

I. APPLICATION

(i) Proxy

Q1. Representing Competitors

Are there any restrictions placed on the Japanese patent attorney with respect to simultaneously representing competitors in overlapping areas of technology?

If not, do the patent attorneys have an obligation to notify their foreign clients of such conflicts of interest?

A1. Yes, there is a restriction.

Patent attorney – The Patent Attorneys Law Art. 31 provides that a case should not be accepted which may have a conflict of interest with another case being represented. However, simultaneous representation is allowed if the parties concerned give consent to the patent attorney.

The Patent Attorneys Law Art.31 applies equally to foreign clients, who should be notified and whose consent is required when a patent attorney wants to represent simultaneously competitors in overlapping areas of technology.

Q2. Pro Se (Self representation) Application

Does the Japan Patent Office (JPO) permit pro se applications? That is, is it permitted for an inventor to file and prosecute their own patent application without the assistance of a patent attorney?

A2. The JPO permits so-called pro se (self representation) applications as long as the applicant has their domicile or residence in Japan irrespective of their nationality. Otherwise, it is not permitted for an inventor to file and prosecute their application without the assistance of a Patent Administrator [the Patent Law Art.8(1)]. Patent attorneys and attorneys at law can be Patent Administrators. Any person, including non-Japanese, who has their domicile or residence in Japan and is an applicant's representative with respect to the applicant's patent, can be a Patent Administrator. The Patent Administrator shall represent the principal in all procedures and in a suit instituted against measures taken by an administrative agency in accordance with the Patent Law or an order or ordinance thereunder [the Patent Law Art.8(2)]. However, the "resident abroad" – i.e. the applicant - can limit the scope of powers of attorney.

As an exception, if the applicant has a Patent administrator, the applicant (or in case of a legal entity, its representative) is able to proceed before the JPO during their stay in Japan without the assistance of a Patent administrator (Art.1 of the Enforcement Ordinance under the Patent Law).

Another exception is admitted when a PCT application filed in the U.S. or other foreign countries designating Japan enters into the Japanese national phase (the Patent Law Art.184-11 applies). In this case, the resident abroad is allowed to proceed before the JPO on condition that the resident appoints a Patent Administrator within 3 months after the expiration of 30 months from the priority date for the filing of a translation of the PCT application, or within 3 months from the day when a request for examination is filed within the above-described 30 months.

(ii) Formality

Q3. When Corporate Nationality Certificate Cannot be Notarized

It is now recognized that in some U.S. states such as California, Notary Publics can only attest that the person signing the form is that person. A Notary Public cannot legally notarize Corporate Nationality Certificates. How can we properly obtain Corporate Nationality Certificates that will satisfy the Japanese requirements?

A3. The contents of the corporate nationality certificate should be certified by the corporate representative and the statements should be sworn before a notary. Please refer to the attached form. This certificate satisfies the Japanese requirements.

In some U.S. states where a Notary Public cannot attest corporate nationality, a valid Corporate Nationality Certificate can be obtained by having the certificate certified by the corporate representative before a Notary Public and having the notary notarize the sworn certificate.

However, please be advised that normally the notification for a corporate citizenship is not requested in the Power of Attorney for filing applications. It is required by the JPO only when the applicant name does not show whether the applicant is a corporation or not. For example, when the applicant name includes "Corp.", "Inc.", etc., the corporate citizenship is not necessary, because these words can verify that the applicant is a corporation (or a legal entity).

CORPORATION NATIONALITY CERTIFICATE

I hereby certify that the undersigned is a corporation duly organized under the laws of the State within the United States of America where its principal place of business is located and that the person who signed the above power of attorney is a representative of said corporation and is authorized to execute such documents on their behalf.

Name:

Title:

Corporate Name:

United States of America

State: s:

County:

Sworn and subscribed before me on day of , 20 .

(Notary Public)

Seal

Q4. Electronic Filing

Can applications be filed electronically?

A4. Yes, applications can be filed electronically by on-line filing through the Internet. Data of filing documents is sent through the Internet, using “the Internet application software”.

The method of on-line filing through the Internet became available in October 2005. In order for one to file an application through the Internet, he or she needs to obtain an electronic certificate for security reasons. On-line filing through the Internet is done by using the Internet application software, which is downloadable from the JPO's website.

Though it may be technically possible to file an application from overseas, an applicant who resides outside of Japan is not allowed to directly file the application through the Internet from overseas (see Q2). On the other hand, an applicant who resides in Japan but temporarily outside of Japan may file the application from overseas, if he or she obtains the electronic certificate in Japan, and all the other electronic environments such as those referred to the above are set.

Q5. Filing Application in Foreign Language

Can we file a patent application in a foreign language?

A5. Yes. You can file a patent application written in English to obtain a filing date. Currently, the Japan Patent Office only accepts English-language applications.

You must file a Japanese translation of the English-language application within one year and two months from the priority date. Otherwise, the application is deemed to be withdrawn.

The examination is conducted in the Japanese language.

You can amend the specification, claims, and drawings within the disclosure of the original English text. However, you cannot amend the English text in any way.

If new matter is introduced into the Japanese translation beyond the disclosure of the original English text, it will cause rejection of the application and invalidation of the patent.

(iii) Specification and Claims

Q6. Format for the Specification

What format for the specification should be used to file a patent application in Japan?

A6. The Japan Patent Office accepts the (trilateral) Common Application Format (CAF)

from January 1, 2009. Therefore, required format in Japan is same as in USPTO and EPO, and it will be accepted by the Japan Patent Office without the need for amendments related to formalities.

Q7. "Summary of Invention"

What items should be included in "Summary of Invention"?

A7. "Summary of Invention" includes following items: "Technical Problem"; "Solution to Problem"; and "Advantageous Effect of Invention".

Q8. Essential Description in "Summary of Invention"

Are there legal requirements for the description in "Summary of Invention"? If yes, what should be written down?

A8. Yes, Art.24-2 of Regulation requires to state the features which are necessary for a person skilled in the art to recognize the technical significance of the invention, including the problems to be solved by the invention, technical means used for solving the problems and the others. Therefore, at least the description of a technical problem and a solution to the problem are necessary. The others, such as an advantageous effect of the invention, are not necessary unless they are essential for the skilled person to recognize the technical significance.

Q9. Plural Advantages

If an invention shows plural advantages, must a claim include all the features corresponding to each advantages? Or can we separate the features into a plurality of independent claims?

A9. We can separate the features into a plurality of independent claims to obtain broader scope of protection. Note that the each independent claims must meet the requirements of the unity of invention (Art.37) and be supported by the specification (Art.36(6)(1)).

Q10. Claim Format

Is one particular claim format, for example, European two-part form, Jepson, etc., affect a scope of protection in later stage, such as litigation? If yes, what format is advantageous/disadvantageous?

A10. No, claim format does not affect a scope of protection.

In some countries, a preamble in a two part form claim or a Jepson type claim is interpreted as a prior art. In Japan, every technical features in a claim, including a preamble

and a body, are treated equally and a scope of protection is interpreted from whole written technical features in a claim. Therefore, there is no particular claim format which is advantageous/disadvantageous.

Q11. Multiple Dependency

Can a dependent claim depend on other multiple dependent claim?

A11. Yes. Multiple dependency on multiple dependency is admitted in Japan.

Q12. Dependent Claims

Will dependent claims be automatically determined to be invalid in a trial for invalidation if the independent claim is determined to be invalid?

A12. No. A trial for invalidation should be demanded for each claim whether independent or dependent, and dependent claims can be maintained if they do not have any reasons for invalidation themselves, even though the independent claim is determined to be invalid. So, it is recommendable to draft dependent claims if these dependent claims have any additional significant features.

Q13. Independent Claims

Is there any restriction for number of independent claims, such as one independent claim per one category?

A13. No. An application can involve any number of independent claims. Note that all the claims must fulfill a requirement of unity of invention. See Q37 also.

Q14. Claim Categories

Show allowed claim categories in Japan.

A14. There are two categories – a product and a process. The process is further divided into two – a simple process and a process of manufacturing. See Q136 also.

Note that a device, an apparatus, a system or a program is categorized as a product. A method or a use is categorized as a process.

(iv) Divisional Application

Q15. When a Divisional Application Can Be Filed

(1) When can a divisional application be filed in Japan?

(2) Can a divisional application be filed even after the expiry of the time period for filing a Request for Examination in its parent application?

A15. (1a) In the Patent Law, Art.44 regarding a divisional application was amended and

has been effective since April 1, 2007. It is applied to not only applications whose parent applications were filed before April 1, 2007, but also those filed on or after April 1, 2007. The time period in which a divisional application can be filed depends on when the parent application was filed. The details are explained below.

(1b) In an application filed before April 1, 2007, a divisional application can be filed during the time period when an amendment can be filed (Art.44(1), see Fig.23-A).

