after the filing date of the application concerned; the inventor of the other application is not identical with the inventor of the invention claimed in the application concerned; and the applicant of the other application is not identical with the applicant of the application concerned at the time of fling of the application concerned. The examiner determines that the invention claimed in the application concerned is identical with the cited invention not only when there are no differences between the invention claimed in the application concerned and the cited invention, but also when there are differences between them, provided that the two are substantially identical. Here, "substantially identical" refers to cases where the differences between the invention claimed in the application concerned and the cited invention are minor variations in the means for solving the problem (such as the addition, deletion, or conversion of common general knowledge or commonly used art that do not yield new effects).

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Examination Guidelines for Patent and Utility Model in Japan | Japan Patent Office
Especially, Part III Patentability Chapter 2 Section 3 「Procedure of Determining Novelty and Inventive Step」 and Part III Patentability Chapter 3「Secret Prior Art (Patent Act Article 29bis)」

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The provision stipulated in the Patent Act also applies to utility models (Article 3 and Article 3bis, Utility Model Act). Please note that utility model rights are registered without undergoing substantive examination.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

The invention was not publicly known or has not been publicly worked, published, or made available to the public through electric telecommunication lines before the filing of the patent application. (Article 29(1), Patent Act)

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

No, there are no novelty-specific considerations regarding the relevant date or the scope of information taken into account.

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

Absolute novelty is adopted.

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

No, there are no specific rules or contextual factors that affect what is considered as prior art for the purposes of assessing novelty.

5. Please provide any additional information relevant to the requirement of novelty under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or other interested parties, captured by patent office practice.

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Especially, Part III Patentability Chapter 2 Section 1 「Novelty」 and Section 3「Procedure of Determining Novelty and Inventive Step」

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The provision stipulated in the Patent Act also applies to utility models (Article 3, Utility Model Act).
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C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

The invention could not easily have been made, before the filing of the patent application, by a person with ordinary skill in the art on the basis of the prior art. (Article 29(2), Patent Act)

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

At the time of filing the application

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the “person skilled in the art”, focusing on how the standard is understood or applied, rather than its formal legal definition?

Inventive step is determined by examining whether or not it is possible to reason that a person skilled in the art could have easily arrived at the claimed invention from the primary prior art. To determine whether a person skilled in the art could have easily arrived at the claimed invention, it is necessary to comprehensively assess the facts in support of the non-existence of an inventive step and those in support of the existence of an inventive step.
Factors in support of the non-existence of an inventive step include: (1) motivation for applying secondary prior art to primary prior art (i.e., (1) relation of technical fields, (2)similarity of problems to be solved, (3) similarity of operations or functions, and (4) suggestions shown in the content of the prior art); (2) design vatiation of primary prior art; and (3) mere aggregation of prior art.
Factors in support of the existence of an inventive step include: (1) advantageous effects, and (2) obstructive factors.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:** No, there are no specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness.

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Examination Guidelines for Patent and Utility Model in Japan | Japan Patent Office
Especially, Part III Patentability Chapter 2 Section 2 「Inventive Step 」 and Section 3「Procedure of Determining Novelty and Inventive Step」

Please upload any document relevant to the requirement of inventive step or non-obviousness under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The provision stipulated in the Patent Act also applies to utility models (Article 3(2), Utility Model Act).
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D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Disclosure not to be taken into consideration in determining novelty and inventive step if it occurred within one year before the filing date: (a) against the will of the person having the right to obtain a patent; or (b) as a result of actions of the person having the right to obtain a patent (excluding the case in which it has been disclosed through the publication in the bulletin pertaining to inventions, utility models, designs or trademarks). (Article 30 ,Patent Act)

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

The application must be filed within one year from the date on which certain disclosures are made.

3. Where such a mechanism exists, which categories of disclosures are covered by it?

(a) Against the will of the person having the right to obtain a patent; or (b) as a result of actions of the person having the right to obtain a patent (excluding the case in which it has been disclosed through the publication in the bulletin pertaining to inventions, utility models, designs, or trademarks).

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

Yes

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:** The applicant shall submit (in the case of 1 (b) above): (a) a written statement to that effect at the time of filing; and (b) proof, within 30 days of the filing date, that the disclosure was in respect of the invention.

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

No

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:** No, there are no such rights or protections.

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Examination Guidelines for Patent and Utility Model in Japan | Japan Patent Office
Especially, Part III Patentability Chapter 2 Section 5 「Exceptions to Lack of Novelty of Invention (Patent Act Article 30)」
Procedures for Seeking the Application of Exceptions to Lack of Novelty of Invention, corresponding to the Patent Act Article 30 | Japan Patent Office

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

The provision stipulated in the Patent Act also applies to utility models (Article 11, Utility Model Act).
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Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.