

✉ Wishing **SVIPLA** members and their clients  
great success in Japan,

# 10 Suggestions for Patent Prosecution in Japan



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# Disclaimer

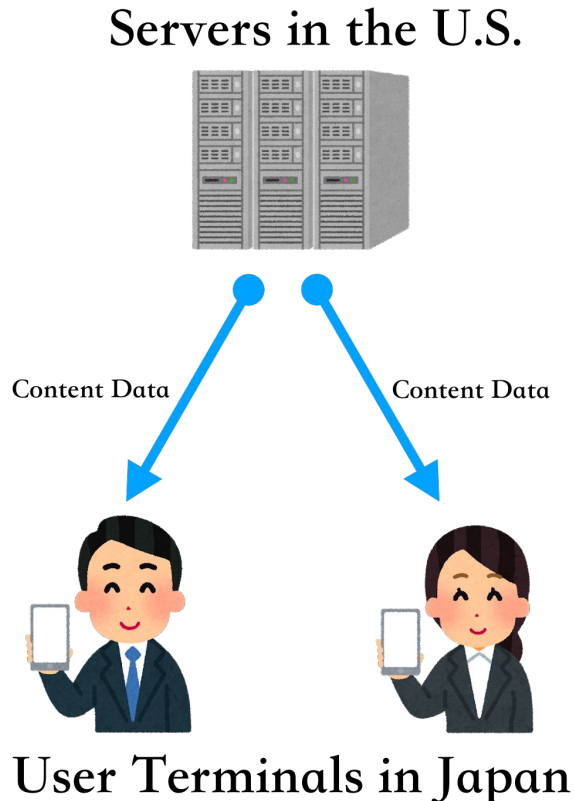
These are personal suggestions but not official suggestions by any Japanese IP association.

This information is provided for general informational purposes only and is not intended as legal advice. Because every case is unique, readers should refrain from acting based on this information without first consulting their attorneys.

The law is constantly developing, and this information may not be updated with every development. The mere presentation of this information does not create an attorney-client relationship with RYUKA & PARTNERS. We expressly and wholly disclaim liability for this information.

# Five Suggestions for the Claims

# Suggestion 1: For Web services requiring substantial terminal functions, adding claims to the system having a server and terminal (“System”), and terminal claims

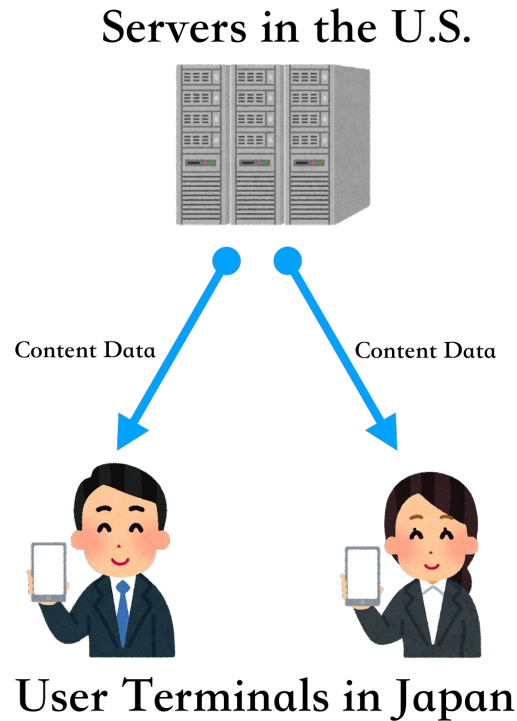


## Traditional Issues:

No one provides both server and terminal.  
(no infringement)

Terminals are provided by users, not by a competitor.

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



*Dwango v. FC2.*

(The IP High Court,  
En Banc, May 26, 2023)

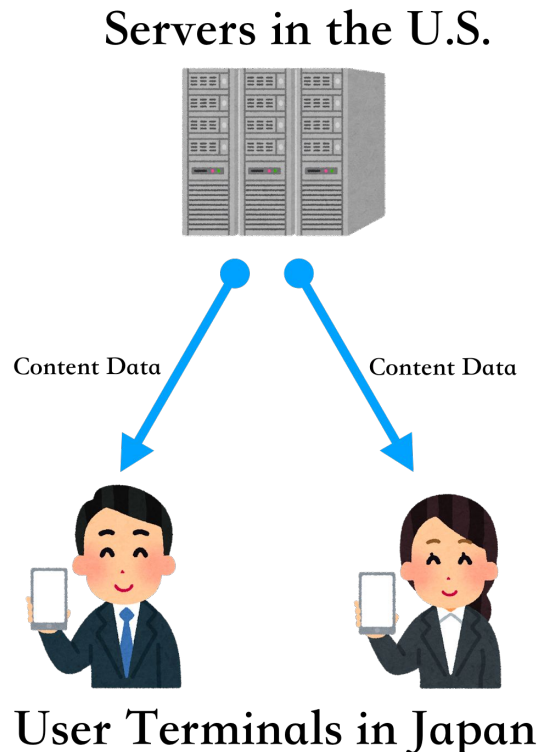
Patent No. 6526304

# 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 comments could be overlaid on the video in the browser of the user terminal.

The claimed system was “produced” at this point.

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



Reasons\*:

The essential functions of the terminal were created in Japan.

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

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

(The article will be published by AIPLA.)

# Suggestion 2: Adding claim dependencies

Single dependency is suggested for high claim fees and validities  
US

Multiple dependencies are accepted with **no extra claim fees**:  
JP, CN, KR, TW

Multiple-dependent claims from other multiple-dependent claims  
("Multi-Multi") are accepted with **no extra claim fees**:  
EP, European Countries, AU, NZ, CA

At the entries from PCT, you need amendments anyway.  
**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).

