

Newsletter / IP Japan**Inventions concerning specific use of food**

The Intellectual Property Subcommittee of the Industrial Structure Council held on December 8, 2015 discussed patentability of inventions concerning specific use of food. In the meeting, the subcommittee suggested revising the Examination Guidelines for inventions concerning specific use of food. As of the present moment, they are planning to put the revised Examination Guidelines into effect in the coming April, and the new Examination Guidelines would be applied to examinations conducted on or after the effective date, generally the publication date of the new Examination Guidelines.

On January 20, 2016, the Japan Patent Office (JPO) released a notice that the JPO will suspend the substantial examinations of applications of inventions concerning specific use of food, which would be rejected by the Decision of Rejection* under Article 29(1)(iii) (novelty) for the reason that the limitation of use does not specify the claimed inventions if they are examined in accordance with the current Examination Guidelines, until the effective date of the new Examination Guidelines. (*Exception: Applications which would be rejected by the Decision of Rejection by not responding to the Notification of Reasons for Rejection)

<< Our views and suggestions >>

- (1) It can be considered that the JPO intends to rendering final decisions of rejecting applications under Article 29(1)(iii) (novelty) with not taking into consideration of the point that specific use can make a difference by suspending issuance of the Decision of Rejection for the reason of lack of novelty. Therefore, although the JPO did not state, it can be expected that the Reconsideration by examiner before Appeal and the Appeal/Trial procedures would also be suspended.
- (2) Although the JPO will suspend rendering the final decisions of rejection for such applications as mentioned above, as same as before, they keep following the principle of first-to-file. Therefore, if you are now contemplating obtaining patent rights for specific use of food, we would recommend filing applications at your earliest convenience, even before the revision of the Examination Guidelines.
- (3) We believe that you can voluntarily request the JPO for applying the new Examination Guidelines to the examinations of inventions concerning specific

use of food by submitting a Written Statement, for the applications which have already filed and will shortly be examined.

- (4) If you have already filed applications of inventions concerning specific use of food and you wish to file a Request for Accelerated Examination, we are of the opinion that you would better wait and request the accelerated examination until the new Examination Guidelines be effective in order to avoid receiving unnecessary Office Actions.

The Subcommittee discussed inventions concerning specific use of food in respect of the following Items 1-3.

1. Specification of claimed invention with limitation of use

In case that an invention concerning food is claimed with limitation of use, the limitation of use should be interpreted to specify the claimed invention.

However, for plants or animals, even if the claims are with limitation of use, it merely indicates the usefulness of the plants or animals. Therefore, they should be interpreted, just for plants and animals themselves, as ones without limitation of use.

2. Forms of Claims

The following proposed forms of claims should be accepted with considering needs of inspection and for consistency with fields other than food.

(Proposal)

Regarding forms of such claims as, "Agent containing component A as an active component for use in X", "Composition containing component A as an active component for use in X", "Food composition containing component A as an active component for use in X" and "Yogurt containing component A as an active component for use in X", the limitation of use should be interpreted that it contains meanings to specify the claimed invention.

*"Agent containing component A as an active component for use in X" can, as a matter of course, be used as a definition of claims of inventions in fields other than food.

*"Composition containing component A as an active component for use in X" can, as a matter of course, be used as a definition of claims of inventions in fields other than food.

*The active component does not need to be a compound, it can be an extract or a microorganism, etc.

(Ex. Agent containing Curcuma longa extract as an active component for use in X)

Note:

Because a definition such as "Food for use in X" can include plants and animals, the description should be interpreted as a food *without* limitation of use. However, in case that the definition is assumed to mean that it does not include plants and animals from the description of the specification etc., such limitation of use should be interpreted to specify the claimed invention.

What follows is a list of several examples of "Inventions which will be interpreted as *without limitation of use*" and "Inventions which will be interpreted as *with limitation of use*", although whether or not they are "with" or "without" will be actually determined in the process of substantial examinations of specific and individual applications.

(Examples)

< Inventions which will be interpreted as *without limitation of use* > (which include plants or animals *per se.*)

- Banana for use in X.
- Fresh tea leaves for use in X.
- Mackerel for use in X.
- Beef for use in X.

< Inventions which will be interpreted as *with limitation of use* >

- Banana juice for use in X.
- Tea drink for use in X.
- Fish sausage for use in X.
- Cow's milk for use in X.

3. Determination on inventive step and descriptive requirements

Like in other fields, inventive step, description requirements, etc. are to be appropriately determined after the invention is determined as to whether it possess novelty as inventions concerning specific use of food. The examples of the determination concerned will be described in the Examination Handbook.

*Even if the limitation of use on an invention concerning food is interpreted to specify the claimed invention and it is determined that the invention possesses novelty, the two conditions do not directly mean that the invention concerning specific use of food is to be patented. When a person skilled in the art can easily arrive at the invention from the prior art, i.e. when inventive step of the invention cannot be acknowledged, the invention should be determined to be unpatentable. Further, the invention should also be determined to be unpatentable for violation of description requirements, such as support requirements and/or enablement requirements, in case that data and/or Working Examples, which support the invention is appropriate for new uses, are not sufficiently described in the specification etc.

(Reference: Handout and Summary of the 7th working group on the Patent Examination Guidelines,
The Intellectual Property Subcommittee of the Industrial Structure Council)

If you have any questions or need any assistance about this matter, please feel free to
contact us.

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