

## **Addition of examples not considered to be product-by-process claims<sup>1</sup>**

### **1. Background**

The Japan Patent Office (JPO) published interim handling procedures of product-by-process claims<sup>2</sup> (i.e. claims for products reciting manufacturing processes of the products; hereinafter referred to as “PBP claims”) on July 6, 2015 in accordance with the Supreme Court decisions of June 5, 2015<sup>3</sup>, and showed types of examples considered to be PBP claims and those not considered to be PBP claims, as well as types of examples where “impossible or impractical circumstances”<sup>4,5</sup> are considered to exist and those where the circumstances are not considered to exist. The details of those examples have been reflected in the revised “Examination Handbook for Patent and Utility Model” (hereinafter referred to as “Examination Handbook”; see Sections 2203-2205) 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.

Upon publishing the reference examples, the JPO stated that it would continue to review handling procedures of PBP claims in view of, *inter alia*, adding further examples not considered to be PBP claims and would update the Examination Handbook around the beginning of April 2016, based on the review.

In light of terms used relatively frequently in actual patent applications as

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<sup>1</sup> Addition of examples to “Type (2): Case in which, by indicating simply a state, a structure or a feature is merely identified” under “3. Types/operative examples not corresponding to a ‘case in which a manufacturing method for a product is described’” in Section 2204 “Determination Regarding Whether or Not ‘When a Claim Concerning an Invention of a Product Includes a Manufacturing Method for a Product’ is Relevant” of the “Examination Handbook for Patent and Utility Model”.

<sup>2</sup> “Interim Handling Procedures for Examinations involving Product-by-process Claims”

<sup>3</sup> Case Nos. 2012 (Ju) 1204 and 2012 (Ju) 2658

<sup>4</sup> Circumstances in which it is impossible or utterly impractical to specify the product directly based on its structure or property (feature) at the time of the filing of an application.

<sup>5</sup> As described in the interim handling procedures of product-by-process claims, if a claim is determined to fall under the PBP claims, a notice of reasons for refusal (violation of the clarity requirement) will be issued except a case where the existence of “impossible or impractical circumstances” is recognized. An applicant can amend a claim to a non-PBP claim, or can submit a written opinion in which the applicant can argue and verify the existence of the circumstances, thereby the reasons for refusal (violation of the clarity requirement) can be resolved.

well as expressions requested by users for inquiry, the JPO has identified and hereby publishes examples not considered to be PBP claims as those to be added to the Examination Handbook when revised.

The JPO will continue to review handling procedures of PBP claims and will revise the Examination Handbook.

## **2. Relevant part in the Examination Handbook**

The examiner determines whether or not at least a portion of a claim of a product under examination corresponds to a “case where a claim includes a manufacturing method for a product” on the basis of Section 2204 of the Examination Handbook (see Section 2203 of the Examination Handbook).

Section 2204 of the Examination Handbook shows the following “Basic idea” applicable to determining whether or not a claim pertaining to an invention of a product corresponds to a “case where a claim includes a manufacturing method for a product”:

- (1) The examiner determines whether or not at least a portion of a claim of a product corresponds to a "case where a claim includes a manufacturing method for a product" by taking into consideration, in addition to the description, the claims, and the drawings, common general knowledge in the technical field to which the invention belongs. (It is necessary to note that even if one of the following types or examples appears to be relevant, there are cases in which different determinations may be made on the basis of common general knowledge in the technical field.)
- (2) In view of the fact that the burden of proof for the description requirement, in general, is on the applicant side, the examiner may notify, if he/she considers appropriate, a reason for refusal for the violation of the clarity requirement and thereby provide the applicant with an opportunity to argue and verify that “impossible or impractical circumstances” exist, or an opportunity to submit a written opinion and/or amendment. It is appropriate to avoid, by doing so, the situation where a patent is subsequently granted containing a reason for invalidation, or the interests of third parties are unfairly prejudiced.

Based on these, Section 2204 of the Examination Handbook shows “Type (2): Case in which, by indicating simply a state, a structure or a feature is merely identified” with 12 examples under the types not considered to be PBP claims (i.e. types not corresponding to a “case where a claim includes a manufacturing method for a product”), as well as the types and examples considered to be PBP claims<sup>6</sup>.

Newly identified examples shown in the next Item 3 will be added to the examples under the types not considered to be PBP claims.

### **3. Additional examples not considered to be product-by-process claims**

Additional examples of Type (2) will be shown below<sup>7</sup>. Those are presented as examples considered to come under the category “Case in which, by indicating simply a state, a structure or a feature is merely identified”, in light of the meaning of terms and common general knowledge.

If wordings are different from those in the following examples, it does not necessarily mean that they are not considered to come under Type (2). For example, the mere fact that a wording which is similar to one of the following examples but has a different expression does not necessarily deny the applicability of that wording to Type (2); a determination on whether or not certain language comes under Type (2) should be made based on the “Basic idea” described in the above<sup>8</sup>.

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<sup>6</sup> In case of a PBP claim, if a person skilled in the art would not be able to understand the characteristics of a product (e.g., the structure or property) even considering the content of the description and drawings as well as the common general knowledge at the time of the filing of an application, to the extent that patentability requirements such as novelty and inventive step cannot be properly assessed, the invention is deemed to be unclear regardless of the presence “impossible or impractical circumstances”, since the invention cannot be understood from one claim in such a case. (See the “Examination Guidelines for Patent and Utility Model in Japan”, Part II, Chapter 2, Section 3, Clarity Requirement, 4.3.1. (2).)

<sup>7</sup> As described in the “Basic idea”, the examiner determines whether or not at least a portion of a claim of a product corresponds to a “case where a claim includes a manufacturing method for a product”. Therefore, the following examples show at least a portion of claims, not necessarily the entire claims.

<sup>8</sup> New matter may be added to a claim in some cases where the claim is amended to bring it to conform to one of the examples. Appropriateness of claim amendment should be considered on a case-by-case basis.

**Additional Examples:**

“a member B welded to a member A”;

“a chamfered member”;

“a lid caulked to a body”;

“spun twisted yarn using roving A and roving B”;

“a pigment coated with a polymer A”;

“a PEGylated protein”;

“a humanized antibody”; and

“a protein having an amino acid sequence represented by SEQ. No. X in which at least one amino acid is deleted, substituted or added”.

- In particular, shown below are terms whose concept is established as those specifying the structure or feature (property) of products. (For example, the definition, etc., of such a term can be found in a dictionary, a textbook, or a technical standards document, etc., and in this light, it is considered that the concept of that term has been established as that specifying the structure or feature (property) of a product.)

“A casting”, “a casting product”, “a forging”;

“a welded part”, “a brazed part”, “a soldered part”, “a fusion-spliced part”;

“a machined part”, “a cut off part”, “a ground surface”, “a press-fit surface”,

“a press-fit structure”;

“a sintered object”, “a green compact”;

“an oriented film”, “a blown film”;

“printed parts”, “a printed coil”, “a printed capacitor”;

“a coating film”, “a vapor-deposited film”, “(as a layer or a film) a coating layer”;

“a diffusion layer”, “an epitaxial layer”, “an epitaxial growth layer”;

“float glass”, “a hot-dip zinc-coated steel sheet”, “vulcanized rubber”, “an embossed product”; and

“a welded assembly”, “an integrally molded article”.