

## Differences of Arguments Over Japan and U.S. Office Actions



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## Inventive Step Requirement Is Stricter in Japan

### US --- Non Obviousness (35 USC 103)

“A patent may not be obtained ... if ... the subject matter as a whole would have been obvious.”

### JP --- Non Easiness (Art. 29.2)

“Where ... would have been able to easily make the invention ..., a patent shall not be granted.”

### Literally Stricter in Japan



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## Practical Differences in Japan

1. Motivation for combination is more easily found.
2. Rejected even w/o motivation.

**KSR Supreme Court decision is much closer to JP.**

(detailed in the following slides)



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## Motivation is more easily found in JP

For Example:

1. Cited references share a common object.
2. Technical fields of citations are related.  
(next slide)



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## A wide range of technical fields are found related in JP

**Slot machine and ball game machine**  
**No. Ke-103, Tokyo High Court, 1996**

**Camera and flash**  
**No. Ke-177, Tokyo High Court, 1980**

**Printing machine and mere ink supply system**  
**No. Ke-21, Tokyo High Court, 1996**



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## Rejected even w/o motivation, if the invention is one of the followings

1. Engineering design naturally carried out for a particular application
2. Addition of well known elements to the prior art
3. Combination of prior art with no new effect
4. Functions or effects of a claimed element and cited reference are the same.

Enough for the examiner to state one of the above.  
Then:



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## Burden of Proof Shifts to the Applicant

**Proof or explanation of the inventive step must be made.**

**Asserting lack of motivation does not work.**



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## Weak Argument in JP

**- Inoperability of Combined Invention**

**∴ The combined invention becomes operable by the following modifications, which are still considered easy.**

- (一) Engineering Design Naturally Carried Out for the Particular Application, and
- (ニ) Addition of Well Known Elements to the Combined Invention



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## Weak Argument in JP

**- Commercial Success**

**(1) Denied**

Ke-10488, IP High Court, Jan. 31, 2006, Ke-10380, IP High Court, Jan. 23, 2006,  
Ke-10069, IP High Court, Oct. 11, 2005, Ke-10037, IP High Court, Jun. 27, 2005,  
Ke-10101, IP High Court, Apr. 28, 2005, Ke-259, Tokyo High Court, Mar. 3, 2005,  
Ke-245, Tokyo High Court, Feb. 28, 2005, Ke-277, Tokyo High Court, Jan. 31, 2005,  
Ke-126, Tokyo High Court, Dec.27, 2004, Ke-326, Tokyo High Court, Jul. 29, 2005,  
Ke-175, Tokyo High Court, May. 31, 2005, and many others.

**(2) Affirmed**

Sho-36, pp373, Tokyo High Court, Sep. 18, 1962.



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## Weak Argument in JP

**- Long-standing Need or Problem**

**- Copied by Others**

**∴ The difficulties of the invention might be considered irrelevant.**



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## Weak Argument in JP

**- Critical Limitation, Proportions or Conditions in electrical/software fields**

**∴ Oftentimes not really critical in electrical/software fields, and considered to be an Engineering Design Naturally Carried Out for the Particular Application.**



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## Weak Argument in JP

**- Teaching Away**

**∴ Motivation can be found for other various reasons.**

**- Combination by Hindsight**

**∴ Mere Combination of Known Elements is considered easy.**



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## New Advantages of the Invention Are Essential in JP

### Unexpected Advantages

→ Considered for Non-Easiness (JPEP II 2.5(3))

### Advantages Already Provided by Any Citation

→ Not Considered (No. Ke-7, Tokyo High Court, 1969)

## New Advantages Can Be Argued Even When Not Originally Disclosed

US : Advantages Inherently Flow  
from the Original Disclosure ... OK  
(MPEP 716.02(f))

JP : Advantages That Can Be Understood  
from the Original Disclosure ... OK  
(No. Ke-198, Tokyo High Court,  
1997)

## Avoid explaining how advantages are obtained in too much detail

### Reasons:

1. The examiner considers that such details are not understood from the original disclosure
2. It leaves less file wrapper estoppel

## Find out problems that occur in practicing prior art inventions

If the same problem does not occur in practicing the present invention, this can be argued as an advantage of the present invention.

⇒ Explain the problems in detail and simplify the reasons why the problems are avoided in practicing the present invention.

## Advantages Are Important in JP Because of the Object of Patent Law.

“This law aims to contribute to the developments of industries by promoting the protection and utilization of the inventions, and thereby encouraging the inventions.” (Art. 1, Patent Law)

Inventors are not automatically protected by the constitution. The examiner watches for new advantages provided to the industries.

## Maximize interview opportunities in Japan

Explain effects of the invention at the interview and submit only an amendment.

Paper arguments estoppels in Japan as well, while amendment does not kill entire equivalence, unlike Festo in the US.

## Maximize interview opportunities in Japan

Telephone conference is well accepted and still, quite effective.

Fax him/her an amendment proposal beforehand.

Search by the examiner  
Learn how his/her OAs change by arguments.  
Effective for overcoming subject matter OAs.



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## Conclusion for overcoming OAs in JP

- New results of the invention are essential for overcoming “Non-easiness” rejection.
- Find problems in practicing prior art inventions.
- Create results that could be understood from the specification.
- Tell effects at the interviews.



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## Appendix 1: Common Portions Rejected in Both Countries:

**Selecting optimum or workable ranges that are not critical** (MPEP 2144.05, JPEP II 2.5(1))

**Combining equivalents known for the same purpose** (MPEP 2144.06, JPEP II 2.5(1))

**Selecting a known material based on its known suitability** (MPEP 2144.07, JPEP II 2.5(1))

JPEP: Japanese Patent Examination Guideline



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## about RYUKA

Despite the world recession, RYUKA presented a record number of patent applications in 2009. 264 patent applications in total were transferred to us from various major law firms during the course of the year.

The reason for this is our commitment to proactive communication. Proactive communication leads us to a deeper understanding of our clients, our own proposals, and our creative processes.

RYUKA will strive to learn more for the future contribution to our valued clients and society. If you need more information, contact us at:

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