

## 6 Use of Standards Development Documents in Patent Examinations (\*)

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*In the process of formulating a technical standard, in addition to already formulated standards, various technical documents are submitted, such as draft standards subject to adoption and standard proposal documents (contributions) submitted by participants in standards development (hereinafter collectively referred to as “standards development documents”). Appropriate use of these documents as prior art documents in patent examinations is considered to contribute to maintaining and improving the quality of patent examinations. However, for many of standards development documents, it is not easy to determine the nature of prior art whether it is publicly known prior art or known to the public through publication. Therefore, the purpose of this research is to obtain suggestions concerning the use of standards development documents in patent examinations, and guidelines concerning the future policy for organizing such documents as examination materials, and more specifically to collect information about the document management policies of standards developing/setting organizations in Japan and abroad and the handling of standards development documents at overseas intellectual property offices and thereby deliberating about the use of standards development documents in patent examinations through discussions at a committee of experts.*

### I Introduction

#### 1 Background and purpose of this research

In the process of formulating a technical standard, various technical documents (in this report, these documents are hereinafter collectively referred to as “standards development documents”), such as draft standards subject to adoption and standard proposal documents (contributions) submitted by participants in standards development, are submitted in addition to already formulated standards. Appropriate use of these documents in patent examinations as prior art documents for patent examinations is considered to contribute to maintaining and improving the quality of patent examinations. It seems to be necessary to organize the following points for the purpose of further promoting the use of standards development documents in the future.

First, it is necessary to organize information that is necessary in determining whether standards development documents can be used in patent examinations. For many standards development documents, it is not easy to determine whether the document is publicly known (specifically, whether it is publicly known (publicly known) and whether it is a distributed publication (publicly known through publication)). Second, it is also necessary to take the perspective of understanding user need for the use of standards development documents as prior art documents and obtaining guidelines

concerning standards development documents which should be given priority when organizing such documents as examination materials.

Therefore, the primary purpose of this research study is to collect information about the document management policies of standards developing/setting organizations in Japan and abroad and the handling of standards development documents at overseas intellectual property offices and thereby obtain suggestions concerning the use of standards development documents in patent examinations through discussions at a committee of intellectuals. In addition, the second purpose thereof is to obtain suggestions concerning the future policy for organizing such documents, such as guidelines concerning standards development documents which should be given priority when organizing such documents as examination materials.

#### 2 Methods used in this research study

##### (1) Survey of public information

We surveyed and organized information concerning standards development documents in Japan and abroad, such as the outline, document management, confidentiality control, and qualification requirements for members, etc. of each standards developing/setting organization, mainly by using Internet information. The standards developing/setting organizations in Japan and abroad that were covered by this survey are the International Organization for Standardization (ISO), the International Electrotechnical Commission (IEC), the International Telecommunication Union (ITU),

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the European Telecommunications Standards Institute (ETSI), the American National Standards Institute (ANSI), the IEEE-SA, the USB-IF, the OMA, the PCI-SIG, the Wi-Fi Alliance, the 3GPP, the DVB, the Japanese Industrial Standards Committee (JISC), the Association of Radio Industries and Businesses (ARIB) and the Telecommunication Technology Committee (TTC).

Determining whether a standard development document can be used in patent examination as a prior art document is nothing other than determining whether said standard development document is publicly known (hereinafter the mere statement of being “publicly known” means both the case pertaining to Article 29, paragraph (1), item (i) of the Patent Act and the case pertaining to item (iii) of said paragraph), specifically, whether the standard development document is positively understood in determining whether the invention described therein falls under the “inventions that were publicly known” (publicly known) as prescribed in Article 29, paragraph (1), item (i) of the Patent Act or the “inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line” (publicly known through publication, etc.) as prescribed in item (iii) of said paragraph. Therefore, we surveyed 50 judicial precedents concerning patent lawsuits that were filed in Japan in relation to the question of whether a prior art document, etc. is publicly known, and analyzed them with the advice of attorneys at law.

## **(2) Domestic interview surveys**

In order to understand the actual conditions of standards development activities by companies, we conducted interview surveys with 10 companies which actively participate in standards development activities and strategically exploit technical standards. In addition, in order to survey the actual conditions of committees, mainly those in Japan, we conducted domestic interview surveys with the Information Processing Society of Japan (IPSJ) and the Japan Business Machine and Information System Industries Association (JBMIA), both of which are bodies that deeply engage in standards development activities, for example, by serving as the domestic secretariat of an internal committee of a standards developing/setting organization. We conducted interview surveys with the JISC, the ARIB and the TTC, which are domestic standards developing/setting

organizations, mainly in relation to information that cannot be obtained through survey of public information for the purpose of understanding the actual conditions of operations of committees for preparing standards and management of documents handled, etc. in standards developing/setting organizations.

