

10 Suggestions on Patent Prosecutions in Japan from our practices



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about us:

Since 1998
42 attorneys
98 in total



Recognitions:

Firm of the Year 2024,
Rising Star,

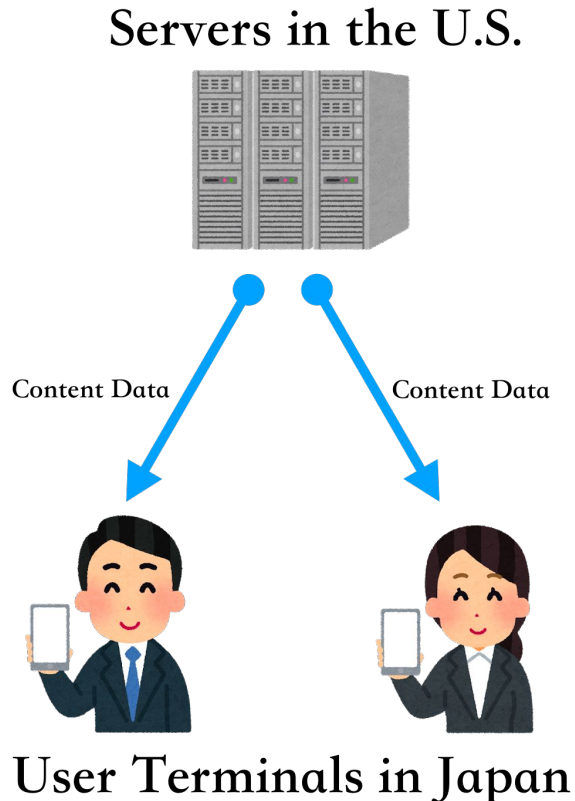
Patent Prosecution,
Japan IP,

Asia IP
ILASA

Five Suggestions for Claims and Specifications

Suggestion 1:

Claiming a system having a web server and a terminal

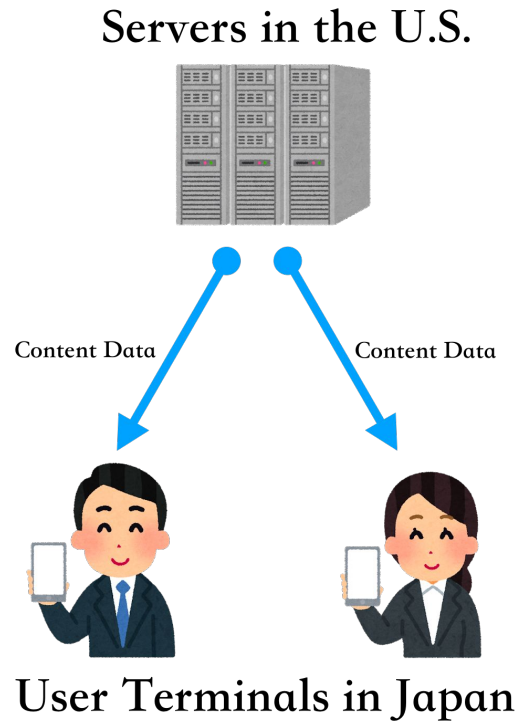


Traditional Issue:

No one provides both server and terminals.

➔ divided infringement
(no infringement)

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



Dwango v. FC2.

The Supreme Court,
March 3, 2025 (Today!)

Patent No. 6526304

Reasoning 1:

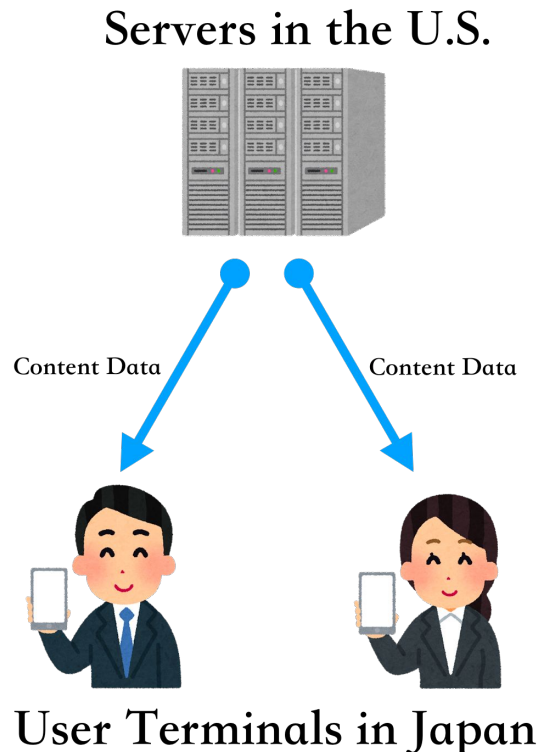
The System was “produced” when the terminal accesses the server.

