

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

- 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**

- 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.

