



# PHEP: Description Requirement

## **International Policy and Strategy Project**

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## Current progress in IP5 offices

1. JPO prepared the three hypothetical cases regarding the issue mentioned below.

(Office-specific) Amount of scientific data required in a patent specification to support patent claims

(Uniform format for judgment by IP5 offices was prepared.)

2. Sufficiency of description requirement of the hypothetical cases were judged by the IP5 offices.

- The results from each office were collected by JPO.

→ Now JPO is reviewing them





## User feedbacks

- ❑ For PHEP studies, it is useful to collect users' observations on hypothetical cases provided by JPO.
- ✓ JIPA had asked following organizations (IP5 industry) review three hypothetical cases and obtained feedbacks as below.

	A	B	C	D		E	F		
Case 1	yes/no	yes	yes	yes/no	yes	yes	no	no	no
Case 2	no	no	yes/no	yes/no	no	no	no	no	no
Case3	yes/no	no	yes	no	yes	yes	yes	no	no

- We will further discuss these results among IP5 industry.



## Discussion of Hypothetical cases by the users (Case 1)

### ■ Outline of the invention

#### [Claims]

1. A composition, which comprises, as a principal ingredient, A and one or more selected from the group consisting of B, C, and D and is a powder having an average L/D of 3.0 or lower, a bulk density of 0.80 g/mL or lower, and a repose angle of 60 degree or smaller.

- ✓ Claim which is expressed by a plurality of configurations and parameters
- ✓ **Only an upper limits of the parameters are claimed**
- ✓ **A lower limit of the parameters are written in the specification**
- ✓ Three working examples





## ■ Discussion toward the unified opinion by the users : Case 1

- Sufficiency of description requirement regarding claims which is expressed only by the upper limit of the parameters
  - Regarding Case1, many users express the opinion that description requirement is sufficient
  - Some opinion which cannot admit description requirement are based on insufficiency of the working examples

Input from  
Users

In Case 1, unnecessary of limiting the lower limit of the parameters can be understood by the specification and common general technical knowledge.

Effect obtained within the scope of the claimed parameters are explained and confirmed in the working examples which includes parameters near the upper limit.

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Under Discussion

⇒ Description requirement are satisfied?

Description requirement are satisfied regarding claims which is expressed only by the upper limit or the lower limit, when the effects are logically explained in the specification within the scope of the claim?





## Discussion of Hypothetical cases by the users (Case 2)

### ■ Outline of invention

#### [Claims]

1. A composition comprising ingredient (A) and ingredient (B), wherein the ingredient (A) has a ratio (R) defined by the following formula (I) in a range of 40 to 65%,

Formula (I)  $R = (ds - do) / do \times 100 (\%)$

where “ds” is a diameter of a workpiece flowing out from a extrusion tool, and “do” is a diameter of a extrusion tool.

- ✓ A claim expressed by a plurality of components and parameters.
- ✓ The parameter is defined by a certain range.
- ✓ According to the range of the parameter, embodiments show only one parameter near center of the range.





## ■ Discussion toward the unified opinion by the users : Case 2

- A claim related to parameters which have few embodiments.
- Most of users' opinions are "it does not meet the description requirements."

Input from  
Users

But, in real case, the offices other than JPO recognized the sufficiency of description requirements

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Under Discussion

⇒ May users' opinion not meet the description requirements?

How about the answer, "if the efficacy in the range of parameters written in claims is described logically in embodiments, the claims may meet the description requirements."?





## Discussion of Hypothetical cases by the users (Case 3)

### ■ Outline of the invention

#### [Claims]

1. A cosmetic comprising the ingredients (A), (B), (C), and an oily gelling agent.
2. The cosmetic according to claim 1, wherein the oily gelling agent is produced from ingredients (E), (F), (G).

- ✓ The claim is expressed in multiple ingredients
- ✓ One of the ingredient is expressed in comprehensive words, “oily gelling agent”
- ✓ The “oily gelling agent” is explained in the specification.





## ■ Discussion toward the unified opinion by the users : Case 3

- Whether or not the claim including the comprehensive words can fulfil the description requirement
  - Many users express the opinion that the case should meet the requirement
  - Most of the opinions which cannot admit description requirement are based on the reason that any limitations regarding "oily gelling agent" was not stated in the claim.

Input from  
Users

The condition of "oily gelling agent" where the invention takes the effect is described in the specification.

Additionally, "oily gelling agent" is general terminology.

Namely, the condition of "oily gelling agent" is obvious for a person skilled in the art.

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### Under Discussion

⇒ The case 3 may be allowed to meet the description requirement?

If the words in the claim is not specific terminology and the performance of the word is understandable by referring the specification as a whole, it meets the description requirement, even if there is not limitation to the word in the claim?





## Summary

- ❑ To improve a predictability of examination results, harmonization is desirable by users.
- ❑ JIPA will continue to work for consistent practices among IP5 offices.
- ❑ IP5 industry will continue to discuss to derive a possible unified description judgment for reference to offices.

# Thank you for your attention.

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