

# Suggestions based on the JPO handbook for examining product-by-process claims

## 我们的建议按照PBP权利要求审查的手册



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# Product-By-Process (PBP) Claims 生产方法限定产品的权利要求

“Claims for inventions of products reciting manufacturing processes of the products”

Example:

*Protein manufactured by a manufacturing process  $P$  (processes  $p1$ ,  $p2$ , ... and  $p_n$ )*

# The Supreme Court interpreted PBP claims broadly \* 最高法院把PBP解释得很宽

“The scope of PBP claims extends to actual products that have the same or equivalent elements or characteristics as products 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

日本のPBP权利要求的范围比美国的大

At the US courts, 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**  
**但法院又说PBP权利要求不清楚**

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

⇒ **PBP claims can be invalid in semiconductor fields**

**JPO's Exam. Handbook says that  
a product claim is examined as PBP claim,  
if it recites a process in part**  
日本の審査手册说产品权利要求中，  
如果部分包含生产方法，也当成PBP权利要求来审

A notice of reasons for rejection will be issued for the lack of clarity.

The applicant may **amend** the claim or argue the **impossibility or impracticality** to define the product by its elements or characteristics

# Examples from the Exam. Handbook

## 审查手册的例子

### - PBP Claim

A polymer **Z** acquired by reacting a monomer **X** with a monomer **Y** at 50 °C.

### - **NOT** PBP Claim

A method for manufacturing a polymer **Z** in which a monomer **X** is reacted with a monomer **Y** at 50 °C.

# Examples of **NOT** PBP claims (1)

## 非PBP权利要求的例子 (1)

### - Indicating simply a state of the product -

- An item in which a resin composition has been cured
- An article in which an affixed chip is bonded to a sensor chip
- An item in which **X** is formed to have a thickness different from a thickness of **Y**
- A composition formed by mixing **X** with **Y**
- A tire created using a rubber composition



## Examples of **NOT** PBP claims (2)

- A laminated film formed by placing a layer **Z** between a layer **X** and a layer **Y**
- Removably configured
- A member **Y** welded to a member **X**
- A chamfered member
- A lid caulked to a body
- Spun twisted yarn using roving **X** and roving **Y**
- A pigment coated with a polymer **X**

## Examples of **NOT** PBP claims (3)

- A polymer polymerized with a monomer **X** and a monomer **Y**
- A protein **X** being modified after translation\*
- A humanized antibody
- A protein having an amino acid sequence represented by SEQ. No. **X** in which at least one amino acid is deleted, substituted or added

# We suggest converting process to static expression, if possible

## 我们建议把步骤改写成静态表述

(made by) curing resin → resin being cured

(made by) connecting **X** → **X** is connected to **Y**

(made by) blending **X** and **Y** → **X** and **Y** are blended

(made by) forming **X** and **Y** with different thicknesses  
→ **X** and **Y** having different thickness

## We also suggest “method for making” claims 还建议写成 “用于制造……的方法”

- 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 extends to the product

“用于制造……的方法” 的范围延及产品

- 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)

# However, process claims are often NOT considered as “method for making” claims 但方法权利要求并不都被认为是“生产方法”

“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)

# Suggestions for being considered as “method for making” claims 被认定为“生产方法”的建议

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 the wafer by resist,  
                         exposing the resist, and  
                         etching the resist.

Sufficient:        further etching the wafer.

**PBP claims are still valid, if it is impractical to define the product by its elements or characteristics,**

**如果用元件或特征来定义产品是代价太高或太费时的话，  
被认为是做不到**

“for example, for analyzing the structure or characteristics of the product, in view of the time constraints of filing a patent application,”

⇒ PBP claims do not lack clarity.

\* Sup. Ct. June 5, 2015

⇒ PBP claims can still be valid

in life science and chemistry fields



**JPO added, “impossibility or impracticality argument is accepted, unless the examiner can show reasonable and specific doubt”**

**“不可能或做不到” 的争辩理由是可接受的，  
除非审查员给出合理且具体的质疑**

“However, the following arguments are unacceptable.”

“Drafting claims differently would have taken time.”

“PBP claim is easier to understand.”

- from the Exam. Handbook

# What should we do for maintaining the PBP claims?

## 为了保住PBP权利要求该怎么做？

**Be specific** in arguing the impossibility or impracticality to define the product by its elements or characteristics.

**Preserve evidences** such as inventor's declarations for proving the impossibility or impracticality.

We can add that defining the product by its elements or characteristics **would have significantly delayed the filing date**, which had to be avoided in view of filing competition.

# What should we do when

## PBP claims are asserted to you?

当有人用PBP权利要求向你主张权利时该怎么做？

- 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 ?

当PBP权利要求被挑战时该怎么做？

- 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 非常感謝!

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Top 20 Japan Patent Firm, MIP

Top 20 Japan Trademark Firm, MIP

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