

Background and essential point of revision of the relevant parts in
Examination Handbook on Clarity Requirement for Product-by-process
claims

1. Background

The Supreme Court entered judgment on the case involving product-by-process claims (claims concerning inventions of products reciting manufacturing processes of the products; hereinafter referred to as “PBP Claims”)¹. In response to this judgment, the JPO has published “Interim Handling Procedures for Examinations and Appeal/Trials involving Product-by-process Claims” on July 6, 2015. The content of this publication is reflected in the revised “Examination Handbook for Patent and Utility Model (hereinafter referred to as “Examination Handbook”) published on September 16, 2015.

Subsequently, the JPO published “Reference examples of arguments and verification presented by applicants involving ‘impossible or impractical circumstances’ concerning product-by process claims” on November 25, 2015, and published “Addition of examples not considered to be product-by-process claims” on January 27, 2016.

Upon publishing the reference examples, the JPO stated that it would continue to review handling procedures of PBP claims and would update the Examination Handbook around the beginning of April 2016.

2. Essential point of the revision

The essential point in this revision of Examination Handbook is as below:

- (a) In order to achieve further clarification of item (1) of “1. Basic idea”, section 2204, the following description is added to item (1) and the operative example in Type (1-1) is replaced with a new one (in particular, the second case of “bolt and nut (shown later)” is deleted).

¹ Nos. 2012 (Ju) 1204 and 2012 (Ju) 2658

Particularly, even if a claim corresponds formally to one of the following types or examples showing “where a claim recites the manufacturing process of the product”, when it is clear what structure or characteristics of the product are represented by the manufacturing process (Note) considering the description, claims and drawings as well as common general knowledge, at the time of the filing of the application, in the art to which the invention belongs, the examiner does not consider that the claimed invention violates the clarity requirement because it corresponds to a case "where a claim recites the manufacturing process of the product".

(Note) The Pravastatin Sodium Case decisions (the Supreme Court of Japan, June 5, 2015, Second Petty Bench, case Nos. 2012 (Ju) 1204 and 2012 (Ju) 2658)

(b) Additional examples not considered to be PBP claims (published on January 27, 2016) are added to Type (2)² in section 2204.

Reference examples of arguments and verification involving “impossible or impractical circumstances” (published on November 25, 2015) are incorporated into section 2205.

(c) Two cases³ are added as an operative example of Type (2) in section 2204, and one case⁴ is added as an operative example considered to be involving “impossible or impractical circumstances” in section 2205, respectively.

² “Type (2): Case in which, by indicating simply a state, a structure or characteristics are merely indicated”.

³ “A polymer prepared by polymerizing a monomer A and a monomer B” and “A protein A modified after translation”.

⁴ “A monoclonal antibody prepared by a hybridoma cell A”.

The aim of the above (a) will be explained as below.

Regarding the case of “bolt and nut”⁵ listed in Type (1-1)⁶, it is clear in light of the common technical knowledge what structure of the “device” as a product is represented by the description of the case. However, since chronological elements are described in the manufacturing process for the case, the case formally corresponds to a “case where a claim recites the manufacturing process of the product”.

Taking this into consideration, referring to “Interim Handling Procedures for Examinations (published on July 6, 2015)”, since the JPO is in a position where the conclusion relating to the clarity requirement in the judgment of the Supreme Court should be apprehended in a strict manner⁷, this case corresponds to a “case where a claim recites the manufacturing process of the product” and an example of amendment (Example of Amendment) of this case is also provided: the description regarding the chronological elements is deleted while a claim is maintained as an invention of a product, ensuring not to fall under a case where a claim recites the manufacturing process of the product.

However, it is clear what structure of the “device” is represented by the manufacturing process of an “device” for this case, thus this case does not fall under the description “it is generally unclear ~” stated in an explanation⁸ of the reason leading to the conclusion in the judgment of the Supreme Court.

⁵ An example where “a device having a fixed portion wherein a bolt having a convex portion is inserted into a hole having a concave portion so that the convex portion and the concave portion can be engaged, and a nut is screwed with the end of the bolt”.

⁶ “Type (1-1): Case in which, pertaining to manufacturing, a description of elements over time exists”.

⁷ A portion of “According to the above, it is appropriate to construe that when a claim of a patent for an invention of a product recites the manufacturing process of the product, the recitation of the claim should be held to meet the requirement that the claimed invention is clear as prescribed in Article 36, paragraph (6), item (ii) of the Patent Act, only if there are circumstances where it was impossible or utterly impractical to directly define the product subject to the invention by means of its structure or characteristics at the time of the filing of the application”.

⁸ “When a claim of a patent for an invention of a product recites the manufacturing process of the product, it is generally unclear what structure or characteristics of the product are represented by the manufacturing process, or whether the technical scope of the patented invention is limited to products manufactured by the manufacturing process, although the subject matter of the invention is the product, and this would prevent those who read the recitation of the claim, etc. from clearly understanding the content of the invention~, leading to an inappropriate situation”.

In view of this, and as a result of considering opinions of experts in the related areas and users, such case is treated as not applicable to a case “where claims concerning inventions of products reciting manufacturing processes of the products. Accordingly, the operative example of Type (1-1) is replaced with a new example.

Such handling procedure is applicable when other typical and operative examples fall under cases where “a claim recites the manufacturing process of the product”.

The description newly added to item (1) of “1. Basic idea” in section 2204 provides clarity on the handling procedure described above.