

Prosecution Strategy in Japan

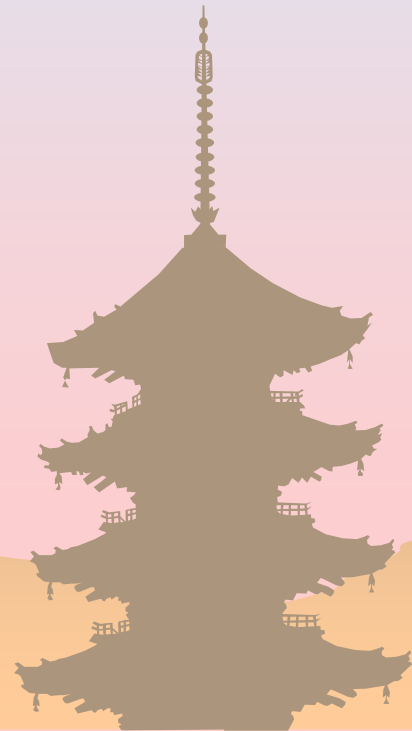
FICPI/AIPLA Colloquium
Edinburgh Scotland
June 2010

Takaki Nishijima

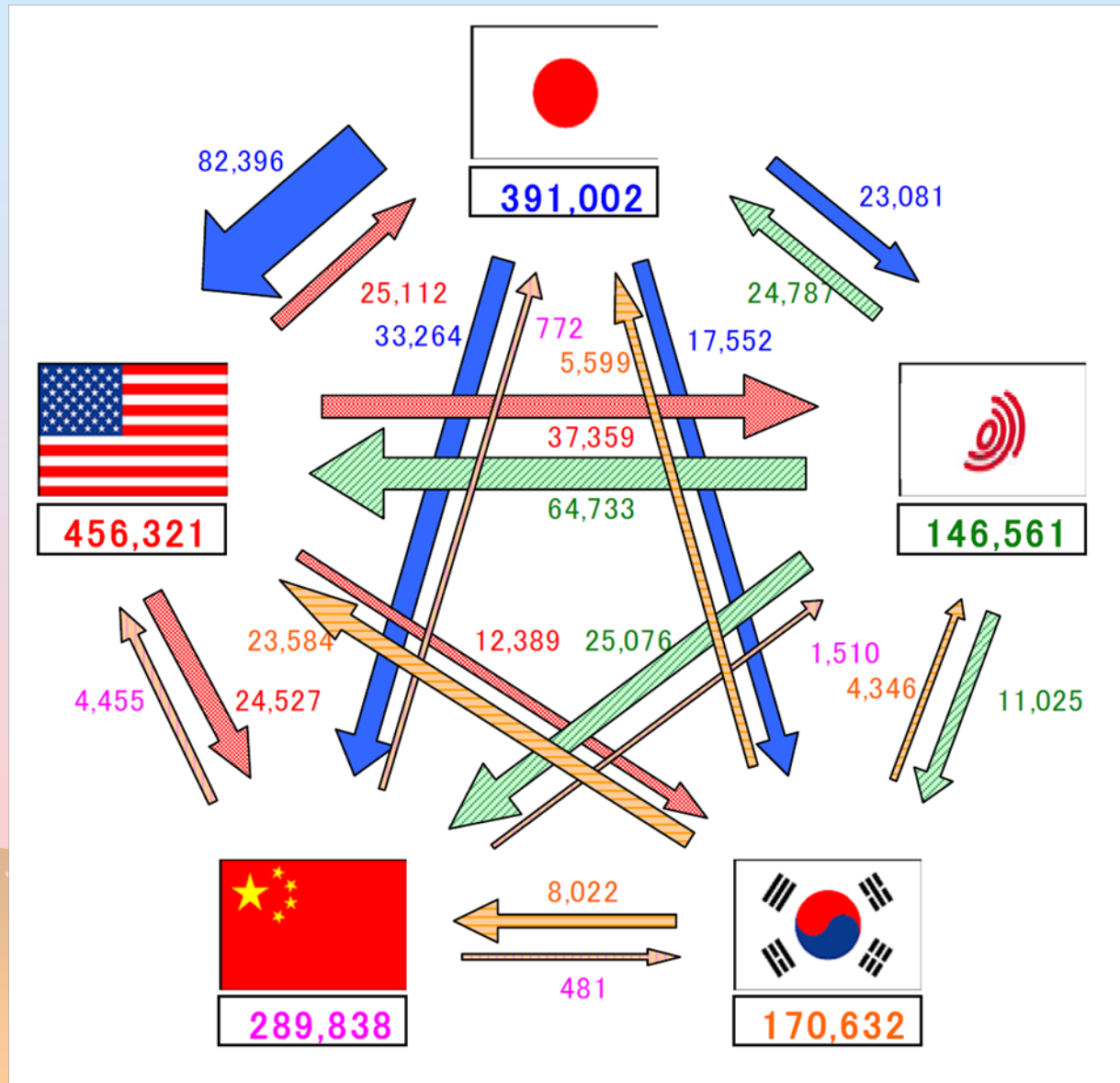
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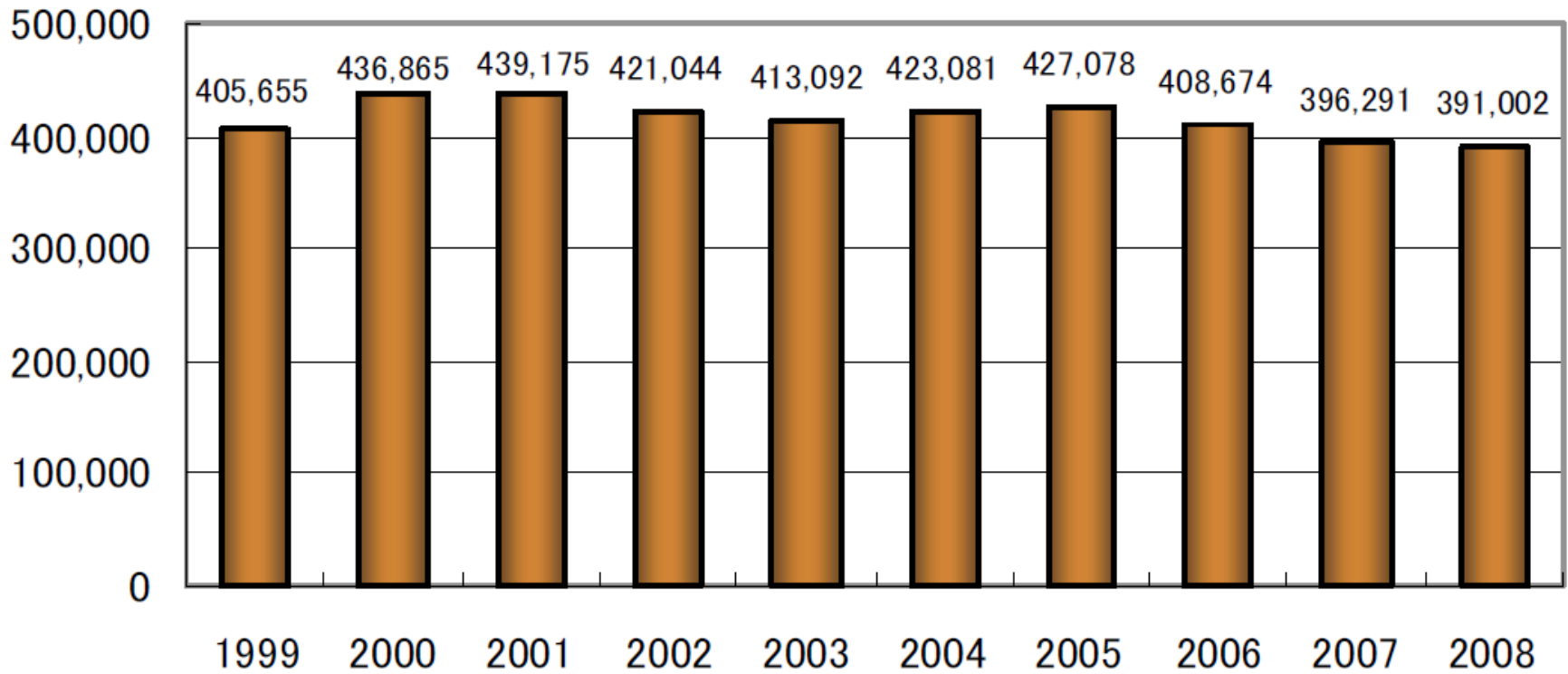
Statistics



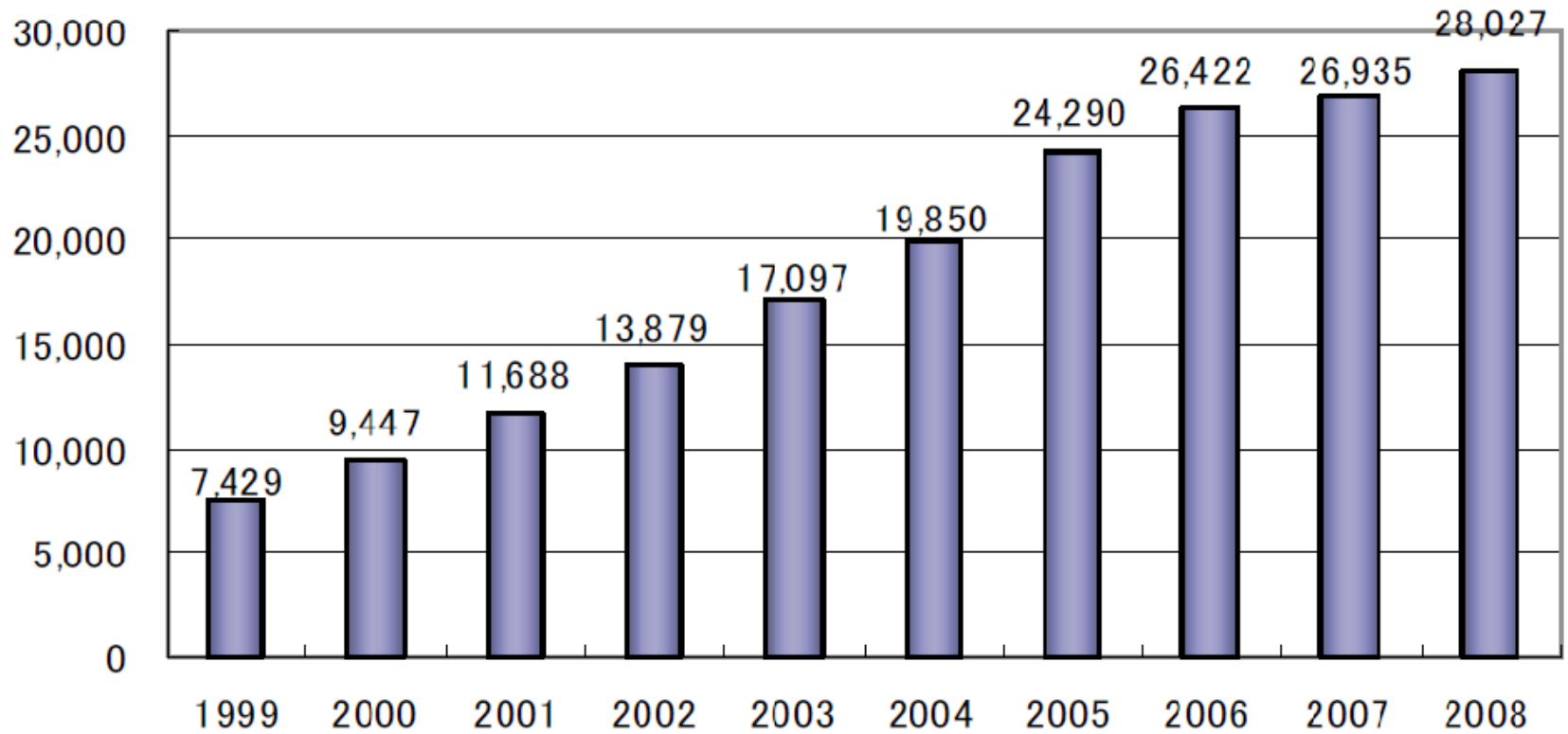
Applications between Countries (2008)