That is, the time period is either one of the followings:

(1b-i) Before an applicant receives the first Office Action, the applicant can file a divisional application at anytime;

(1b-ii) After an applicant receives an Office Action, the applicant can file a divisional application within the time period designated by the Examiner to file a written opinion against the Office Action; and

(1b-iii) After a Decision of Rejection is made, an applicant can file a divisional application at the same time of filing of a Notice of Appeal against the Decision of Rejection. The Notice of Appeal can be filed within 3 months from the date when the applicant received the Decision of Rejection.

(1c) In an application filed on or after April 1, 2007, a divisional application can be filed even during the following time period (Art.44(1), see Fig.23-B) in addition to the aforementioned time period, (1b-i) to (1b-3) allowed for an application filed before April 1, 2007 (Art.44(1)(i));

(1c-i) After a Decision of Rejection is first issued, an applicant can file a divisional application within 3 months from the date when the applicant received the Decision of Rejection, (Art.44(1)(iii)); and

(1c-ii) After an application is granted in the examination procedure (not in the Appeal procedure), an applicant can file a divisional application within 30 days from the date when the applicant received the Decision of Grant (Art.44(1)(ii)).

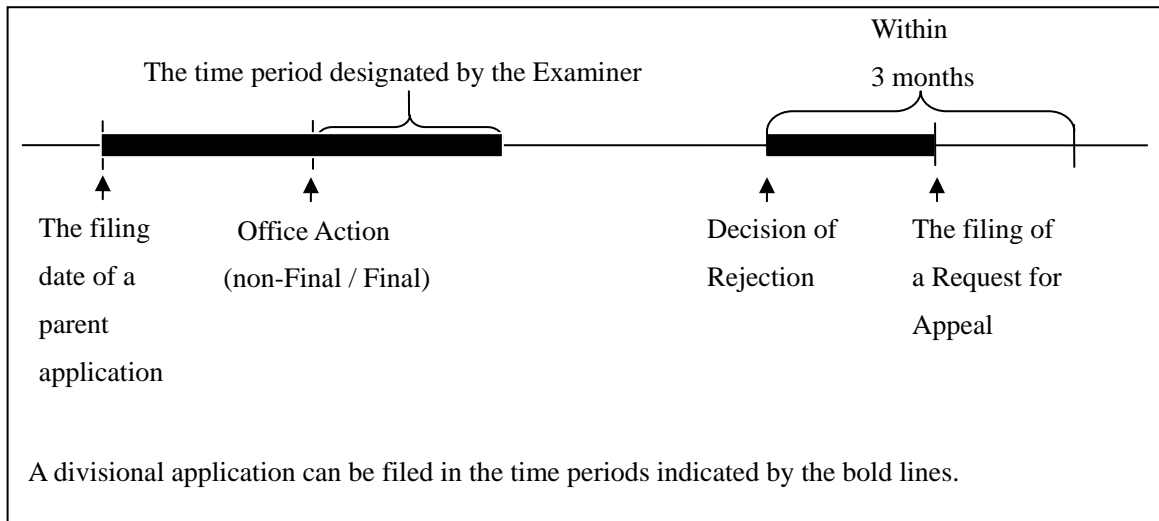


Fig.23-A [In the case of a divisional application whose parent application was filed before April 1, 2007]

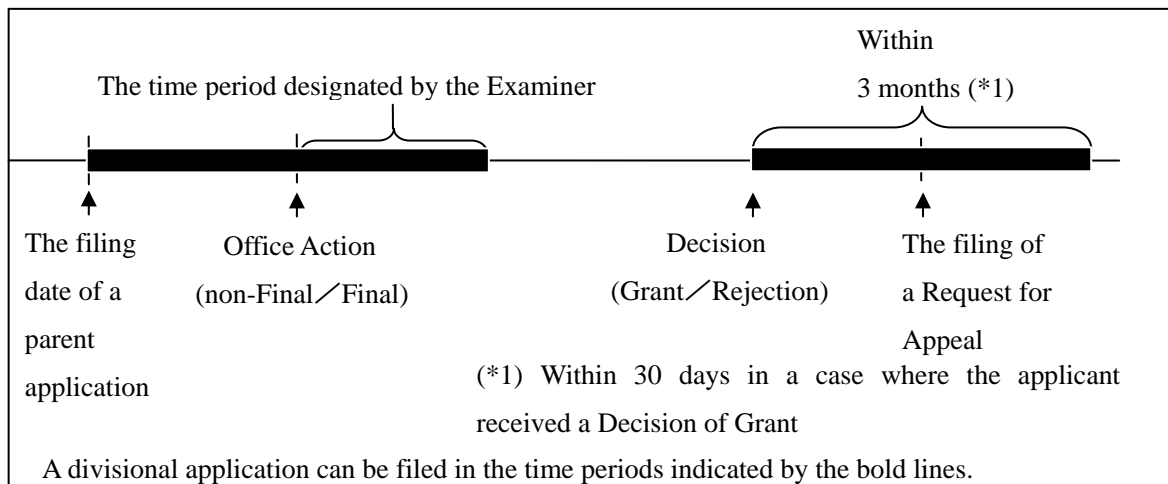


Fig.23-B [In the case of a divisional application whose parent application was filed on or is filed after April 1, 2007]

(2) Yes, a divisional application of the parent application can be filed even after the expiry of the time period for filing the Request for Examination. In this case, an applicant can file a Request for Examination of the divisional application within 30 days from the actual filing date of the divisional application (Art.48-3(2)) (See Fig.23-C).

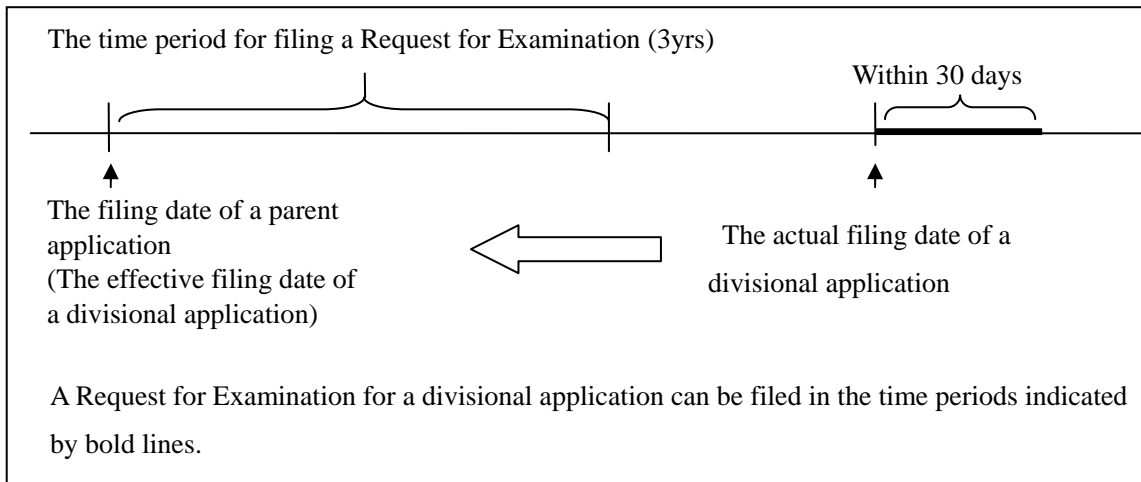


Fig.23-C

Q16. Requirements for Divisional Application

- (1) What are the other requirements to file a divisional application besides a time period?
- (2) What does an applicant filing a divisional application after April 1, 2007 have to pay attention to?
- (3) In a divisional application, is it necessary to submit a priority document, even though it is submitted in its parent application?

A16. (1a) In the Patent Law, a divisional application satisfying the following requirements has the benefit in which the divisional application is deemed to have been filed on the filing date of its parent application (Art.44(1)).

(1a-i) The parent application includes two or more inventions; and

(1a-ii) Only a part of the inventions in the parent application is claimed in the divisional application.

If a divisional application does not satisfy the above-requirements, the divisional application cannot obtain the benefit. In this case, the filing date of the divisional application is the actual filing date of the divisional application.

(1b) In the Examination Guidelines issued by the JPO, the above-requirements (1a-i) and (1a-ii) are interpreted as follows:

(1b-i) An invention claimed in a divisional application has to be described in the specification and drawing at the time when the divisional application is filed;

(1b-ii) (An) invention(s) claimed in a divisional application is/are not all of inventions

described in the specification and drawing at the time when the divisional application is filed;
and

(1b-iii) A divisional application must not include a new matter not disclosed in the original claims, specification and drawings of its parent application.

(1c) If a divisional application filed in the time period according to the aforementioned A23.(1c-i or 1c-ii), the subject matter which used to be claimed in the original specification but not claimed in the last specification immediately before the Office Action or Decision of Rejection cannot be claimed in the divisional application. This is because the subject matter not claimed in the last specification must not be recaptured by any amendments.

(2a) In the case where a divisional application whose parent application was filed on or after April 1, 2007, even though the Office Action is not made FINAL, there is a case the Office Action is substantially treated as FINAL as follows.

