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科 目：共通問題

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When a utility patent application is prepared and filed for prosecution, it is necessary that some formality and statutory requirements be satisfied before a patent is granted by the Patent Office on the invention to which the application is directed.

The formality requirements are relatively simple. In the U.S., it is required only that an application should include a specification, at least one claim, and drawings where necessary. An oath or declaration by Inventor(s), let alone the application filing fee, can be submitted later.

The statutory requirements are somewhat more complicated than the formality requirements. In brief, to be patentable, the invention claimed in the application must be new, non-obvious, and useful. To be new, that is, to have the “novelty”, the invention must be distinctive over any part of prior art. What constitutes prior art is difficult to determine in some cases, but it generally includes preceding issued patents, preceding publications, and products and methods embodying inventions that are already available to the public.

Non-obviousness, which is also called “inventive step”, means that the invention for which the application is filed must have a significant difference over the prior art. Whether an invention is non-obvious or not is an issue that is generally most controversial during the prosecution at the Patent Office.

To satisfy the requirement to be useful, that is, to satisfy the “utility” requirement, is generally not difficult. It is because this requirement is interpreted very broadly.

There are some things that are not eligible for a patent, that is, that are excluded from the “statutory subject matter”. Laws of nature are not patentable, nor are abstract ideas and mere discoveries. However, living subject matter is patentable if it is a product made through engineering. Accordingly, while biotechnology or gene engineering has already achieved cloning, a rapid advance of such a technology will bring about a

serious issue regarding the appropriateness of intellectual property rights for clones.