## **(3) Overseas interview survey**

In order to survey the actual conditions of the use of standards development documents in patent examinations in countries other than Japan, we conducted interview surveys with the European Patent Office (EPO) and the Korean Intellectual Property Office (KIPO), and also compiled information obtained through literature search with regard to the United States Patent and Trademark Office (USPTO). We also conducted interview surveys with the ISO, the IEC and the ITU, all of which are international standards developing/setting organizations, mainly in relation to information that cannot be obtained through survey of public information for the purpose of understanding the actual conditions of operations of committees for preparing standards and management of documents handled, etc. in standards developing/setting organizations.

## **(4) Consideration by the committee**

We established a committee consisting of persons of learning and experience who have expert knowledge relating to this research and study, persons involved in standards developing/setting organizations, persons in charge of standards development activities at companies, persons in charge of intellectual property at companies, attorneys at law and patent attorneys. At the committee, we held discussions and conducted analysis from a technical standpoint and received advice from participants.

# **II Survey of Domestic Judicial Precedents**

## **1 Method of searching judicial precedents**

It is considered that the question of whether a prior art document, etc. falls under any of the items of Article 29, paragraph (1) of the Patent Act is determined in patent lawsuits filed in relation to the question of whether the prior art document, etc. is publicly known. The provisions of those items are as follows: item (i): inventions that were publicly known in Japan or a foreign

country, prior to the filing of the patent application; item (ii): inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent application; item (iii): inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent application. In light of these provisions, we extracted 50 relevant judicial precedents.

## **2 Analysis of judicial precedents**

We surveyed the extracted 50 judicial precedents and analyzed them with the advice of attorneys at law.

In relation to a determination concerning the distributed publication as prescribed in Article 29, paragraph (1), item (iii) of the Patent Act, there are a few judicial precedents citing the judgment of the Second Petty Bench of the Supreme Court of July 4, 1980; 1978 (Gyo-Tsu) 69, such as the judgment of the First Petty Bench of the Supreme Court of July 17, 1986; 1986 (Gyo-Tsu) 18) which is regarded as the reference. In the relevant judgment, the court determined, based on the following three points, that there is no problem in finding that the relevant document falls under a distributed publication: (1) the distributed publication as prescribed in Article 29(1)(iii) of the Patent Act refers to a document, drawing or other information communication medium equivalent thereto that was reproduced for the purpose of disclosure to the public through distribution and was actually distributed; (2) it is not limited to a document of which a considerable number of reproductions from the original are widely provided to the public; and (3) it may be a document which is issued by copying the original thereof in each case if the original itself has been published and there is an established system whereby the public can freely inspect the document and a copy of the document is issued upon request of the public without delay.

Next, we summarized and organized the following four perspectives based on the trends of the judicial precedents.

### Perspective 1: Regarding the nature of a document or information

In many judicial precedents, the facts concerning the nature (for example, a material distributed in a study group, pamphlet for advertising, catalogue, manual or written proposal), content and purpose of a document

affect a determination concerning whether the invention is described in a distributed publication or a publicly known invention. In judicial precedents, the court determines the nature, content and purpose of a relevant document and takes into account whether the document is scheduled to be widely distributed or published to third parties or whether the document is recognized as having been widely distributed or published to third parties. If the document is recognized as such, the invention described in the document is determined to be an invention described in a distributed publication or a publicly known invention. Otherwise, the document is not determined to be a publication.

### Perspective 2: Regarding confidentiality obligation and maintenance of confidentiality

Mainly, it is relevant if there is an explicit agreement to keep the information confidential such confidential agreement, and if there is no explicit agreement on confidentiality, the court takes into account the existence or absence of an implicit confidentiality obligation based on the nature and content of a document or information. The court finds that a document or information is publicly known if it finds that there is neither explicit agreement on maintenance of confidentiality nor implicit confidentiality obligation in relation to the document or information. There is a case where the court ruled that the confidentiality obligation under the principle of good faith is recognized if it is objectively obvious that a document is a trade secret even if there is no explicit agreement on maintenance of confidentiality therefor, and thereby determined that the document is not a publication. On the other hand, in another judicial precedent, the court determined that a material distributed at a workshop of an international conference is a distributed publication because the host of the workshop distributed it without imposing any confidentiality obligation and those who received it consider that they can freely use it.