If a reason of rejection notified in an Office Action in a divisional application is the same as the reason already notified in the prosecution in its parent application, even though the Office Action is not FINAL, an amendment for the Office Action is restricted in accordance with the manner of amendment in the case of a FINAL Office Action (Art.17-2(5), 50-2).

(2b) Regardless of the filing date of the parent application, an applicant who files a divisional application has to submit a Statement. In the Statement, the applicant has to state:

(2b-i) If the divisional application has a portion modified from its parent application, that the modified portion is substantially included in the description of the original specification of the parent application;

(2b-ii) That the rejection notified in the prosecution in the parent application has been already overcome; and

(2b-iii) That each invention claimed in the divisional application is not identical to any inventions claimed in the parent application.

(3) No. As long as documents (e.g. a priority document, a written statement required in the article for exceptions to lack of novelty) are submitted in its parent application, it is unnecessary to submit those documents in the divisional application (Art.44(4)). The documents submitted in the parent application are deemed to be submitted on the actual filing date of its divisional application.

Q17. Conversion to Utility Model Application

Is it possible to file a divisional application as a utility model application from a patent application?

A17. Yes. A divisional application filed out of a patent application can be a utility model

application by conversion of application. The conversion to a utility model, however, is only possible within 9 years and 6 months from the filing date of the patent application.

(v)Priority

Q18. Inventors to be included

In filing a Japanese patent application where convention priority is claimed based on two or more earlier U.S. cases, must the Japanese case include all inventors named in all convention cases, even if the claims of the Japanese case do not include contributions by one or more of the inventors named in the convention cases?

A18. The Patent Law does not provide definite guidance as to how to deal with relationship between claims and inventors. For example, in Japan, there is no practice to amend the name of any inventor according to an increase or decrease in the number of claims.

Thus, it seems that the JPO does not concern itself about the decision as to whether to include all inventors named in all convention cases in the case of filing a Japanese patent application. Discrepancies for inventors between U.S. and Japanese applications do not create any negative result during the prosecution before the JPO. It is correct, however, to include names of all the original inventors into the Japanese application, as far as they contributed to any part of the claimed inventions of the Japanese application.

Q19. Omitted Priority

If a claim of priority is omitted when the application is filed, by accident, is there any way to correct such error?

A19. There is no way to correct the error. It is not allowed to add a claim of priority to an application after it has been filed.

In this connection, if the error were found before the expiration of the priority period, it is possible to withdraw the application and re-file an application with the addition of the claim of priority, within the priority term of the basic application.

Q20. Claiming Both U.S. and Japanese Priorities

Assume the following facts:

The original U.S. application is filed on January 1, 2005 and claims invention "A";
and

The Japanese Convention application is filed on January 1, 2006 and claims priority on the original U.S. application. Then, whether a second Japanese application can be properly filed on January 1, 2007 with claims for inventions A and A' and claim priority on

the original U.S. application, and also the first Japanese application?

A20. No, the second Japanese application cannot enjoy the benefit of priority based on said earlier original U.S. application. Further, the second Japanese application cannot enjoy the benefit of priority for invention A based on the first Japanese application, since the first Japanese application has already enjoyed the benefit of priority for invention A based on said earlier original U.S. application.

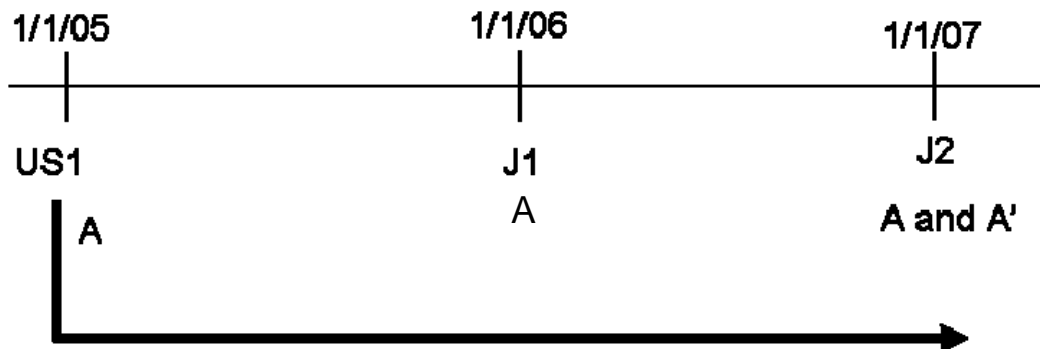
Q21. Hypothetical Case and Discussion

Assume the following factual situation:

- a. January 1, 2005 – the U.S. application (US1) is filed claiming “A”;
- b. January 1, 2006 – the Japanese application (J1) is filed claiming “A” and claiming priority based on the U.S. application filed on January 1, 2005 (US1); and
- c. January 1, 2007 - a second Japanese application (J2) is filed claiming “A and A’” (“A’” is added), and claiming priority based on both the U.S. application filed on January 1, 2005 (US1) and the Japanese application filed on January 1, 2006 (J1).

Whether under the Japanese practice, is the second Japanese application (J2) noted in “c” above a proper application?

Time Line



A21. The second application is a proper application as an application. However, the claiming Convention priority may be denied depending on the situation which will be explained below.

(1) With respect to the claimed invention “A”:

First, the U.S. priority based on the U.S. application (US1) will be apparently denied in the course of prosecution for the reason that the second Japanese application (J2) was filed more than one year after the priority date [Paris Convention Art.4A(1) and 4C(1)].

Second, the so-called internal priority based on the first Japanese application (J1) will also be denied, because the Patent Law Art.41 prohibits extension or accumulation of the period of priority.

Third, a patent application is laid open after one year and 6 months from the filing date of the first application or the priority date, if the Convention priority is claimed in the application. Therefore, the first Japanese application (J1) may have already been laid open when the second Japanese application (J2) was filed.

Accordingly, as for the inventive part of the claim "A", the second Japanese application (J2) will be rejected for lack of novelty over the laid-open publication of the first Japanese application (J1).

(2) With respect to the inventive part of the claimed invention "A":

Depending upon when "A" is first disclosed in a specification, different results may take place as follows:

(i) If "A" is first disclosed in the U.S. application (US1) and "A" is also included in the first Japanese application (J1), the invention "A" will be rejected for the same reason as in the case of "A";

(ii) If "A" is first disclosed in the first Japanese application filed January 1, 2006 (J1), the second Japanese application (J2) can enjoy the benefit of the internal priority; or

(iii) If "A" is first disclosed in the second Japanese application filed January 1, 2007 (J2), as for the inventive part of the claim "A", the second application (J2) will be considered and handled as the "first" or "earliest" application.

Q22. Hypothetical Case and Discussion, Continued

Assume the following factual situation (similar to Q28):

a. January 1, 2005 – the U.S. application (US1) was filed claiming "A";

b. A PCT (U.S.) application (PCT) was filed claiming "A" and claiming U.S. priority of January 1, 2005 (US1) (please note that on or after January 1, 2004, when a PCT application is filed, all the member countries are automatically designated);

c. July 1, 2006 - A first Japanese application (J1) was filed claiming "A" and claiming priority (U.S.) of January 1, 2005 (US1) and PCT of January 1, 2006 (PCT); and

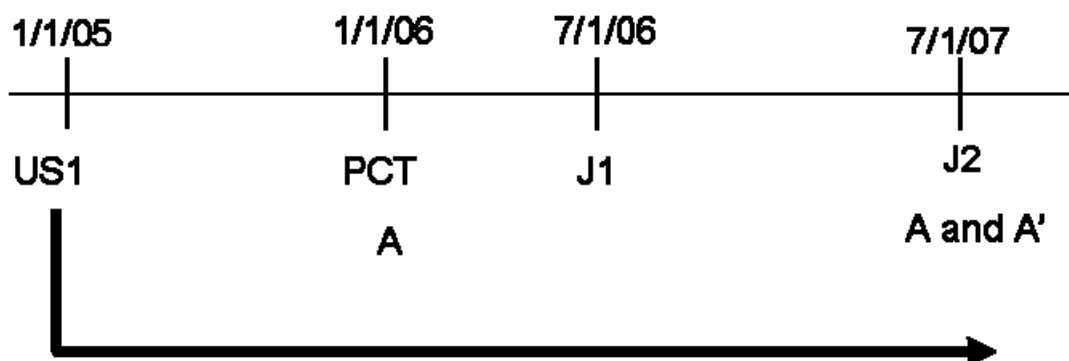
d. July 1, 2007 - A second Japanese application (J2) was filed claiming "A" and "A'", and also claiming priorities based on all of January 1, 2005 (US1), (PCT) of January 1, 2006 (J1) and (JP) of July 1, 2006 (J2).

Whether under the Japanese practice, is the second Japanese application (J2) a proper application?

A22. The second application is a proper application as an application. However, the

claiming Convention priority may be denied depending on the situation which will be explained below.

Time Line



(1) With respect to the claimed invention “A”:

First, all of the priority claims based on the U.S. application (US1), the PCT application (PCT), and the first Japanese application (J1) will be denied in the course of prosecution for the same reason as stated in Q28.

