

Supreme Court of Japan decided on Product-by-Process Claims

What should we do?

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The Supreme Court interpreted product-by-process (PBP) claims broadly *

“The scope of PBP claims extends to actual products that have the same or equivalent elements or characteristics as products that are made by the claimed process, **irrespective of how the actual products were made.**”

* Sup. Ct. June 5, 2015

PBP Claims have broader scope in Japan than in the US

In the US, the scope of PBP claims is limited to products that are made by the recited process.*

This limitation does not apply in Japan.

* *Abbott Labs v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009, en banc), certiorari denied.

However, the Court also said that PBP claims are often invalid for lack of clarity

“It is generally more difficult to understand the elements or characteristics of products, if the products are defined by a process. Therefore, PBP claims should be found invalid for lack of clarity unless it was impossible or impractical to define the product by its elements or characteristics at the time the application was filed.”

⇒ PBP claims can be often invalid
in semiconductor fields

It is considered impractical, if it is very costly or it takes a long time

“It is considered impractical to define a product by its elements or characteristics, if it is very costly or it takes a long time to, for example, analyze the structure or characteristics of the product, in view of the time constraints of filing a patent application.”

⇒ PBP claims can still be valid
in life science and chemistry fields

What should we do? We suggest “method for making” claims

- If patentable elements or characteristics of the products are understood, those should be recited in claims.
- If patentable elements or characteristics of the products are NOT understood, we suggest drafting “method for making” claims (as well as PBP claims).

Scope of “method for making” claims extend to the products

- Importing, selling and using the products infringe patents, even if the products were made in a foreign country.*

cf. Mere method claims:

- Only “using the method” infringes the patent.
- If the product is made in a foreign country, no infringement

* See H15(Wa)14687 (Tokyo D. Ct., May 28, 2004)
S45(Wa)7935 (Tokyo D. Ct., November 26, 1970)

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However, process claims are often NOT considered as “method for making” claims

“The invention is directed to a **cutting method** of a street manhole, which is a cutting method, but not a method for making a product”
H16(Ne)4518 (Tokyo High Court, Feb 24, 2005)

“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.”

H15(Wa)860 (Osaka D. Ct., April 27, 2004)

“A method of making claim **should change** chemical or physical characteristics or forms”

H13(Wa)3764 (Tokyo D. Ct., November 26, 2003)

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Suggestions for being considered as “method for making” claims

Explicitly say “**method for making/producing** a product.”

The product to be made should **not be a part of an object**.

→ Could be considered as mere method for forming or changing something.

The product must **be changed**.

Not enough: A method for making a wafer, comprising:
covering a wafer by resist,
exposing the resist, and
etching the resist.

Sufficient: further etching the wafer.

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What should we do for maintaining PBP claims?

- Based on the Supreme Court decision, PBP claims will be rejected and/or invalidated
- We must prove that it was **impossible or impractical** to define the product by its elements or characteristics.
⇒ **Preserve evidences** such as inventor’s declarations
- Then, we could argue that it was impractical because defining the product by its elements or characteristics **would have delayed the filing date**, which had to be avoided in view of filing competition.

What should we do when an allowance is issued

- The examination procedure of PBP claims must be changed.
- However, the examiner may not apply the new procedure, if the substantial examination has already been carried out.
⇒ PBP claims **can be inadvertently allowed** for a while

We suggest reviewing the allowed claims and filing a divisional application if necessary.

What should we do when PBP claims are asserted to you?

- The validity of the claims must be evaluated in view of the Supreme Court decision.
- If it was possible and practical to claim the elements or characteristics of the product, an **invalidation trial** can be requested at the JPO
- It takes only 10 months and is inexpensive.



What should we do when your PBP claims are challenged ?

- The patent owner can limit the scope of issued claims by requesting a **correction trial**, although cannot shift or enlarge the scope.
- Correction takes only 3 months and is inexpensive.
- In the correction (trial), the patent owner can add elements or characteristics of the products to the claims, provided the specification supports the amendments.



THANK YOU!

If you have any questions, please let us know.

We always **enjoy** discussing legal issues with foreign associates. No fee

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