

在亚洲申请专利的 10项建议

10 Suggestions on
Patent Prosecutions in Asia

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with Free Vision

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权利要求

Claims

可接受的从属权利要求 在不同的法域有所不同

Acceptable Dependencies Are Different by Jurisdictions

允许多项从属权利要求引用多项从属权利要求(多项引多项):

欧洲专利、欧洲国家、澳大利亚、新西兰、加拿大

Multiple-dependent claims from other multiple-dependent claims (Multi-Multi) are accepted:

EP, European Countries, AU, NZ, CA

建议单项从属:

美国

Single dependency is suggested

US

允许单层的多项从属:

日本、中国、韩国、台湾等

Single layer of multiple dependencies is accepted:

JP, CN, KR, TW etc.

通过PCT进入各国时, 修改是无法避免的,
那么最初的PCT申请应该如何撰写呢?

Anyway, we need amendments at the entries from PCT.
How shall we start when filing a PCT application?

建议 1: 在美国提交PCT时, 采用单层的多项从属, 或是将欧洲专利局选为国际检索单位, 进而采用多项引多项的模式 (参照MPEP1824.6.4)

Suggestion 1: In PCT in the US, adopting single layer of multiple dependencies, or multi-multi via ISA-EPO (MPEP1824.6.4)

事后增加从属权利要求, 会比减少更为困难

Later adding dependencies is more difficult than reducing them.

欧洲专利局: 不允许新增从属关系(新的合并行为)

EPO: May not accept addition of dependency (new combination).

中国、韩国: 1. 多项引多项的权利要求会被驳回,

但仍然会对创造性要件进行审查

⇒ 可以先观察现有技术, 再对从属权利要求进行选择

2. 在中国, 一定会发来审查意见通知(韩国也类似)

⇒ 宁愿收到较为简单的审查意见通知

CN, KR: 1. Multi-Multi claims are objected, but still examined about inventive step. ⇒ Can choose dependencies after seeing prior art.
2. One office action is always issued in CN (similar in KR). ⇒ Better to receive an easier office action

中国、德国: PCT阶段的权利要求的数量, 会影响审查费用

CN, DE: Claim number at PCT stage changes examination fees

美国: 在进入美国时, 能够通过PCT继续申请(旁路申请)的方式, 轻易变更权利要求的从属关系

US: Claim dependencies can be easily changed at the entry via continuation from PCT application (bypass application).

建议 2: 申请日本和欧洲专利时, 将针对存储介质的权利要求转换为针对计算机程序的权利要求

Suggestion 2: Converting Medium Claims to Program Claims in JP and EP

权利要求的对象 Claim Subject	日、欧、台 JP, EP, TW	美、韩、中 US, KR, CN
以功能定义的计算机程序 Programs defined by its functions	允许 YES	不允许 NO
记录了计算机程序的存储或录制介质 Memory or recording medium storing program	可接受 Acceptable	允许 YES

∴ 通过互联网销售计算机程序的行为：
直接侵犯计算机程序的权利，但不直接侵犯介质的权利

∴ Selling program over the Internet:
directly infringes program claims, but not medium claims.

计算机程序的权利要求的形式

日本专利审查指南

Forms of Program Claims

- 该程序能够让计算机
实施程序 A, B ...
(运行装置 A, B .../实现功能 A, B ...)

Japan Patent Examination Guideline (“JPEG”)

- A program which causes a computer to
carry out procedures A, B ...
(operate as means A, B ... / realize functions A, B ...)

对照：欧洲专利局审查指南

- 该计算机程序构成了一组指令，计算机执行这组指令时，会
实施步骤A, B ...
(权利要求1中的方法)

欧洲专利局的模式在日本也可通用。

Cf. EPO Guideline for Examination

- A computer program comprising instructions which, when executed by a computer, cause the computer to carry out steps A, B, ...
(the method as claimed in claim 1.)

EPO style is also acceptable in Japan.

在进入日本的PCT申请中 支持计算机程序的权利要求

Supporting program claims in PCT applications for the entry to JPO

在基于优先权的申请、PCT的申请中，至少要包含如下这样的标准描述

[0052] 通过网络2010提供软件程序，由中央处理器2000将其安装至闪存2040，并读取至内存2020。随后，该软件程序会由中央处理器2000进行读取，并且要求中央处理器2000执行本说明书参照附图--和--所描述的所有步骤。

Include at least standard descriptions such as below in the Priority base and PCT applications.

[0052] Software programs are provided via a network 2010, installed to flash memory 2040, and read out to RAM 2020 by CPU 2000. The software programs are then read by the CPU 2000 and make the CPU 2000 execute all steps that are described in this specification with reference to Figs -- and --.