Second, the first Japanese application (J1) may have been already laid open when the second Japanese application (J2) was filed, because the period of one year and 6 months for open-laying the application is counted from the international filing date of the PCT application (January 1, 2006). In addition, the PCT application (PCT) should have been already internationally published when the second Japanese application (J2) was filed.

Accordingly, as for the inventive part of the claim “A”, the second Japanese application (J2) will be rejected for lack of novelty over the laid-open publication of the first Japanese application (J1) or the international publication of the PCT application (PCT).

(2) With respect to the claimed invention “A”:

Depending upon when “A” is first disclosed, different results are expected to take place as follows:

(i) If “A” is first disclosed in the U.S. application filed January 1, 2005 (US1) or the PCT application (PCT), the invention “A” will be rejected for the same reason as in the case of “A”;

(ii) If “A” is disclosed in the first Japanese application filed July 1, 2006 (J1), the second Japanese application (J2) can enjoy the benefit of the internal priority;

(iii) If “A” is first disclosed in the second Japanese application (J2) filed on July 1, 2007, as for the inventive part of the claim “A”, the second application (J2) will be considered and handled as the “first” or “earliest” application.

(vi) Internal Priority

Q23. How Internal Priority is Claimed

Is it possible to file a Japanese application (patent or utility model) which claims the priority based on an earlier filed Japanese application (patent or utility model) within the priority year (so-called internal priority period) allowing inclusion of earlier related invention made within the priority year?

A23. Yes, it is possible.

The internal priority system provides an applicant of a Japanese application with the same benefit as enjoyed by those of Paris Convention applications.

A later filed application claiming an internal priority based on an earlier filed application can protect a fundamental invention as well as its improvements or peripheral inventions. In this case, the invention of the earlier Japanese application is combined with the later filed application as a single application and the earlier filed application is deemed withdrawn after a lapse of 1 year and 3 months (15 months) from the priority date (the filing date of the earlier filed application).

Q24. How is Double Patenting Avoided in the Case of the Internal Priority?

Where one files a later Japanese application claiming the internal priority based on an earlier filed Japanese application and claiming the same subject matter plus additional subject matter, can one avoid a double patenting rejection by filing of withdrawal of the earlier-filed application?

A24. As stated above, a single application will only be pending, which is the later filed Japanese application which covers the original invention contained in the earlier filed Japanese application and the related improvements or related different inventions contained in the later filed Japanese application. Accordingly, the double patenting rejection should not take place for the internal priority application.

(vi) National Phase Entry of PCT Application

Q25. Nationalizing a PCT Application

(1) When can a national phase application be filed in Japan?

(2) A PCT application was filed in the U.S. Patent and Trademark Office. Please explain the procedure involved in commencing the national phase in Japan.

A25. (1) A national phase application must be filed within 30 months from the priority date, irrespectively of the filing of a demand under Chapter II of PCT has been filed.

(2) It is required to file a petition for commencing a national phase in Japan and a

Japanese translation of each of the specification, claims, abstract and, if any English legends are contained in drawings, those drawings of the international (PCT) application as originally filed.

The petition of a national phase application must be filed within 30 months from the priority date, but you can file within two months from the filing date of petition about a translation when the petition is filed within two months before the termination date.

The Japanese translation of the Amendment filed and entered under Art.19 and/or Art.34 of the PCT can also be filed, but this is not mandatory. If the applicant wishes the national phase application to be examined with the amended claims, it should be necessary to submit the Japanese translation of the Amendments under Art.19 or 34 of the PCT.

However, please note that an introduction of new matter is prohibited.

Further, when the applicant amended under Art.19 of the PCT, the applicant can file a translation of the amended claims instead of a translation of claims originally filed in the international (PCT) application.

It is recommendable to submit the Amendment when a request for examination is filed, after having carefully reviewed the Amendment in respect of whether or not the amended matter would be considered as introducing new matter under our patent practice. By this, you can save unnecessary cost for translation of the Amendment at the time of filing the national phase application in Japan. In addition, you can take into the consideration, any change in technical importance or any new prior art found in relation to the claimed invention up to the time when a request for examination is filed, which situation may affect your claiming in the Japanese application.

The original applicant of the national phase application in Japan must be the inventor(s) or, if the invention was assigned, the assignee(s) who is named in the petition. We recommend, therefore, that when you instruct your Japanese associate to file a national phase application in Japan, you send a copy of the request of the international application and documents to be translated together with your instruction.

(vii) Utility Model

Q26. Outlines of Utility Model System in Japan

Explain outlines of the utility model system in Japan.

A26.

(1) Targets of Protection

Targets of protection, called "a device", by the Utility Model Law are limited to technical ideas relating to the shape, structure or combination of an article including articles and immovable properties, such as buildings, bridges, and plants. In other hands, materials

themselves (e.g.: medicines, chemical compounds, glasses and alloys etc.), and methods are not the targets of protection.

(2) Novelty

Similar to the patent system, the Utility Model Law establishes three cases for novelty-breaking: publicly-known; publicly-worked; and publication in Japan or other countries before a filing date of an application. Note that the novelty breaking cases are not limited to be domestic.

(3) Inventive Step

While the patent system requires an invention not to be easily obtained by a person skilled in the art (Art.29(2) of the Patent Law), the utility model system requires a device not to be very easily obtained by a person skilled in the art (Art.3(2) of the Utility Model Law). It seems that the inventive step of the invention is higher than that of the device. However, the inventive steps of the patent system and the utility model system are treated as to be equal in a technical opinion (see (9) below) issued by the JPO, substantially there exists no difference between them.

(4) Procedures for application

All the utility model applications should be accompanied by drawings (Art.5(2) of the Utility Model Law), because an object of protection is limited to the device of an article. Further, the annual fee for each year from the first to the third year shall be paid in a lump sum, simultaneously with the filing of the utility model application.

(5) Fees

Fees for a utility model application and registration are lower than fees for a patent application and registration.

(6) Examination

A utility model right is granted only after the examination of formal and basic requirements except substantive requirements (e.g. novelty and inventive steps etc), so that a non-substantive examination system is adopted in the Utility Model Law. Therefore, if a utility model application satisfies the formal and basic requirements, the application will be registered. However, if it does not satisfy the substantive registration requirements, it shall be disputed in an appeal for invalidation (Art.37 of the Utility Model Law). It is noted that a utility model application will be registerable in about 4 months from the filing date, while a patent application will be registerable for in about 27 months from the date of request for examination (as of 2006).

(7) Amendment and Correction

The applicant may file amendments only for one month from the filing date or a period specified by the Commissioner.

Further, the owner of a utility model right shall be entitled to one opportunity to correct the description, claim(s) for utility model registration or drawing(s) attached to the request, excluding the prescribed cases (Art.14-2(1) of the Utility Model Law).

However, only where correction has as its objective the cancellation of claim(s), the owner of a utility model right may correct the description, claim(s) for utility model registration or drawing(s) without limitation for the time or number of times, excluding after the notification of the conclusion of trial examination (Art.14-2(7) of the Utility Model Law).

(8) Term of right

The term of the utility model right is 10 years from the filing date of the application (Art.15 of the Utility Model Law), while the term of patent right is 20 years from the filing date (Art.67 of the Patent Law).

(9) Exercise of right

Basically, a utility model right is the same as a patent right in the exercise of right, but it is different from the patent right in that the utility model right may be exercised only after giving a warning in the form of a report of a technical opinion as to registrability of the utility model in order to avoid abuse of the right (Art.29-2 of the Utility Model Law).

However, where the owner of a utility model right has exercised their utility model right or given a warning to an infringer, and a trial decision that the utility model registration is to be invalidated has become conclusive, such owner shall be liable to indemnify any other party with respect to any damage caused to that party by the exercise of that right or by the giving of the warning (Art.29-3(1) of the Utility Model Law). The reason, therefore, is that the technical opinion is a kind of nonbinding comment of the Japan Patent Office.

Any person may make, to the Commissioner of the JPO, a request for a technical opinion (Art.12 of the Utility Model Law). The request may be made even after the expiration of the utility model right except when the registration has been invalidated in a utility model invalidation trial. It takes about six months from the date of request to get the technical opinion.

Q27. Conversion between Utility Model Application and Patent Application

Is it possible to convert between an utility model application and a patent application?

A27. Yes, A utility model application may be converted to a patent application and *vice versa*. A utility model application may be converted into a patent application within 3 years from the filing date of the utility model application only during the pendency of the case before the JPO. The owner of a utility model right may file a patent application on the basis on their utility model registration (Art.46-2 of the Patent Law). However, in such a case, the

owner shall abandon their utility model right in order to avoid double registration.

Q28. Double Registration (Branch Off)

Can a utility model right and a patent right on same subject matter stand parallel? Namely, can a utility model application be branched off from a patent application?

A28. No, double registration of a utility model right and a patent right is not admitted. Thus, filing a converted utility model application from a patent application causes withdrawal of the original patent application.

