

MAEDA & SUZUKI
PATENT Co., LTD.
IWANAMI SHOTEN HITOTSUBASHI BLDG. 8F.,
5-5, HITOTSUBASHI 2-CHOME,
CHIYODA-KU, TOKYO 101-0003, JAPAN
TELEPHONE 81-3-6261-4255 FACSIMILE 81-3-6261-4245
E-mail address : ms@msspatent.com

July 29, 2015

MAEDA & SUZUKI PATENT Co., LTD.

Chief Administrator Hiroki MIYAO

Examinations involving Product-by-process Claims

On June 5, 2015, the Supreme Court entered judgments on two cases (Nos. 2012(ju)1204 and 2012(ju)2658) involving product-by-process claims, i.e., claims concerning inventions of products reciting manufacturing processes of the products.

Following the judgments, the Japan Patent Office has announced the Examination Guidelines concerning product-by-process claims, which is very controversial in Japan (refer to the second page). The Examination Guidelines apply to any and all cases regardless of before or after acquisition of a patent. Therefore, it is expected to increase the number of notices of reasons for refusal concerning violation of Article 36(6)(ii) for the time being.

Our firm cannot be satisfied with the Examination Guidelines and is against them, as well as the judgments by the Supreme Court. Thus, we will continuously demand that the situation be improved.

We would appreciate your understanding and cooperation in this matter.

Please contact us if you would like to know in detail about Examinations involving Product-by-process Claims or have any questions.

< **Interim Handling of Examinations(Product-by-process Claims)** >

Based on the opinion of the judgments by the Supreme Court on the above-mentioned cases, an outline of the interim handling of examinations is provided below:

○ When a claim concerning an invention of a product recites a manufacturing process of the product, the examiner will notify any reasons for refusal whenever the invention of that product is not clear. However, this will not be the case when the examiner can find that the invention involves "impossible or impractical circumstances".

- ● The term "impossible or impractical circumstances" means any circumstances in which it is impossible or utterly impractical to define the product based on its structure or characteristics at the time the subject application for such product was filed.
- ● The reasons for refusal will be notified to give the applicant an opportunity to assert and prove the existence of "impossible or impractical circumstances", and also an opportunity to make an argument and/or an amendment thereof. These opportunities are given in order to avoid situations in which an already granted patent could include grounds for invalidation, or in which interests of third parties could be unfairly harmed.

○ The applicant can file other responses as arguments against a notice of reasons for refusal in order to resolve such reasons, including:

- (i) deleting any claim concerned,
- (ii) amending any claim concerned into a claim concerning an invention of a process for producing a product,
- (iii) amending any claim concerned into a claim concerning an invention of a product which does not include a manufacturing process, and/or
- (iv) asserting and proving the existence of "impossible or impractical circumstances" based on a written argument.

○ When the applicant asserts and proves the existence of "impossible or impractical circumstances", the examiner will, normally, conclude that "impossible or impractical circumstances" do exist. However, this will not be the case when the examiner has doubts, based on a tangible reason, about the existence of "impossible or impractical circumstances".