### Perspective 3: Regarding the nature of a meeting

The point at issue is the case where third parties cannot necessarily freely attend a meeting. It is pointed out that a workshop of an international conference has a certain degree of publicity because experts, journalists, etc. who belong to a European or U.S. university, research institute or pharmaceutical company can attend even though attendees to the meeting are limited

to invited guests.

#### Perspective 4: Regarding the date on which an invention became publicly known

The date of publication of a catalogue, pamphlet, instruction handbook (manual), etc. is not necessarily clear. In such cases, the court determines the date on which an invention became publicly known by using peripheral information, such as a newspaper announcing that the relevant product is to be put on sale, a magazine, information on a website and advertisement.

### III Intellectual Property Offices

#### 1 EPO

The EPO has established cooperative ties with the IEEE, the ETSI, the ITU and the IEU, respectively, and is thereby actively carrying forward the use of standards development documents in patent examinations. Furthermore, the EPO also uses the documents of the 3GPP, the IETF (Internet Engineering Task Force), etc. which disclose their standards development documents on the web.

In EPO's examination practice, a standard development document is cited as a prior art document if it first becomes available to the public pursuant to Article 54 of the European Patent Convention and forms part of the state of the art.

The state of the art is described in Chapter IV "State of the art" in Part G "Patentability" in the Guidelines for Examination in the European Patent Office. Referring to 7.2.1 and 7.6 in said Chapter, the requirements for using a standard development document in a patent examination are that there is no confidentiality contract concerning the document and that the document has been made available to the public before the date of filing or the date of priority. It is considered that the EPO has agreed on the use of documents that satisfy the aforementioned requirements with standards developing/setting organizations and receives provision thereof based on the agreement. Standards development documents obtained by the EPO are accumulated in a database within the EPO, which is not open to the public, and can be used by examiners.

The EPO considers it important to cooperate with standards developing/setting organizations in the future because the ICT field will be expanded through accumulation with conventional art.

#### 2 KIPO

The standards developing/setting organizations whose standards development documents the KIPO uses in patent examinations are the 3GPP and the IETF, which disclose information to the public, as well as the IEEE, etc. which provide paid data provision services together with provision of papers. The KIPO also uses the public information of the ITU, the ETSI, etc. which anyone can access.

In the KIPO's examination practice, a standard development document is cited as a prior art document if it falls under any of the subparagraphs of Article 29, paragraph (1) of the South Korean Patent Act. The provisions on novelty in the South Korean Patent Act are very similar to those in the Japanese Patent Act (items of Article 29, paragraph (1)). In addition, the Patent Examination Guidelines contain the section "3.3 Invention prescribed in a distributed publication" in 3. Relevant provisions in Chapter 2, as well as the section "3.4 Inventions distributed to the public through telecommunication line." Therefore, the guidelines are also similar to the Japanese Examination Guidelines in many points.

#### 3 USPTO

We picked up points of focus from literature information.<sup>1</sup>

Examiners at the USPTO also have a need for the use of standards development documents. The examiners receive provision of information from the STIC, which is a library facility run by the USPTO by accessing the NPL website or by obtaining hard copies. They use at a minimum the IEEE standards. In addition, information about standards, such as those of the 3GPP, is incorporated in the "public pair" that is a USPTO database.

At the USPTO, it is considered that information collected based on a memorandum of understanding concluded with a standards developing/setting organization is not necessarily applicable to Section 102 of the new law as "prior art."

### IV Major Standards Developing/Setting Organizations

International organizations with which we conducted an interview are described below.

- ISO  
[Standards] : ISO standards are available for

sale. In Japan, the standards can be purchased through the JSA (Japanese Standards Association). Draft International Standards (DIS) and Final Draft International Standards (FDIS), which are draft standards, are also available for sale.

[Distribution, management, publication, etc. of documents]: Documents handled by the ISO are mainly standards (Draft International Standards (DIS), Final Draft International Standards (FDIS) and International Standards (IS)) and other documentations (Working Drafts (WDs), Committee Drafts (CDs), Technical Reports (TRs), Technical Specifications (TSs) and Publicly Available Specifications (PAS)), and they are called N-documents. Basically, the secretaries upload them on the ISO system named "e-Committee." The date on which a document is posted is attached, but it is not attached to the document. WDs are information available only to the members of a relevant working group (WG), and are managed by IDs and passwords. When a document is posted, the relevant secretary informs the national secretariat to that effect by email, and the national secretariat notifies the members of the national committee thereof. The members who have their own IDs and passwords access the eCommittees to obtain the document. The downloaded document is also distributed to the members of the committee who do not have ID and password, and the information is also shared by the persons concerned at companies to which the members belong, for the purpose of consideration. It is also possible to obtain information about the stage where a standard under development or a withdrawn standard is at present with respect to each Technical Committee (TC) from the "Standards catalogue" on the ISO's website that is open to the public.