(viii) Fees

Q29. Official Fees Calculation

How official fees are determined for claims?

A29. Official fees are required for filing an application, a request for examination, and annuities.

The official fee for filing the application is a fixed amount.

The official fee for request for examination and an annuity are calculated based on the number of the claims.

Q30. Additional Fees for Multiple Dependent Claim

Are additional fees for a multiple dependent claim imposed?

A30. No. Regardless of single/multiple dependency, a single claim is counted as one in fee calculation.

Q31. Attorney's Fees

Show brief amount of a Japanese patent attorney's charge for filing a patent application. Is there any standard fee schedule or such?

A31. The JPAA (Japan Patent Attorneys Association)'s standard price on services has been abolished since 2001. Thus, there is no fixed standard fee schedule for attorney's fee. Attorneys and clients should previously determine and agree with fees.

Therefore, showing the amount of charge is difficult because it differs depending upon attorneys, technical fields, volume of the contents, etc.

For your information, translation costs (English to Japanese) for typical cases may fall within about JPY200,000 to JPY500,000. According to the survey conducted by JPAA in 2003, 80% of the domestic applications for a typical model case (15 pages of specification, 5 claims, 5 drawings, and 1 page of abstract) fall within JPY250,000 to JPY350,000.

(ix) Others

Q32. Non-Inventor's Application

Is an application filed by a non-inventor, who has received an invention from a true inventor and filed the application without a succession of a right to obtain a patent for the invention, destined to be refused, like 35 U.S.C. 102(f)?

A32. Theoretically, Yes, filing by a non-inventor brings a reason for rejection, Art.49(vii). However, undue succession of a right to obtain a patent cannot generally be noticed by the Examiner. Then, the non-inventor's application seems to be granted in many cases. See next question.

Q33. Non-Inventor's Patent Right

Is a patent right obtained by a non-inventor invalid?

A33. Yes, obtaining a patent right by a non-inventor brings a reason for invalidation, Art.123(vi). To invalidate the non-inventor's patent right requires an appeal for patent invalidation.

Q34. Recovery against Non-Inventor's Application/Patent Right

Explain a recovery against non-inventor's application/patent right, namely, a way to win the patent right by its true owner.

A34. The ways differ depending on its situation.

(1) Before a publication of a foregoing non-inventor's application

In this case, the non-inventor's application has a reason for rejection and the invention still keeps its novelty. The true owner can file an application and during its prosecution the Examiner may raise a reason for rejection, based on Art.29-2 (unpublished prior art)*. In a reply to the office action, the true owner can point out that the cited application has defect and the inventor of both applications are same, Art.29-2 cannot be applied.

Note that, generally it is extremely difficult to know that non-inventor's application has been filed before its publication.

*Under current practice, a reason based on Art.39 (first to file rule) will not be raised because the applicants of the two applications are different.

(2) After a publication of a foregoing non-inventor's application, within six months from the publication date

In this case, the invention has lacked its novelty, but Art.30(2) (grace period in case of unwilling disclosure) is applicable. The true owner still can file an application with claiming grace period, see also Q56.

(3) After six months from a date of a publication of a foregoing non-inventor's application.

In this case, the invention has lacked its novelty, thus a patent right for the invention cannot be obtained by filing a new application.

Before a grant of the non-inventor's patent application, status as the applicant can be retrieved by filing a notification of change in applicant to the JPO with a deed of assignment. If the non-inventor do not agree with the deed, final and conclusive judgment of a quiet title action for the status as the applicant can substitute the deed.

After the grant, revised Art.74 will allow assignment of the patent right obtained by the non-inventor to the true owner. The effective date of revised Art.74 is April 1, 2012.

Q35. Time vs. Day

Explain cases where a filing time or a filing date of an application is considered.

A35. Novelty of the claimed invention is determined by the filing time of the application (Art.29(1)). Theoretically, even if the application is filed on the same day as the publication of an invention by a third party, but the application is filed before the publication of the invention on the same day, then the claimed invention is novel over the publication. Under current practice, the JPO records only a filing date of an application, the Examiner will not raise a lack of novelty or inventive step based on a document having a publication date same as the filing date of the application. For more details, see the Examination Guidelines, Part II, Chapter 2(http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm).

Conversely, first to file rule is based on the filing date of the application (Art. 39), see Q69.

II. EXAMINATION

II.1 Patentability

(i) Statutory Requirements

Q36. Statutory Requirements

Explain Statutory Requirements in Japanese practice.

A36. Art.2(1) defines patentable invention as “*An advanced creation of a technical idea using natural laws*”. Moreover, Art.29 also requires industrial applicability. That brings that a man-made rule, a mathematical formula, and a personally usable method etc. cannot be patented.

In addition, there are specific technical matters as follows:

(1) Medical method

A method of human treatment cannot be patented by a lack of the industrial applicability. However, a medicine, a treatment apparatus, and a method for controlling a treatment apparatus can be patented. A method of animal (non-human) treatment can also be patented unlike European practice.

(2) CII (Computer Implemented Invention)

A computer implemented invention, such as software or a business-model, can be patented only when it is considered to use natural laws. Under Japanese practice, claiming practical information processing using hardware can fulfill this requirement. A basic concept of the CII, such as a business-model, is not necessarily to be technical itself.

(ii) Unity of Invention

Q37. Unity of Invention

What is the requirement of the unity of invention in Japan?

A37. If all the claimed invention in a single application is linked as to form a single general inventive concept, the application meets requirement of the unity of invention. This requirement corresponds to the rule 13 of the PCT.

More concretely speaking, if two or more inventions have same or corresponding specific technical feature, these inventions satisfy the conditions of the unity of invention. Here, “specific technical feature” means a technical feature apparently contributes to the invention over prior art.

For more details of examples, see the Examination Guidelines, Part I, Chapter 2(http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm).

(iii) Enablement Requirement

Q38. Enablement requirement

How should a claimed invention be disclosed in a detailed description of the invention?

A38. In the JPO, the detailed description of the invention shall be described in such a manner that a person skilled in the art can carry out the claimed invention.

Q39. Incorporation by Reference (IBR)

Is IBR available in Japan?

A39. No. In the JPO, the detailed description of the invention shall be described in such a manner that a person skilled in the art can carry out the claimed invention on the basis of matters described in the specification and drawings taking into account the common general knowledge as of the filing. Therefore, incorporation of the whole or part of a prior art document by a mere reference and/or by mere stating that its content is incorporated is not allowed.

Q40. Number of Working Examples Needed to Satisfy the Enablement Requirement

How many working examples are needed to satisfy the enablement requirement?

A40. As stated above, in JPO, the detailed description of the invention shall be described in such a manner that a person skilled in the art can carry out the claimed invention on the basis of matters described in the specification and drawings taking into consideration the common general knowledge as of the filing. Therefore, if "a person skilled in the art" who is supposed to have ordinary skill cannot understand how to carry out the invention on the basis of teachings in the specification and drawings taking into consideration the common general knowledge as of the filing, then, such a description of the invention should be deemed to be insufficient for enabling such a person to carry out the invention. For example, if a large amount of trials and errors or complicated experimentation is needed to find a way to carry out the invention beyond the reasonable extent that can be expected from a person skilled in the art, such a description should not be deemed to be sufficient. On the other hand, in cases where it is possible to explain the invention so as to enable a person skilled in the art to carry out the invention, no working examples are necessary. Accordingly, the number of working examples needed to satisfy the enablement requirement depends on the claimed invention.

Q41. Best Mode of Practicing the Invention

Is the best mode of practicing the invention required to be disclosed?

A41. It is proper to describe the mode that an applicant considers to be the best about the modes for carrying out the invention in terms of the requirements in Art. 36(4)(i). However, even if it is clear not to describe the mode that an applicant considers to be the best, it does not constitute a reason for rejection.

Q42. Advantageous effects or merits of the invention

Is the advantageous effects or merits of the invention required to be stated in the description?

A42. An applicant should describe an advantageous effect of a claimed invention over the relevant prior art, if any, as far as he/she knows.

(iv) Support Requirement

Q43. Extent of Disclosure in the Description and Drawings vs. Broadness of Claims

How the claims must be supported by the description?

A43. Art. 36(6)(i) requires "*statement setting forth the invention for which patent is sought and which is described in the detailed description of the invention.*" The JPO states that typical cases exhibiting nonconformity to the provision of Art. 36(6)(i) are presented as follows;

(1) the matter corresponding to claims is neither stated nor implied in a detailed description of the invention;

(2) the terms used in claims and those used in a detailed description of the invention are inconsistent, and as a result, the relationship between a claim and a detailed description of the invention is unclear;

(3) the matter disclosed in a detailed description of the invention cannot be extended and generalized to the scope of the matter in a claimed invention even if taking into account the common general knowledge as of the filing; or

(4) a means for solving the problems described in a detailed description of the invention is not reflected in the claims, and as a result, a patent beyond the scope described in a detailed description of the invention is consequently claimed.

