



# TIPS FOR IP PROSECUTIONS in Japan

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# TABLE OF CONTENTS

1. PART I GENERAL
2. PART I GENERAL (A) Specification
3. PART I GENERAL (B) Claims
4. PART I GENERAL (C) Examples
5. PART II AMENDMENT in Japan
6. PART III FULFILLMENT OF REGULATIONS
7. PART IV SUBSTANTIVE EXAMINATION in JPO
8. PART V RECENT TOPICS
9. TIPS FOR TRADEMARK PROSECUTIONS
10. INTELLECTUAL PROPERTY LITIGATIONS in Japan



# PART I GENERAL

## INVENTION IS A MEANS FOR SOLVING A PRIOR ART'S PROBLEM

In patent prosecutions, before  
Novelty, Inventive step, Description requirements  
(Enablement, Support requirements and Clarity),  
we should consider the above.



# PART I GENERAL (A)

## (A) Requirements for SPECIFICATION regarding the premise of "INVENTION IS..."

- In a specification, required is description such that the claimed invention can solve a **PRIOR ART'S PROBLEM**.
- When an inventor (applicant) files a patent application, the inventor has to know and describe a **prior art's problem** to be solved by the invention of the application.
- The inventor has to explicitly show the prior art's problem in the specification when one skilled in the art cannot recognize the problem.
- That is, "**LIMITATION BY INVENTOR'S RECOGNITION (before filing) theory.**"



# PART I GENERAL (A)

## (A) Requirements for SPECIFICATION (continued)

- Assertion after filing is not accepted when a problem is not explicitly or implicitly described in the original document and one skilled in the art cannot recognize the problem.
- In preparing a specification, please be aware the differences among;
  - (i) a problem that an inventor intends to solve (broad),
  - (ii) an effect essentially achieved by a claimed invention (middle) and
  - (iii) an effect achieved by one of claimed inventions (narrow).

# PART I GENERAL (B)


## (B) Requirements for a CLAIM regarding the premise of "INVENTION IS..."

- In a claim, a “means necessary for solving a PRIOR ART'S PROBLEM” should be described.
- A prior art's problem has to be solved by constitutional elements of a claim.
- Ideally, an objective problem are solved (=an objective effect is achieved) only by whole constitutional elements of a claim.


# PART I GENERAL (B)

## (B) Requirements for a CLAIM (continued)

### (i) Unnecessarily too narrow claim

Partial elements (A+B) of a claim (A+B+C) can solve a problem (achieve an objective effect).  Not able to prevent from other's conducting (A+B) to achieve the objective effect.

### (ii) Over-broaden or Unclear claim

Addition to element D to a claim (A+B+C) is necessary for solving a problem (over-broaden), or it is unclear whether the scope of a claim surely solves the problem (unclear and might be over-broaden).  Rejection

(based on Support or Enablement requirements, Unclearness)

# PART I GENERAL (C)

## (C) Requirements for EXAMPLES in general

- In order to show that claimed invention can solve an objective problem, a working example and result data is basically required.
- Usually, in mechanical or electrical field, when one skilled in the art can easily recognize an effect of constitutional elements described in the specification, thus an example sometimes can be omitted.





# PART I GENERAL (C)

## (C) Requirements for **EXAMPLES** in chemical inventions

(including pharmaceutical and biotechnology)

- Usually, characteristic feature of invention in chemistry is based on Unpredictable Effect of substance such as compound, composition, or genes.
  - (i) The "unpredictable effect" of known substance should be proved by a working example.
  - (ii) The effect of novel substance also should be proved by a working example because the effect is not known and unpredictable.

# PART I GENERAL (C)

## (C) Requirements for EXAMPLES in chemistry (continued)

(iii) In order to secure a broaden claim, an applicant should prove that scope of a claim can solve an objective problem, by showing one or more working examples.

- In summary, based on the specification, an expert in the art is necessarily able to recognize that the claimed scope can achieve the objective effect, thus usually one or more working examples are necessary for chemical invention.
- When an applicant failed to prove the above expert's recognition, scope of claims should be limited to example level (fatal in pharmaceuticals or biochemical field).

# PART I GENERAL (C)

## (C) Requirements for **EXAMPLES** in chemistry (continued)

### Common arguments by a chemical examiner

#### PREMISE

An invention is a means for solving a prior art's problem.

The problem should be solved within scope of a claim.

An effect other than experimental data is unpredictable.

As for the (rest) claim scope not covered by experimental data, it is unknown whether the objective problem can be solved or not.

