

Prosecuting Software Inventions



March 5, 2010

Akihiro Ryuka
Confidential

Invention must be a creation of technical ideas utilizing law of nature. (JP Patent Law)

For example,

- : Controlling tangible objects
- ×: Method of playing games per se

Computer software inventions are:

- : if software cooperates with hardware.
- ×: if no technical creation is found.

2

Business Method and Software Inventions

Pure Business Method	NO
Software Inventions for New Business Method	YES, if: the software specifically cooperates with hardware (Japan Paten Examination Guidelines)
Suggestion	Recite cooperative relationships with hardware in claims. Include more specific cooperative relationships in the specification so that they can be recited in the claims after filing.

3

JPEG Example 3 (Not Acceptable)

[Claim2]

A service method for offering service points depending on an amount of commodity purchased at a shop on the Internet, comprising the steps of:

notifying an amount of service points offered and a name of a person to whom the said service points are offered via the Internet;

acquiring the e-mail address of the said person from a customer list storage means based on the name of the said person;

adding the said service points to the accumulated points of the said person stored in the said customer list storage means; and

notifying to the said person that the said service points have been given via e-mail using the e-mail address of the said person.

4

JPEG Example 4 (Acceptable)

[Claim 3]

A service method for offering service points depending on an amount of commodity purchased at a shop on the Internet, comprising the steps of:

notifying a server of an amount of service points offered and a name of the person to whom the said service points are offered via the Internet;

acquiring by said server, the e-mail address of the said person from a customer list storage means based on the name of the said person;

adding by said server, the said service points to the accumulated points of the said person stored in the said customer list storage means; and

notifying by said server, to the said person that the said service points have been given, by e-mail using the said e-mail address of the said person.

5

JPEG Example 5 (Not Acceptable)

[Claim 1]

A computerized card game machine, comprising:

means for assigning specific points of a score to a set of cards dealt, according to the complexity of the hand involved.

6

JPEG Example 6 (Acceptable)

[Claim 2]

A computerized card game machine, comprising:

means for memorizing a scoring hand data table in which a given set of cards is matched to specific scoring hand data, and a score data table in which the scoring hand data are matched to the score data;

means for assigning corresponding scoring hand data by retrieving said scoring hand data table based on a set of cards selected, assigning corresponding score data by retrieving the score data table on the basis of the applicable scoring hand data, and

outputting all of the scoring hand data and total points scored.

7

JPEG Example 1 (Not Acceptable)

[Claim 1]

A storing method of articles distributed via network, comprising the steps of:

receiving articles distributed via communication network;

displaying the said received articles;

checking if intended keywords exist in texts of the said articles by users, and if exist, giving "save" command to an article storing execution means; and

storing the said article given "save" command on the article storage means.

8

JPEG Example 2 (Acceptable)

[Claim 2]

A storing method of articles distributed via network, comprising the steps of:

receiving articles distributed via communication network;

displaying the received articles;

determining whether intended keywords exist in texts of the said articles by article storing determination means, and if exist, giving "save" command from the said determination means to an article storing execution means; and

storing the said article given "save" command on the article storage means.

9

Describing a computer block diagram to support future amendment in Japan

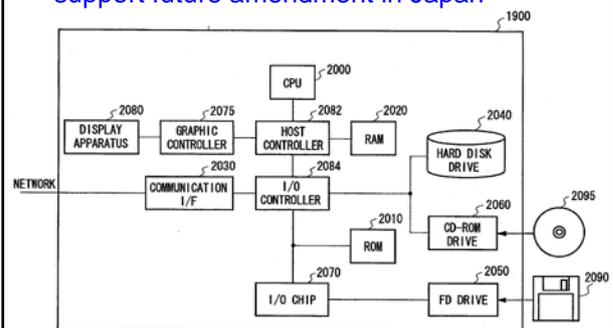


FIG. 4

10

Describing cooperation with hardware to support future amendment in Japan

[0050] CPU 2000 may read data files ---- from hard disk drive 2040, process them, and rewrite the files to hard disk drive 2040 again. Tables ----, and ---- data described in the embodiments can be read from hard disk drive 2040 and temporarily stored in RAM 2020 by CPU 2000. CPU 2000 may then read tables and data from RAM 2020, process them, and store them to RAM 2020 again. Graphic controller displays images created by CPU 2000 on display apparatus 2080.

11

Program and Medium Claims

	JP	Cf. US
Program per se	YES	NO
Computer readable medium	YES	YES
Suggestion	Rewrite Medium Claims ↓ Program Claims	Rewrite Program Claims ↓ Medium Claims

12

Forms of Program Claims

- A program which makes a computer execute procedure A, procedure B, procedure C, ...
- A program which makes a computer operate as means A, means B, means C, ...
- A program which makes a computer realize function A, function B, function C, ...

13

Forms of Storage Medium Claims

- A computer-readable storage medium having a program recorded thereon, where the program makes the computer execute procedure A, procedure B, procedure C, ...
- A computer-readable storage medium having a program recorded thereon, where the program makes the computer operate as means A, means B, means C, ...
- A computer-readable storage medium having a program recorded thereon, where the program makes the computer realize function A, function B, function C...

14

Claim Form of Storage Medium Having Structured Data

A computer-readable storage medium having data recorded thereon, where the data comprise data structure A, data structure B, data structure C, ...

15

For claiming programs / recording mediums in the future

[0052] Software programs are provided via recording mediums such as floppy disk 2090 and optical disk 2095. The programs are installed from the recording medium to hard disk drive 2040, and read out to RAM 2020 by CPU 2000. The programs are then read by CPU 2000 and make CPU 2000 execute all steps that were described in the specification referring to Figs -- and --.

16

Functional Claims

	JP	Cf. US	Cf. EP
Scope of Protection	Anything capable of realizing the function. (Although, the scope is often limited to what is disclosed in the specification.)	Limited to the embodiments disclosed in the specification and their equivalents only. 35 USC § 112, 6th paragraph	Anything capable of realizing the function.
Suggestion	Draft functional claims.	Consider adding structural claims that recite structural features.	Draft functional claims.

17

Multiple Dependencies

	JP	Cf. US	Cf. EP
Depending from multiple of multi-Dependent claims	YES Good for future amendments More possibilities to have dependent claims examined	NO	YES Good for future amendments More possibilities to have dependent claims examined
Single Multiple Dependency	YES Counted as one claim for the claim excess fee	YES, but: a surcharge of \$390 is required and each dependency is counted as one claim.	YES Counted as one claim for the claim excess fee

18

Excess Claim Fee

	JP	Cf. US	Cf. EP
Basic Fee Coverage	1 claim	3 independent claims, 20 claims in total	15 claims
Excess Claim Fee	4,000 JPY per claim (about 50 USD)	220 USD per independent claim 52 USD per claim	200 EURO per claim 500 EURO per claim from the 51st claim.
Suggestion	Consider claims depending from (i) multiple of multi-dependent claims.	Consider claims depending from (ii) a different category.	Consider claims depending from (i) multiple of multi-dependent claims, and (ii) a different category.

19

Claim Strategy for PCT Application

- Will enter into JP
→ Adopt JP style
- Will NOT enter into JP, but will enter into EP
→ Adopt EP style
- Will NOT enter into JP or EP, will enter into US
→ Adopt US style

Claim amendments are accepted with less difficulty in JP→EP→US, than the reverse US→EP→JP.

20

Thank you very much.

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 lean more for the future contribution to our valued clients and society.



www.ryuka.com