

2203 Points to Note in Examination When a Claim Concerning an Invention of a Product Includes a Manufacturing Method for a Product

Examiner shall proceed with the examination while paying attention to the following points when determining whether or not “4.3.2 The case where a claim concerning an invention of a product includes a manufacturing method for a product” of “Part II Chapter 2 Section 3 Clarity Requirement” is relevant, and proceeding with the examination in cases where it is relevant.

- (1) The Examiner shall determine, on the basis of the present handbook, Section 2204, whether or not at least a portion of claims pertaining to an invention of a product corresponds to a "case where a claim concerning an invention of a product includes a manufacturing method for a product".
- (2) The Examiner shall determine, on the basis of the present handbook, Section 2205, whether or not, when a determination is made of correspondence to the "case where a claim includes a manufacturing method for a product" in the above (1), regarding the description, whether or not the description corresponds to a "case of existence of impossible/impractical circumstances¹." In addition, if a claim and a proof have been made that the circumstances exist in the descriptions, an opinion, etc., a determination is to be made in consideration of the same.
- (3) Subsequent to Final Notification of Reasons for Rejection, after receiving a demand for an Appeal Against Examiner's Decision of Rejection/Refusal or a notification of Article 50bis, regarding an amendment which treats a "description of a manufacturing method for the product" as, simply, a description of such aspects as a structure or characteristics, or an amendment which, if a manufacturing method for the product is provided in the invention for the product, simply treats the invention as an invention of the manufacturing method for the product, then the Examiner, normally, shall find that the amendment is an amendment corresponding to a clarification of an unclear description (Article 17bis(5)(iv)).²

¹ I.e., " circumstances that is impossible or utterly impractical to define the product by its structure or characteristics at the time of filing."

² Hypothetically speaking, if the amendment is not performed, then ordinarily, this means that a Notification of Reasons for Rejection for violation of the requirement for definiteness has been notified, and furthermore, in applying the provisions of Article 17bis(5), the legislative intent of the same should be sufficiently taken into consideration so as not to operate any more strictly than necessary. Therefore, this time, the amendment is to be admitted. The provisions of the same paragraph are to be treated as having been provided with the intent of establishing an examination procedure which quickly and accurately secures granting of rights while taking into consideration the basic purpose of the patent system, which is to fully achieve protection for an invention, and in

this end, an amendment in response to a Final Notification of Reasons for Rejection is to be performed within a scope in which it is possible to effectively utilize the examination results that have already been performed. Furthermore, it is considered that even if the amendment is admitted, the examination results that have already been performed can generally be effectively utilized.