

10 Suggestions for Patent Prosecutions in Japan Extracted from Our Practice



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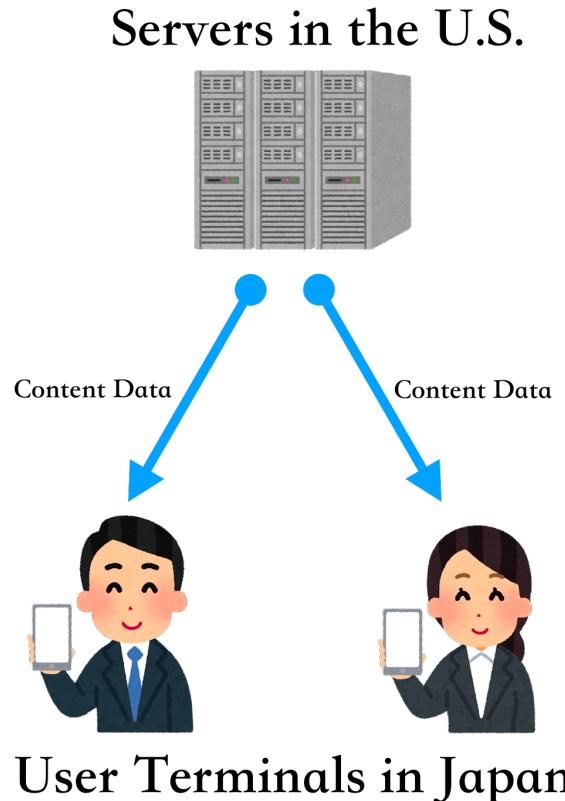
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Four Suggestions for Claims

Suggestion 1:

Claiming a system having a web server and a terminal

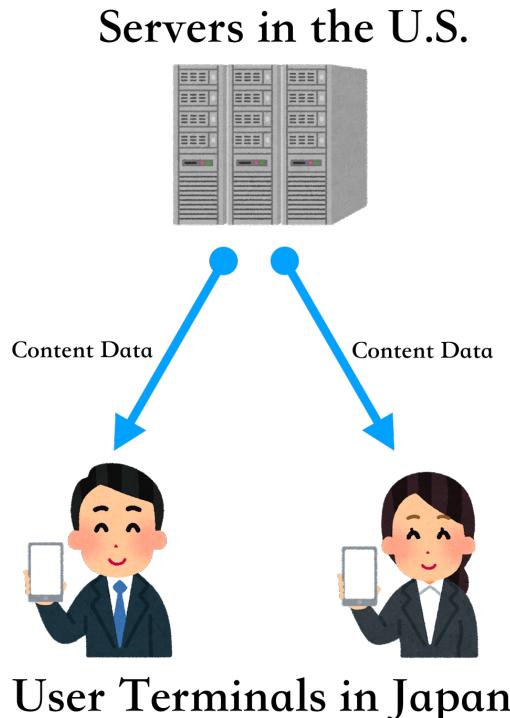


Traditional Issue:

No single entity provides both the server and the terminals.

→ divided infringement
(no infringement)

FC2 inc. of the US was held to infringe a Japanese patent although they provided services from a US server.



Dwango v. FC2.
The Supreme Court,
March 3, 2025
[Machine Translation of the Decision](#)

Patent No. 6526304

Reasoning 1:

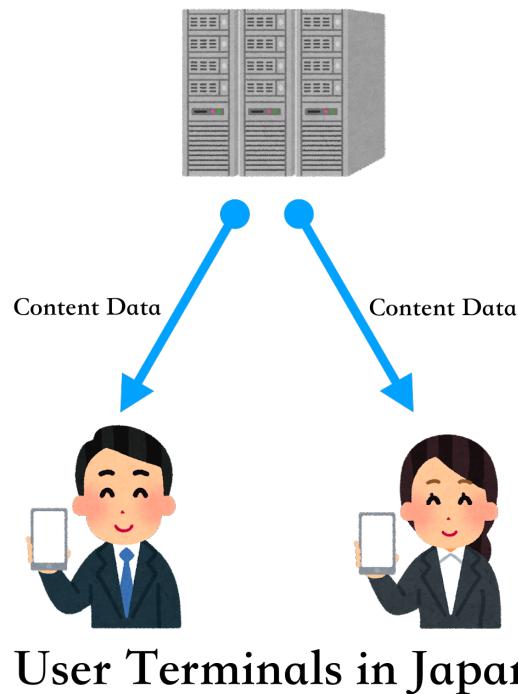
The system was produced when the terminal accessed the server

