

10 Suggestions on Patent Prosecutions in Asia



Aki Ryuka

Japanese Patent Attorney
Attorney at Law, California, U.S.A.

August 31, 2021

Claims

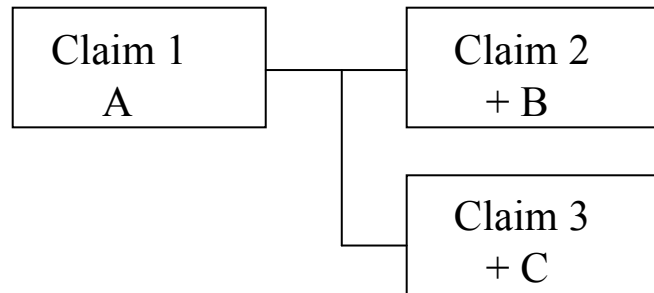
Suggestion 1: Providing Multiple Layers of Multiple Claim Dependencies in JP

Each claim should depend from all possible claims.

1. Wider protection is achieved.
2. More claims will be examined.
 - Claims depending from claim 1 are generally examined.
3. Amendment scope is expanded.

Claim dependencies expand amendment scopes

After the final OA, only the elements that already exist in claims can be further limited in Japan.



A claim having A + B + C cannot be made after the final OA because: C is a new element to claim 2, and B is a new element to claim 3.

Acceptable Dependencies Are Different by Jurisdictions

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

JP, EP, European Countries, AU, NZ, CA

Single dependency is suggested

US

Single layer of multiple dependencies is accepted:

CN, KR, TW etc.

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

In PCT applications filed in the US, adopting single layer of multiple dependencies, or multi-multi utilizing ISA-EPO/JPO (MPEP1824.6.4)

Later adding dependencies is more difficult than reducing them.

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

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

⇒ Can chose dependencies after seeing prior art.

2. One office action is always issued in CN (similar in KR).

⇒ Better to receive an easier office action

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

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

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

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

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

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.)

EPO style is also acceptable in Japan.

Supporting program claims in PCT applications for the entry to JPO

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 --.

Suggestion 3: Drafting means(step) + function

	JP, KR, EP	US
Scope of Protection	<p>Anything capable of realizing the function.</p> <p>(Although unclear words are construed in reference to the specification and often limited in Japan)</p>	<p>Limited to the embodiments disclosed in the specification and their equivalents only.</p> <p>Williamson v. Citrix Online, LLC, 792 F.3d 1339 (Fed. Cir. 2015)(en banc), 35 USC 112(f)</p>
Suggestions (Do both)	Draft functional claims	Draft structural claims that recite structural features.

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

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.

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

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

Cf. Mere method Claims:

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

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)

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.

Prosecution

Suggestion 5: Simplifying instructions for reducing your internal fees

For PCT national entry, we only need:

PCT application number, and

English text, for lowering translation fee

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

a copy of the US assignment

Suggestion 6: Omitting human translation of office actions

RYUKA: Provide comments with a link to
Global Dossier Translation

Clients: Request human translation of OAs, only if necessary

Global Dossier Translation:

