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科 目：共通問題

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In preparing a utility patent application and proceeding with the patent application, it is required to meet some formalities and legal requirements before the Patent Office grants a patent on the application.

It is relatively simple to meet the formalities. In the United States, it is simply required to submit a specification, at least one claim, and any required drawing. A declaration or an oath by an inventor can be submitted at an adequate time after filing of the application, not to mention a filing fee.

It is a little more complicated to meet the legal requirements. Briefly saying, the invention recited in the application should be novel, unobvious, and useful so that the application is patented. To be novel i.e. to have “novelty” means that the invention is distinctly different from any part of the prior art. It is sometimes difficult to determine the constituent elements of the prior art. Generally, the prior art includes a patent issued before the filing of the application, a printed publication issued before the filing of the application, and a manufacture and a process embodying the invention already available in the public.

Unobviousness is also called “inventive step”. Inventive step means a significant difference between the invention of the application and the prior art invention. Whether an invention is unobvious is a most controversial issue in normal prosecution of patent application in the Patent Office.

It is usually not difficult to satisfy the requirement on usefulness, so-called “utility” requirement because this requirement is very broadly interpreted.

It should be noted that there are some items which are unpatentable, specifically, objects which are not protected by law. The natural law is unpatentable. The same is the case for abstract ideas or things which have been simply discovered. However, a living organism is patentable if it is an engineered product. Biotechnology and genetic engineering have succeeded in creating clone animals. A drastic progress in these fields, however, may raise a serious issue on adequacy as to whether such a clone animal be under the protection of intellectual property right in the future.