Q44. Undue Breadth (Claims Reading on Inoperative Subject Matter)

Does the presence of inoperative embodiments within the scope of a claim render the claim non-enabled?

A44. Yes. As stated above, Art. 36(6)(i) requires "*statement setting forth the invention for which patent is sought and which is described in the detailed description of the invention,*"

and therefore a claim must be supported over the whole of its breadth.

Q45. Burden of Proof on Support Requirement

Is the burden of proof on support requirement on the Examiner?

A45. No. The burden is on the applicant to establish why the result expected could be reached for a whole extent of the claimed subject matter.

(v) Clarity Requirement

Q46. Definition by Function

Is it possible to define a claimed invention by function?

A46. Yes. There is no prohibition against the use of functional language in the claims. However, the JPO states that when the claims include matters defining a product by its function or characteristics, etc., the scope of the invention cannot necessarily be clear and an invention for which a patent is sought may not be clearly identified.

Q47. Definition of Terms

How is a claim examined when the claim statement is unclear?

A47. Where the statement in a claim is deemed to be unclear by itself, the Examiner should examine whether a term in the claim is defined or explained in the specification and drawings, and should evaluate whether such definition or explanation, if any, makes the claim statement clear by considering the common general knowledge as of the filing.

Q48. Recitation in Optional Form

Are optional expressions permitted in a claim?

A48. If there are expressions where optionally added items are described along with such words as "when desired," "if necessary," "preferably," etc., there are some cases that the statement of the claims is not clear. Further, if there are recitations where numerical ranges include zero, for example, 0 to 10%, such a claim may be unclear since it is unclear as to whether the component concerned should be included or not, i.e., indispensable or optional.

Q49. Use of Ambiguous Terms

Do ambiguous terms indicating extent automatically render a claim invalid due to indefiniteness?

A49. As a rule, ambiguous terms indicating extent shall not be used when writing a claim. If there are expressions where the standard or degree of comparison is unclear such as

"with slightly greater specific gravity," "much bigger," "low temperature," "high temperature," "hard to slip," "easy to slip" or where the meaning of the term is unclear, there are some cases that the scope of the invention is not clear.

Q50. Claims Attempting to Define the Invention by Objectives to be Attained

Can a claim be defined by objectives to be attained?

A50. The JPO states that where a claim includes the definition of a product by the result to be achieved, there may be cases where concrete products which can obtain such a result cannot be conceived. When a certain concrete means which can obtain such result is disclosed in the specification or drawings and it is also recognized that only the concrete means is substantially disclosed, the scope of the invention is usually deemed to be unclear.

Q51. Devices or Products with Limitations on Their Usage

May devices or products be claimed with limitations on their usage?

A51. Yes. When devices or products are claimed with limitations on their usage, the protection conferred by the claim is interpreted as being limited to the stated use.

(vi) Novelty

Q52. Novelty

What are novelty requirements?

A52. The Patent Law establishes three cases for novelty-breaking: publicly-known; publicly-worked; and publication. The publication contains publication by document and publication by electric telecommunication lines, so-called internet publication. A claimed invention must not fall under these cases.

Q53. Details of Novelty Requirements

Explain details of novelty requirements.

A53. Art.29(1) provides that a claimed invention loses its novelty when the invention comes under following cases:

(1) publicly-known

An invention publicly known in Japan or other countries before a filing date of an application;

(2) publicly-worked

An invention publicly worked in Japan or other countries before a filing date of an application; and

(3) publication

An invention described in a document distributed to or utilizable by the public through electric telecommunication lines in Japan or other countries before a filing date of an application.

Note that “a document” is construed as a medium which have been made for the purpose of disclosure to the public by way of distribution. Therefore, “a document” includes, for example, a microfilm, a floppy disk or other media.

Further, “described” requires a skilled person technically recognizes the invention subject to the state of the art at the filing date. Therefore, “an invention described in a document” refers to an invention recognizable from the explicit description of the document and matters amount to be described therein.

“electric telecommunication lines” needs to be bidirectional, so one-way telecommunications, such as broadcasting, are not included. Internet connection is included, of course.

“utilizable by the public” means that the web page including information about an invention is linked from other web pages on the Internet or is placed within search engines and the web page is not inaccessible to the public. “utilizable” does not need actual view by somebody, a “utilizable” state itself can fulfill this requirement.

Q54. Date of Publication of a Paper Submitted to a Journal

Would a paper submitted for consideration by a professional journal be a “publication” as of the date it is submitted to the journal (i.e., before the journal actually prints the paper)?

A54. No. Even though the paper has been submitted for consideration by a professional journal, it has not been actually distributed to a person having no secrecy obligation. Therefore, the actual distribution date of the journal is considered to be the publication date.

Q55. Oral Presentation

If an oral presentation describing an invention is made at a conference of specialists, is the event considered to be one where the invention is publicly used or known in Japan?

A55. If the specialists do not have any confidentiality obligation with respect to the invention, the oral presentation will constitute an event that results in the invention becoming publicly known or used. On the other hand, if the specialists are actually obligated to keep the invention secret under certain regulations or if they are deemed to be most likely obligated to do so, it does not constitute an event resulting in public knowledge or public use in Japan. The obligation can be cultural or institutional, based on established practice or

procedure, and need not be legally enforceable.

Q56. Grace Period

Is there Grace Period in Japan?

A56. Yes. According to Art 30, which was amended in 2011, an applicant can claim Grace Period of six months, if their invention loses novelty against the will of the applicant or if their invention loses novelty due to their own act. However, exceptionally, if their invention is published by the JPO or a foreign patent office, the applicant will receive no Grace Period.

The effective date of amended Art 30 is April 1, 2012.

Q57. Presentation via Internet

Can the six-month grace period be enjoyed for the presentation of invention on the Internet?

A57. Yes. In this case, a certificate proving the fact of the presentation of invention on the internet should include (1) an internet address (URL), (2) a date on which the invention is presented on the internet, (3) a name of a person or entity who makes the presentation of the invention on the internet, and (4) explanation to identify the invention. In order to prove the fact including the items (1) to (4) by objective evidence(s), a printed copy of a webpage including the items (1) to (4) is generally required. Furthermore, a certificate by one who is responsible for information on the webpage is also required, except that the website is highly unlikely to be suspected on its credibility.

Q58. Presentation Outside Japan

Will the six-month grace period be applied for the invention presented outside of Japan? If yes, will such presentation be a prior art for a patent application in Japan, if a Japanese application claims a convention priority based on a foreign application which has been filed within 6 months from the presentation?

A58. Yes, the grace period can be enjoyed for the presentation of invention conducted outside of Japan. The presentation can be made any language including English as well as Japanese. When a certificate proving the fact of the presentation includes a document written in non-Japanese language, translation of Japanese should be attached.

A presentation conducted outside of Japan will be a prior art for an application in Japan unless the Japanese application is made within 6 months from the date of the presentation. Claiming a convention priority based on a foreign application which has been filed within 6 months from the presentation does not qualify the applicant to enjoy the benefit of the grace period.

Q59. Procedures for Grace Period

Explain procedures required to receive grace period.

A59. Patent Law Art.30(1) and (4) defines as follows:

(1) The patent application must be filed in Japan within 6 months from the date on which the inventor makes the presentation of the invention, even when the application claims convention priority;

(2) A written statement to seek protection by the grace period must be submitted simultaneously with the filing of the application; and

(3) A certificate proving the fact of the presentation of the invention must be filed with the JPO within 30 days from the filing date.

If the application is filed as a PCT international application designating Japan, the applicant can also enjoy the benefit of the 6-month grace period as long as the PCT application is filed within 6 months from the presentation of the invention [the Patent Law Art.184-14]. In this case, the written statement and the certificate must be submitted to the JPO within 30 days after expiration of the 30-month period from the priority date (or within 30 days from the date on which a request for examination is filed, when the request for examination is filed within the 30-month period).

Q60. Document published during Grace Period

Is a document which is published by the third party during the 6-month grace period regarded as a prior art?

A60. Yes. The provisions for the grace period in Japan give exception to lack of novelty of invention which satisfies certain requirements (the Patent Law Art.30). However, this grace period has no retroactive effects in respect of the filing date. Thus publications by the third party or any patent application filed prior to the filing date will be prior arts even the applicant receives the grace period.

(vii) Inventive Step

Q61. Inventive Step in Japan

How the Law requires for an inventive step?

A61. Art. 29(2) settles:

Where an invention could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention or inventions referred to in any of the paragraphs of Subsection (1), a patent shall

not be granted for such an invention notwithstanding Subsection (1).

Q62. Definition of Person Skilled in the Art

Explain about a person skilled in the art.

