Latest Progress on Written Description/Sufficiency Disclosure

21 May 2015

Japan Patent Office
Background

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)

<table>
<thead>
<tr>
<th>Case No.</th>
<th>Technical Field</th>
<th>Judgment of Description Requirement</th>
<th>Summary</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
<td>Enablement</td>
<td>Written Description</td>
</tr>
<tr>
<td>6</td>
<td>Chemistry</td>
<td>R</td>
<td>A</td>
</tr>
<tr>
<td>8</td>
<td>Chemistry</td>
<td>R</td>
<td>A</td>
</tr>
<tr>
<td>9</td>
<td>Chemistry</td>
<td>A</td>
<td>A</td>
</tr>
</tbody>
</table>
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.