建议 3: 撰写装置(步骤)+功能

Suggestion 3: Drafting means(step) + function

	日、韩、欧洲专利 JP, KR, EP	美国 US
保护范围 Scope of Protection	<p>能够实现功能的一切对象都受保护。 (然而日本会参照说明书, 对不明确的语句进行解释, 并且往往会缩小其范围)</p> <p>Anything capable of realizing the function. (Although unclear words are construed in reference to the specification and often limited in Japan)</p>	<p>仅限于说明书中公开的实施方式, 或与其同等的对象才能受到保护。 Williamson v. Citrix Online, LLC, 792 F.3d 1339 (Fed. Cir. 2015)(en banc), 35 USC 112(f)</p> <p>Limited to the embodiments disclosed in the specification and their equivalents only.</p>
建议 (两者都做) Suggestions (Do both)	撰写功能型权利要求 Draft functional claims	撰写结构型权利要求, 对结构特征进行描述 Draft structural claims that recite structural features.

建议 4: 在日本, 将权利要求转换为“产品生产方法”

Suggestion 4: Converting to “Method for Making” claims in JP

例: “研磨玻璃表面的方法”, 或“焊接的方法”

→ 采用“产品生产方法”的权利要求。

- 权利范围得以扩展到通过以上方法制造的产品。
- 即使上述产品生产于国外, 进口、销售、使用这些产品也会侵犯专利权。

H15(Wa)14687 (Tokyo District Court, May 28, 2004)

S45(Wa)7935 (Tokyo District Court, November 26, 1970)

Ex. “Method for grinding a glass surface,” or “Method for welding”

→ Adopt “Method for making” claims.

- Claim scope extends to the products made by the methods.
- Importing, selling and using the products infringe patents, even if the products were made in a foreign country.

对照: 单纯方法的权利要求:

- 只有“使用该方法”才会侵犯专利权。
- 如果产品生产于国外, 将不会构成侵权

Cf. Mere method Claims:

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

然而，以过程界定产品的权利要求， 往往不被认可为“产品生产方法”

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

“该发明的对象是一种**切割井盖的方法**，属于切割方法，而非产品生产方法”

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

“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”

“由产品生产方法制造出的所谓产品，必须能够单独进行销售”“本案权利要求中所主张的，**仅仅是产品的一部分**，因此该权利要求不属于生产特定产品的方法”

H15(Wa)860 (Osaka D. Ct., 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.”

“产品生产方法的权利要求，应当导致化学或物理上的特性或形态**发生改变**”

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

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

关于如何构成“产品生产方法”的建议

Suggestions for being considered as “method for making” claims

明确将其称为“**制造/生产产品的方法**”

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

生产出的产品**不应是物品的一部分**

→ 否则可能会被认为是使物体成型或改变的单纯方法

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

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

产品必须**发生改变**。

反面例子：一种制造晶圆的方法，包括下述步骤：

用抗蚀剂覆盖晶圆，
曝光该抗蚀剂，并且
蚀刻该抗蚀剂。

正面例子：进一步蚀刻该晶圆。

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.

申请手续

Prosecution

建议5: 简化指示, 从而减少内部费用

Suggestion 5: Simplifying instructions for reducing your internal fees

在PCT进入国家阶段, 我们只需要:
PCT申请号,
英语文本, 用于降低翻译费用

For PCT national entry, we only need:

PCT application number, and

English text, for lowering translation fee

通过巴黎公约途径申请时, 只需向我们提供一份美国的转让协议复印件, 我们便能得知申请人和发明人的信息

For Paris route, the applicant and inventor information can be supplied by sending us:

a copy of the US assignment

建议6：省去对审查意见通知的人工翻译

Suggestion 6: Omitting human translation of office actions

RYUKA: 提供意见, 并附上全球专利案卷系统的翻译链接

顾客: 只有在必要时, 才需要委托人工翻译审查意见通知

RYUKA: Provide comments with a link to Global Dossier Translation

Clients: Request human translation of OAs, only if necessary

全球专利案卷系统的翻译:

日本: 审查意见通知的当天

中国: 2个月内 (第一次审查意见通知有长达4个月的答复期限)

Global Dossier Translation:

JP: Same day as OA

CN: In two months (Response to 1st OA has four months)

如此一来, 可以节省 (占总费用的20%~50%的) 人工翻译费

Human translation fee (20 to 50 percent of total fee) is saved

建议7: 现有申请被在后申请所引用时, 可以考虑提出分案申请

Suggestion 7: Considering a divisional application, if cited to a later filed application

- 于在后申请中原始提出的权利要求, 可能会被现有申请所公开
⇒ 可以考虑对相同的内容提出权利要求
 - The present application may disclose what a later applicant originally claimed.
⇒ Consider claiming the same.
- 在后申请中的实施方式, 可能会透露相关的产品规划
⇒ 可以考虑将这些实施方式也纳入权利要求之中
 - The embodiment of the later filed application may indicate their product plan.
⇒ Consider claims covering their embodiment.

