

Product-by-Process Claim in Japan



The Supreme Court of Japan judged regarding Product-by-Process (PBP) claims on June 5, 2015. Since this judgment has a great impact on IP-related businesspeople both at home and abroad, we here announce our report on the outline of this judgment and the resultant change in JPO practices. The scope of this decision includes the cases which have already been patented. We expect attention from those who plan to apply in Japan with claim of priority as well as from those who have cases ongoing at the JPO.

Until recently, the Japan Patent Office has taken a view that the description of claims which specifies the product by the manufacturing process should in principle be regarded as covering the final product in general on identifying the claimed invention. The courts have agreed to this principle and have decided the technical scope of patented invention.

The above-mentioned Supreme Court decision upset the former decision of the Intellectual Property High Court, which had maintained that the technical scope of the patented invention should be interpreted as being limited to the product manufactured through the manufacturing process stated in the claims, and supported the JPO view, while at the same time demanding the strict clarity as requirements for the patent, consequently causing a sensation.

According to the Supreme Court decision, PBP claims would satisfy the requirement of clarity only if “there exist circumstances where it is impossible or utterly impractical to directly specify the structure or feature of the product at the time of filing an application”.

In response to this decision, the JPO began the practices based on “the notice of provisional guideline on examining PBP claims” dated July 6. The next page offers the figure briefly explaining the examining process.

The JPO illustrates “the description of the manufacturing process of the product” within at least a part of claims regarding the invention of the product with some examples such as the statement of successive elements on manufacture, but the illustration is not exhaustive.

The JPO also cites the two following examples of “impossible or utterly impractical to directly specify the structure or feature of the product”: (1) a case in which it is technically impossible to analyze the structure or the feature of the product at the time

of filling an application, and (2) a case in which it may require an excessive and uneconomical amount of time and cost to carry out the work of specifying the structure or the feature of the product when the speed necessary for the patent application is taken into account. Nevertheless, it is still difficult to make a right decision because they lack the corresponding actual cases so far.

Meanwhile, the JPO states that the applicant who got the patent rejected owing to the failure of satisfying the requirement of clarity would be able to take the following actions:

1. Deleting the claims in question
2. Amending the claims in question to the invention of the method of manufacturing the product
3. Amending the claims in question to the invention of the product without manufacturing process
4. Arguing and proving the existence of circumstances “impossible or utterly impractical to directly specify the structure or feature of the product” by submitting a written opinion etc.

Even if these amendments clear the reason for refusal on the basis of the requirement of clarity, they might arouse other reasons for refusal such as lack of support requirement.

We should therefore try our best not to use PBP claims in the future cases currently considered to be filed in Japan, including international applications which are to be filed in Japan with the claim of priority.

When PBP claims are inevitably used, the description and the written opinion should be readily prepared to argue and prove the existence of circumstances “impossible or utterly impractical” to specify the product (if possible) and we also should make the description considering the possible amendments in future in preparation for the refusal based on the lack of clarity, e.g. stating the manufacturing process.

The cases filed in the past are now frequently faced with the refusal due to the lack of clarity concerning PBP claims. Though it is very difficult to salvage them, the immediate task would be making rebuttal as effective as possible on the basis of the profound reinvestigation on the filed description.

Fig. Provisional Flowchart of Examining PBP Claim in the JPO