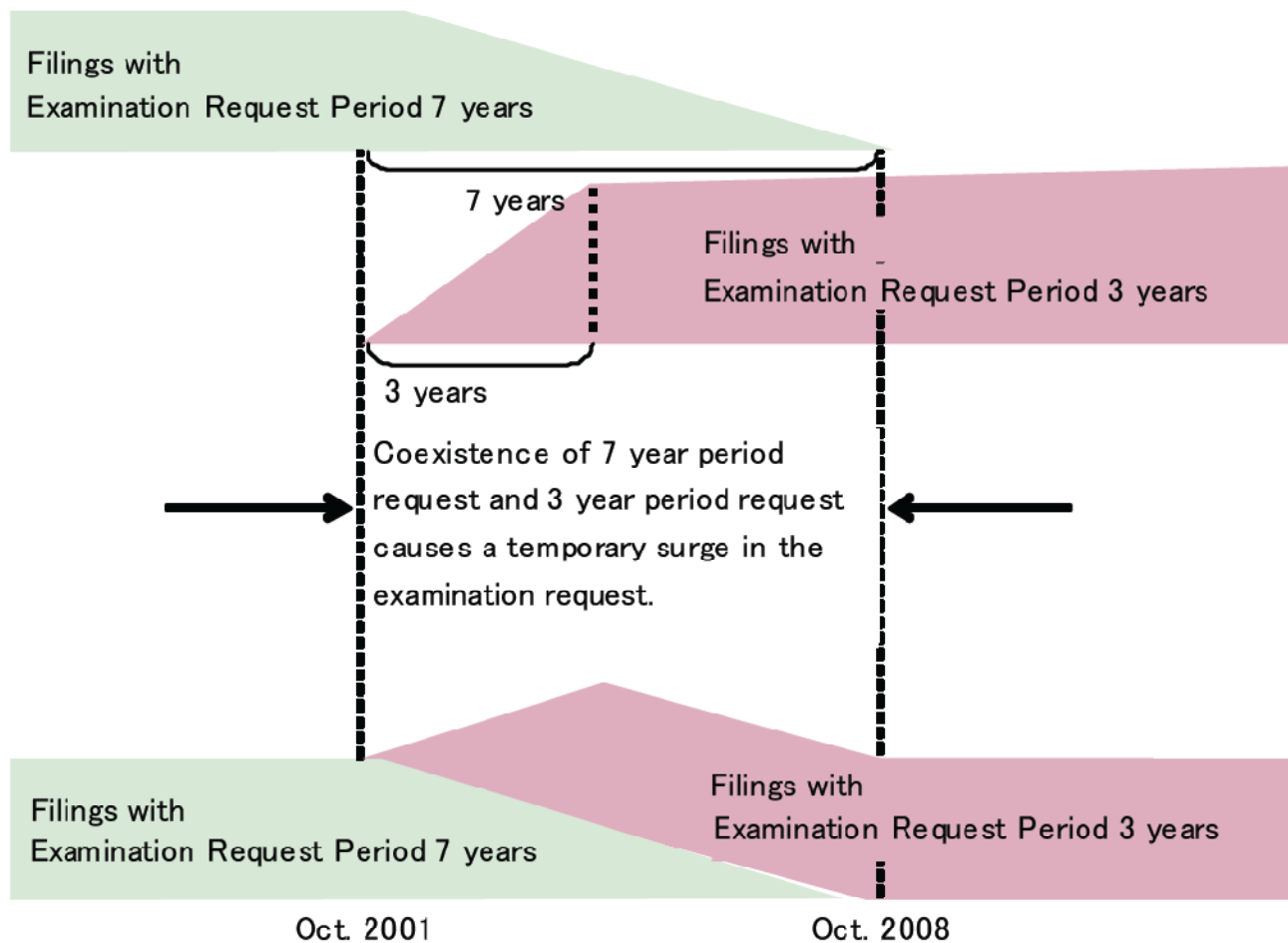
Changes in the Number of Patent Applications



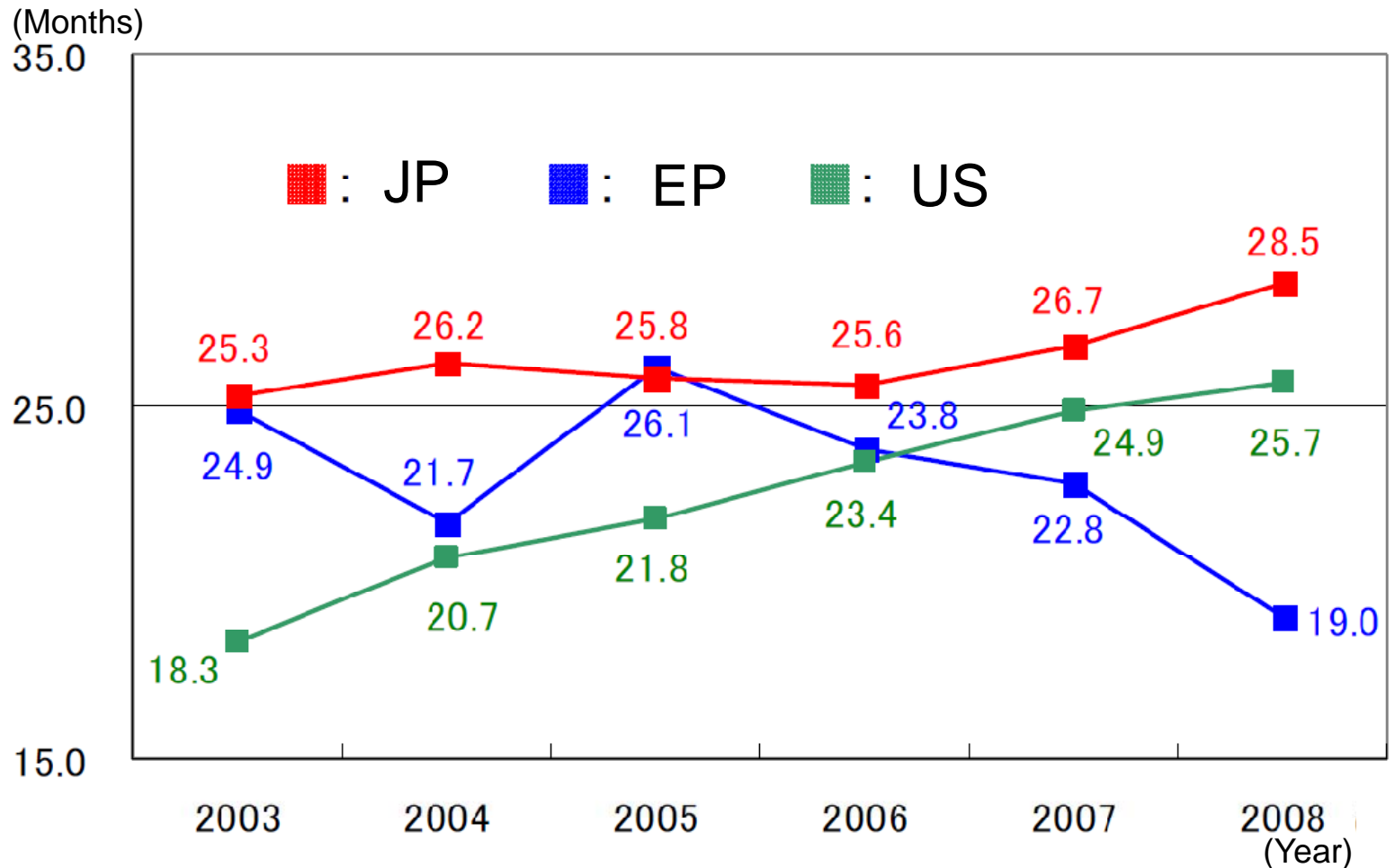
Changes in the Number of PCT Applications



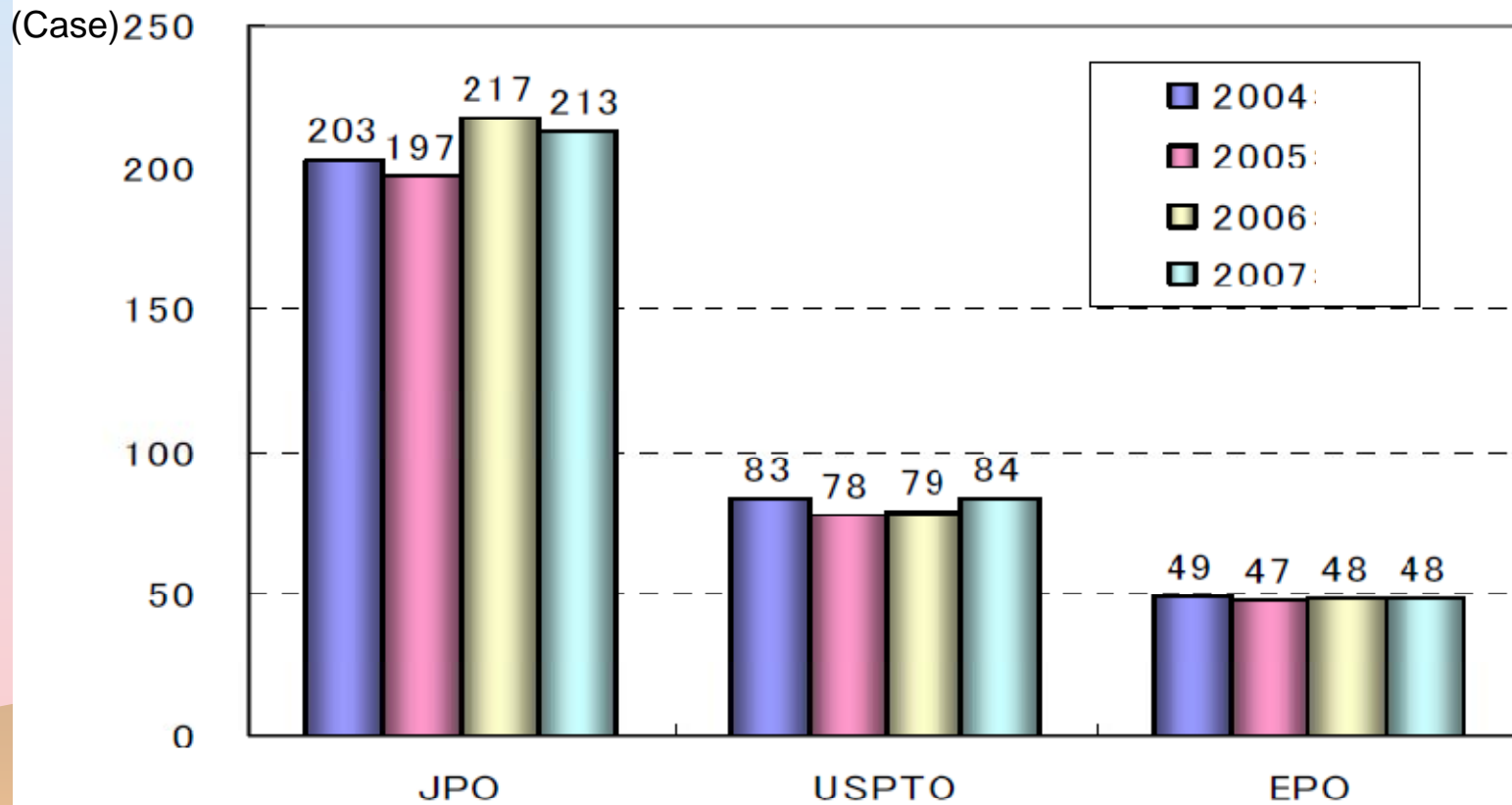
Rapid Increase in the Number of Requests for Examination Due to the Coexistence of New and Old Examination Request Systems (bumps in request)



