



For the harmonization of Description Requirement

Comparison of the Description Requirement based on the "First Action" among IP5 office.

*Japan Intellectual Property Association
The Second Subcommittee, The First Patent
Committee*

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I. Comparison of the description requirement

◆ 3. Result

(1) Samples (covering all technical field): total 81 cases

	Written Description	Clarity	Enablement
US	5	27	7
EP	7	47	4
JP	19	30	13
KR	11	47	6
CN*	24	44	1

Please note that the sum of grounds duplicates as most OA contains plural reasons for the rejection.

* Including number of the cases which were pointed out “Written Description Deficiency” or “Lack of Clarity” based on Art.20 of Chinese Detailed Patent Rule.



Comparison of the Description Requirement based on the "First Action" among the IP5 Offices..

Results of the Study for JP-PCT ..

and ..

Some Typical Examples of Description Requirement among IP5 Offices ..

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I Method ..

(1)-Select of the Cases ..

- JP-PCT applications (PCT applications which were filed to JPO) which were published on "first week of August 2006", "first week of December 2006", "first week of April 2007", and "first week of August 2007" are examined..
- The cases which were notified of the "First Action" in all of JP, US, EP, KR and CN were selected as investigation objects from the above JP-PCT applications..
- For each case, the claims of each countries' application were checked about whether the claims were essentially different at the time of examination as a result of amendment. The cases whose claims were substantially difference among the IP5 applications were eliminated from the investigation objects..
- After the above screening, the investigation objects of this study resulted in 81 cases ..
- We have thoroughly studied each of applications and selected 10 typical cases. These selections have been also supported by studying members'

II 10 typical and major Examples of the Judgments ..

Case No. 13 ..

Technical Field ..	Electric ..
Claim ..	This claim included a "report production means" (by functional expression) as an element of the invention of information system ..
Specification ..	In the specification, the only explanation regarding "report production means" was that "The report function can be actualized using a specialized software" ..
Official Action ..	JP .. The examiner rejected this invention by the following reasons.. The sentence, "the report function can be actualized using a specialized software" in the specification, is merely a wishful explanation. Such description did not disclose the invention sufficiently enough for the person skilled in the art to enable it..
	EP .. No reason for refusal based on description requirement deficiency was indicated ..
	US .. No reason for refusal based on description requirement deficiency was indicated ..
	KR .. KR application was not filed ..
	CN .. CN application was not filed ..
Remark ..	The invention of this case is expressed as so-called "functional claim", and only JPO rejected the claim because of lack of the enablement requirement. The applicant deleted all claims including the "report production means" from Japanese application. On the other hand, neither EP nor US pointed out lack of the enablement requirement based on the words of "report production means".. When this patent application was filed (in 2005), it was quite normal for the person skilled in the art (the technician of the information system) that the report was produced with dedicated



II. Further Collection of “Typical Cases”.

◆ 1. The Relation to the “Discussing Issues” which were proposed at IP5 meeting.

[issue No.1] Propriety of description requirement judgment based on working example

No.6, 8, 9



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

[issue No.2] Judgment of special cases

- For example: Cases for the invention about objects specified by the function or the use of them.

No.3

[issue No.3] Judgment of enablement requirement in specific technical fields.

No.2, 7

[issue No.4] Consideration of the information submitted after filing patent application

Thank you for your attention.

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