A62. The current Examination Guidelines defines a person skilled in the art as follows. *In determining non-obviousness of the invention, the Examination Guidelines, Part II, Section 2.2(2) prescribes that a person skilled in the art is a hypothetical person who has a common general knowledge in the art at the time of filing the application and ability to use ordinary technical means for research and development, can exercise ordinary creative ability in selecting materials and changing designs, is capable of comprehending all technical matters in the state of the art at the time of filing the application, and is capable of comprehending all technical matters in the field of technology relevant to the problem to be solved by the invention. Thus, Examiner is not considered to be a person of ordinary skill in the art, but Examiner is supposed to carry out the examination taking the knowledge of such hypothetical person into consideration.*

Q63. Additional Experimental Data

Can we submit an additional experimental data to overcome inventive step rejection?

A63. Generally, yes. Examination Guideline explains “Effects to be considered, asserted in a response to an office action” as follows:

Where advantageous effects compared to cited inventions are described in a specification, or where advantageous effects are not explicitly described but can be inferred from the statements in the specification or the drawings by a person skilled in the art, the effects asserted or verified (e.g., experimental results) in a written argument, etc. should be considered. However, the effects asserted in the written argument, which are not described in the specification and that a person skilled in the art couldn't deduce from the description of the specification or the drawings, should not be taken into consideration.

Q64. Inventive Step in Selective invention

Explain how an inventive step is considered in a selective invention.

A64. In accordance with the Examination Guideline, a selective invention involves an inventive step, when it generates an advantageous effect, not disclosed in a cited reference, qualitatively different or qualitatively the same but quantitatively prominent in comparison with that of an invention with a generic concept in a cited invention, neither of the effect being foreseen by a person skilled in the art from the state of the art.

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

Q65. Unpublished Prior Art

Does a disclosure in unpublished prior application prevent later filed patent application from grant?

A65. Yes. Art.29-2 settles:

Where an invention claimed in a patent application is identical with an invention or a device disclosed in the specification or drawings originally attached to the request of another application for a patent or of an application for a utility model registration which was filed prior to the filing date of the patent application and for which the Patent Gazette which states the matter referred to in each paragraph of Art. 66(3) of the said Law (hereinafter referred to as "the Gazette containing the Patent") was published under the said subsection or the laying open for public inspection was effected or the Utility Model Gazette which states the matter referred to in each paragraph of Art. 14(3) of Utility Model Law (No. 123 of 1959) (hereinafter referred to as "the Gazette containing the Utility Model") was published under the said subsection after the filing of the patent application, a patent shall not be granted for the invention notwithstanding Art. 29(1).

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

Is Art.29-2 applied to a case where inventors or applicants of a prior application and a present application are same? In other words, is an unpublished prior art self-collisive?

A66. No, Art. 29-2 excludes self-collisive cases such as an invention or device made by the same person as the inventor of the invention claimed in the patent application. Moreover, this provision shall not apply where, at the time of filing of the patent application, the applicant of the patent application and the applicant of the other application for a patent or the application for a utility model registration are the same.

Q67. Foreign Unpublished Prior Art

Is Art. 29-2 applied to a case where a prior application is a foreign application other than Japan?

A67. No, Art.29-2 is only applied on a domestic application. Note that an application of the Japanese National Phase entry of a PCT application is treated as a domestic application. In such case, the language of the publication does not matter.

Q68. Priority vs. Unpublished Prior Art

What if the application claims priority?

A68. If the present application claims priority, Art. 29-2 will be applied as if the priority date is filing date.

(ix) First to File Rule

Q69. First to File or First to Invent

Which is prior, first to file or first to invent in Japan?

A69. Japanese patent law is based on the first-to-file principle. Under Art 39, where two or more patent applications claiming identical inventions have been filed on different dates, only the applicant who filed the patent application on the earliest date shall be entitled to obtain a patent for the invention claimed. If two or more applications have been filed on same day, the application entitled to obtain a patent must be determined by a conference of applicants.

(x) Specific Technical Field; Chemistry, Medicine and Biotechnology

Q70. Written Requirement for invention Concerning New Compound

If an inventor discovers a new compound that is effective for treating a disease, but does not know its mechanism, would the claim relating the compound be rejected if there is no description of the mechanism explaining how the compound works?

A70. No. In the case the claimed invention relates to a new compound, it would be sufficient to disclose: how to make and use the compound and the effect of the compound treating a disease. It is not necessary to clarify the mechanism (i.e. chemical reaction, biological reaction) of the compound.

However, in order to demonstrate the effect (efficacy data) of the compound for treating a disease, at least one working example would be required.

Q71. Second Use of a Known Pharmaceutical Composition

Is second use of a known pharmaceutical composition patentable in Japan?

A71. Yes. A claim may be drafted as follows:

“A pharmaceutical composition for treating (combating) disease X (second purpose) comprising a compound Y as an active ingredient.”

The novelty of a pharmaceutical invention is judged from the two viewpoints; one is the compound contained in the composition, and the other is the pharmaceutical use (e.g., The Tokyo High Court Judgment of April 25, 2001 (Heisei 10(Gyo Ke)401) etc.). Therefore, even if there is no difference in composition from a known pharmaceutical composition and

if the second pharmaceutical use is clearly different from the first pharmaceutical use, the pharmaceutical composition is patentable for the second use. However, if the second use is the species of the first use, for example, then the second use would not be distinguishable from the first use. In addition, if the second use can be derived from the first use (asthma treating composition vs. a bronchio-dilatation composition), then the novelty of the second invention would be denied.

Q72. Enablement Requirement for Medicine

Explain enable requirement for medicine.

A72. According to the Examination Guideline, normally one or more representative embodiments or working examples are necessary which enable a person skilled in the art to work the invention, except the case where a person skilled in the art can manufacture the compounds etc. and can use the compounds etc. for medicinal use, in the light of common general technical knowledge as of the filing. As for working examples supporting the medicinal use, a description of the result of the pharmacological test is usually required.

In order to confirm the pharmacological effect of compounds etc. of the claimed medicinal invention, all of the followings should be made sufficiently clear, in principle; (i) which compounds etc. are (ii) applied to what sort of the pharmacological test system, (iii) what sort of result is obtained, and (iv) what sort of relationship the pharmacological test system has with the medicinal use of the claimed medicinal invention. It should be noted that the result of the pharmacological test should be described with numerical data as a general rule, but when the result cannot be described with the numerical data due to the nature of the pharmacological test system, an objective description equivalent to the numerical data for example, a description of the objective observation result by a medical doctor may be accepted. Furthermore, a clinical test, an animal experiment, and in-vitro test are employed as the pharmacological test system.

Q73. Pharmacological Data

If the specification includes an example which exactly describes how to test the claimed chemical composition, can the data associated with the example later be added, if it is proven that the example is actual, rather than “paper” or “prophetic”?

A73. No. The written requirement (support and enablement) concerning the pharmaceutical invention is very strict in recent practice. If the pharmacological efficacy data of the pharmaceutical composition of the example (or the description which is considered equivalent to the pharmacological efficacy data) were not disclosed in the specification at the filing date of the patent application, it is almost impossible to obtain a patent for the

pharmaceutical composition. The addition of the data to the specification after the filing date of the present application is considered as new matter. "Paper" or "prophetic" examples are not considered as the working examples.

Q74. Physical-Chemical Data

What physical-chemical data are required in Japanese applications to support an invention of a composition which is a mixture of known ingredients?

A74. The physical-chemical data should be usually required in the specification for an invention of a composition. The chemical field is the technical field where the effect of a composition cannot be readily expected based on the components constituting the composition. A composition invention is usually invented for providing a new and useful composition for some intended purpose. Such usefulness is usually proved by the physical-chemical property of the composition relating to such intended purpose. The kind of the physical-chemical property of the composition should vary depending on the kind of the composition. For example, please assume that an adhesive composition has been invented, which provides a stronger adhesive property than the conventional adhesive composition. In order to confirm that the claimed adhesive composition is indeed useful as an adhesive composition, it is natural that the specification should contain physical-chemical data based on which the adhesive strength of the claimed invention can be evaluated.

Q75. Physical data or Test Data of a Compound

(1) Assuming that an invention is a chemical compound, are physical data (such as melting points, viscosity, etc.) required for support an invention of a chemical compound?

(2) If a herbicidal composition containing such a compound is claimed, are herbicidal test data required?

(3) How many examples are necessary?

A75.

(1) Yes.

It is usually necessary for supporting the utility of an invention of a chemical compound. Physical data or test data are useful for proving that the compound was actually prepared and for proving that the compound would be useful for the intended purpose (such as the use of an effective component for a pharmaceutical composition).

(2) Yes.

As stated above, the chemical field is the technical field where the effect of a composition cannot be readily expected based on the components constituting the composition. It is usually impossible to expect the property or usefulness of the compound.

Therefore, test data concerning the herbicidal effect should be usually necessary for proving an invention of a herbicidal composition.

(3) Depends on the cases.