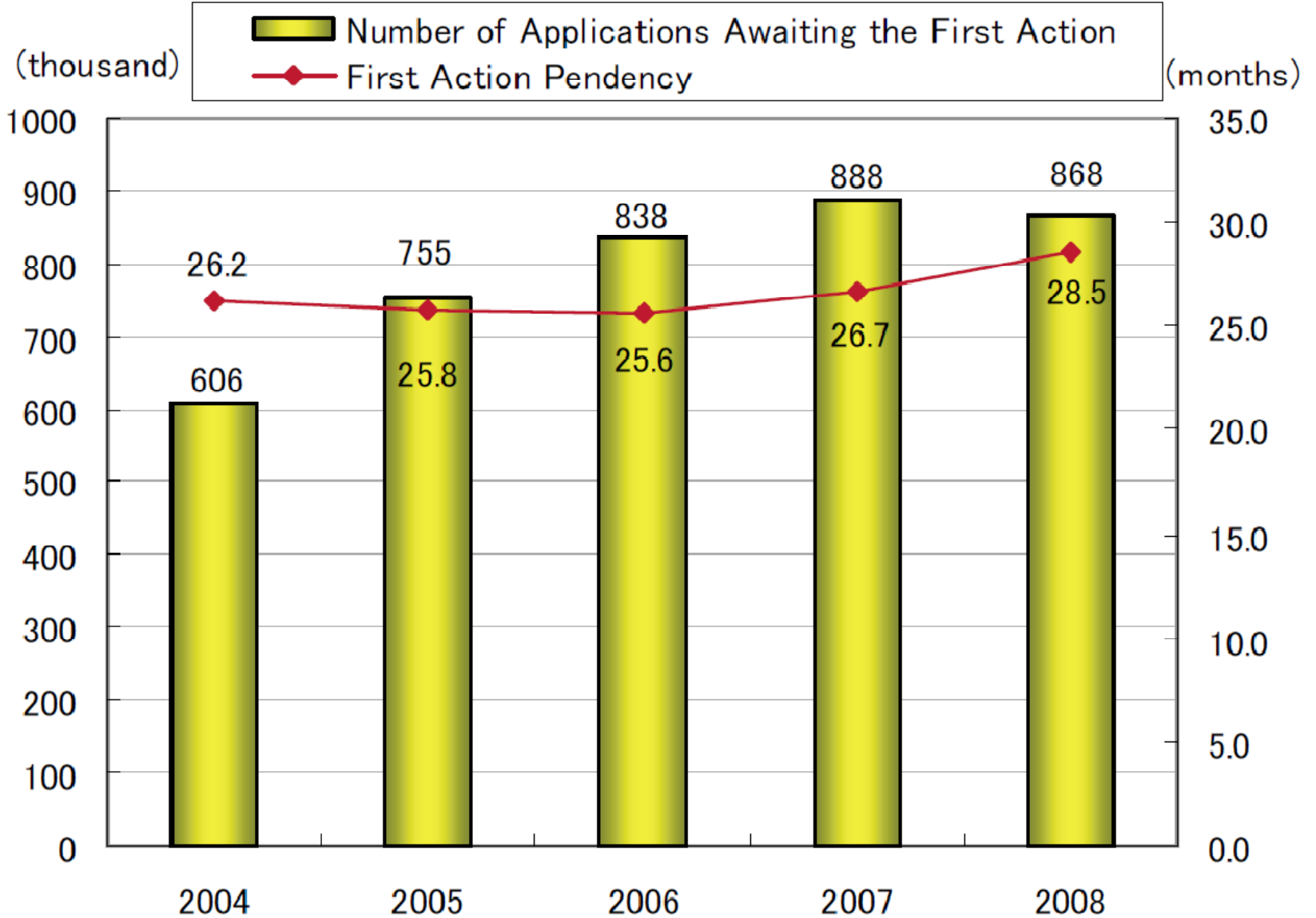
Examination Waiting Period



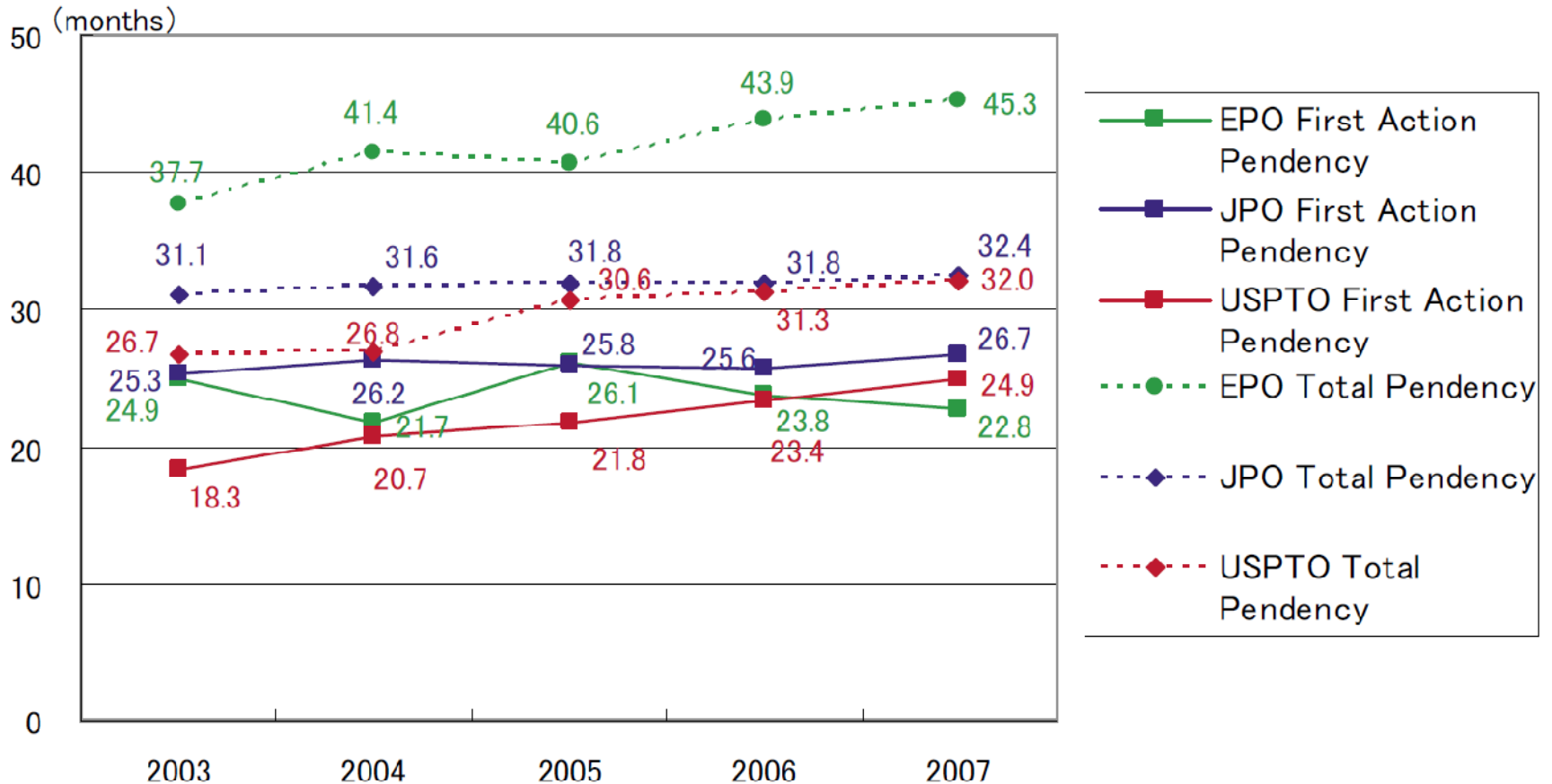
Disposal by Examination



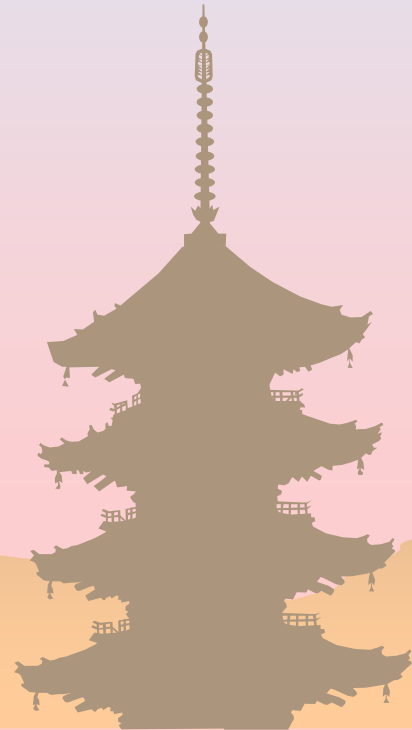
Number of Applications Awaiting the First Action and First Action Pendency



