

**QUESTIONS AND ANSWERS
REGARDING JAPANESE PATENT PRACTICE
TABLE OF CONTENTS**

QUESTIONS AND ANSWERS compiled
by the International Activities Center of
the Japan Patent Attorneys Association

I. APPLICATION

(i) Proxy	P. 1
Q1. Representing Competitors	
Q2. Pro Se (Self representation) Application	
(ii) Formality.....	P. 2
Q3. When Corporate Nationality Certificate Cannot be Notarized	
Q4. Electronic Filing	
Q5. Filing Application in Foreign Language	
(iii) Specification and Claims.....	P. 4
Q6. Format for the Specification	
Q7. "Summary of Invention"	
Q8. Essential Description in "Summary of Invention"	
Q9. Plural Advantages	
Q10. Claim Format	
Q11. Multiple Dependency	
Q12. Dependent Claims	
Q13. Independent Claims	
Q14. Claim Categories	
(iv) Divisional Application.....	P. 6
Q15. When a Divisional Application Can Be Filed	
Q16. Requirements for Divisional Application	
Q17. Conversion to Utility Model Application	
(v) Priority.....	P. 1 1
Q18. Inventors to be included	

Q19. Omitted Priority	
Q20. Claiming Both U.S. and Japanese Priorities	
Q21. Hypothetical Case and Discussion	
Q22. Hypothetical Case and Discussion, Continued	
(vi) Internal Priority	P. 1 5
Q23. How Internal Priority is Claimed	
Q24. How is Double Patenting Avoided in the Case of the Internal Priority?	
(vi) National Phase Entry of PCT Application	P. 1 5
Q25. Nationalizing a PCT Application	
(vii) Utility Model	P. 1 6
Q26. Outlines of Utility Model System in Japan	
Q27. Conversion between Utility Model Application and Patent Application	
Q28. Double Registration (Branch Off)	
(viii) Fees	P. 1 9
Q29. Official Fees Calculation	
Q30. Additional Fees for Multiple Dependent Claim	
Q31. Attorney's Fees	
(ix) Others	P. 2 0
Q32. Non-Inventor's Application	
Q33. Non-Inventor's Patent Right	
Q34. Recovery against Non-Inventor's Application/Patent Right	
Q35. Time vs. Day	

II. EXAMINATION

II.1 Patentability

(i) Statutory Requirements	P. 2 2
Q36. Statutory Requirements	
(ii) Unity of Invention	P. 2 2
Q37. Unity of Invention	

(iii) Enablement Requirement	P. 2 3
Q38. Enablement requirement	
Q39. Incorporation by Reference (IBR)	
Q40. Number of Working Examples Needed to Satisfy the Enablement Requirement	
Q41. Best Mode of Practicing the Invention	
Q42. Advantageous effects or merits of the invention	
(iv) Support Requirement	P. 2 4
Q43. Extent of Disclosure in the Description and Drawings vs. Broadness of Claims	
Q44. Undue Breadth (Claims Reading on Inoperative Subject Matter)	
Q45. Burden of Proof on Support Requirement	
(v) Clarity Requirement	P. 2 5
Q46. Definition by Function	
Q47. Definition of Terms	
Q48. Recitation in Optional Form	
Q49. Use of Ambiguous Terms	
Q50. Claims Attempting to Define the Invention by Objectives to be Attained	
Q51. Devices or Products with Limitations on Their Usage	
(vi) Novelty	P. 2 6
Q52. Novelty	
Q53. Details of Novelty Requirements	
Q54. Date of Publication of a Paper Submitted to a Journal	
Q55. Oral Presentation	
Q56. Grace Period	
Q57. Presentation via Internet	
Q58. Presentation Outside Japan	
Q59. Procedures for Grace Period	
Q60. Document published during Grace Period	
(vii) Inventive Step	P. 2 9
Q61. Inventive Step in Japan	
Q62. Definition of Person Skilled in the Art	
Q63. Additional Experimental Data	
Q64. Inventive Step in Selective invention	

(viii) Unpublished Prior Art (Disclosed in Unpublished Prior Application, Art. 29-2) ...P. 3 1

Q65. Unpublished Prior Art

Q66. Self-Collision (Exemption of Art. 29-2)

Q67. Foreign Unpublished Prior Art

Q68. Priority vs. Unpublished Prior Art

(ix) First to File Rule.....P. 3 2

Q69. First to File or First to Invent

(x) Specific Technical Field; Chemistry, Medicine and Biotechnology.....P. 3 2

Q70. Written Requirement for invention Concerning New Compound

Q71. Second Use of a Known Pharmaceutical Composition

Q72. Enablement Requirement for Medicine

Q73. Pharmacological Data

Q74. Physical-Chemical Data

Q75. Physical data or Test Data of a Compound

Q76. Later filed supportive Data

Q77. Paper or Prophetic Examples

Q78. Deposit of Microorganism or Biotech Material

Q79. Sequence Listing

Q80. Transgenic Animals

(xi) Specific Technical Field; CII (Computer Implemented Inventions).....P. 3 8

Q81. Statutory Requirements for CII

Q82. Claim Categories of CII

Q83. Pure Algorithms or Program Listings

Q84. Drafting Claims and Specification

II.2 Prosecution

(i) Request for Substantive ExaminationP. 3 9

Q85. Who can file a request for substantive examination?

