

4 Patent Examination Practices (Description Requirements)

— Desirable Descriptions —

The description requirements for descriptions, etc. have been gaining attention in recent years. Given the various arguments going on concerning the description requirements, this study was carried out by a subcommittee on the Study on Description Requirements in the Biotechnology Field, which conducted examinations dedicated to the biotechnology field, and a subcommittee on Study on Desirable Descriptions, which conducted examinations without limiting the technical field. In the Study on Desirable Descriptions, with the aim of supporting preparation of desirable descriptions that satisfy the description requirements in Japan, the United States and Europe, the relevant subcommittee created examples of desirable descriptions for each technical field and summarized the points to be noted in preparing such descriptions, from the viewpoint of patent obtainment and enforcement in Japan, the United States and Europe.

I Introduction

When filing a patent application, it is important to prepare the description (including the patent claims and drawings; the same shall apply hereinafter) by giving consideration to satisfaction of the description requirements for acquiring a patent as well as to patent enforcement. Also, considering the increase in the number of foreign applications nowadays, it is important to use Japanese wording that is suitable for translation and to prepare a description that takes into account the systems and operations in Europe, the United States and other foreign countries.

“Intellectual Property Strategic Program 2006” and “Intellectual Property Strategic Program 2007” also mention the following as one of the measures for promoting the appropriate use of the intellectual property system: “In light of problems arising from incorrect translations of patent descriptions prepared for filing foreign patent applications, the government of Japan (GOJ) will continue to use seminars and instruction manuals to thoroughly promote the use of plain and clear terminology and expressions when writing patent descriptions in order to avoid incorrect translations. More specifically, the GOJ will recommend that each sentence be short, the correspondence between the

subject and the predicate be clear, and ambiguous and abstract terms be avoided.”

Under such circumstances, it will be significant for applicants’ prompt obtainment of patents and appropriate patent enforcement to create examples of desirable descriptions that satisfy the description requirements in Japan and foreign countries and gives consideration to the subsequent translation work and enforcement, and to summarize the points to be noted for preparing such descriptions.

This study aims at supporting the preparation of desirable descriptions that satisfy the description requirements in Japan, the United States and Europe, by creating examples of desirable descriptions for each technical field and summarizing the points to be noted in preparing such descriptions, from the viewpoint of patent obtainment and enforcement in Japan, the United States and Europe.

II Points to be Noted in Preparing Desirable Descriptions

In this study, examinations were made on points to be noted in preparing desirable descriptions, specifically, the points to be noted concerning the overall statements in a description, those from the viewpoint of patent enforcement and those from the

viewpoint of translation.

1 Summary of the points to be noted concerning the overall statements in a description

In this study, the general matters to be noted by patent applicants were examined based on the Japanese examination standards. The matters to be noted concerning statements in patent claims include (i) the descriptive form of claims, (ii) the support requirement, and (iii) the clarity requirement. Meanwhile, the matters to be noted concerning statements in a description include (i) the enablement requirement, (ii) the Ministerial Ordinance requirement, and (iii) the requirement for disclosure of information on prior art documents. These matters were examined in this study with focus on the points to be specially noted by applicants.

2 Summary of the points to be noted from the viewpoint of patent enforcement

In this study, court judgments relating to infringement lawsuits in Japan were extracted, and the points to be noted from the viewpoint of patent enforcement were examined. The major points to be noted from the viewpoint of patent enforcement are summarized under the following items: (i) whether the claims include any unnecessary elements; (ii) clarity of the terms used in the claims; (iii) functional expressions; (iv) statements of numerical ranges; (v) whether the claims are difficult to prove; (vi) statements of effects in the detailed explanation of the invention; and (vii) whether the working examples are sufficient.

The question of whether or not the description requirements are satisfied relates not only to determination on patent validity, but also determination on establishment of infringement, in other words, recognition of the technical scope of the patented invention. Therefore, rather than preparing a description merely from the viewpoint of

obtaining a patent, it is important to prepare a description that allows the applicant to obtain a patent that will be as effective as possible upon patent enforcement.