Examination Pendency and Final Decision Term at Trilateral Offices




Official Action



37 CFR § 1.104 Nature of Examination.(US)

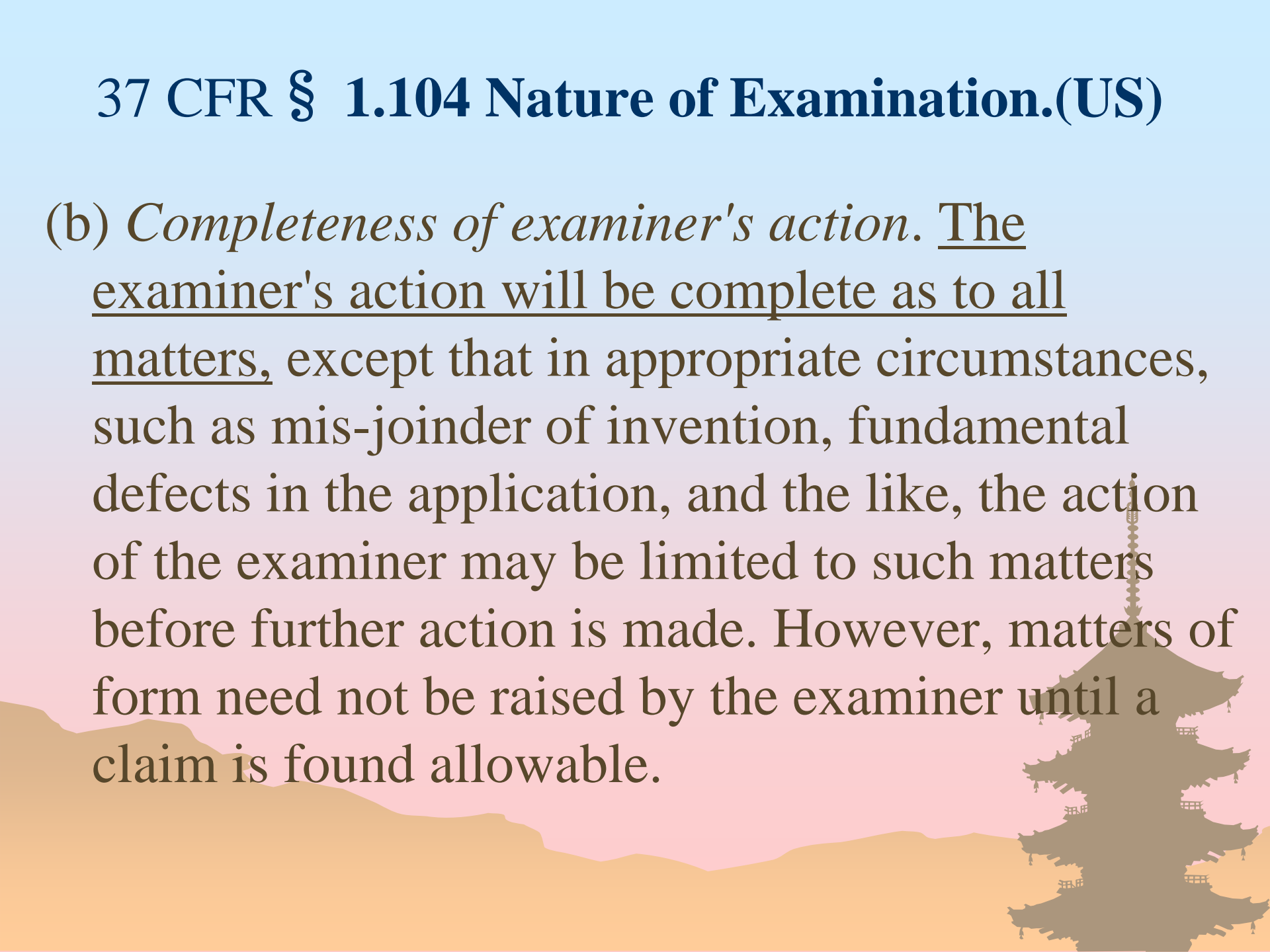
(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.



37 CFR § 1.104 Nature of Examination.(US)

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as mis-joinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.



Examination guidelines (Japan)

1993 guideline

2. Specifically Basic Direction

(1)The examiner, as a principle, is supposed to examine an application with regard to **all the grounds of rejection** as enumerated in Article 49 in a first official action.

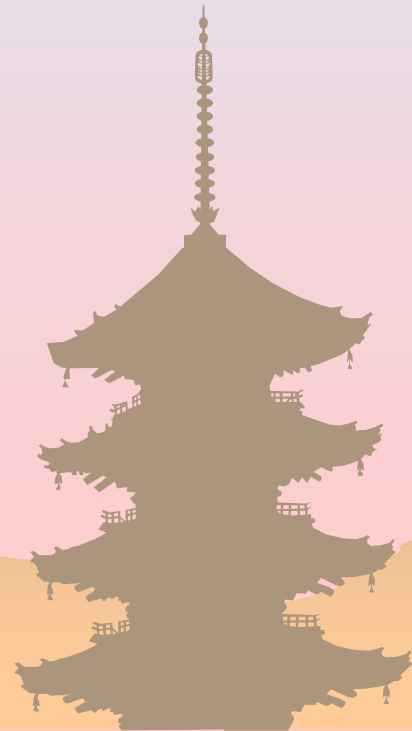
2007 guideline

IX How to proceed the examination

4.3 Specific Procedure “The examiner examines an application with regard to **all the grounds of rejection** in a first official action, makes **the official action up to two times and proceeds the examination taking account of the efficiency of the procedure as a whole.**”



Non-Prior Art Rejection



Unity of invention

Article 37

Where two or more inventions have a **technical relationship** to construct a group of inventions which meet a requirement of unity of invention as prescribed by a regulation of METI, they can be filed in a single application.

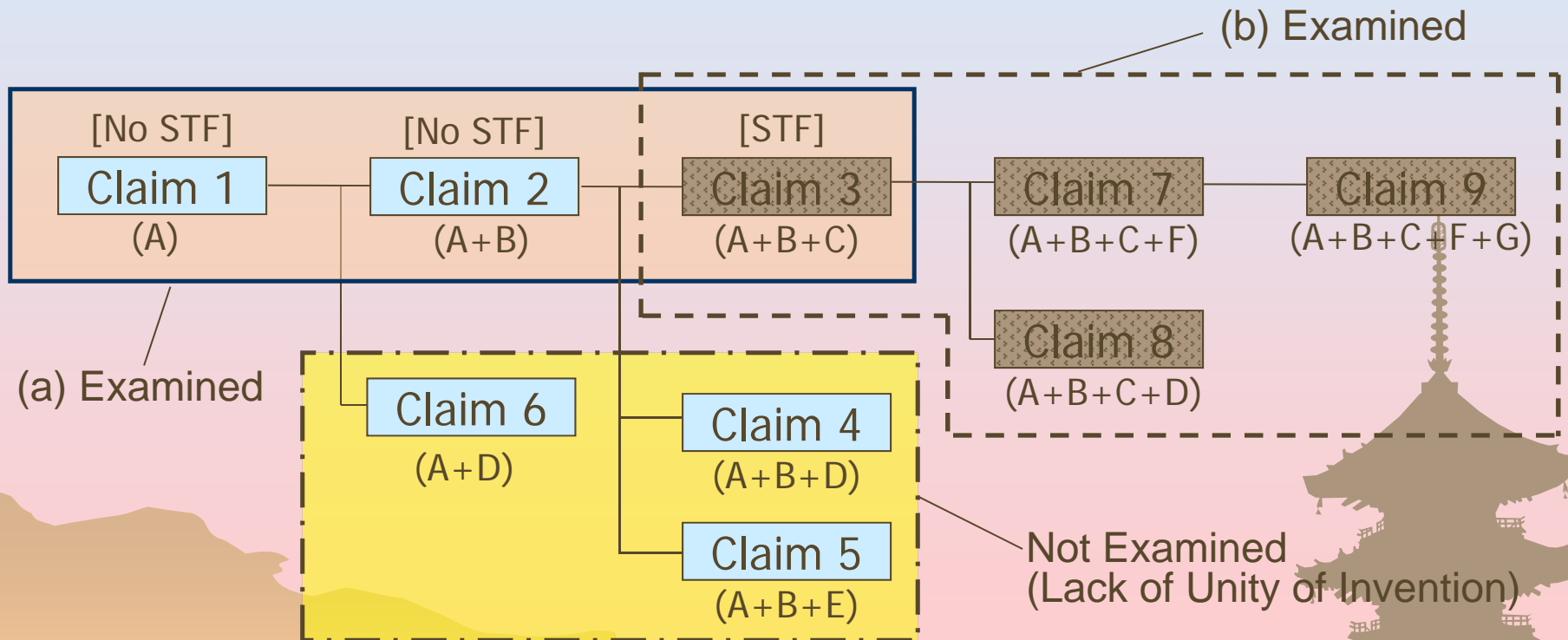
The regulation 25-8 of METI ;

“The **technical relationship** means a relationship in which **two or more inventions form a single general inventive concept as defined in PCT rule 13.**”



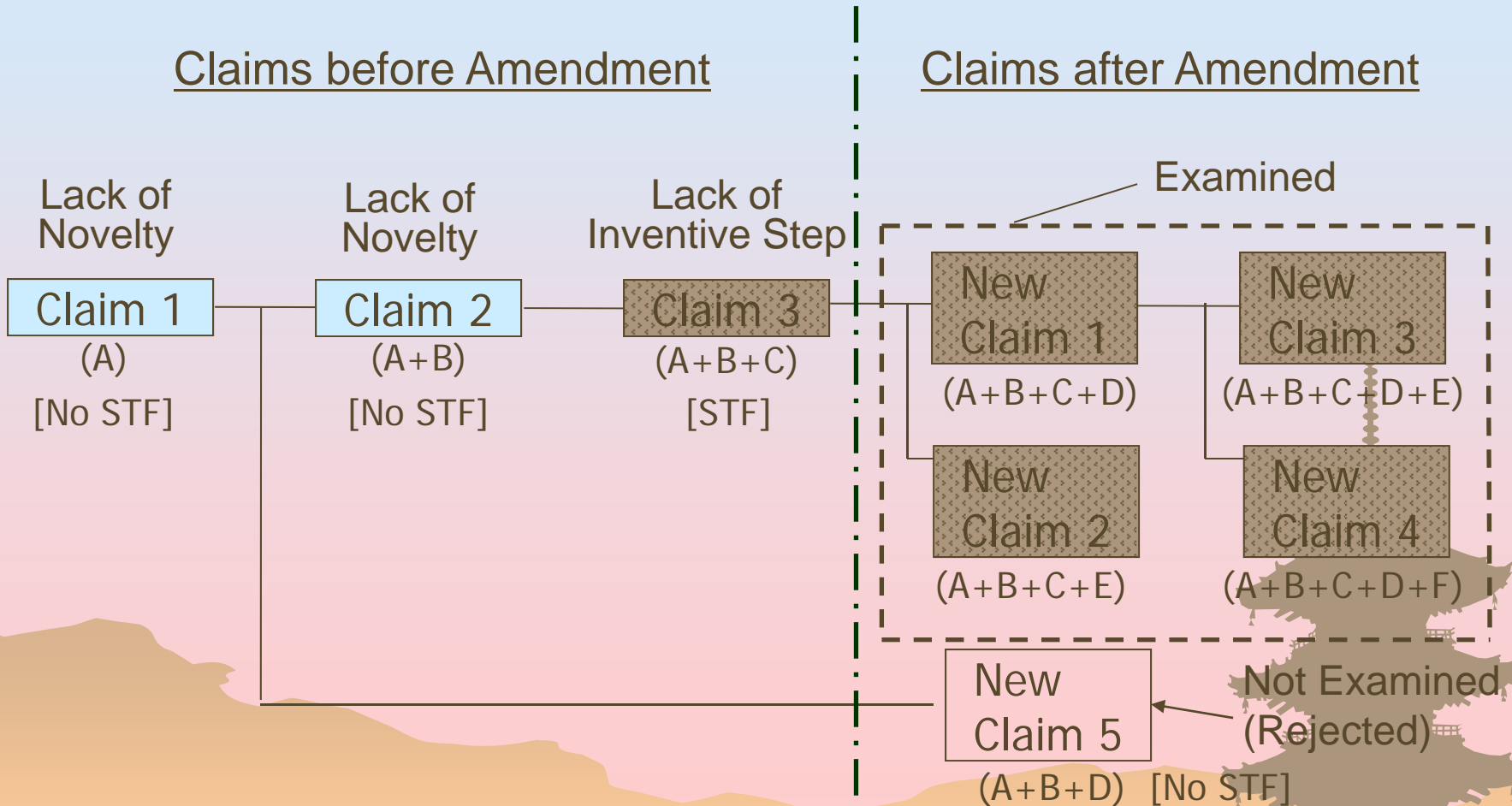
Restriction for Unity of Invention (1)