[Regarding the confidentiality obligation]: There are no established strict provisions on the confidentiality obligation, and there are also no special provisions on the confidentiality obligation in relation to the committee activities of domestic organizations. The confidentiality obligation is within the bounds of common sense.

- IEC

[Standards]: The IEC standards can be purchased from the JSA, but they cannot be obtained for free. Standards development documents other than actual standards are also not in the state of being available from the website for free. The IEC Members can access the Management Server and the Technical Server, and can inspect the documents stored thereon.

[Distribution, management, publication, etc. of documents]: There are the cases where electronic data attached to an email is submitted to the Central Office and the cases where a proponent uploads data to the prescribed place in the server. Distribution is conducted by way of downloading from the server. Both processes are managed by IDs and passwords.

Availability of a document depends on the current stage of the document in the development process. At the initial stage, only members of a working group (WG) that handles the document can obtain the document. On the other hand, at a later stage in the process, the document is widely distributed by the National Committee (NC).

At the IEC, a document is deemed to be published at the time when it is uploaded to the IEC's server and becomes available for inspection by the members of the relevant working group. However, this does not mean publication to the general public. A member of a working group accesses a working document by using his/her login ID and password.

[Regarding the confidentiality obligation]: There are no provisions on the confidentiality obligation. The IEC's documents are considered to be open to the public because there is no confidentiality obligation.

[Regarding cooperation with patent offices]: The IEC provides the EPO with all the documents, including working documents, by giving it the right to access the IEC's server because the IEC considers a working document to become open to the public when the document is submitted to a relevant working group of the IEC.

The IEC cooperates with patent offices for the purpose of ensuring that its documents are helpful for patent examinations as prior art.

- ITU

[Standards] The ITU-T Recommendations and the ITU-R Recommendations are available to the general public for free via the ITU's website. Other standards development documents are not in the state of being available for access via the website for free.

[Distribution, management, publication, etc. of documents]: Documents are mainly submitted by direct upload to the server of the ITU-T, and it is possible to obtain the documents by direct download through access to the server. The ITU Members can access documents used at meetings from the account of the TIES (Telecommunication

Information Exchange Service). The ITU Member States can obtain all documents from three sectors (ITU-T, ITU-R and ITU-D). Sector Members can obtain only documents in a relevant sector, respectively. The ITU Member States and the ITU-T Members can access the documents of the relevant Study Group (SG) and all the other documents.

[Regarding the confidentiality obligation]: The ITU Member States and the ITU-T Members are not required to sign any confidentiality or non-disclosure contract in order to participate in discussions at a SG or receive any ITU-T-related document.

[Regarding cooperation with patent offices]: Partnership between intellectual property offices and standards developing/setting organizations is beneficial to both parties. Intellectual property offices are able to improve the quality of their patent examinations by accessing an accumulation of volumes of related technical documents while standards developing/setting organizations are able to gain better understanding of patent activities in various technical fields subject to their authorities. The EPO is an ITU-T Sector Member, and it itself has access to all documents that are available for ITU-T Sector Members. The ITU is providing the EPO with an additional service to enable the EPO to download specific ITU-T documents from a mirror website.

## **V Results of Interviews with Domestic Companies**

We organized the answers of the respondents to the interviews with companies from the following four perspectives.

- Information about document management, confidentiality obligation, etc. of participating standards developing/setting organizations  
A common answer was that there had been neither explicit provisions on the confidentiality obligation nor provisions on document management in relation to de jure standards developing/setting organizations. In most cases, a person who is eligible for membership of a committee is a member of the organization or deliberative body, which is almost always a corporate member. A person of learning and experience (university teachers, etc.) often becomes a member of a committee as needed. Members of a committee and intellectuals who suit the needs of the committee participate in the

meetings of the committee at the proposal stage, and persons outside rarely freely participate therein.

