
INTRODUCTION OF ARTICLES

Examination Guidelines Regarding the Requirement for Disclosure of Information on Prior Art Documents

The Fourth Subcommittee,
The First Patent Committee

The system, which requires the disclosure of information on prior art by applicants, has been introduced for the purport of contributing, not only to the promotion of examination, but also to the stability of patent rights by more adequate examination capably that is clearly evaluate the relationship between any invention for which a patent is sought and prior art.

The points of the system to be noted have been summarized through the discussion between the Examination Standards Office of the Japan Patent Office and our committee in the Japan Intellectual Property Association (Public comment). Following are the issues that we need to pay attention as applicant;

- (1) Is it necessary to indicate information on prior art documents on the claim-by-claim basis?
It is unnecessary for any dependent claim that specifies well-known art if it is properly disclosed within an underlying claim. However, in the case of a dependent claim including an external addition, which adds any novel art, the indication is necessary.
- (2) Is it necessary to indicate any application prior to its publication filed by the same applicant as an “invention which a person desiring a patent knows”?
It is desirable, however, failure to do so will not stand for the reason of a notice provided in Section 48-septies of the Patent Law.
- (3) Is it necessary to add information on prior art documents when claims are amended?
It is necessary to add new information when the amendment breaks the correspondence of the information on prior art documents disclosed within the specification.
- (4) We uneasy that the decisions on the disclosure requirement over those cases “where it seems highly likely that the applicant knew” vary from every application. By way of countermeasure, three examiners check to attempt the leveling of the decisions.

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Practical Issues on Jointly Owning and Owned U.S. Patents

The First International Affairs Committee

As the globalization of business activities grows and technological competition heats up, there