When the terminal received files from the server, the server and terminal were connected, and the claimed functions, which overlays user comments on the video in the browser of the user terminal, were realized.

The claimed system was “produced” at this point.

Reasoning 2: The system was produced in Japan

Servers in the U.S.



The essential functions of the terminal were created in Japan.

We suggest filing JP applications for Web service inventions.

* Other factors: [Japanese patents may apply to overseas servers](#)

* Other suggestions: [AIPLA Publication](#)

Suggestion 2: Adding program claims

Claim Subject	JP (and EP, TW, CN)	US (and KR)
Programs defined by their functions	YES	NO
Memory or recording medium storing program	YES	YES

∴ Providing programs, e.g. Java Script, over the Internet **directly infringes program claims.**

Exemplary forms of program claims

Japan Patent Examination Guidelines ([Guidelines in Japanese](#))

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

Cf. [EPO Guideline for Examination](#)

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

We recommend the EPO style, as it is also acceptable in Japan.

Supporting program claims in PCT applications for the entry to Japan

Include supporting descriptions such as below in the Priority or PCT Application.

[0052] Software program stored in a Solid State Drive 2010 is read out to RAM 2020 and executed by the computer 2000. Then, the software program causes the computer 2000 to carry out all steps described in this specification with reference to Figs -- and --.

Suggestion 3: Converting process claims to “method for producing” claims

Because a mere process claim does not extend to the products made by that process, unlike USC 271 (g).

ex. “Method for grinding a glass surface” or “method for welding”

→ Convert to “method for producing” style

to cover the products made by that method.

→ Importing the products also infringes the patent.

Mere process claims are often not regarded as “methods for producing a product”

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

“To be qualified as a product, which is to be produced by a method-for-producing, the product should be separately sold.”

“The claimed subject is **only a part of a product**, and therefore, the claim is not considered as a method for producing a particular product.” H15(Wa)860 (Osaka D. Ct., April 27, 2004)

“A method-of-producing claim **should change** chemical or physical characteristics or forms” H13(Wa)3764 (Tokyo D. Ct., November 26, 2003)

Suggestions to be considered as “method for producing” claims

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

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

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

The product must **be changed**.

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

Sufficient: further etching the wafer.

Suggestion 4: Adding claim dependencies

Single dependency is suggested for claim fees and validities
US

Multiple dependencies are accepted with **no extra claim fees**,
but must not depend on other multiple dependent claims:

JP, CN, KR, TW

Multiple-dependent claims may depend on other multiple
dependent claims (**Multi-Multi**) with **no extra claim fees**:

EP, AU, NZ, CA

How shall you start with PCT claims?

In PCT, adopting multiple dependencies

Because:

1. Adding dependencies after 18 months is much more difficult than reducing dependencies.
2. EPO may not accept the addition of dependencies (if new combinations)
3. There are **no claim fees** in PCT Applications even in the US.

Four Suggestions on Procedures

Suggestion 5:

Filing a divisional application, if your application has been cited to a competitor's application

- Your application discloses (a part of) the competitor's ideal claims
 - ⇒ Considering claiming the same.
 - ⇒ Increasing the chance to cover the competitor