- Regarding rules for the filing of patent applications in standards development activities, all the interviewed companies answered that it was fundamental to complete the filing of a patent application for an invention for which a patent application should be filed before submission of a contribution, etc.
- There have been almost no cases in which a right for technology disclosed in standards development activities was unintentionally obtained by another person.
- There was no opinion that clearly denies use of standards development documents in patent examinations among all the 10 interviewed companies. Most of those companies answered that they in principle agreed to use standards development documents in patent examinations as prior art documents. As for the fields in which the use of such documents in patent examinations is expected, the companies pointed out the fields in which patents are actively exploited, the ICT field, the field of wireless communication technology, etc. Standards development documents that are highly technically valued as the seeds of patents are the first proposal documents.

## **VI Consideration of Use of Standards Development Documents in Patent Examinations**

In this Chapter, we consider the requirements for using standards development documents in patent examinations in light of the content of Chapters II to V and discussions held at this research study committee.

### **1 Legal grounds to be taken into consideration, etc.**

- Patent Act  
As indicated in Chapter II, whether a standard development document can be used in a patent examination as a cited document in order to deny novelty or an inventive step is probably determined in relation to Article 29, paragraph (1), item (i) or (iii) of the Patent Act. That is, a determination will be made on the question of whether the invention pertaining to the document falls under the “inventions that were

publicly known in Japan or a foreign country, prior to the filing of the patent application” (publicly known) as prescribed in Article 29, paragraph (1), item (i) of the Patent Act or the “inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent application” (publicly known through publication, etc.) as prescribed in item (iii) of said paragraph. However, in consideration of the JPO's actual examination practice, there is a limitation to the ex officio search and finding of facts by examiners, and it is difficult to determine “whether the invention was publicly known” in relation to item (i) of said paragraph at the examination stage. Therefore, in organizing standards development documents as examination materials, it is realistic to determine whether standards development documents fall under “distributed publications” and present to examiners the documents that fall under item (iii) of said paragraph as examination materials. Consequently, discussions are held on the use of standards development documents in patent examinations with a central focus on the question of whether item (iii) of said paragraph is applicable (that is, whether a standard development document can be considered to fall under a “distributed publication” or to have been “made publicly available through an electric telecommunication line” (publicly known through publication, etc.))

- Examination Guidelines for Patent and Utility Model in Japan

We consider the issue of determining whether a “standard development document” falls under a “distributed publication” or has been “made publicly available through an electric telecommunication line” as prescribed in Article 29, paragraph (1), item (iii) of the Patent Act while referring to parts in the Examination Guidelines for Patent and Utility Model in Japan that are considered to be related to the issue.

#### “Distributed publication”

In consideration of the Examination Guidelines, Part II, Chapter 2, 1.2.4, in order for a document to fall under a distributed publication, it is important that a reproduction of the document becomes available for inspection by unspecified persons, and the fact of actual inspection is not required. This point is mentioned in the two judicial precedents of the

Supreme Court shown in Chapter II. In relation to standards development documents, whether a standard development document has become available for inspection by unspecified persons through distribution at a committee may be determined.

#### “Publicly available through an electric telecommunication line”

In consideration of the Examination Guidelines, Part II, Chapter 5, 1, in relation to standards development documents, whether information uploaded on the server of a standards developing/setting organization is available for access by unspecified persons via the Internet may be determined.

## **2 Items to be considered in determining whether it is appropriate to use a standard development document in a patent examination**

The following five items, A to E, should be taken into consideration in determining whether a standard development document can be used in patent examinations based on the judicial precedents shown in Chapter II and the matters considered in the previous section.

A: Nature, content, purpose of the document / B: Confidentiality obligation / C: Distribution of the document and authority to access database / D: Requirements for participating in a committee, etc. / E: Date of publication

## **3 Consideration of an example case**

The JPO receives the provision of DIS and documents thereafter (including FDIS and IS) from the ISO. These documents are considered below. The status of the documents is shown below with respect to each of the five items to be considered, and the way of making a determination is considered.

#### A: Nature and content of the documents

[Status]: The sale of the documents in countries is permitted by the ISO.

[Determination]: Based on the fact of permission for the sale of the documents, it is possible to determine that the documents are supposed to be published. As there is no condition set on the sale of the documents, they can be obtained by unspecified persons. Therefore, the documents are considered to be in the state of being available for inspection by unspecified persons.

### B: Confidentiality obligation

[Status]: As the sale of the documents is permitted without any limitation, there is neither explicit nor implicit confidentiality obligation.