❁ **Example in which invention in claim has “a special technical feature (STF)”**



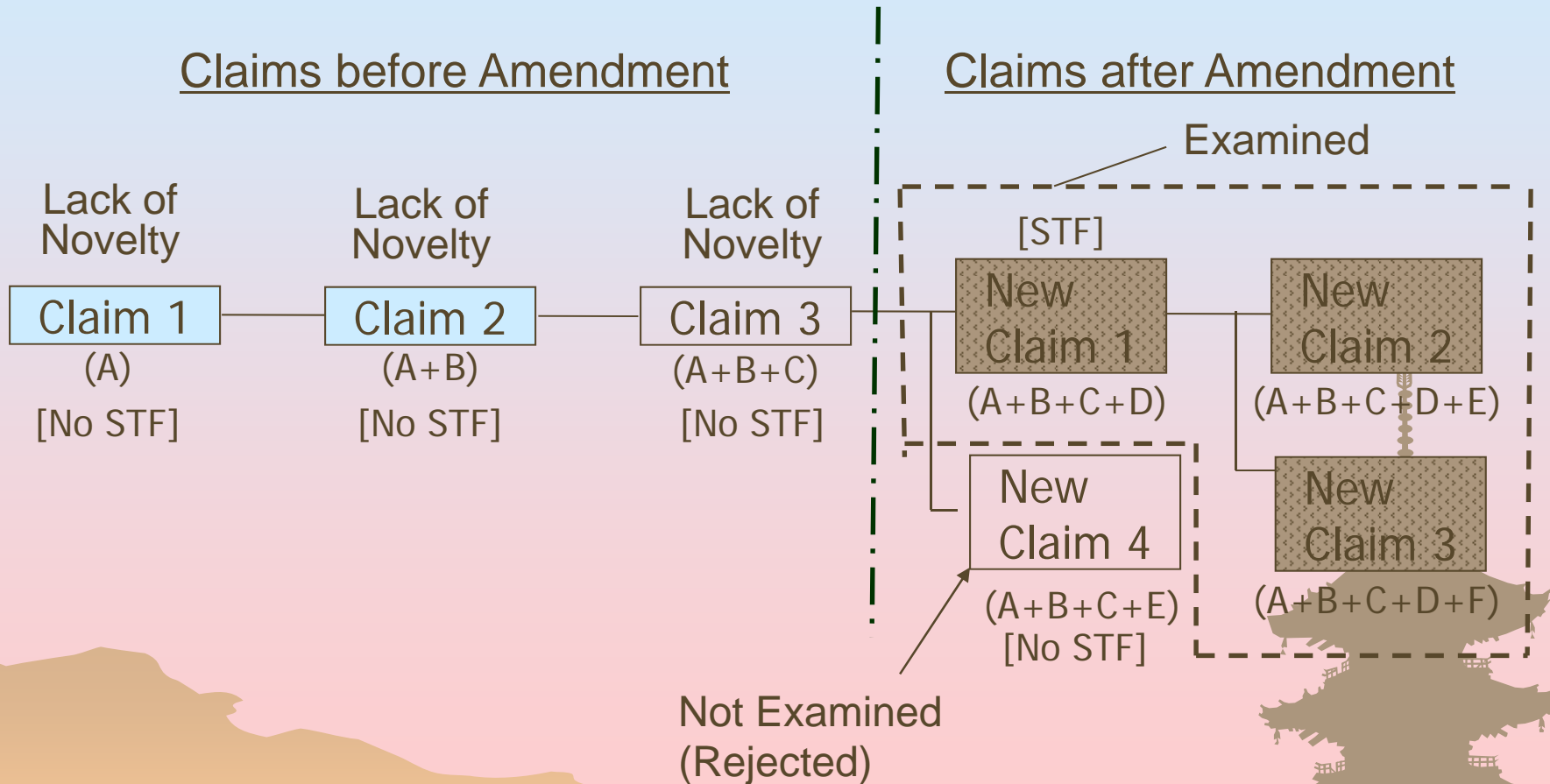
Restriction for Unity of Invention (2)

Example 1



Restriction for Unity of Invention (3)

Example 2



Conditions for Prior Art Search

All the inventions which meet the requirement of unity of invention (Article 37) shall be subjected to a prior art search.

The inventions as follows **can be excluded** from the prior art search;(Examination Guideline IX “How to Proceed Examination” Sec.2, 2.1 (3))

- (1) It is clear that an invention introduces a new matter.
- (2) It is clear that an invention is liable to public order.
- (3) It is clear that an invention is not statutory. (not technical, medical treatment etc.)

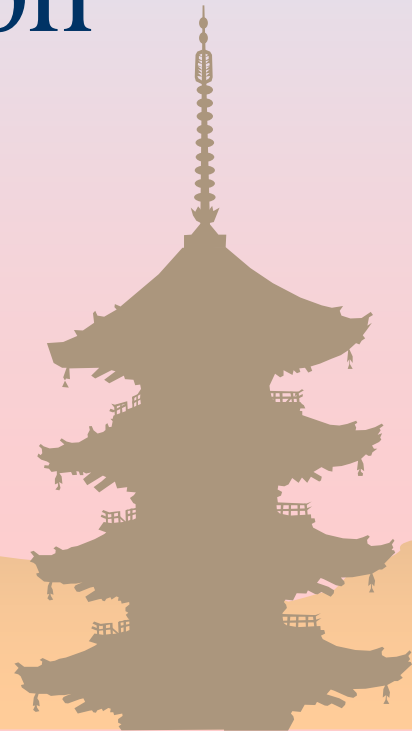


Effective Date

The above examples are based on the 2007 Revised Examination Guidelines which are applied to the **Examination on or after April 1, 2007. However, the similar practice is applied to the previous applications.**



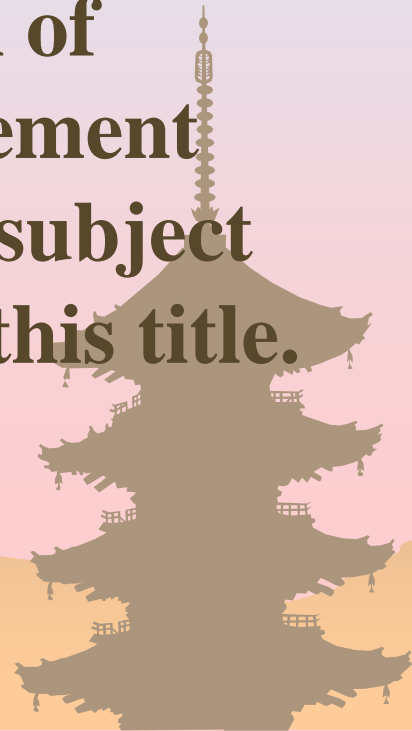
(Non-statutory Subject Matter)
Article 29 main paragraph



Statutory Subject Matter (US)

Section 101 of the US Patent Law

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



Statutory Subject Matter (Japan)

Article 2(1) of the Japanese Patent Law
definition of “invention”

"the highly advanced creation of technical ideas by which a law of nature is utilized."



Statutory Subject Matter (Japan)

Article 29 Main paragraph prescribes:

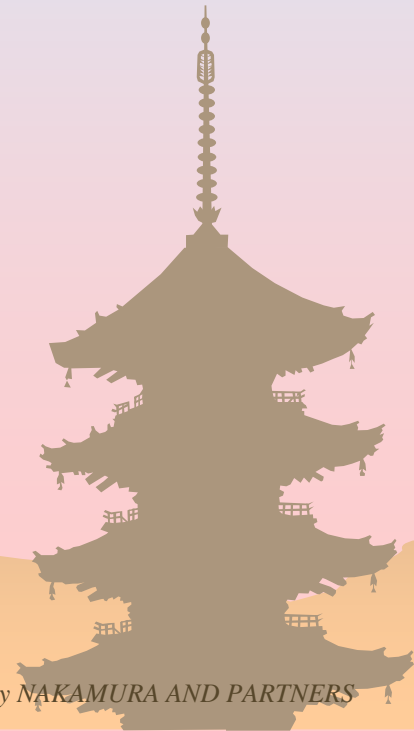
“Any person who has made an invention which is industrially applicable may a patent therefor”



Non-Statutory Subject Matter (Japan)

Law of Nature is not utilized and not industrially applicable and thus, not patentable.

- (1) Natural laws itself;
- (2) Mere discoveries and not a creation;
- (3) Those contrary to natural laws;
- (4) Those not utilizing natural laws;
- (5) Those other than technical ideas;**
 - (a) Personal skill;
 - (b) Mere presentations of information; and
 - (c) Mere aesthetic creations.



Article 36 (6) (i)

(Support Requirement by the Disclosure)

Patent Law

“The invention for which a patent is sought shall be supported in the detailed explanation. “

Guideline

2.2.1.1 Typical Examples of Violation of Article 36(6)(i)

(1) It is clear for a person skilled in the art that a matter corresponding to what is claimed is neither stated nor implied in the detailed description of the invention.

(2) Terms used in the claims and those used in the detailed description of the invention are inconsistent for a person skilled in the art, and as a result, the relation between the claim and the detailed description of the invention is unclear.

(3) In case the content disclosed in the detailed description of the invention cannot always be expanded or generalized to the scope of the claimed invention even in the light of the common general knowledge as of the filing.



Article 36 (6) (ii) (Definite Claim Recitation)

Patent Law

“The invention for which a patent is sought shall be definite.”

Guideline

2.2.2 Patent Act Article 36(6)(ii)

(a) Expressions where optionally added items or selective items are described along with such words as “when desired,” “if necessary,” etc., or expressions including such words as “especially,” “for example,” “etc.,” “desirably,” and “suitably.”

Such expressions would leave unclear the condition on which of the optionally added or selective items are chosen, thus allow the claim statements to be interpreted in many ways.

(b) A claim includes statements defining the product by its function or characteristics, etc., so that the scope of the invention is unclear.