Considering claims that cover the competitor's embodiments

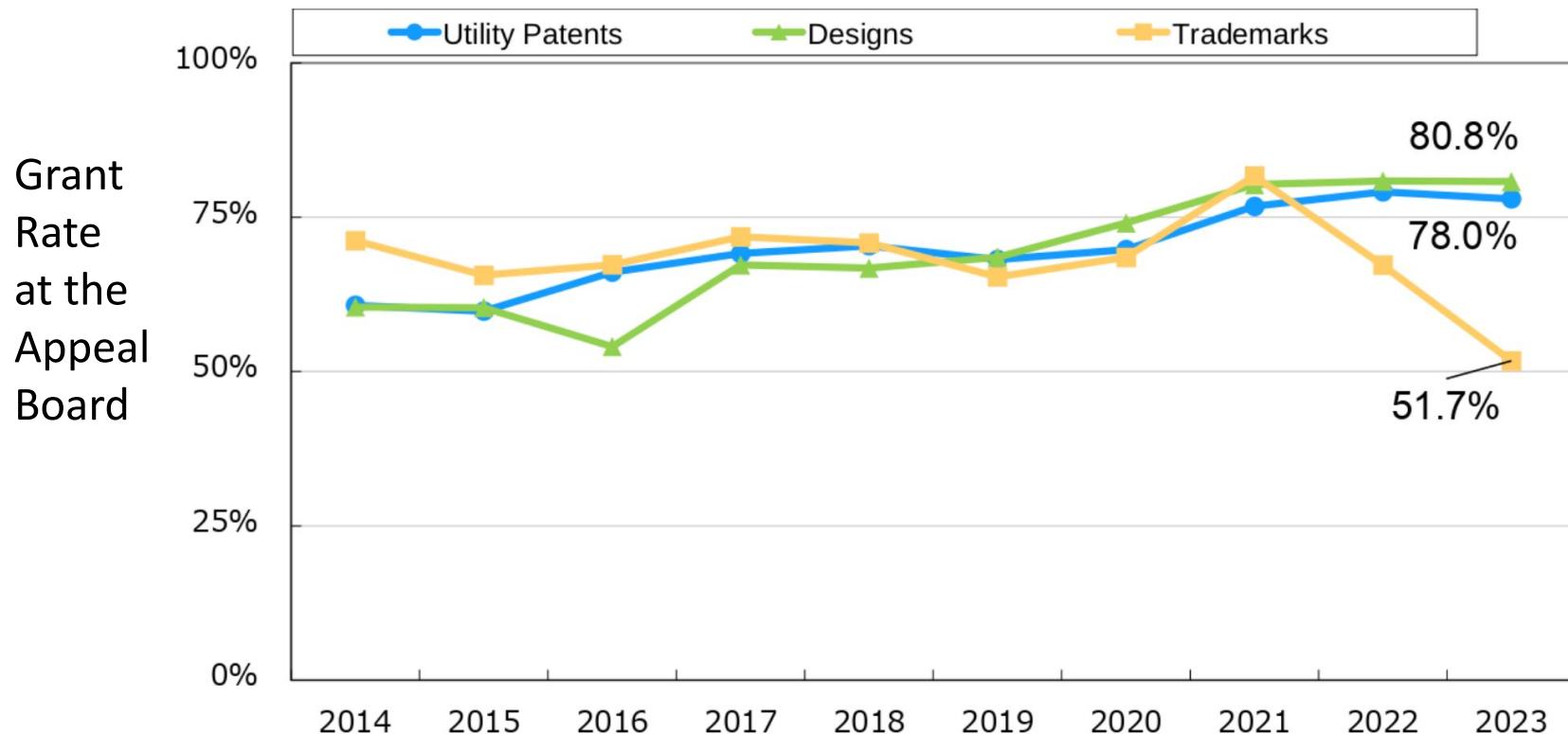
∴ The embodiments show the competitor's product idea.