在获得专利授权之后, 我们会针对那些引用了您的专利的在后申请进行调查。

Upon receiving an allowance, we search later applications to which your application has been cited.

在美国也通用的建议

Suggestions common in the USA

建议8: 为软件发明提供支持

Suggestion 8. Supporting software inventions

	常见的建议 General Suggestions	RYUKA的建议 RYUKA Suggestions
日 韩 JP KR	在权利要求中写明软件与硬件的 协作关系 Write cooperative relationships with hardware in claims.	写明左侧所有的项目，并且避免提及与人类活动、经济、游戏、心理相关的问题和语句。 Write all of left and avoid writing problems and claim words that exist in human activities, economics, games and psychologies.
美 US	明确说明软件的具体应用、 显著优势 、及其原因 Make clear specific application and what is significantly more and why	
欧 中 EPO CN	明确说明权利要求中的要素如何 有利于解决技术问题 Make clear how claimed elements contribute solving technical problems .	

为日本的软件发明的修改提供支持

Supporting amendments of software inventions in Japan

1. 即使只是一台普通的电脑或手机，也要对诸如存储器、内存等硬件进行描述。

1. Describe hardware such as storages and memories, even if the hardware is a typical PC or cell phone.

2. 写明软件将会如何使用表格、数据库、或者临时数据。

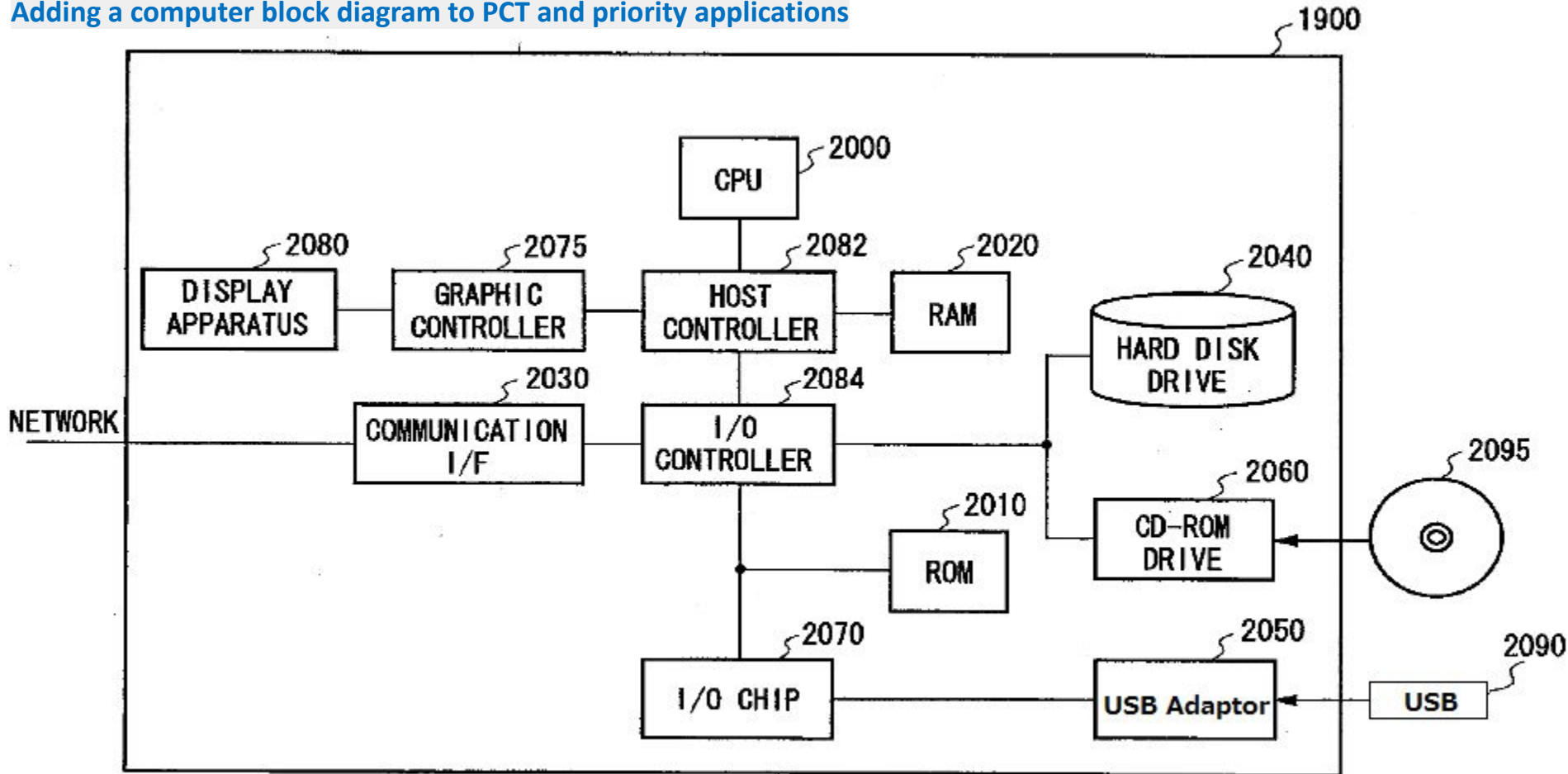
2. Describe how software uses tables, databases or temporary data.