When the terminal receives 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

Although the server was in the US, the System was produced in Japan.



The essential functions of the terminal were created in Japan.

We suggest filing patent applications in Japan if the server can be anywhere in the world.

* Other reasons: [Japanese patents may apply to overseas servers](#)
(published by AIPLA)

Suggestion 2: Converting process claims to “method for producing” claims in JP

Because the scope of mere process claims does not extend to the products made by the process.

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

→ Convert to “method for producing” style.

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

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

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

Mere process claims are often NOT considered as the “method for producing”

“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 3: Converting Medium Claims to Program Claims

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

∴ Providing programs over the Internet **directly infringes program claims**, but not recording-medium claims.

* Chinese Patent Examination Guidelines was updated in 2024 to allow "Computer program product" claims. The change applies to all pending applications.

Forms of Program Claims

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 ...)

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.)

We suggest the EPO style because it is acceptable in both countries.

Supporting program claims in PCT applications for the entry to Japan

Include at least standard descriptions such as below in the Priority Application or PCT Application.

[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 --.

Suggestion 4. Supporting software inventions

	General Suggestions	We suggest:
JP KR	Write cooperative relationships with hardware in the claims.	1. Writing all of those 2. Avoiding writing problems and words in human activities, economics, and psychology, e.g, fees, monetary transactions, and impressions.
US	Make clear specific applications , what is significantly more , and why.	
EPO CN	Make clear how claimed elements contribute to solving technical problems .	