[Determination]: As the documents are sold for a price, it is presumed that their unnecessary distribution is not permitted. However, this point is a copyright-related issue and is not related to the confidentiality obligation. It is possible to determine that there is neither explicit nor implicit confidentiality obligation.

### C: Distribution of the documents and authority to access database

[Status]: The present status of development of standards by each TC is open to the public via the "Standards catalogue" on the ISO's website. Therefore, it is possible for unspecified persons to know the status of DIS and documents thereafter. In addition, as a result of confirming dozens of DIS at the voting stage, all of them were confirmed to be available for purchase. Not only DIS but also some FDIS were confirmed to be actually sold and be available for purchase. In addition, it is obvious that IS are for sale.

Moreover, even if there are some DIS and FDIS that are not for sale, they are also uploaded to eCommittees through the Central Office and are referred to each country. Information about such documents is notified to responsible domestic deliberative bodies in each country. The domestic deliberative bodies can download the documents that require an ID and password from eCommittees, and the documents are delivered to the members necessary for deliberation. The members share information with necessary persons concerned at the companies or bodies to which they belong.

[Determination]: It is clear that documents on sale are in the state of being available for inspection by unspecified persons. If there is a document for which sale has been permitted but has yet to be sold, such document is also disclosed to many experts in each country who are outside a specific committee. Many persons, though they are experts in a specific field, participate in a standards developing/setting organization. Under such circumstances, it is conceivable to make it sufficient to consider "unspecified persons" who are taken into consideration in making a determination concerning Article 29, paragraph (1), item (iii) of the Patent Act not to be "unspecified general persons" but to be "unspecified persons" in the relevant field. The grounds for this idea are as

follows.

- (1) In the case of a document of an international standards developing/setting organization, the purpose of its disclosure is to disseminate the document.
- (2) Committee members are persons who belong to companies, and individuals cannot become such members. Therefore, it can be said that the document is distributed not to "unspecified general persons" but to "unspecified persons who belong to companies."

Moreover, even "unspecified general persons" can confirm the state of a document having come into the state of being subject to voting as a DIS; therefore, such a document that has yet to be sold may be put on sale as a result of such person's wish for the sale of the document. Consequently, it may be possible to say that such documents are also in the state of being available for "unspecified general persons."

### D: Requirements for participating in a committee, etc.

[Status]: If a committee requires, intellectuals (university professors, etc.) in the relevant field, other than the committee members and the members of other bodies, also attend a meeting of the committee. Basically, the regular members (companies) of a domestic deliberative body are entitled to be members of a national committee. There are no special conditions for becoming a regular member of a domestic deliberative body of the ISO, and any company can sometimes become a member if it has the ability to pay membership fees. Moreover, there are bodies that make it a condition for becoming a regular member to run a business and those that impose loose conditions, such as having a certain degree of ability to formulate standards. Regarding the domestic deliberative bodies of SCs that deal with DIS and FDIS obtained by the JPO, there are no special requirements for becoming a member thereof other than the requirements of "being a company" and "having the ability to pay membership fees."

[Determination]: DIS and documents thereafter are documents that are referred to by those outside the committee (referred to all ISO Members). Therefore, the requirements for participating in a committee and those for becoming a member of a committee can be considered to be outside this question.



#### E: Date of publication

Two kinds of dates are regarded as the date of publication. One is the date on which the sale of a document actually started, while another is the date on which the document was uploaded to eCommittees.

[Determination]: If it is possible to deem “many experts in each country” to be “unspecified persons” in terms of a determination concerning Item C, it is possible to consider the date on which a document is uploaded to eCommittees as the date of publication. This is because a deliberative body in each country becomes able to download the document with an ID and password and to distribute it to persons concerned in the deliberation at the time when the document is uploaded to eCommittees. Even in the case where a DIS or document thereafter is determined to be a distributed publication based on the fact that its sale is permitted, it is possible to consider the date on which the document was uploaded to eCommittees as the date of publication.

#### [Comprehensive determination]

As mentioned in Items A and B, DIS and documents thereafter are issued on the premise of their sale to the general public by the ISO itself or permission of their sale to the general public in each country. Therefore, it is obvious that the documents are those that were reproduced for the purpose of publication to the public through distribution, that is, a “publication.” Documents that have been “on sale,” including those that have yet to be sold, are considered to be put into the “state of being available for inspection by unspecified persons.” Therefore, they are recognized as having been “distributed.” Consequently, it is obvious that such documents satisfy the requirement prescribed in Article 29, paragraph (1), item (iii) of the Patent Act.