Article 36 (4)

(Enablement Requirement)

Patent Law

“in accordance with Ordinance of the METI, the detailed explanation shall be clear and sufficient as to enable any person ordinarily skilled in the art to which the invention pertains to work the claimed invention,”

Guideline

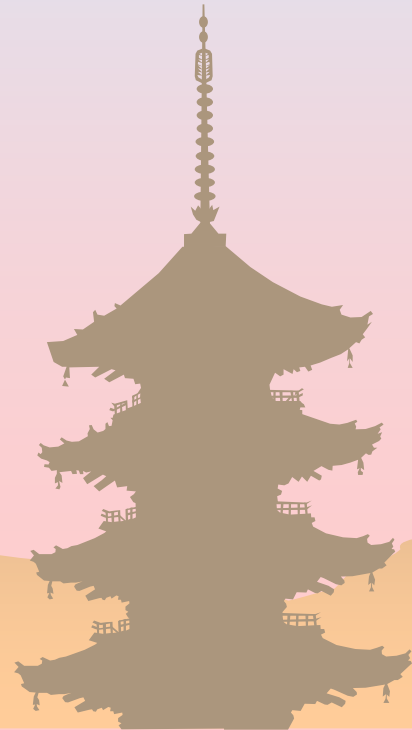
3.2.2.1 Improper Description of Modes for Carrying Out the Invention 2.2.2

(1) A person skilled in the art cannot carry out the claimed invention because a technical means corresponding to a matter defining the claimed invention is described in a merely functional or abstract way in the mode for carrying out the invention and in such a manner that it is unclear and incomprehensible how the technical means should be embodied into a material, apparatus or process, even taking into consideration the common general knowledge as of the filing.

(2) A person skilled in the art cannot carry out the claimed invention because the relation between each technical means corresponding to a matter defining the claimed invention is unclear and incomprehensible in the mode for carrying out the invention, even taking into consideration the common general knowledge as of the filing.



Efficient Examination Proceedings



Divisional application (Article 44)

An applicant for patent may divide a patent application when it includes two or more inventions to file new applications,

(1) during the time when an amendment for a specification, claims, or drawings can be made;

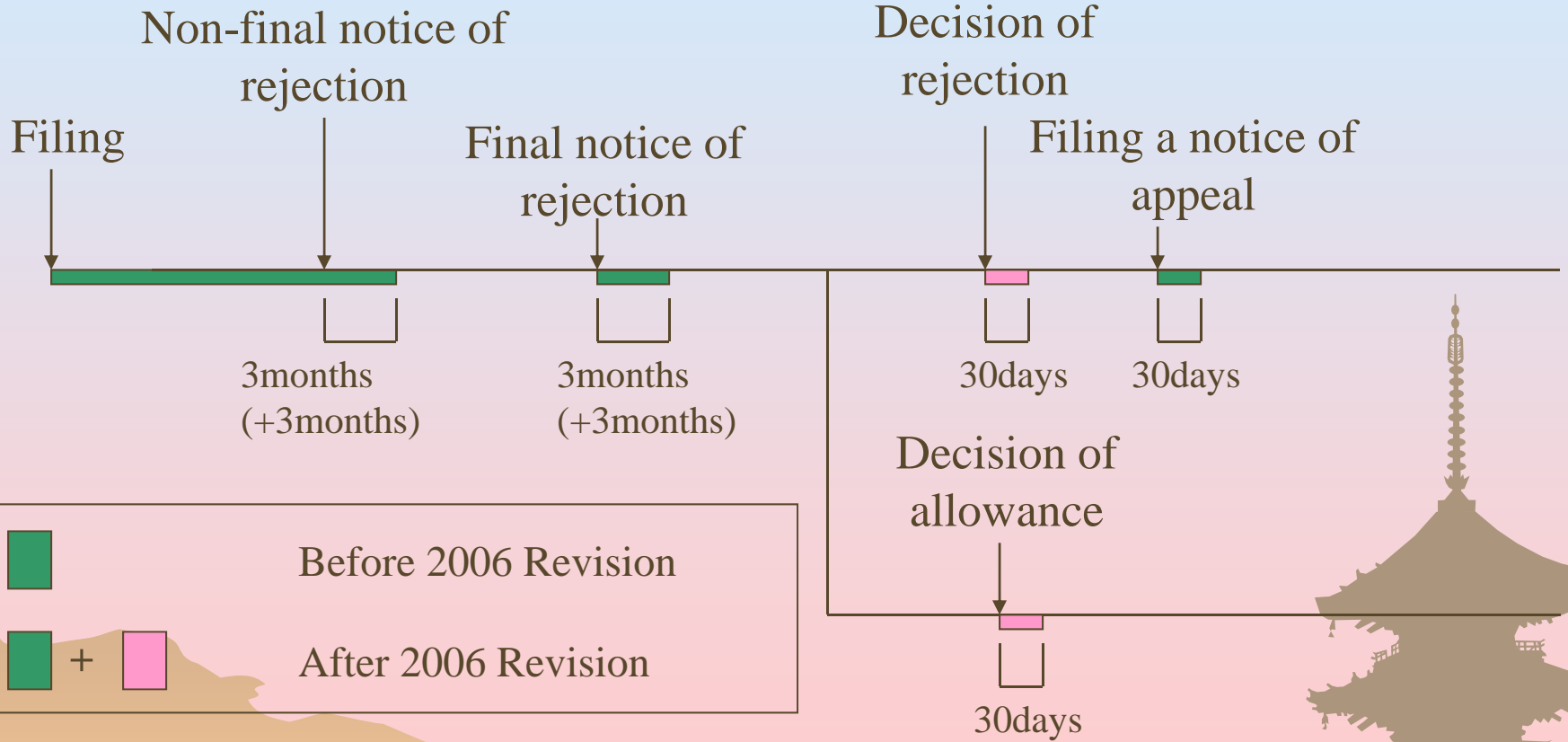
(2) **(New)** within 30 days from the date of delivery of notice of allowance; or

(3) **(New)** within 30 days from the date of delivery of a final rejection by the examiner for the first time.

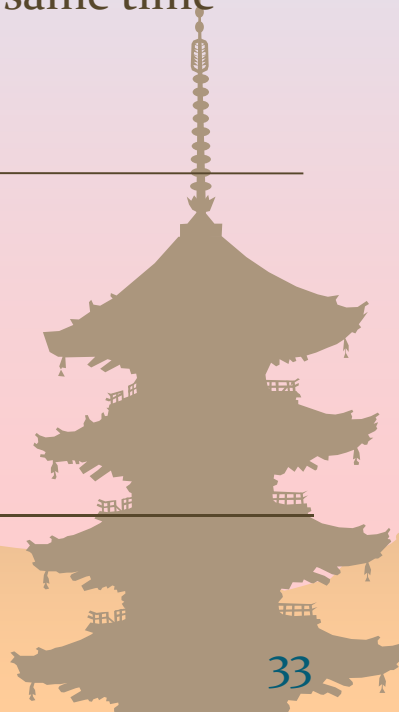
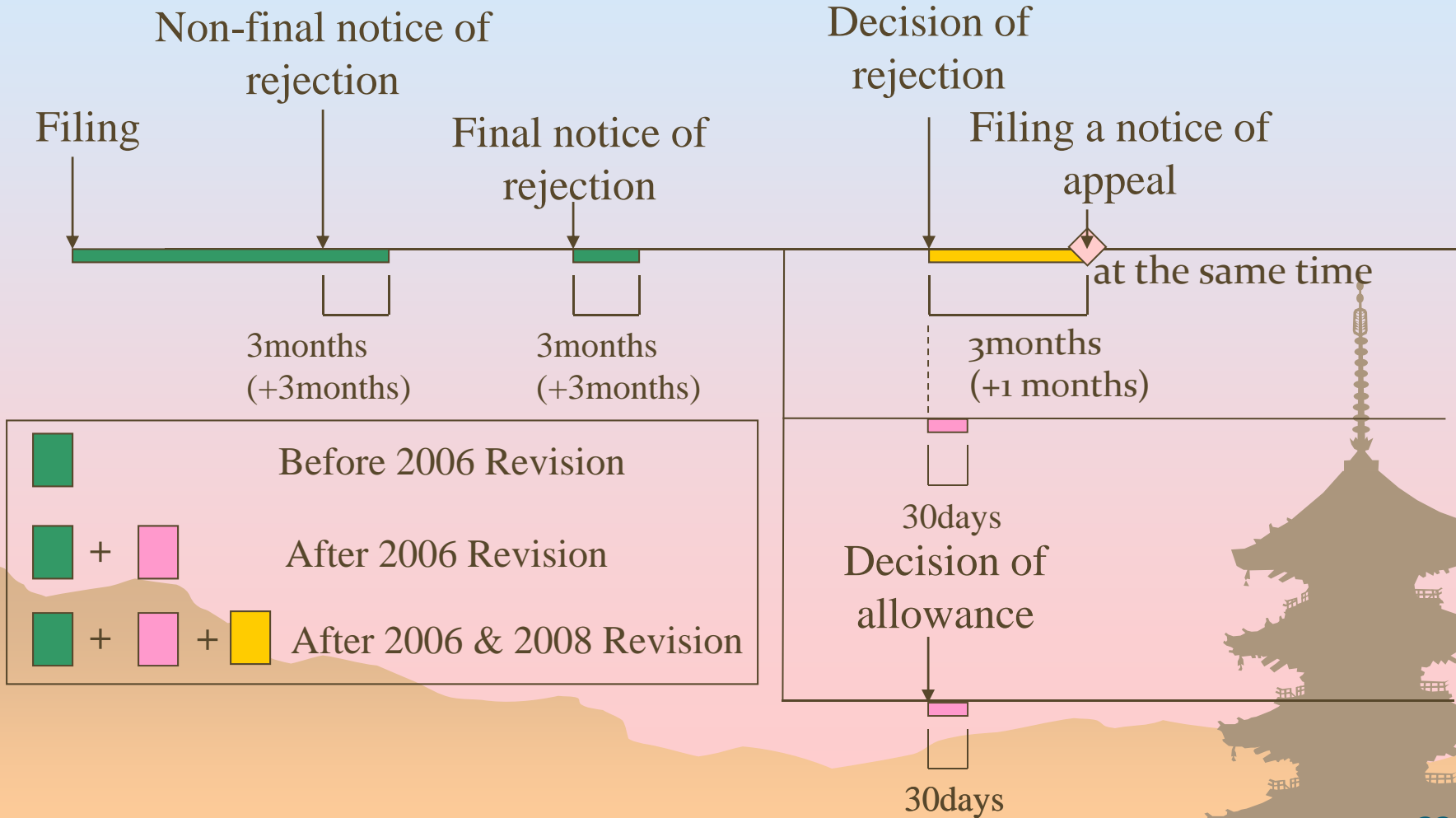


Periods Possible To File **Divisional Applications**

(Before 2008 Revision)



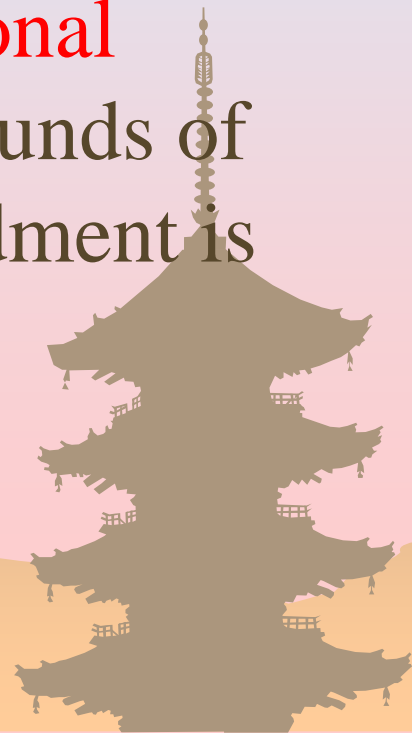
Periods Possible To File **Divisional Applications** (After 2008 Revisions)



Article 50bis

(1) The claims of **the divisional application** shall be different from other family applications.