3 Summary of the points to be noted from the viewpoint of translation

In this study, the points to be noted from the viewpoint of translation were examined. According to the results of examination, the terms that should be noted from the viewpoint of translation are (i) idiomatic phrases, (ii) terms based on the culture of each country, and (iii) coined terms and compound terms. There are cases where it would be inappropriate to directly machine-translate these terms, so sufficient consideration should be made when using such terms. The points to be noted concerning sentences are (i) clarity of the subject, (ii) use of demonstrative pronouns, (iii) correspondence between the subject and predicate, (iv) sentence length, and (v) use of particles. With regard to patent claims, it became clear that Japanese claims intended for obtainment of a patent in Japan are not necessarily suitable for translation. Therefore, it would be preferable from the viewpoint of translation to prepare Japanese claims for translation in advance by taking into account the claims to be used when filing applications with the United States or Europe. With machine-translating patent claims, it is necessary to also make corrections as appropriate after the machine translation.

III Examples of Desirable Descriptions

In this study, desirable descriptions were examined from the viewpoint of description requirements, patent enforcement and translation for each technical field, and examples of “desirable descriptions” were created. The technical fields examined were the chemical field, mechanical field, physics field and electric/electronic field. The patent claims of each example include more than one type of claim selected from claims with

numerical limitations, Markush claims, claims with functional expressions (including means-plus-function claims) or claims relating to software inventions. The example of a “desirable description” in each technical field relates to the following invention:

1. Chemical field: invention relating to a method for producing ester
2. Mechanical field: invention relating to a goods container for vehicles
3. Physics field: invention relating to a radio receiver, etc.
4. Electric/electronic field: invention relating to a coded data transfer device

In “bad examples, desirable examples and points to be noted” for each of the technical fields above, bad examples were created from the viewpoint of the description requirements or patent enforcement. By comparing examples of desirable descriptions with bad examples, it was clear how the bad examples could be corrected so as to create desirable descriptions. As for the parts compared, the reasons and basis for the example to be considered a bad case were examined, and the points that should be noted in preparing a description from the viewpoint of the description requirements and patent enforcement in Japan, the United States and Europe were summarized. The points to be noted include Japanese and U.S. court judgments and EPO Board of Appeal decisions that serve as reference.

In the “points to be noted from the viewpoint of translation” for each of the technical fields above, examples of desirable descriptions and bad examples were translated into English using the Japanese-English machine-translation function of the Advanced Industrial Property Network (AIPN) of the JPO, and by examining the translation results, the points to be noted were summarized. Regarding patent claims, not only the results of machine translation, but also English claims for reference are indicated. As a result of the examination, it became clear that it is difficult to translate a description,

particularly patent claims, to a level appropriate for a patent application, by only using the AIPN machine translation, and that Japanese claims intended for obtainment of a patent in Japan are not necessarily suitable for translation. However, the examination results of this study could be used as materials that contribute to improving the accuracy of the AIPN machine translation. The AIPN machine translation is hoped to further improve in the future.

IV Questionnaire Survey Results

In this study, a questionnaire survey of domestic users was conducted with the aim of clarifying the points being noted by applicants when preparing descriptions, etc.

As a result of the questionnaire survey, many respondents mentioned that they took note of the following basic matters when filing an application or when responding to a notice of reasons for refusal in order to satisfy the description requirements in Japan: “use general technical terms in claim statements,” “use consistent terms in the claims and the description” and “include many working examples in the description.” Also in the survey on matters that are noted for satisfying the description requirements in Europe and the United States, although some mentioned points specific to the United States, bearing in mind the best mode requirement, most respondents mentioned the same matters as those for satisfying the description requirements in Japan. These results are considered to reflect applicants’ awareness that, in order to satisfy description requirements, it is at least necessary to comply with the basic matters for satisfying the description requirements by referring to court judgments and examination guidelines.

As for the points being noted by applicants for preparing descriptions that are to be translated into a foreign language, in addition to such basic points as “clarifying the relationship between the subject and the predicate,” “making each sentence short” and “clarifying the modification relation between

terms and phrases,” some respondents were found to be giving some specific considerations to translation by “using a translator who can understand the technical background” or “sending the Japanese and English descriptions to the local patent attorney.”

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