## Suggestion 3: Converting Medium Claims to Program Claims in JP and EP

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

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

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

# Supporting program claims in PCT applications for 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: Drafting means (step) + function

	JP, KR, EP	US
<b>Scope of Protection</b>	<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>
<b>Suggestions (Do both)</b>	<b>Add functional claims</b>	<b>Add structural claims</b> that recite structural features.

# Suggestion 5: Converting process claims to “method for producing” claims in JP

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

→ Convert to “method for producing” style.

- Claim scope extends to the products produced 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)

Cf. Mere process claims:

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

# 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.



# Five Suggestions for Specification and Prosecution

## Suggestion 6: Omitting human translation of office actions

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

We provides 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 1<sup>st</sup> OA has four months)

## Suggestion 7: Simplifying instructions for reducing 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 8: Consider filing a divisional application, if cited to an application filed later by a competitor

- 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 9. Supporting software inventions

	General Suggestions	RYUKA Suggestions
JP KR	Write <b>cooperative relationships</b> 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 <b>specific applications</b> , what is <b>significantly more</b> , and why.	
EPO CN	Make clear how claimed elements <b>contribute to solving technical problems</b> .	

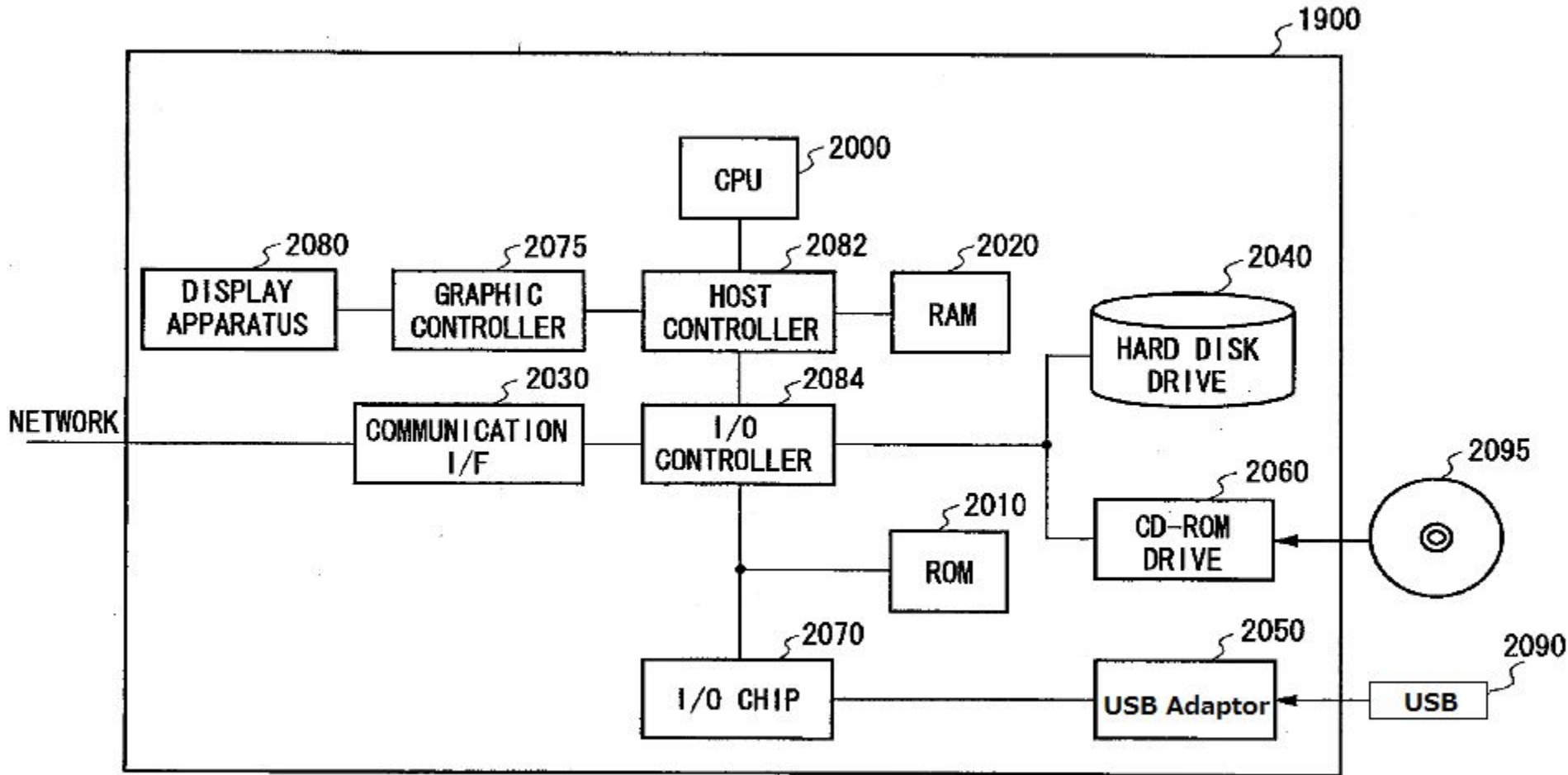
References

[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 10: 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 11: 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.

# Other materials important for **SVIPLA** members

## **Ai & Business Method**

Protecting **AI** Inventions

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

## **Missed Due Date?**

**Restoration** is available for unintentional lapse.

## **Fee Issues**

Office Fees for **Small/New Entities** & Universities

**Deferring Fees** & Extending Pendency of Applications

# Thank you

## about us:

Celebrated the 25<sup>th</sup> year in 2023.  
44 attorneys, 100 in total

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Top 10 Japan Trademark Firm,	Asia IP
Top 20 Japan Patent Firm,	MIP
Top 20 Japan Trademark Firm,	MIP

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