JP: Same day as OA

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

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

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

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

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

Suggestions common in the USA

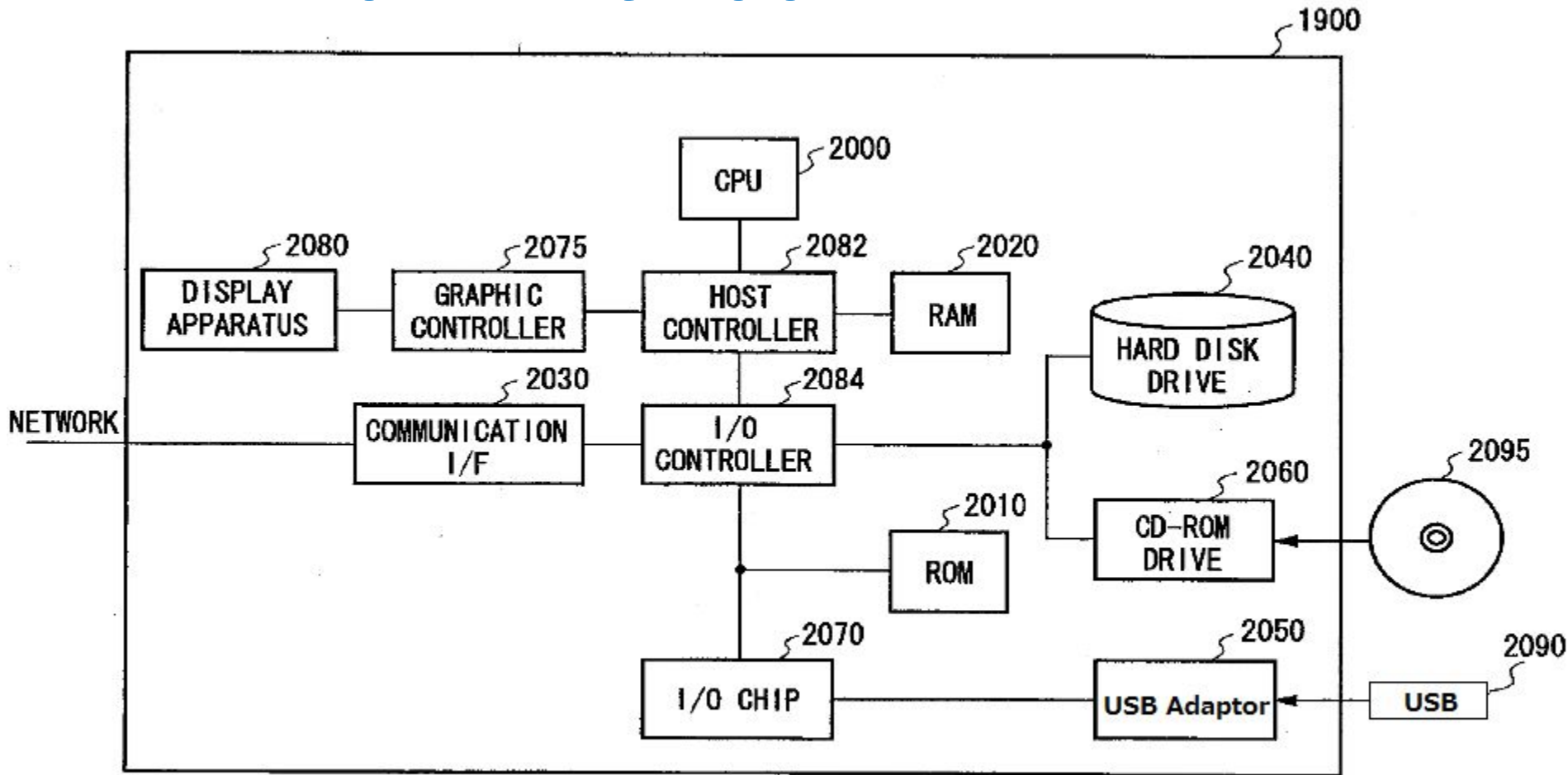
Suggestion 8. Supporting software inventions

	General Suggestions	RYUKA Suggestions
JP KR	Write cooperative relationships with hardware in claims.	Write all of left and avoid writing problems and claim words that exist in human activities, economics, games and psychologies.
US	Make clear specific application and what is significantly more and why	
EPO CN	Make clear how claimed elements contribute solving technical problems.	

Supporting amendments of software inventions in Japan

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



Describing cooperative relationships with hardware in PCT and priority applications

A simple description like below may still help in JP in 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 to RAM 2020 again.

Suggestion 9: Move discussions of prior art into the embodiment

- Discuss general technologies as a part of your invention.
- Discuss different technologies as an alternative solution.

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)

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

Reasons:

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.

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.

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

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.

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

1. Tokyo District Court, H10(wa)30302

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

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

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

Those mean claimed invention.

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

→ Claimed inventions are construed to achieve the effect.

Suggestion:

According to the first embodiment, is achieved.

→ Does not necessarily limit claims.

Thank you

about us:

Celebrated 20th year in 2018.

44 attorneys, 100 in total

They say:

Rising Star in Japan IP, ILASA

Top 5 Japan Patent Firm, Asia IP

Top 10 Japan Trademark Firm, Asia IP

Top 20 Japan Patent Firm, MIP

Top 20 Japan Trademark Firm, MIP

We **commit** to **proactive communication** aiming for deeper understanding of our clients and creative processes.