(2) If not, the office action for **the divisional application** shall be the last notice of grounds of rejection in which only restrictive amendment is allowed.



Last Notice of Ground of Rejection(17bis (5))

(1) When an amendment in response to a first office action could overcome the ground of rejection but causes another ground of rejection, a “Last Notice of Ground of Rejection” is issued.

(2) After the Last Notice of Ground of Rejection is issued, the applicant cannot expand the claims nor increase the number of claims, but can only limit the claims without changing the object of the invention and the technical field of the invention.

Article 17bis (4)

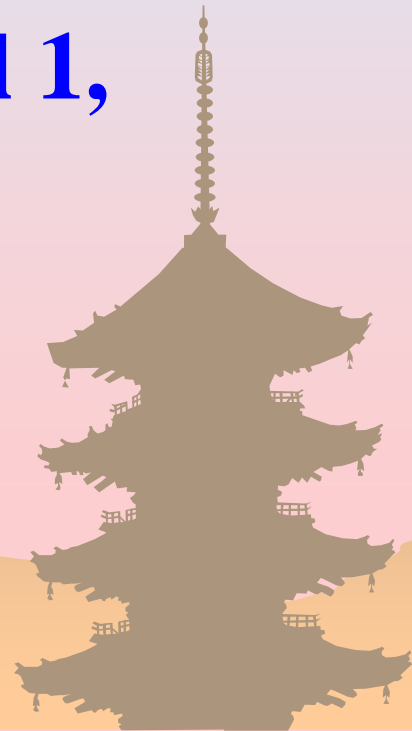
(1) Both Inventions before amendment and those after amendment shall meet the requirement of unity of invention;

(2) so called “**shift-amendment**” is **not allowed** (Technical feature of the invention shall not be changed beyond the scope of unity of invention through an amendment).



Effective Date

2006 Patent Revision is applied to **an application** (Not divisional, converted applications) filed **on or after April 1, 2007**.



Mandatory Explanation Document

When a divisional application is filed:

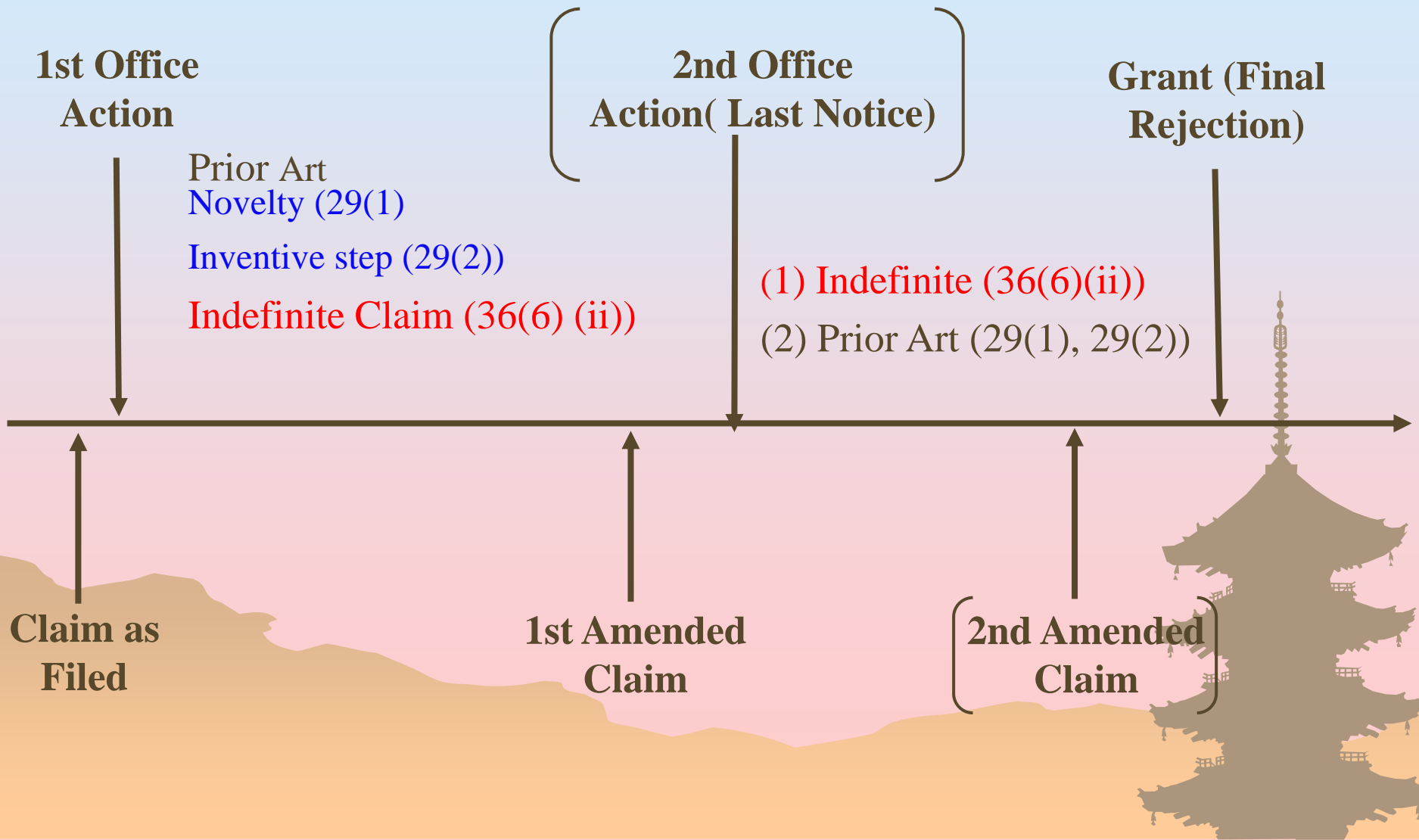
An applicant of the divisional application must file an explanation document in which;

(i) **changes** from the parent application should be **highlighted**, and

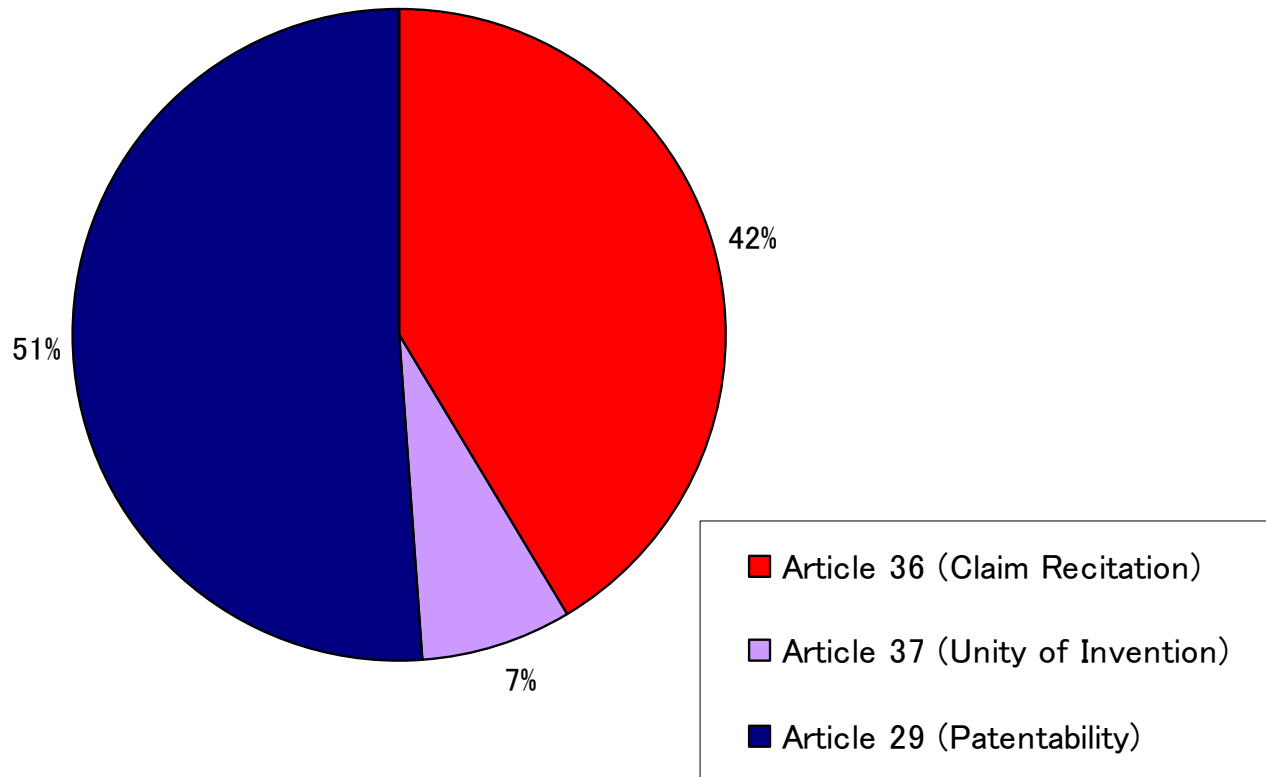
(ii) **support** of the disclosure for the changes and **the differences** from the claimed invention of the patent application **shall be clearly explained**.