Q86. When the request should be filed?

Q87. Queuing Time for First Office Action

(ii) Expedition.....P. 4 0

Q88. What kinds of Expeditions are available?

Q89. What is preferential examination?	
Q90. What is accelerated examination?	
Q91. What is super-accelerated examination?	
Q92. Preferential Examination vs. Accelerated Examination	
(iii) Office Action	P. 4 2
Q93. Non-final OA vs. Final OA	
Q94. Decision for Dismissal of Amendments	
Q95. Notice of Reasons for Rejection on Violation of Requirements for Disclosure of	
Q96. Decision of rejection	
Q97. Decision to Grant a Patent	
Q98. Declarations to Support Broad Claims	
(iv) Extension of Time	P. 4 3
Q99. Extension of Time for Responding to OA	
Q100. Request for Extension of Time	
(v) Amendments	P. 4 4
Q101. When can amendments be filed?	
Q102. Requirements for Amendment in response to non-final OA	
Q103. Requirements for Amendment after Final OA	
Q104. Requirements for Amendment When Filing an Appeal against Decision of Rejection	
Q105. Amending Junior Application to Have it Read on Senior Application (Senior	
Q106. Amending Japanese claims to Parallel Issued Foreign Claims	
Q107. Advantage of Paralleling Issued Foreign Claims	
Q108. Further Narrowing the Paralleled Claims	
Q109. New Matter	
Q110. Amendment Changing Special Technical Feature	
Q111. Amendments Challenged by Third Parties	
(vi) Argument (Remarks)	P. 4 8
Q112. Time Frames for Reply to OA	
Q113. Affidavits to Evidence the Knowledge of a Person Skilled in the Art	
(vii) Interview	P. 4 9
Q114. Interview Recommended	

Q115. Recommended Strategy	
(viii) Donation of Information	P. 4 9
Q116. When can the information be submitted?	
Q117. Who can submit the information?	
Q118. What kind of information can be submitted?	
Q119. Feedback of Donation of Information	
Q120. Notification to Applicant of Donation of Information	
Q121. Effect of Donation of Information	
Q122. Disadvantages of Donation of information	
(ix) Appeal against Examiner's Decision of Rejection	P. 5 1
Q123. Filing an Appeal against Examiner's Decision of Rejection	
Q124. Amendments	
Q125. Reconsideration by Examiner before Appeal	
Q126. Shin-Jin (questioning/interrogation by an appeal board)	
Q127. Documentary Proceeding	
Q128. Appeal Decision	
(x) Suit against Appeal Decision	P. 5 2
Q129. General Requirements for Suit against Appeal Decision	
Q130. Amendment, Divisional Application	
Q131. Complaints against the IP High Court Decision	
(xi) Registration, Term and Maintenance of Patent Right	P. 5 2
Q132. Registration	
Q133. Term and Maintenance of Patent right	
Q134. How to Know Maintenance / Expiration of Registration	
Q135. Registration of Extension of Term of Patent Right	

III PATENT RIGHTS

III.1 Infringement	P. 5 5
Q136. Implementation	
Q137. Remedies for Patent Infringement	
Q138. Injunction	
Q139. Damages	

- Q140. Monetary Recovery Before the Issuance of the Patent
- Q141. Defendant's Defense
- Q142. Claim Interpretation
- Q143. Doctrine of equivalence
- Q144. Prosecution history estoppels
- Q145. Doctrine of Claim Differentiation
- Q146. Emphasis of Advantageous Effect
- Q147. Reference Numerals in Claims

III.2 Trial for Patent InvalidationP. 5 9

- Q148. Trial for patent invalidation
- Q149. Grounds for Patent Invalidation
- Q150. Who can request a trial for patent invalidation?
- Q151. When can a trial for patent invalidation be requested?
- Q152. Amendments
- Q153. Complaints against a Trial Decision

III.3 Trial for Correction.....P. 6 1

- Q154. Trial for Correction
- Q155. What kind of correction can be requested?
- Q156. Who can file a request for a trial for correction?
- Q157. When can a trial for correction be requested?
- Q158. Complaints against a Trial Dismissal

III.4 Administrative Opinion, others.....P. 6 2

- Q159. Administrative Opinion
- Q160. Who can request an administrative opinion to the JPO?
- Q161. Complaints against an Administrative Opinion
- Q162. Trial for Invalidation of Registration of Extension of Term of Patent Right
- Q163. Retrial

**QUESTIONS AND ANSWERS
REGARDING JAPANESE PATENT PRACTICE**

FIRST EDITION 1993

1992 AND 1993 US/JAPAN PATENT PRACTICE COMMITTEE

SECOND EDITION 1998

1996 AND 1997 INTERNATIONAL ACTIVITIES COMMITTEE THIRD GROUP

THIRD EDITION 2007

2007 INTERNATIONAL ACTIVITIES CENTER

FORTH EDITION 2012

2012 INTERNATIONAL ACTIVITIES CENTER

JAPAN PATENT ATTORNEYS ASSOCIATION

3-4-2 Kasumigaseki Chiyoda-ku Tokyo 100-0013, JAPAN

<http://www.jpaa.or.jp/>