

Six Common Mistakes in Japanese Patent Filings



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Six Common Mistakes in Japanese Patent Filings

<Claims>

1. "Mere method claims" for forming a product
2. Limitations only by names of claimed subject and elements
3. Single dependent claims

<Specification>

4. Detailed prior art
5. Detailed objects, summary, and effects of the invention
6. Words, "the invention" and "the present invention"

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Mistake 1: "Mere method claims" for forming a product

Ex. "Method for grinding a glass surface"

Suggestion: **Adopt "Method for making" claims.**

Benefit of "Method for Making" Claims:

Claim scope extends to the final products.

Selling and using the final products infringe patents.

Cf. Mere method Claims:

Only "using the method" infringes the patent.

It used in a foreign country, no infringement.

Better to try, even when chances are small.

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Decisions of "Method for making" claims

1. H16(Ne)4518 (Tokyo High Court, Feb 24, 2005)

"The invention is directed to a Cutting Method of Street Manhole, which is a cutting method, but not a method for making a product"

2. H15(Wa)860 (Osaka District Court, April 27, 2004)

"To be qualified as a product, which is to be made by a method for making, the product should be separately sold" "The claimed subject is only a part of a product, and therefore, claim is not considered as a method for making a particular product."

3. H13(Wa)3764 (Tokyo District Court, November 26, 2003)

"A method of making claim should change chemical or physical characteristics or forms"

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Suggestions for "Method for Making" Claims.

1. Explicitly say "method for making/producing (product)"
2. The product to be made should not be a part of an object.
→ Could be considered as mere method for forming/changing.
3. The product must have been changed.
Not enough: covering a wafer by resist, exposing the resist, and etching the resist.
Sufficient: further etching the wafer.

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Mistake 2: Limitation only by "name" of the claimed subject

Ex. "Secondary Battery," where elements of the top claim can be any battery.

Suggestion: **Add requisite elements for accomplishing the subject,**

or

Broaden the name of the claimed subject.

In determining inventive step, limiting by name of claimed subject does not help a lot

In infringement litigation, it limits the scope of claims.

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Limitation only by name of claim element: Not suggested as well

Ex. “carrier” which does not carry anything in claim language.

**Suggestion: Add explanation for being the named element, or
Broaden the name of claimed element.**

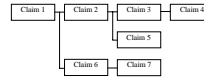
In determining inventive step, limiting by name of claimed element does not always help, for vagueness.

In infringement litigation, meaning of the element is narrowly construed in reference to the specification.

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Mistake 3: Single dependencies

Only claims depending from “STF claim” are examined.



Special technical feature (STF) was found in claim:	Claims to be examined
1	1~7
2	1~5
3	1~4
4	1~4
Not Found	1~4

To increase a chance to be examined,
Claim 5 should depend from claims 3 and 4 as well.
Claims 6 and 7 should depend from claims 2 to 5 as well.

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Drafting multiple dependent claims

Suggestion:

Each claim should depend from all possible claims.

What about PCT Application to be entered into JP or EP

Suggestion: JP/EP Style

Depending from multiple of multiple-dependent claims,
because adding dependencies later may introduce a new matter.

What about PCT to be entered into US as well.

Suggestion:

File a continuation from PCT and amend claims at the entry.

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Mistake 4: Detailed prior art

Anything explained in “Prior Art” section is deemed not a part of his invention.

- Cannot be used in amendment.
- Descriptions in “Prior Art” limit claimed scope.
- More description, more limited.

If problems of prior art are discussed, the invention is construed not to have the same problems.

- Descriptions of prior art problem limit claimed scope.

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Descriptions of Prior Art

Suggestion:

1. **Move discussions and explanations of prior art into embodiment.**
2. **Discuss and explain them as a part of your invention or an alternative solution.**
3. **In the prior art section, merely say:**
Ex. Abstract of 2001-12345 says that “(cited sentences).”
(No admission is made.)
Cf. In ****, it is disclosed that *****.
(Applicant’s admission is made)

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Mistake 5: Detailed Objects, Summary, and Effects of the invention

Anything written in those sections limit the scope of the inventions, since:

**Objects of the invention,
Summary of the invention, and
Effects of the invention**

mean:

those of the claimed invention.

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Decisions that limited claims in reference to Objects, Summary, and Effects of the invention

1. Tokyo District Court, H10(wa)30302

Claimed phrase, “lower portion” was limited in reference to the explanation made in Effect of the Invention section.

2. Osaka District Court, H08(wa)13483

Claimed phrase, “natural stone” was limited in reference to the explanation in Object of the Invention section.

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Drafting Objects, Summary, and Effects of the invention

Suggestion:

Write minimum in the following sections.

Objects of the invention

Summary of the invention

Effects of the invention

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Mistake 6: Saying “the invention” or “the present invention” in preferred embodiment

“The invention” or “the present invention” means claimed invention.

Ex. According to the present invention, (effect) is achieved.
→ Claimed inventions are construed to achieve the effect.

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Avoiding “the invention” and “the present invention”

Suggestion: Avoid saying “the invention” or “the present invention.” (本発明)

Ex. According to the first embodiment, is achieved.
→ Does not necessarily limit claims.

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