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# **IP5 PHEP activities: Written Description/ Sufficiency of Disclosure**

January 19, 2017

ICG Meeting

Japan Patent Office

# **1. Background**

## **2. Current Case Studies**

## **3. Further Case Studies**

- **PHEP Meeting (Oct. 2015)**

Agreed to conduct case studies(hereafter “**current case studies**”) on **hypothetical cases** dealing with **chemistry, support requirements** corresponding to the actual cases.

- **IP5 Heads Meeting (Jun. 2016)**

Agreed to the next steps

- to **collect opinions from the IP5 Users** on the **current** hypothetical cases
- to make an **analysis** on the **current** case studies conducted by the offices and the opinion from the IP5 Users
- to conduct **further case studies** dealing with **other technical fields and requirements**

- Contents of the **Current** Case Studies

1. Preparation of Three Hypothetical Cases

2. Outline of IP5 Offices' Case Studies

3. Analysis on IP5 Offices' Case Studies

4. Opinions from IP5 Users

5. Analysis on IP5 Offices' Case Studies  
and the opinions from IP5 Users

***Done!***

***Discussed at  
PHEP Meeting  
(Oct. 2016)***

- **Further** Case Studies

1. Background

**2. Current Case Studies**

3. Further Case Studies

### Introduction of **IP5 Users' Opinions** for Current Case Studies at PHEP Meeting (Oct. 2016)

Case	Sufficiency	Remarks
1	Yes	Claim defined by only either the upper limit or the lower limit of parameter meets the requirement, <b>if a person having ordinary skill in the art can understand that it is not necessary to define the other in the specification.</b>
2	Conditional	We are not able to reach any unified opinion. Many of us commented that <b>with only reference to the description in this hypothetical case, they cannot make any defined judgment</b> (yes/no). Some suggest that we should look to more cases rather than going in to detail.
3	Yes	The claim comprises a comprehensive term (i.e. “oily gelling agent”), and the term isn’t specified in the claim. <b>If the term described in the claim(s) is a general term and the performance to fulfil an element indicated by the term is understood from the description of the specification, the written description is satisfied even though such the term is not specified in the claim(s).</b>

### Results of Current Case Studies

	<b>EPO</b>	<b>KIPO</b>	<b>JPO</b>	<b>USPTO</b>	<b>SIPO</b>	<b>IP5 Users</b>
CASE 1	Yes	Yes	Yes	Yes	Yes	Yes
CASE 2	No	Yes	Yes/No	Yes	Yes/No	Conditional
CASE 3	Yes	Yes	Yes	Yes	Yes	Yes

### **Agreed to Next Steps** for Current Case Studies at PHEP Meeting (Oct. 2016)

- By the end of December 2016:
  - IP5 Offices to **share comments** on the user's opinion
- By the end of February 2017:
  - JPO to **prepare and distribute draft analysis** on the current case studies and user opinion



**1. Background**

**2. Current Case Studies**

**3. Further Case Studies**

### 3. Further Case Studies

## Introduction of Candidate Actual Cases for Further Case Studies at PHEP Meeting (Oct. 2016) → *Agreed!*

Case No.	Technical Field	Summary of Invention	Reason pointed out by Office(s) due to lack of <b>Clarity requirement</b>
3	<b>Electric</b>	Device comprising means for switching types of keyboard images displayed on the screen with a touch operation in a specified area of the touch screen	The invention should not be defined by the 'means' which is expressed by the result to be achieved except when it is absolutely necessary.
11	<b>Electric</b>	Secondary cell charge/discharge electricity amount estimation method	The specific term recited in the claim was unclear.
12	<b>Machine</b>	Type device comprising a plurality of type units for printing date	The relationship between the component A and B recited in the claim was unclear.

### 3. Further Case Studies

#### JPO's **Proposal** for **Next Steps** for Further Case Studies

- By the end of December 2016:  
→ JPO to prepare **new hypothetical cases for further case studies** in **electrical and mechanical fields** based on the actual cases 3, 11 and 12
- By the end of February 2017:  
→ IP5 offices will **submit the result of analysis** of the new hypothetical cases to the JPO
- By the end of March 2017:  
→ **IP5 Users** to **submit the opinions** on the new hypothetical cases to the JPO
- IP5 Heads/Deputy Heads Meeting on June 2017  
→ JPO to **report analysis** on IP5 offices' case studies and the opinions from IP5 users

**Agreed at  
PHEP Meeting  
(Oct. 2016)**

**JPO's Proposal**

## New Hypothetical Cases for Further Case Studies

Case	Technical Field	Corresponding Actual Case	Issues to be discussed
4	<b>Electric</b>	3	<ul style="list-style-type: none"> <li>• Is the invention unclear because of the statement “means for . . .ing?”</li> <li>• Does the invention of Claim 1 meet the support requirement?</li> </ul>
5	<b>Electric</b>	11	<ul style="list-style-type: none"> <li>• Is the invention unclear because of the statement “specific current condition or voltage condition”?</li> <li>• Does the invention meet the support requirement?</li> </ul>
6	<b>Machine</b>	12	<ul style="list-style-type: none"> <li>• Is the invention unclear because of the statement which does not identify any structural relationship between component A and B recited in the claim?</li> <li>• Does the invention meet the support requirement?</li> </ul>

**Thank you very much.**