Status Report on Sufficiency Disclosure/ Description Requirements

February 23, 2016
Meeting of Trilateral Heads of Office with
Trilateral Industry

JAPAN PATENT OFFICE

1. Background

2. Present Situation

3. Next Steps

1. Background

- IP5 Heads Meeting (2012): Agreed to set up the PHEP

- IP5 Heads Meeting (2014): Agreed to start specific works on the following three priorities for patent harmonization
  - Unity of Invention
  - Citation of Prior Art
  - **Sufficiency of disclosure/written description**

- ☐ Oct. 2014: Industry IP5 Consensus Proposals to the PHEP

- 3rd PHEP Meeting (2014): No agreement made on the Roadmap proposed by the JPO

- ☐ Feb. 2015: **10 Cases from Industry IP5 submitted**

1. Background

- IP5 Deputy Heads Meeting (Mar. 2015)
  - Preparation of hypothetical cases and methodology
  - To decide whether or not to conduct case studies at the next PHEP Meeting

- IP5 Deputy Heads Meeting (May 2015)
  - Proposal of conducting **hypothetical cases** corresponding to the **Cases 6, 8 and 9**

- 4th PHEP Meeting (Oct. 2015)
  1. Hypothetical cases
     - Agreed
  2. Next steps
     - To agree the **proposed format for case studies**
     - To **collect each office's case studies in February**

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- **Agreed format** for case studies

Please fill in the examination results at your office on the following issues to be considered:

1. Does the invention written in the claim meet the support requirements?
   - ☐ Yes
   - ☐ No
   - ☐ Can be true for both Yes and No
2. In Question 1 stated above, if you chose “Yes” (the claimed invention meets the support requirements) or “Can be true for both Yes and No,” please fill in the following details:
   (1) Reasons why the invention is judged to meet the support requirements
   (2) Descriptions of specifications or claims as well as required common general technical knowledge, which serve as a basis for determining that the invention meets the support requirements
3. In Question 1 stated above, if you chose “No” (the claimed invention does not meet the support requirements) or “Can be true for both Yes and No,” please fill in the following details:
   (1) Reasons why the invention is not judged to meet the support requirements
   (2) Desirable descriptions of specifications or claims as well as required common general technical knowledge in the initial application, which serve as a basis for not determining that the invention indicates a violation of requirements

The JPO is collecting case studies from each office.

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- **Current Case Studies on Three Hypothetical Cases**

  ・Hypothetical cases and the results of cases studies conducted by the IP5 Offices

  In addition, preferably,

  ・**Opinion from the IP5 users on the hypothetical cases**

  → ***Progress report at IP5 Heads Meeting in June 2016***

- **Further Case Studies**

  ・Choose **other technical fields and requirements, which are different** from the current hypothetical cases (Technical field: chemistry/ Requirements: support requirements) after IP5 Heads Meeting in June

Thank you very much.

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JAPAN PATENT OFFICE