

Five More Suggestions for Patent Prosecutions in Japan



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Two Suggestions for Claims and Specifications

Suggestion 1. Supporting software inventions

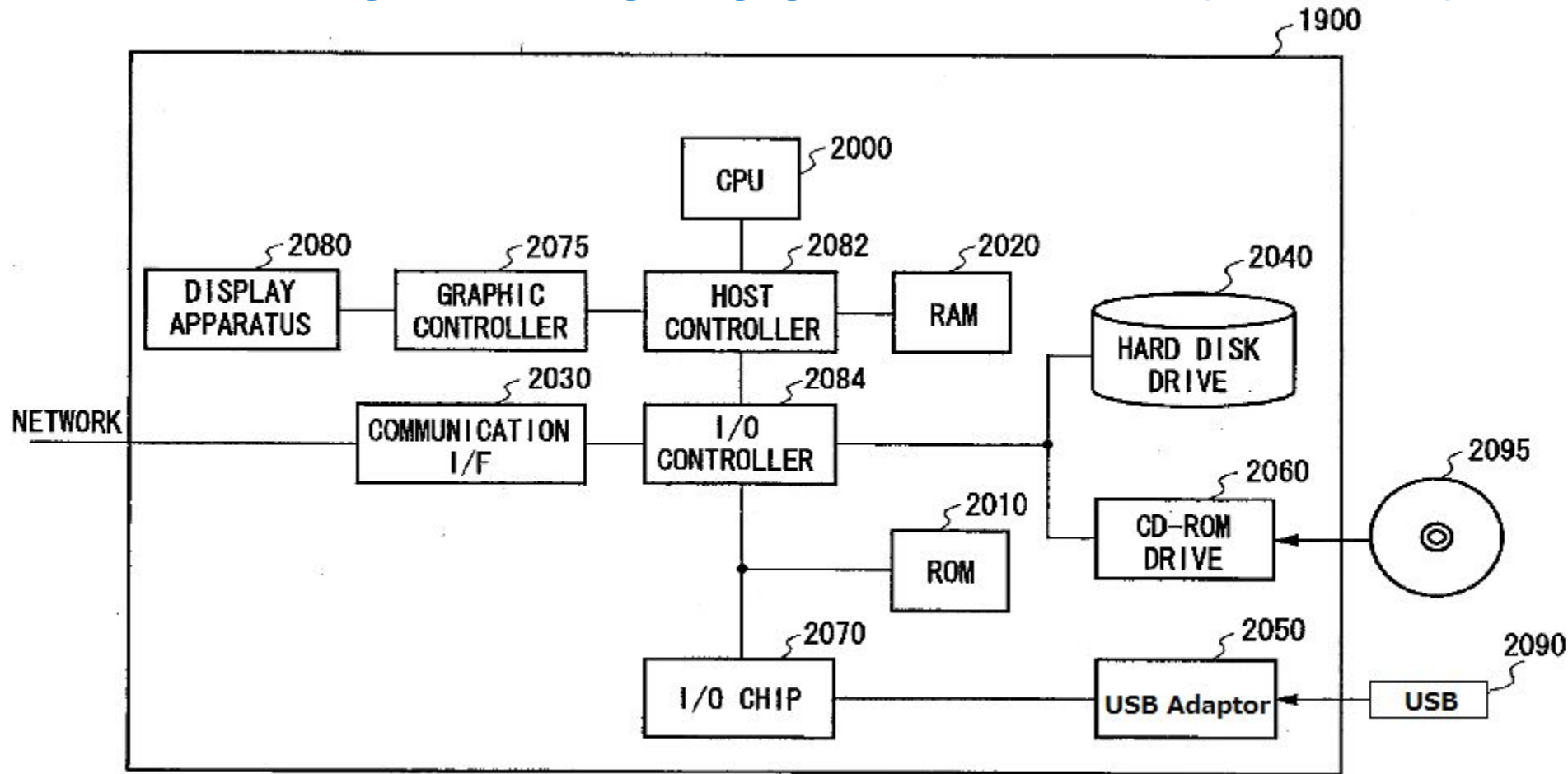
	General Suggestions	We suggest:
JP KR	Write cooperative relationships with hardware in the claims.	1. Writing all of those 2. Avoiding writing problems and words in human activities, economics, and psychology, e.g, fees, monetary transactions, and impressions.
US	Make clear specific applications , what 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 2: 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 are 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)	Add functional claims	Add structural claims that recite structural features.

Three Suggestions for Specification and Prosecution

Suggestion 3:

Simplifying instructions to save your internal fees

For PCT national entry, we only need:

PCT application number, and

English text to help with translation.

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

a copy of the US assignment

Suggestion 4: 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 the Prior Art section is assumed not a part of the present invention.

- Descriptions in the Prior Art section limit the claim scope.
- Amendments that are supported by the Prior Art section are not persuasive for the inventive step.
- More description, more limited.

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

- Descriptions of the prior art problems limit the claim scope.

Suggestion 5: Avoiding Detailed Objects, Summary, and Effects of the invention (Same as in the US)

Anything written in those sections limits the scope of the inventions, since:

objects of the Invention,
summary of the Invention, and
effects of the Invention

mean:

those of the claimed inventions.

Languages in “*** of the Invention” sections limit the scope of claims

1. Tokyo District Court, H10(wa)30302

The claimed phrase, “lower portion” was limited in reference to the explanation made in the Effect of the Invention section.

2. Osaka District Court, H08(wa)13483

The claimed phrase, “natural stone” was limited in reference to the explanation in the 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.
→ Less limiting claims.