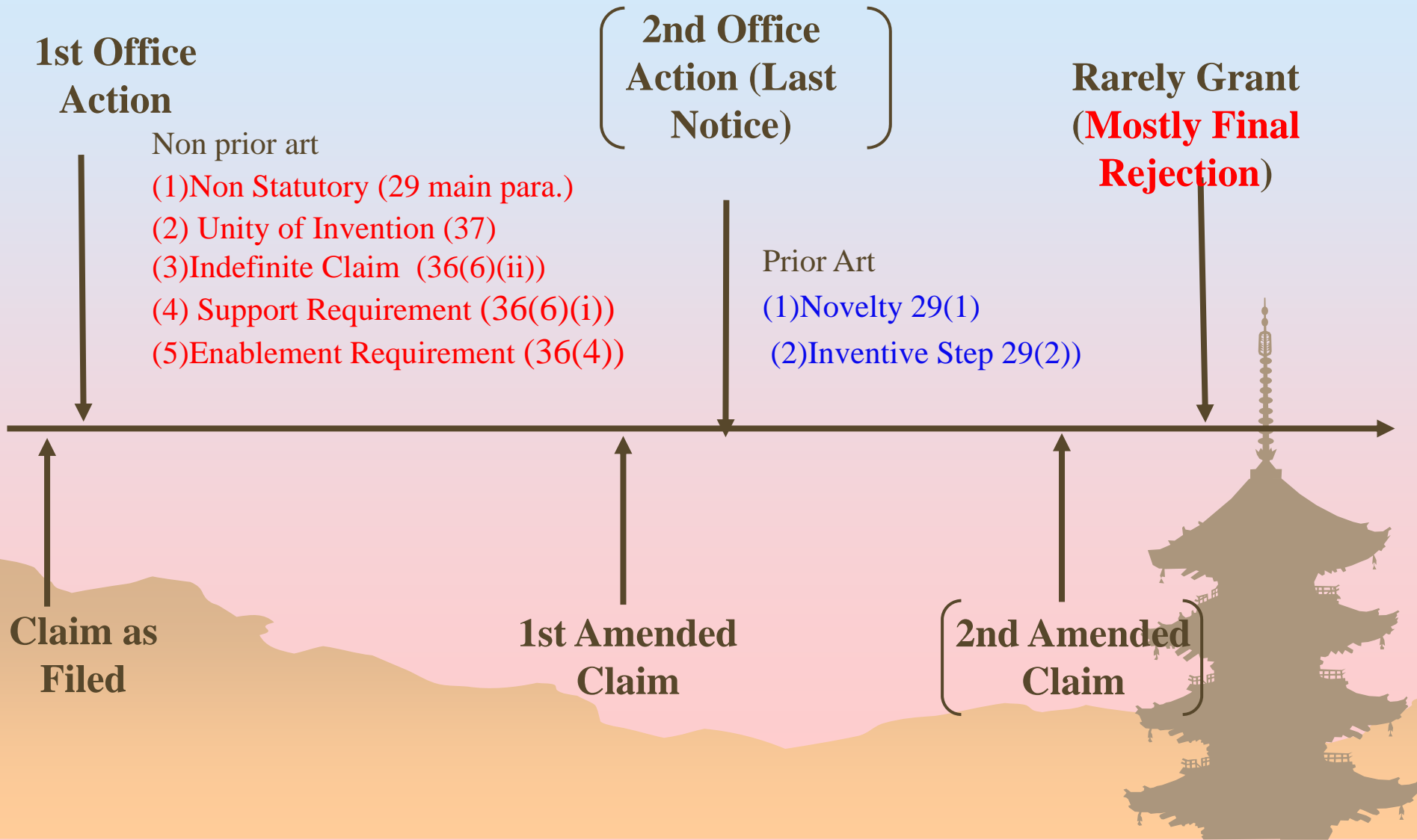
Typical Proceedings (Previous)



Ground of Rejection



Recent trend of Proceedings



Important Notice for the Examination Practice In Japan

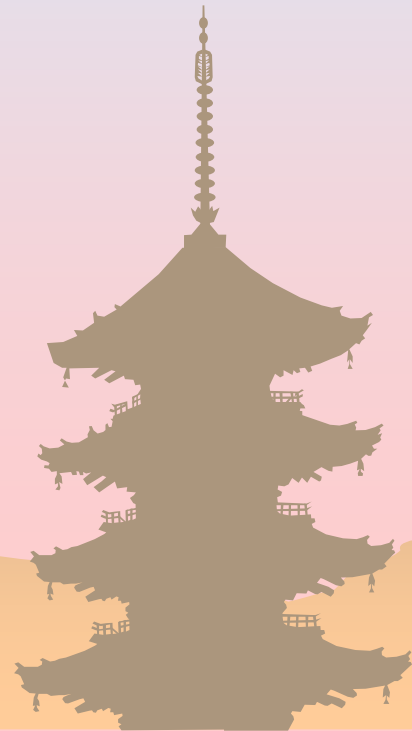
(1) Rejection based on the unity of invention (Article 37) is a part of substantive examination in Japan (No restriction requirement practice).

This means that the second action could be a final rejection (not a last notice of ground of rejection). No response can be filed other than an appeal against the examiner's final rejection. (A divisional application can be filed if the application is filed after April 1, 2007)

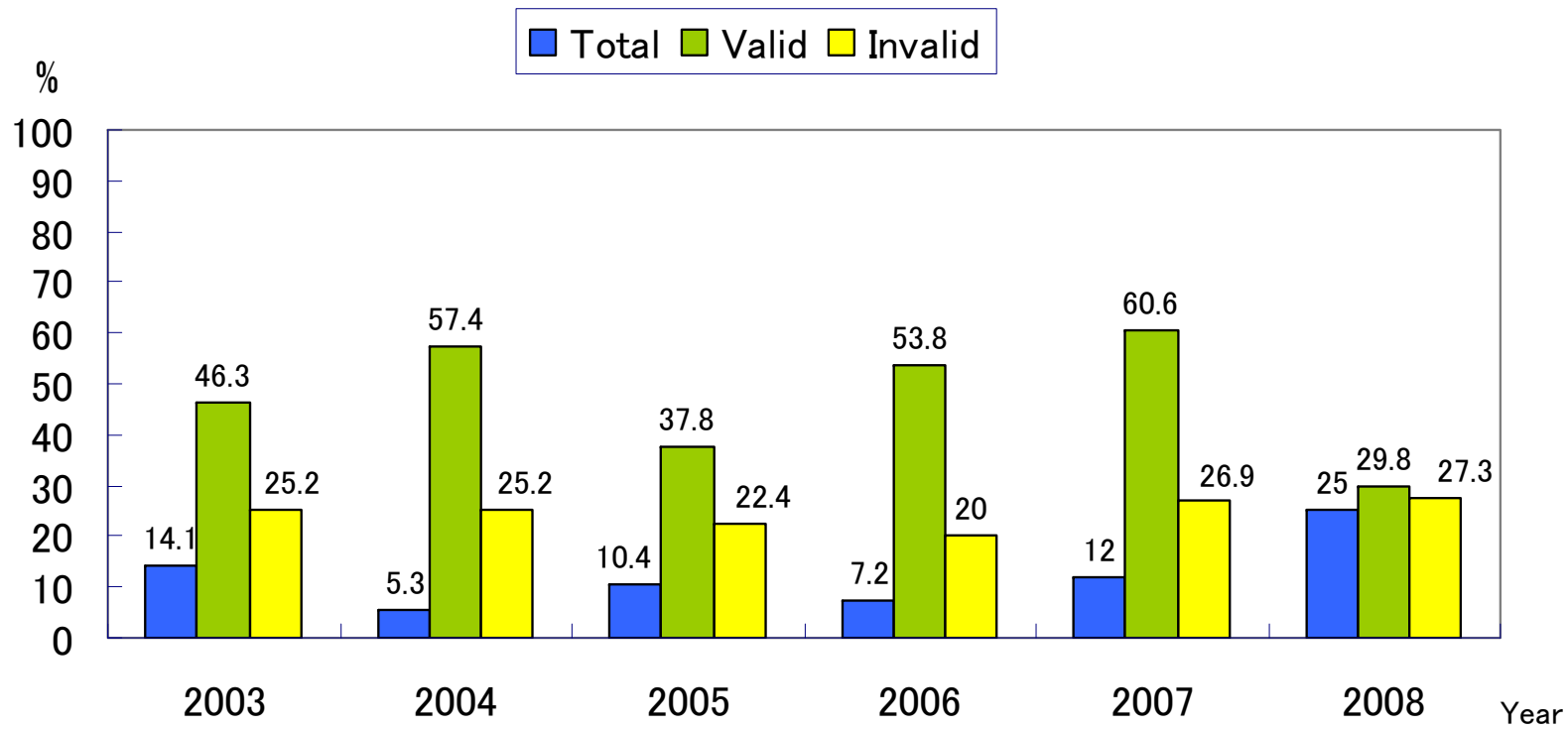
(2) The applicant should avoid the rejection based on the unity of invention in Japan. The claim set should be carefully reviewed at the filing of a request of examination.



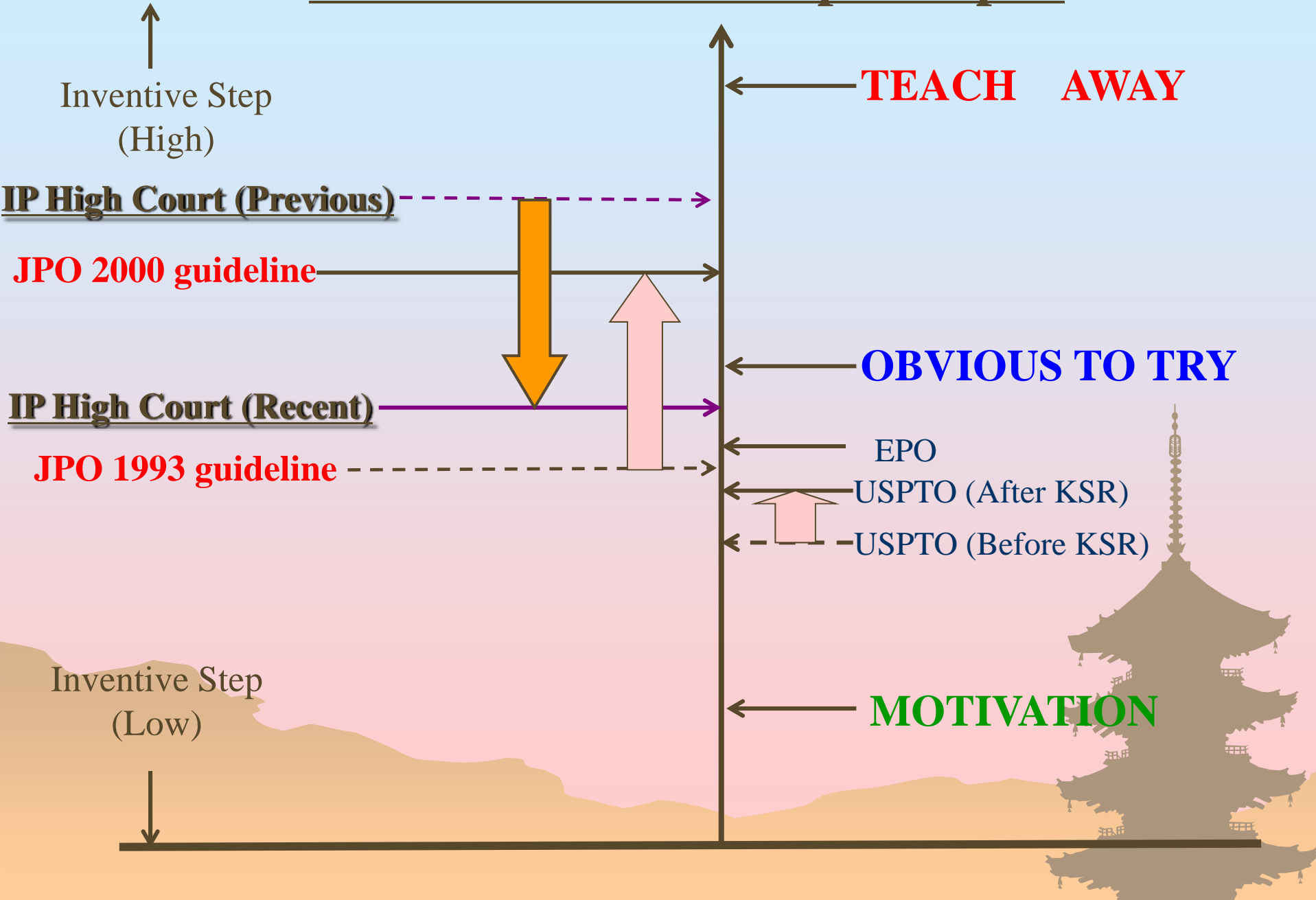
Level of Inventive Step



Dismissal Rate by Court of Validity Trial



Level of Inventive Step in Japan



Thank You

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