# PART I GENERAL (C)

## (C) Requirements for **EXAMPLES** in chemistry (continued)

### Reasons for rejection

- (i) One skilled in the art needs undue trials and errors in order to examine whether the rest scope of a claim not covered by experimental data shows the objective effect or not. ➡ One skilled in the art cannot conduct the whole scope of the claim. (Violation of Enablement requirements)
- (ii) The rest claim scope not covered by experimental data is not supported by the specification. (Violation of Support requirements)
- (iii) It is unknown whether the objective problem can be solved or not in whole scope of the claim. (Unclearness)

# PART I GENERAL (C)

## (C) Requirements for **EXAMPLES** in chemistry (continued)

Possible means for overcoming the above reasons

- In a specification, it should be fully explained for one skilled in the art to recognize that the objective problem can be solved (= the objective effect can be achieved) in whole scope of the claim, preferably mentioning a name of literature, patent, textbook or book which discloses common technical knowledge necessary for the recognition.
- In a response, when an applicant needs claimed range not directly covered by experimental data originally described, the above explanation should be made more fully and in detail.

## PART II AMENDMENT IN JAPAN

- Amendment has to be within the description of claims and specification originally filed at the filing.
- Some examiners only accept an amendment using terms or phrases explicitly written in the original claims or specification. In chemical field, usually NO paraphrasing or extracting concept from the original claims or specification is allowed.

## PART II MY PERSONAL VIEWS

Under current Japanese patent system, a pioneer invention is insufficiently protected, especially in chemistry because examples sufficient for all applied range is difficult to prepare before filing.

- **APPLICATION:** Only claiming one year priority or Divisional application (No continuation application system)

After 1 year from the first filing date, a new application regarding invention based on new additional experimental data might be refused based on a publication of former application with original experimental data.

- **AMENDMENT:** Addition of new experimental data is never allowed.

## PART II

## MY PERSONAL VIEWS

- **SUBSTANTIVE EXAMINATION:** Only new additional experimental data supporting the data described in the original specification can be considered in examination.
- **GRANTED PATENT:** The scope of equivalence under Doctrine of Equivalence should be interpreted as narrow as possible, because Doctrine of Equivalence is an exception of standard claim interpretation.

➡ An experimental level claim usually does NOT have equivalence range, thus scope of claim not covered by experimental data (=the effect is unknown and unpredictable) cannot be protected.