3. 写明表格、数据库等等都会被保存在存储器或内存之中。

3. Describe that the tables, databases, etc. are stored in a storage or memory.

在PCT和优先权的申请中加入电脑结构的模块图

Adding a computer block diagram to PCT and priority applications



在PCT和优先权的申请中描述软件与硬件的协作关系

Describing cooperative relationships with hardware in PCT and priority applications

仅仅是下面这样的简单描述，就能在日本起到一定的积极作用(但还不够理想)。

A simple description like below may still help in JP in some degree. (although not ideal).

[0050]中央处理器2000能够从硬盘2040中读取实施方式中所描述的表格---和---，数据/信息---和---，并且将其暂时储存在内存2020中。随后，中央处理器2000便能从内存2020中读取表格---和---，数据/信息---和---，对其进行处理，并将其再次存入内存2020。

[0050] Tables --- and --- , and data/information --- and --- 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 --- and data/information --- and --- from RAM 2020, process them, and store them to RAM 2020 again.

建议9: 把针对现有技术的论述放到实施方式的板块

Suggestion 9: Move discussions of prior art into the embodiment

- 把通用技术作为您的发明的一部分进行论述
- 把不同的技术作为一种代替方案进行论述

- Discuss general technologies as a part of your invention.

- Discuss different technologies as an alternative solution.

而在现有技术的板块, 只需进行如下记载:

例: 2001-12345的摘要中写到“(引用语句)。”

(没有申请专利)

对照: ****中, 对*****进行了披露。

(申请人对此申请了专利)

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)

无需列出所有的已知文献。两到三项就已经足够。

Not all known references are required. Two or three are enough.

原因:

Reasons:

但凡是在“现有技术”板块中说明的内容，都会被认定为不属于本发明

- “现有技术”中的记载，会缩小权利主张的范围
- 在现有技术说明的基础上做的修改，不利于推动创造性要件的认定
- 越说明，越受限

Anything explained in “Prior Art” section is assumed not a part of the present invention.

- Descriptions in “Prior Art” limit claimed scope.
- Amendments that base on descriptions in prior art section are not persuasive for asserting inventive step.
- More description, more limited.

如果对现有技术的问题进行了论述，通常会认为本发明中不复存在相同的问题

- 对现有技术问题的说明，会缩小权利主张的范围

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

- Descriptions of prior art problem limit claimed scope.

建议10: 不要就发明的目的、概要、 效果展开详细说明

Suggestion 10: Avoid Detailed Objects, Summary, and Effects of the invention

上述板块中的一切内容都会缩小发明的范围, 因为:

发明的目的、
发明的概要、
发明的效果

都与:

发明的权利要求紧密关联

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.

“发明的***”板块中的一切语句， 都会缩小权利要求的范围

Languages in section, “*** of the Invention” limit the scope of claims

1. Tokyo District Court, H10(wa)30302

本案参照发明的效果板块中的说明，对权利要求中的“下部”一词进行了缩小解释

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

本案参照发明的目的板块中的说明，对权利要求中的“天然石材”一词进行了缩小解释

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

不要用“该发明”&“本发明”等说法

Avoid saying “the invention” & “the present invention”

这些语句都影响着发明的权利范围

Those mean claimed invention.

例：通过本发明，可以实现（某种效果）。

→ 发明的权利范围会被解释为必须实现这种效果。

Ex. According to the present invention, (effect) is achieved.

→ Claimed inventions are construed to achieve the effect.

建议：

通过第一个实施方式，……效果得以实现。

→ 不一定会缩小权利范围。

Suggestion:

According to the first embodiment, is achieved.

→ Does not necessarily limit claims.

感谢聆听

Thank you

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即将在2023年迎来25周年纪念。
拥有代理人44名，
工作人员总数达100名。

about us:

Celebrate 25th year in 2023.

44 attorneys, 100 in total



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