

# Latest Progress on Written Description/Sufficiency Disclosure

21 May 2015

Japan Patent Office

## Industry IP5 Consensus Proposals (October 10, 2014)

### Discussion among IP5

- Limited number of issues

- Focus on specific topics

### Submission of Case

- In February 2015, IP5 Industry submitted cases on specific issues.

- Some areas of major differences among the Offices may include:
  - **Limit of claims to examples shown vs. rely on description of entire specification. (Case 6, 8 and 9)**
  - Claims reciting known structure with new function. (No cases)
  - Claiming an essential component where examples all include secondary components. (Case 7)
  - Requiring showing in a drawing every element claimed, even if the element is understood. (Case 2)
  - **Amount of scientific data required in a patent specification to support patent claims. (Case 6, 8 and 9)**
  - Requiring direct and unambiguous support for claim amendments. (No cases)

## Example (Case 6, 8 and 9)

Case No.	Technical Field	Judgment of Description Requirement A: allowed, R: rejected															Summary
		Enablement					Written Description					Clarity					
		JP	US	EP	KR	CN	JP	US	EP	KR	CN	JP	US	EP	KR	CN	
6	Chemistry	R	A	A			R	A	A			R	R	R			Invention regarding the composition specified by the parameter. The example where judged as description requirement deficiency to the embodiments other than described in the working examples by JPO.
8	Chemistry	R	A	A	A	A	R	A	A	A	A	A	A	A	A	A	Invention including special parameter. The example where JPO judged the parameters other than described in the working examples were not supported by the specification.
9	Chemistry	A	A	A			R	A	A			A	A	R			Invention regarding cosmetics comprising multiple component. The example where JPO judged that the "gelling agents" other than described in the working examples were not supported by specification.

- **Prepare hypothetical cases**  
which correspond to IP5 Industry Cases, in order to prevent the application from being easily identified, with **specifying the target of outcome of the each case.**
- **Prepare the methodology of case study**
- **Decide whether or not to conduct the study**  
at 4th PHEP meeting to be held in October 2015

The JPO has compiled a list of definitions of terms used at each Office related to written description/sufficiency of disclosure, based on the paper\* provided by Industry on October 10, 2014.

The JPO will give a status report on the list at the Meeting of IP5 Heads of Office, which was finalized at the Meeting of IP5 Deputy Heads of Office in March, 2015.

\* “PHEP in conjunction with Industry IP5 should clarify the meaning of various terminology used by the different IP5 Offices, and how the terms are applied in actual practice. – E.g., Written description, enablement, support, sufficiency of disclosure, clarity, etc.” (page 5, Industry IP5 Consensus Proposals to the IP5 Patent Harmonization Experts Panel (PHEP), October 10, 2014)

1. In terms of whether the invention for which a patent is sought is described in the description, each of offices use the following terms:

EPO: support in description (Part F Chapter IV, 6.)

JPO: support (Part I, Chapter 1, 2.2.1)

KIPO: support (Part II, Chapter 4, 3.)

SIPO: support (Part II, Chapter 2, 3.2.1)

USPTO: written description (MPEP2163)

2. In terms of whether description is complete for the claimed invention to be carried out, each of offices use the following terms:

EPO: sufficiency of disclosure (Part F, Chapter III, 1.)

JPO: enablement (Part I, Chapter 1, 3.2)

KIPO: enablement (Part II, Chapter 3, 2)

SIPO: enablement (Part II, Chapter 2, 2.1.3)

USPTO: enablement (MPEP2164)

3. In terms of whether each of claims is clear, each of offices use the following terms:

EPO: clarity (Part F, Chapter IV, 4.)

JPO: clarity (Part I, Chapter 1, 2.2.2)

KIPO: clarity (Part II, Chapter 4, 4.)

SIPO: clarity (Part II, Chapter 2, 3.2.2)

USPTO: definiteness (MPEP 2173)

[Note] The usage of these terms is not dependent on different technical fields.

**Thank you very much.**

