

Product by process claims in Japan

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Judge

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Overview

1. Judgement of Supreme Court of Japan
2. Issues
3. Discussion

Judgement of Supreme Court of Japan

1. Process terms don't limit product by process claims.
2. Product by process claims don't satisfy clarity requirement except for cases where impossible or impractical circumstances exist.

Issues

1. How to determine whether a claim fall within a product by process claim ?
2. How to determine a existence of impossible or impractical circumstances ?

Discussion (Issue no.1)

1. Definition of Supreme Court
2. Example
3. Recommendation

Definition of Supreme Court

A product by process claim is a claim which recites process terms.

Example

an apparatus having an anchorage formed by inserting a bolt provided with a convex portion into a hole provided with a concave portion so that the concave portion and the convex portion are engaged, and screwing a nut into an end portion of the bolt

Recommendation

The claim that represent the unambiguous and clear structure or characteristics shall be deemed not to recite the process terms.

Discussion (Issue no.2)

1. Arguments and verification regarding “impossible or impractical circumstances”
 - (1) Opinion of Justice Chiba
 - (2) Guideline of JPO

2. Effect of the new rule
 - (1) Opinion of Justice Chiba
 - (2) Opinion of Justice Yamamoto

Opinion of Justice Chiba

1 “Impossible”

The case where it is impossible mainly from a technical perspective to define the product by analyzing its structure or characteristics.

2 “Utterly impractical”

The case where the work to define the product could force a person to spend time and costs to an extent that is impractical in terms of profitability.

3 Level of verification

In the examination process, since there is a limit due to the nature of the task to the applicant's potential to prove the existence of such circumstances voluntarily and strictly, the JPO will not be able to strictly require the applicant to do so and would be very likely to find the existence of such circumstances unless there is a reasonable.

4 Example

A claim which recites a cell.etc., created by a new genetic manipulation in the field of life science.

Guideline of JPO

1. Basic idea
2. Example
 - (1) claim
 - (2) arguments and verification
3. Opinion of JPO
4. Recommendation

Basic idea

Unless there is reasonable doubt regarding the content of a claim/proof by the applicant regarding the existence of "impossible/impractical circumstances"(normally, unless the Examiner indicates a concrete doubt at the time of a Notification of a Reason for Rejection or the time of a Decision of Rejection), the Examiner shall make a determination that impossible or unrealistic circumstances exist.

Example of claim

A polymerized composition prepared by the steps of: reacting preliminarily a compound having three or more mercapto groups in one molecule and a compound having two or more isocyanate groups in one molecule for 5 to 10 minutes at the temperature of 40–50 degrees Celsius; and then reacting a reaction solution containing the oligomer obtained by the reaction described above, a compound having two mercapto groups in one molecule and

Example of arguments and verification

A polymerized composition defined in claim comprises a compound having three or more mercapto groups in one molecule as a raw material, and further comprises an oligomer obtained under the reaction condition that the compound is preliminary reacted at the temperature of 40–50 degrees Celsius for 5–10 minutes. Therefore, a structure of the resulting polymerized composition becomes absolutely too complicated to express by a general formula (a structural formula), which is the common general knowledge for a person skilled in the art. It is also impossible to express the polymerized composition by the property because a property of a substance cannot be easily understood until a structure thereof is specified, as the property can be determined accordingly, and also because a property of a resulting polymerized composition obtained by a reaction of multiple different kinds of monomers varies depending on a compounding ratio of monomers or a reaction condition.

Example of arguments and verification(cont'd)

Namely, a polymerized composition defined in claim of the present invention cannot be specified directly by the structure or property of the product, but can be specified only by a process (manufacturing process) for preparation of the product.

Therefore, the invention of the polymerized composition defined in claim is deemed to be the case where impossible or utterly impractical circumstances to “specify the product directly by its structure or property at the time of the filing of an application” exist.

Opinion of JPO

In example as described above, the written opinion concretely explains that it is impossible or impractical to specify the product directly by its structure or property since the product is a polymer having complicated and a wide variety of structures. Therefore, the present example is deemed to be the case where the existence of “impossible or impractical circumstances” can be recognized.

Recommendation

The structure of the polymerized composition varies depending on not only the types or the proportions of monomers or oligomers (which are also constituted by the different kinds of monomers), but also the temperature or the time of reacting them, so it is impossible or impractical to specify the product directly by the numbers and combinations of multiple different kinds of monomers that constitute the basic structure of the polymerized composition. Therefore, this example shall be deemed the case where the existence of “impossible or impractical circumstances” exist.

Opinion of Justice Chiba

1. If it is truly "impossible" or "utterly impractical" to define the product by means of its structure, etc., the applicant would not find a great burden in alleging and proving this point.
2. JPO will not be able to strictly require the applicant to prove the existence of such circumstances and would be very likely to find the existence of such circumstances unless there is a reasonable doubt. In this meaning, it is very likely that the applicant would not have to worry so much.
3. To avoid patents to be invalidated later, procedures such as a request for correction (Article 134-2 of the Patent Act) in a patent invalidation trial and a request for a trial for correction (Article 126 of said Act) may be helpful.

Opinion of Justice Yamamoto

Most patent applications claiming inventions of products with product-by-process claims would be refused by reason of the failure to meet the clarity requirement and this could bring about what is called the chilling effect, driving all product-by-process claims out of Japanese patent applications even when these claims are truly necessary, and impeding protection of inventions.

Thank you for your attention.