Upon receiving an allowance, confirming patent applications that have cited your application

See: [Studying Citing Applications to Decide Divisional App.](#)

Suggestion 6: Appealing to the Board

∴ 3 of 4 patent applications are granted



Cited from the [JPO Website \(Japanese\)](#)

The appeal fee is lower than the fee for a divisional application

Office fee for **Appeal**

USD 300 + 36 x claims^{*1}

Office fees for **Divisional and its Examination**

USD 900 + 27 x claims^{*2}

Service fees are comparable

*1 JPY 49,500 + 5,500 x claims

1 USD = JPY 150.8 (Oct. 20, 2025)

*2 JPY 138,000 + 4,000 x claims (large entity)

Rounded for easily read

Claims can be amended:

1. when appealing the case to the appeal board,
2. in response to an OA
 during the pre-appeal examination, and
3. often, after the interviews as well,
 if the interview is accepted

See: [Appeal Procedure is Advantageous at the JPO](#)

Board examiners tend to be more flexible in accepting amendments

Examiners have discretion to enter amendments having no new matter.

Board tries to settle the case at the interview. Even when the Board does not agree with the proposed amendment,

- They may suggest allowable alternatives.

Suggestion 7: Keeping pendencies with fewer divisionals

Green options are less expensive per deferred month.

	Options for extending pendencies	Office & Service Fees (JPY)	Deferred Months	Fees / Month
Request for Examination	Deferring the request (3 years from (PCT) filing date)	10,000	18	600
	Appealing the parent rejection with any amendment & Suspending the divisional examination	180,000 for an appeal + 20,000	12	17,000
Office Actions (OA)	Responding to an OA without analysis	50,000	3	16,700
	Extending the OA response period	16,200	3	5,400
Allowance	Extending the period for paying the issue fee	14,100	30 days	14,100
Divisional	Filing in English & Requesting the examination	345,000	12 (1st. OA) + 6 (rejection decision)	19,200

Suspending the divisional examination

The divisional examination can be **suspended** if:

- the parent rejection decision is **appealed**, and
- the suspension is timely **requested**.

Resumes three months after the decision on appeal.

Suspended period worth Appeal fees.

Reference: [JPO's Published Notice \(Japanese\)](#)

Suggestion 8:

Restoring patents and patent applications, if **unintentionally** lapsed

Subjects of restorations:

- PCT national entry
- Paris priority
- Examination request
- Annuity/renewal after the six-month grace period

Deadlines for restorations

Priority Restoration:

- 2 months from the priority due date, or
- 3 month max. from the PCT entry due date

PCT Entry, Exam. Request and Annuity Restorations:

Earlier of:

- 2 months from knowing the lapse of time
- **1 year** from original due date (6 months for trademarks)

Office fees for restorations (JPY)

Patents 212,100

Trademarks 86,400

Designs 24,500

Utility Models 21,800 (as of Oct 20, 2025)

See: [Restoration is available for unintentional lapse](#)

Two Suggestions to Save Fees

Suggestion 9: Cutting human translations of office actions

Human translation can be 30 percent of the response fees in Asian countries.

Dossier Translation: **Same day** as OA at the JPO

We provide a case specific link to Dossier Translation.
Human translation may be requested, as necessary.

Suggestion 10: Reducing office fees

Available for:

- Micro and small entities
- Universities and NPOs
- **New entities (<10 years)**

Inform the JP agent of the detailed category selected from: [Office Fees for Small/New Entities & Universities](#)

Thank you.

Questions?

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42 Patent Attorneys

Firm of the Year 2024 (Patent Prosecution, Asia IP)



Appendix A: Calculations for Divisional & Appeal Fees

B. Appealing the rejection decision	Fees (JPY)
Service fee excluding substantial analysis	40,000
Late filing appeal brief	15,000
Office fee	$49,500 + 5,500 \times \text{claims}$
Assuming 13 claims: Total:	176,000 for 13 claims

F. Filing divisional application in English	Fees (JPY)
Filing a divisional application in English, followed by translation	105,000
Office fee:	22,000
Requesting the examination	20,000
Office fee	$138,000 + 4,000 \times \text{claims}$
Assuming 15 claims: Total:	345,000 for 15 claims

* The fees and months are typical examples. The fees vary by the firms.

Appendix B: Other suggestions

Five More Suggestions for Patent Prosecutions

Ai & Business Method:

Protecting AI Inventions

IP High Ct. Says Steak Providing System is Patent Eligible.

Claims:

Protecting Medical Treatments in Japan