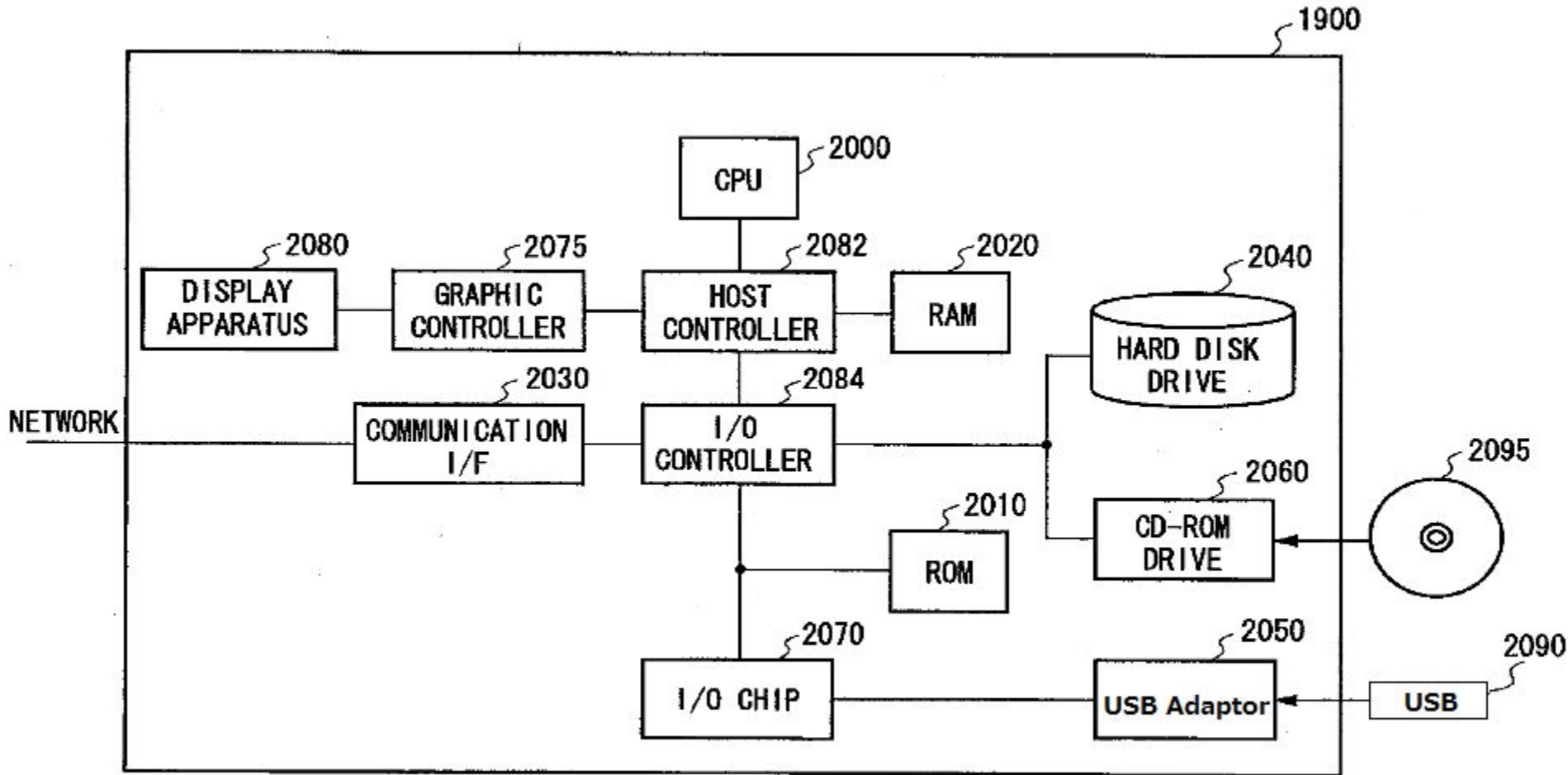
References

[Comparisons of Software Eligibilities in IP5](#)
[Software Inventions in Japan cf. US & EP](#)

Supporting amendments to software inventions in Japan

1. Describe hardware such as storage and memories, even if the hardware is a typical PC or cell phone.
2. Describe how the software uses tables, databases, or temporary data.
3. Describe that the tables, databases, etc. are stored in a storage or memory.

Adding a computer block diagram to PCT and priority applications (for JP)



Describing cooperative relationships with hardware in PCT and priority applications (for Japan)

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

[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 in RAM 2020 again.

Suggestion 5:

Changing claim dependencies

Single dependency is suggested for high 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, European Countries, AU, NZ, CA

How shall you start with PCT claims?

In PCT, adopting multiple dependencies, or Multi-Multi via ISA-EPO (MPEP 1824 6.4)

There are **no claim fees** in PCT Applications even if filed in the US.
Adding dependencies later is more difficult than reducing dependencies.

EPO: May not accept the addition of dependencies (new combinations)

CN, KR: 1. Multi-Multi claims are objected to, but still examined
about the inventive step.

⇒ Can choose dependencies after seeing prior art

2. At least one office action is generally issued.

⇒ Better to receive an easier office action

CN, DE: The number of claims at the PCT stage changes examination fees.

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

Three Suggestions for Specification and Prosecution

Suggestion 6: Filing a divisional application, if cited to the competitor's application