Regarding DIS and documents thereafter, we confirmed the fact that all of the dozens of samples of such documents are sold. Here, we try to consider documents for which sale has been permitted but which have yet to be handled as being “for sale.” Such documents fall under “publications,” but it is difficult to determine whether they are “distributed” publications. However, taking into account the fact that anyone can confirm the status of such a document having come to be subject to voting, the document can be considered to be put into the “state of being

available for inspection by unspecified persons” because there is the possibility that the document will be sold as a result of an “unspecified person's” wish for the sale of the document after confirming the existence of the DIS. Consequently, DIS and documents thereafter are also considered to satisfy the requirement set forth in said item as of the time of their establishment (as of the time of being referred to all the ISO Members) even if they are not handled as being “for sale.”

In this manner, the fact of permission for sale alone is also considered to serve as a ground for falling under said item, but even if not so, it is also possible to consider that a document “was made publicly available through an electric telecommunication line” at the stage where it was uploaded to eCommittees because it becomes accessible to “unspecified persons” at that stage (here, it is the prerequisite that “many experts in each country” who can access eCommittees are recognized as “unspecified persons”).

On these grounds, it is considered that DIS and documents thereafter of the ISO can be determined to be documents that can be available in relation to Article 29(1)(iii) of the Patent Act.

#### **4 Application to actual standards developing/setting organizations**

In consideration of the actual conditions of standards developing/setting organizations, the standards development documents of the ITU are considered to be relatively highly likely to be worthy of being used in patent examinations. The ITU Members (incidentally, the EPO is a member of the ITU) can access various standards development documents from a variety of committees. The ITU is an international organization, and its activities seem to be intended for dissemination of documents. Therefore, the ITU imposes no special confidentiality obligation. Consequently, the ITU documents seem to have a high level of openness, although they are disclosed only to the ITU Members. In addition, the members are at the corporation level, and individuals cannot become a member. However, as there are no special limitations on companies that can become a member, it is considered that “unspecified persons who belong to a company” are considered to be the members. Just like the result of discussions in relation to a determination concerning Item C in Section 3, the documents are considered to be highly likely

to fall under Article 29, paragraph (1), item (iii) of the Patent Act.

## **5 Technical fields and standards developing/setting organizations for which use of standards development documents in patent examinations is desired and standards development documents of which use in patent examinations is desired**

Those interviewed in this research study answered that it is the ICT-related field that continues to be an important field for which it is desired to use standards development documents in patent examinations. They also answered that the EPO is paying attention to the ICT field because there will be increasing numbers of cases in which ICT develops through connection with other fields. They cited international organizations as standards developing/setting organizations for which use of standards development documents in patent examinations is desired because their standards development documents are considered to have a high level of openness. In addition, many of them answered that standards development documents that are highly technically valued are the first proposal documents, and therefore, such documents are considered to be the most useful for patent examinations.

## **6 Summary**

The key point in considering the use of a standard development document in patent examinations is to recognize that the standard development document is put into the state of being available for inspection by unspecified persons or that unspecified persons can access the standard development document uploaded on a server. Various opinions were expressed on this point at the committee. A determination that is considered to be the most reasonable at present was described in the consideration of the example case.

## **VII Conclusion**

Appropriate use of standards development documents that are submitted in the process of formulating technical standards in patent examinations as prior art documents is considered to contribute to maintaining and improving the quality of patent examinations. Therefore, in this research study, we collected information, etc. about the document

management policies of standards developing/setting organizations in Japan and abroad and the handling of standards development documents at overseas intellectual property offices, and considered the use of standards development documents in patent examinations through discussions at a committee of intellectuals.

### **● Domestic judicial precedents**

We surveyed and analyzed with the advice of attorneys at law 50 judicial precedents concerning lawsuits filed in Japan in relation to whether a prior art document is publicly known (Article 29, paragraph (1), items (i) and (iii) of the Patent Act; in particular, item (iii)).

In making a determination concerning the distributed publication as prescribed in Article 29, paragraph (1), item (iii) of the Patent Act, the Supreme Court judgment of Reference No. N3 has been cited in multiple judicial precedents, including the Supreme Court judgment of Reference No. N6, and it is considered to be a standard. According to the Supreme Court judgment of Reference No. N3, in order for a document to fall under a distributed publication, it is important that a reproduction of the document becomes available for inspection by unspecified persons, and the fact of actual inspection is not required.