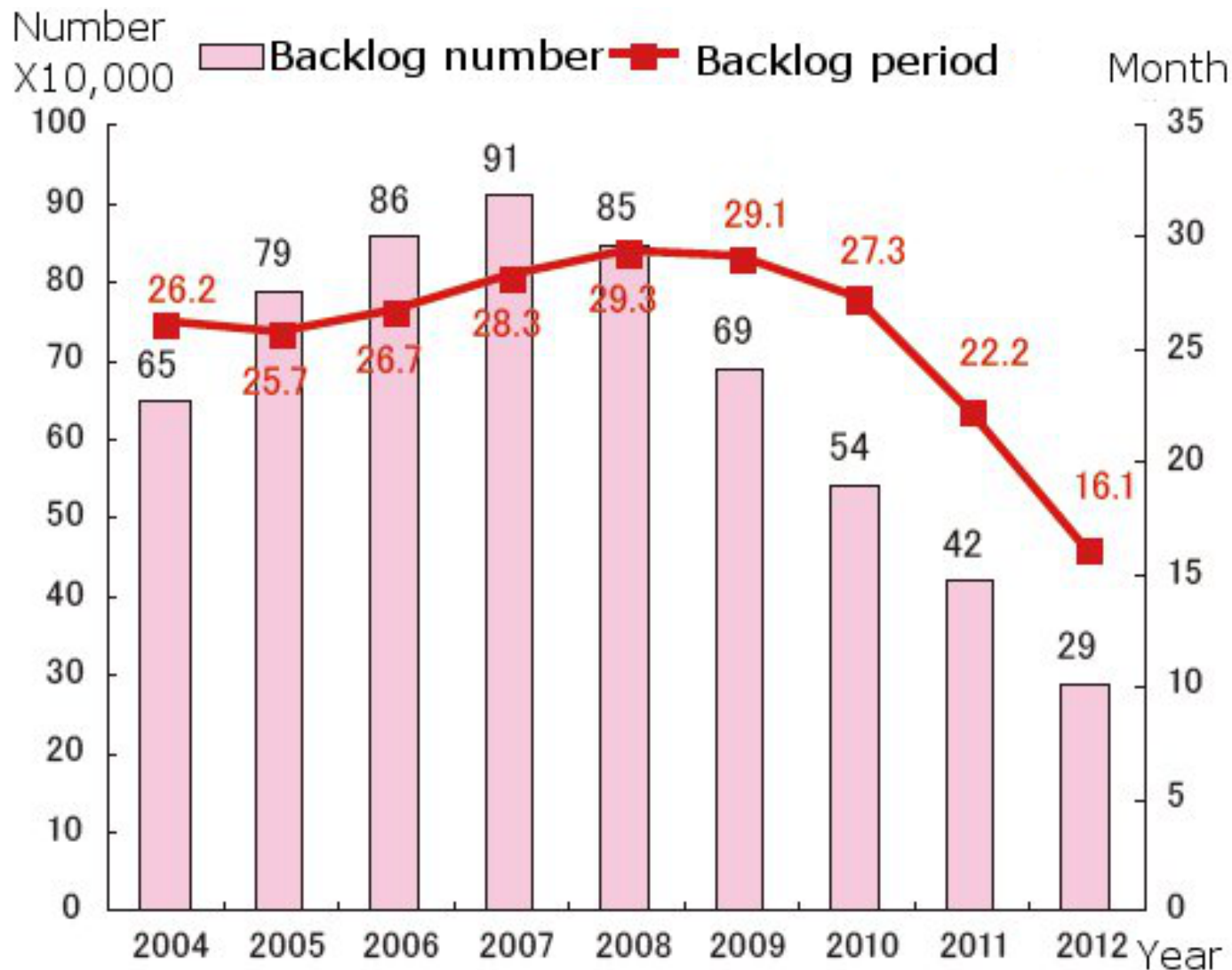
## PART III FULFILLMENT OF REGULATIONS

- Japan Patent Office (JPO) strictly requires fulfilling requirements of laws, rules, regulations and Examination Guidelines.
- Failure of fulfilling any of these regulations usually causes unfavorable results such as constructive withdrawal, abandonment of application, unnecessary official action, narrower scope of a patent accompanied with increased cost and elongated examination.
- A document or a request for extension of term must be received by JPO on or before the due date.

## PART IV SUBSTANTIVE EXAMINATION IN JPO

- In most technical field, searching for prior art is conducted by any of Japanese nonofficial companies designated by JPO.
- Examiners in biotechnology usually conduct searching by herself because this technical field is very specific and prior art materials are often non-patent and/or foreign language literatures.
- After conducting a search, a searcher has an interview with an examiner in charge and reports searching method and results thereof. If necessary, the examiner conducts research by himself and if any violation of requirements is found, an official action notifying reasons of refusal is issued.

# PART IV SUBSTANTIVE EXAMINATION IN JPO



BACKLOG NUMBERS AND PERIOD

# PART V RECENT TOPICS

## AMENDMENT after ISSUE OF SUBSTANTIVE OFFICIAL ACTION

- After July 1, 2013, an amendment after first official action should satisfy limitations such as (i) supported by originally filed document and (ii) within the scope where searching and examination has been conducted.

Inappropriate examples;

(A) Change of a claimed product to a method (vice versa)

(B-i) No relationship between the original objective problem and an objective problem after amendment

(B-ii) No relationship between the original characteristic features and characteristic features after amendment

(B-iii) Further searching is necessary because of amendment

## EXPECTED PATENT ACT AMENDMENT

Patent opposition system in which person who filed an opposition can be anonymous is going to be stipulated in next patent act amendment. (Old opposition system (after grant) was abolished in 2003 in Japan.)

# TIPS FOR TRADEMARK PROSECUTIONS

- (1) Designation of goods/services only having expectation of use at filing an application can be accepted.
- (2) Description of designated goods/services should be CLEAR such as materials, applied field, service network, market, user, etc. can be recognized. Usually, JPO examiners only accept designation of goods or services which have already been accepted for prior applications.
- (3) Names of goods/services described in a list of goods and services classified according to the Nice Classification can be designated. When an applicant want to designate goods/services not described in the list, it is preferable to ask for Japanese trademark attorney's advice.

# TIPS FOR TRADEMARK PROSECUTIONS

(4) When a number of Similarity Groups\* is 8 or more at filing, a proof showing use or intention of use is required.

\*Similarity Group: JPO assigned a similarity group code to a group of Goods and services that are presumed to be similar and to be categorized into one group.

(5) After filing, no goods/services can be added (No change or enlargement of designated goods/services in an amendment). ➡ Additional goods/services should be filed in a new application, registered and managed separately from original application.

(6) Official Fee is based on number of classes according to the Nice Classification.



# TIPS FOR TRADEMARK PROSECUTIONS

## (7) INTERNATIONAL TRADE MARK REGISTRATION under the Agreement adopted at Madrid

- JPO accepts an application or subsequent designation pursuant to the Madrid Protocol.
- When a Japanese substantive examiner finds reason for rejection regarding a subsequent designation, English official action is issued and sometimes the OA contains an amendment draft.
- When an applicant is not satisfied with the draft or no draft is described in the OA, he or she should ask for Japanese trademark attorney's advice.



# IP LITIGATIONS IN JAPAN

- Japan has the IP High court in Tokyo which is composed of the 1<sup>st</sup> to 4<sup>th</sup> Divisions and the 5<sup>th</sup> special Division (en banc).
- IP High court handles (1) suits against appeal (=trial) decisions made by JPO and (2) appeals from district court decisions on intellectual property.
- Some specialized divisions of the Tokyo District Court (4) and Osaka District Court (1) substantially functions as "patent courts",

For more details, see

<http://www.ip.courts.go.jp/documents/pdf/thesis/200505.pdf>

THANK YOU!



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