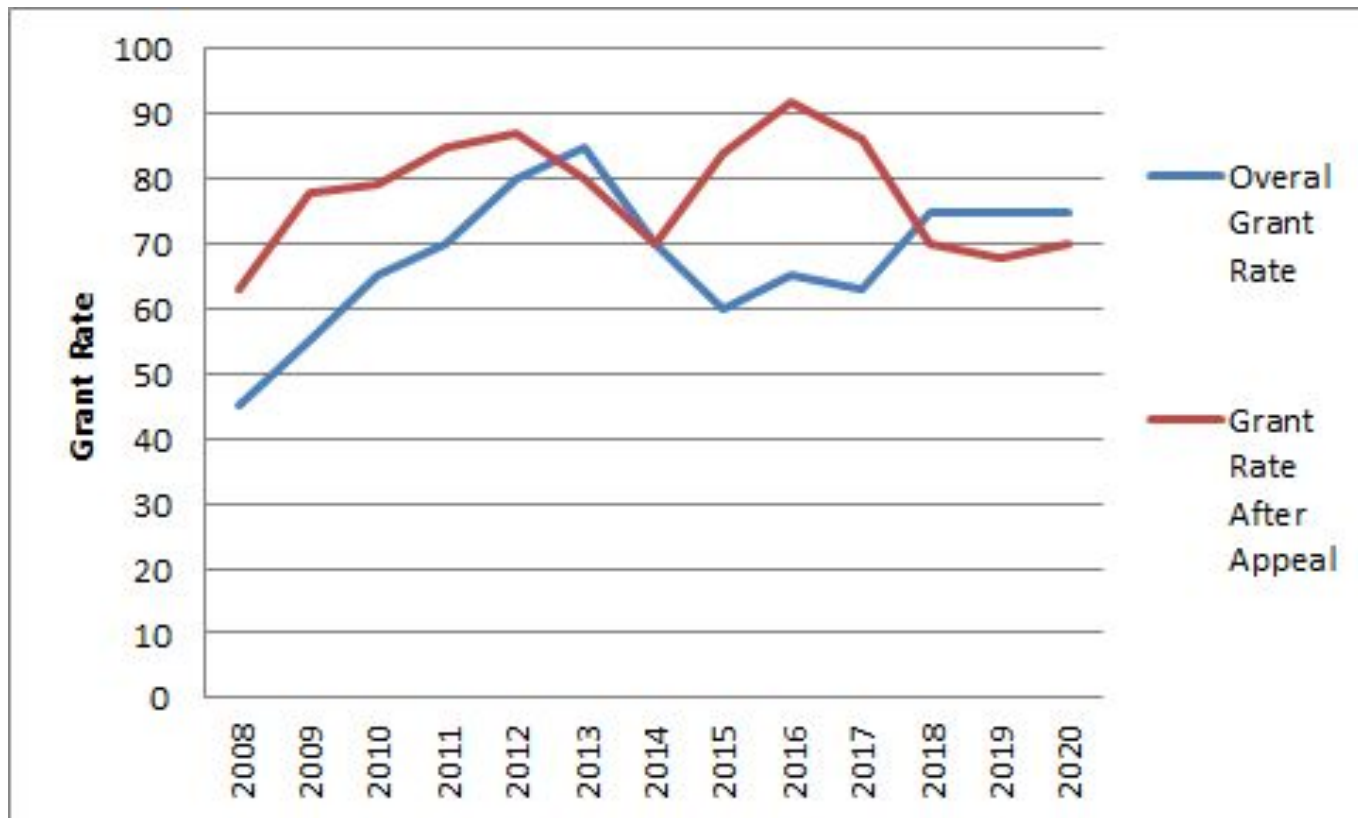
- The present application may disclose what the competitor originally claimed.
 - ⇒ Consider claiming the same.
- The embodiment of the later-filed application may indicate the product plan of the competitor.
 - ⇒ Consider claims covering their embodiment.

Upon receiving an allowance, search for patent applications which cite your application and filed later by competitors.

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

Suggestion 7: Appealing to the Board

70 percent of the appealed cases are allowed



Appeal fee is less than the fee for a divisional application

Appeal

Office fee US\$ 300 + 37 x claims^{*1}

No office fee for interview or oral hearing

Service fee US\$1,000 to 1,800

Total **US\$1,300 to 2,100 + 37 x claims**

Divisional and its examination

Office fee US\$ 900 + 27 x claims^{*2}

Service fee US\$ 800 to 1,500

Total **US\$1,700 to 2,400 + 27 x claims**

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

*2 JPY 138,000 + 4,000 x claims
(If 1US\$ = JPY150)

Claims can be amended:

1. when appealing the case to the appeal board,
2. during the pre-appeal examination, and
3. at the the appeal board

If interview requests and petitions are properly filed and accepted.

Board examiners are less strict in entering amendments

If the original examiner maintains the rejection, the case is transferred to the Board.

- Interview opportunity to propose an amendment
- Examiners have much discretion to enter amendments, and try to settle the case for avoiding the appeal to the court.
- Board examiners are willing to enter amendment, especially at the interview.
- Even when they do not agree with the proposed amendment,
 - they often suggest allowable alternatives.

Inventive step standard is lower at the Board of Appeals

- In the last five years, the IP High Court reversed many Board decisions.
 - Inventive step standard has been lowered
- Still, some first-level examiners don't apply recent court decisions and maintain higher inventive step standard.
- Therefore, the inventive step standard is generally lower at the Board than in the first-level examination.
 - Wider protection

Suggestion 8: Restore Patents/Apps. if Unintentionally Lapsed

Subjects of restorations:

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

The time limit for restorations

Priority Restoration:

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

Other 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

Two Suggestions to Save Fees

Suggestion 9: Reducing office fees

Available for:

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

see: [Office Fees for Small/New Entities & Universities](#)

Suggestion 10: Cutting human translations of office actions

Human translation fees can be 10 to 30 percent of the total response fees in Asia.

We provide a link to Global Dossier Translation.

Clients request human translation of OAs, only if necessary.

Global Dossier Translation: **Same day** as OA in Japan

Other suggestions

Ai & Business Method

[Protecting AI Inventions](#)

[IP High Ct. Says **Steak** Providing System is Patent Eligible.](#)

Fee Issues

[Deferring Fees & Extending Pendency of Applications](#)