Seeing the tendency of the 50 judicial precedents, the points taken into consideration in making such a determination are organized into the four perspectives, that is, “regarding the nature of the document,” “regarding the confidentiality obligation and maintenance of confidentiality,” “regarding the nature of the meeting” and “regarding the date on which the document became publicly known.”

### **● Intellectual property office of each country**

Considering the EPO's examination practice based on the European Patent Convention and the Guidelines for Examination in the European Patent Office, the requirements for using a standard development document in patent examinations are that there is no confidentiality contract and that the document has been made available to the public before the date of filing or the date of priority concerning the document. The EPO is considered to be receiving provision of documents by making an arrangement with each standards developing/setting organization to ensure that it can use documents that satisfy the aforementioned requirements. Although the

method taken by the EPO is not necessarily applicable to Japan without change, it can serve as a useful reference.

- **Actual conditions of standards developing/setting organizations**

It is the mainstream handling that only the members of a relevant committee are permitted to access a standard development document that is discussed at a meeting of the committee at the stage of preparing the draft standard and that such standard development document is distributed only to such members. Access to the server of a standards developing/setting organization is managed by IDs and passwords assigned to the members of a committee of the standards developing/setting organization.

Regarding the confidentiality obligation, there are clear provisions thereon at forum-based organizations. For some of such organizations, compliance with the confidentiality obligation is included in a contract that is concluded when one becomes a member of the organization. It is the actual situation at de jure organizations that compliance with the confidentiality obligation is left to the common-sense determination of each member of a committee.

- **Actual conditions and opinions of domestic companies**

It is fundamental that each company completes the filing of a patent application for an invention for which a patent application should be filed before the submission of a contribution, etc. Within the scope of the interviews this time, it seems that the cases in which the right for technology disclosed in standards development activities was unintentionally obtained by another person have not become obvious as a major issue. On the other hand, there was no opinion that clearly denies the use of standards development documents in patent examinations. The ICT-related field was cited as a field in which the use of standards development documents in patent examinations is expected, although the industries of the interviewed companies were also cited as such. Moreover, there was also an opinion that it is desirable to use, in particular, the proposal documents of international organizations.

- **Consideration of the use of standards development documents in patent examinations**

It is ideal that not only standards development documents but also publicly known

documents whose content is useful for examinations are organized as examination materials to ensure the environment in which examiners can use them in patent examinations. Although information collected through the interviews, etc. this time is within the limited scope, there was no clear objection to the use of standards development documents in patent examinations, and it was confirmed that such use is also basically supported by users.

Here, in actually carrying forward the organization of standards development documents as examination materials, it is necessary to determine whether a standard development document falls under the “distributed publication” or has been “made publicly available through an electric telecommunication line” as prescribed in Article 29, paragraph (1), item (iii) of the Patent Act in order to confirm that the standard development document is publicly known. The key point of determining whether a standard development document falls under the “distributed publication” is whether the standard development document became available for inspection by unspecified persons through distribution at a committee. In addition, the key point of determining whether a standard development document has been “made publicly available through an electric telecommunication line” is whether information uploaded to the server of a standards developing/setting organization as the standard development document can be considered to be accessible to unspecified persons via the Internet. The following are cited as the items that should be taken into consideration in making these determinations: “A: Nature, content and purpose of the document,” “B: Confidentiality obligation,” “C: Distribution of the document and the authority to access database,” “D: Requirements for participating in a committee, etc.” and “E: Date of publication.”

As a specific example, this research study committee considered the question of whether DIS and documents thereafter that are provided to the JPO by the ISO, which are standards development documents already obtained by the JPO, are publicly known. The result of this consideration led to the conclusion that ISO's DIS and documents thereafter can be considered to be distributed publications and that they can be used as prior art documents when giving a notice of reasons for refusal under Article 29, paragraph (1), item (iii) of the Patent Act in patent

examination. Moreover, considering the question of whether other standards development documents are publicly known in light of the discussions held and the opinions expressed at this research study committee, for example, ITU's standards development documents are considered to be highly likely to satisfy the requirement that an invention becomes publicly known through publication, etc., as prescribed in said item.

We hope that discussions are continuously held on the use of standards development documents in patent examinations by using this research study as one step and such use is thereby promoted.

(Senior Researcher: Schuich TAMURA)

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<sup>1</sup> Cooperation between Patent Offices and Standards Developing Organizations, National Academies of Science, National Academies Project on Intellectual Property Management in Standard-Setting Processes: An International Comparison PGA-STEP-10-05 prepared by George T. Willingmyre, P.E., September 23, 2012.  
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