★★★　＜第１１回知的財産翻訳検定試験【第５回英文和訳】＞　★★★

≪１級課題 -知財法務実務-≫

【解答にあたっての注意】
１．＊＊＊START＊＊＊から＊＊＊END＊＊＊までを和訳してください。
２．解答語数に特に制限はありません。
３．課題文に段落番号がある場合、これを訳文に記載してください。
４．課題は２題あります。それぞれの課題の指示に従い、２題すべて解答してください。

〔問１〕下掲の英文は、米国特許出願の審査における非自明性の考え方について述べています。（問題文とする都合上、原文にあった文献引用、及び一部の文章の削除等の改変を施しています。）この英文の要旨を２００字以内の日本語にまとめてください。
日本語要旨の字数には、句読点も含めるものとします（ただし、文頭の字下げ、及び文中に意図せず混入したと思われる空白は字数に含めません）。なお、２００字の字数制限は厳密に適用することとし、字数超過は減点の対象とします。

＊＊＊START＊＊＊
The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts.　It allocates who has the burden of going forward with production of evidence in each step of the examination process.　The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.　If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.　If, however, the examiner does produce a prima facie case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.　The initial evaluation of prima facie obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to render obvious the claimed invention.
To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of

ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.
＊＊＊END＊＊＊

〔問２〕下掲の英文は、米国特許明細書作成実務について解説したものです。この英文全文を読みやすい日本語に和訳してください。

＊＊＊START＊＊＊
Use of Incorporation by Reference
"Incorporation by reference" is an efficient time and space saving technique for making lengthy text in one document be part of a document under preparation without repeating the text per se. This technique is useful, for example, for including information in a patent specification without unduly expanding its size; and it is permitted by the Patent Office, subject to certain restrictions set forth in the MPEP and Federal Circuit case law.
The Patent Office draws a distinction between "essential material" and "nonessential material", and imposes certain restrictions on the types of documents from which essential material may be incorporated into a patent application.
"Essential material" is defined as that which is necessary to satisfy the requirements of the first paragraph of 35 USC §112, i.e., to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode contemplated by the inventor for carrying out the claimed invention. Essential material may be incorporated by reference only to U.S. patents or published U.S. applications which themselves do not incorporate "essential material" by reference. Essential material may not be incorporated by reference to (1) an unpublished U.S. patent application, (2) a foreign

application or patent, or (3) a non-patent publication.　Non-essential material is a matter referred to for purpose of indicating the background of the invention or illustrating the state of the art.

What if a pending application incorporates by reference essential material from a non-U.S. patent or application?　The applicant may correct the improper incorporation by reference by submitting (1) an amendment to amend the specification or drawings to include the material incorporated by reference, and (2) a statement that the inserted material was previously incorporated by reference and contains no new matter.

＊＊＊END＊＊＊