The disclosure of the specification has to enable one skilled in the art to practice the claimed invention. The chemical field is the technical field where the effect of a compound cannot be readily expected from its chemical structure or chemical name. Further, the support requirement is recently strictly evaluated. The support requirement is to evaluate how broadly the working example justifies or generalizes the scope of the claimed invention. Therefore, it should be necessary to provide as many examples as possible at the filing date of the application. Generally, of course, at least one representative working example is required to support the chemical compound. If the chemical compound claimed is defined by the general formula covering a generic concept of a compound, which can broadly cover various distinct types of chemical structures from each other (such as an aliphatic group and aromatic group), it should be reasonably necessary to provide working examples for each one of the distinct chemical groups.

Q76. Later filed supportive Data

If ex-post supportive data lacking in original application, such as physical/chemical/medical data for a chemical compound, are newly added in corresponding application claiming priority in Japan, are any detriments anticipated?

A76. Yes, the priority may be denied. However, insufficient support or disclosure in the specification will cause a rejection of the application. Therefore, if the ex-post supportive data is essential to meet the support requirement or the disclosure requirement, there may be no choice. On the contrary, if the claimed invention is clear in its technical significance, such as usefulness, and can be prepared from the original disclosure, namely, a disclosure without the ex-post supportive data, the priority may be affirmed. (e.g., Part IV: PRIORITY, 4.2 Examples 4 to 6)

Q77. Paper or Prophetic Examples

In the U.S., chemical patent applications often contain a mixture of examples which have actually been carried out and examples which are prophetic (or "paper") examples. Do "paper" examples improve the acceptability of the Japanese patent application?

A77. No. The "paper" or prophetic examples do not either improve the acceptability of the Japanese patent application; or create a specific problem. The JPO does not accept "paper" examples only. In addition, it is not possible to add to the specification, any data obtained by actually carrying out the prophetic examples, after the filing date of the

application, as constituting new matter.

Q78. Deposit of Microorganism or Biotech Material

Assume the deposit has been made (e.g., plasmid, etc.) in the U.S. with ATCC prior to the U.S. filing date of the U.S. application. The Japanese law requires deposit prior to the filing of the priority application. The U.S. law allows deposit after filing of the application. The Accession Number from the ATCC was not made available until after the U.S. filing of the U.S. case. The Accession Number is therefore not disclosed in the U.S. application as originally filed. Can the Accession Number be added to the Japanese application?

A78. No. The priority cannot be enjoyed for the Japanese application, if the invention is related to the microorganisms which were not easily available at the filing date of the U.S. application. In addition, the Accession Number from the ATCC (or any other International Depository Authority under Budapest Treaty, or a storage number when the deposit was made to a reliable public storage authority) cannot be added to the Japanese application even at the filing date of a Japanese application, even if it is desired to retain the convention priority right. Under the current practice, the Accession Number should be described in the basic application to enjoy the convention priority.

In this connection, the Examination Guidelines regarding microorganism explain a case of exceptionally acceptable supplement as follows:

“An amendment of an accession number of a microorganism is not regarded as addition of new matter, if microbiological characteristics of the microorganism are described in the specification as filed, to the extent that the microorganism can be identified, and deposit of the microorganism can be identified based on the name of the depository institution, etc. In such a case, the applicant should make an amendment of the accession number without delay.” (Part VII: Chapter 2 Biological Inventions, 2.3) If the accession number were added to the basic U.S. application after the filing thereof under the condition stated above, then it may be possible to enjoy the Convention priority based on the basic U.S. application for the corresponding Japanese application.

Q79. Sequence Listing

When an application includes an amino acid and/or nucleotide sequence, does the Japanese law require submit the sequence listing? Must the sequence listing in computer readable form be submitted with the application? Can the sequence listing be supplemented after the filing date of the application?

A79. In case where a patent application (including an application claiming the priority of

a foreign application and a PCT national phase application) describes an amino acid and/or a nucleotide sequence in the specification and/or figure, the applicant must prepare the sequence listing for the nucleotide and/or amino acid sequence in accordance with "Guidelines for the preparation of specification which contain nucleotide and/or amino acid sequences" and describe the sequence listing in the specification. Furthermore, when the application is filed, the electronic data of the sequence listing in computer readable form (electronic data) must be submitted.

The submission of the electronic data is made by submitting a floppy disc or compact disc storing the data. When a patent application is filed by using on-line application system, the electronic data can be submitted together with the application.

It is not necessary to submit the sequence listing when the application is filed. However, when no sequence listing is submitted at the filing of the application, the JPO issues a notice of formal objection and requires the applicant to submit the electronic data of the sequence listing within the prescribed term (usually 30 days from the notice). Unless the electronic data are submitted within the prescribed term, the application will be dismissed. Therefore, it is recommendable to submit the sequence listing at the filing of the application.

Q80. Transgenic Animals

Have there been any decisions on what are "inventions liable to contravene public order, morality or public health"? In particular, is this an obstacle to the patenting of transgenic animals?

A80. At present, the provision regarding public order, morality or public health is not considered to create any problem or question for patentability of transgenic animals in Japan.

There have been some decisions ruled by the Tokyo High Court. For example, a banknote forging apparatus, a vest usable for smuggling gold bars, an opium smoking tool, a man's energy enhancing device, etc. were considered liable to contravene public order and morality. An invention relating to a bingo game machine was considered patentable although the judge recognized that it would be usable for gambling. A specific medicine for cancer and Streptomycin were both considered not liable to contravene public health in spite of the fact that they cause harmful but relievable after-effects when they are administered in large quantities.

A plant breed and an improvement of a breed of animal are patentable in Japan as long as they have novelty, inventive step and industrial applicability, and further they are properly disclosed in the applications so that anyone skilled in the art may easily carry out the inventions. In this connection, many patents regarding an animal itself have been

granted in Japan. A Harvard mouse was also granted. No issue was raised in connection with public order, morality or public health.

(xi) Specific Technical Field; CII (Computer Implemented Inventions)

Q81. Statutory Requirements for CII

Explain statutory requirements for CII.

A81. CII, includes software, needs to use natural laws as a whole. Following cases fulfill statutory requirements.

(1) CII for controlling a concrete device or processing accompanied with the controlling, e.g. a software for controlling an engine.

(2) CII for information processing based on physical or technical properties of a subject, e.g. a software for image processing.

(3) CII where information processing by software concretely realized by using hardware resources, such as an arithmetic unit such as a CPU, a storage means such as memory.

Therefore, a manmade rule such as a business model or a rule of video game itself cannot be patented, but when its information processing is concretely realized by using hardware resources, the statutory requirements could be fulfilled by above case (3).

Q82. Claim Categories of CII

Explain claim target and category thereof of CII.

A82. CII can be expressed in various ways. Especially, claiming "a computer program" is admitted. These are exemplified as follows:

Category: device

(1) a computer

(2) a computer program

(3) a computer system

(4) a computer readable storage medium storing a computer program

Category: method

(5) method

Followings are unacceptable cases by non-clarity objections.

- (a list of) program/data signals

- a program product*

*Except cases where the meaning of the word "a program product" is well defined in a specification.

Q83. Pure Algorithms or Program Listings

Can pure algorithms or program listings be patented?

A83. No, they are considered to be a mere disclosure of information and not fulfill the statutory requirements.

Q84. Drafting Claims and Specification

How to draft claims and specification?

A84. Claims must be drafted to use hardware resources on each matter to define the invention included in the claims.

Specification must describe how the procedure or function corresponding to those stated in a claim is implemented or realized by hardware or software. Description merely in an abstract or functional manner is insufficient.

Also, specification must describe how hardware or software is structured sufficient enough to understand. Only functional block diagrams or general flow charts may be insufficient.

II.2 Prosecution

(i) Request for Substantive Examination

Q85. Who can file a request for substantive examination?

A85. Any person can file a request for substantive examination. Typically, applicant files a request for substantive examination to seek for a patent. However, third party can also file a request for substantive examination to have the pending application examined.

Q86. When the request should be filed?

A86. The request can be filed anytime within three years from the filing date. For a divisional application, a conversion application, and an application based on a utility model registration, a request for substantive examination can be filed within 30 days after filing such an application, even if the three-year period has been expired from the filing date of its original application.

If no request is filed within the prescribed period, the application is deemed to have been withdrawn.

Q87. Queuing Time for First Office Action

How long does it typically take to receive a first Office Action after the request for substantive examination?

A87. On average, it took about 29 months in year 2010. JPO targets this to be 11 months in year 2013.

(ii) Expedition

Q88. What kinds of Expeditions are available?

A88. Preferential examination, accelerated examination, super-accelerated examination (trial) and examination under PPH (Patent Prosecution Highway) are available for expeditions.

Q89. What is preferential examination?

A89. The preferential examination is a statutory expedition (Art.48-6). The preferential examination can be requested in a patent application, for those instances where a third party is working the invention without any authority. Such request can be made after publication of the application by either the applicant of the patent application, or by the third party who is working the invention.

Q90. What is accelerated examination?

A90. The accelerated examination is a non-statutory expedition. This is fast track and a first OA will be issued within two to three months after filing a request for accelerated examination. The accelerated examination can be requested by an applicant under the following conditions:

(1) In the case of a working-related application

(1.1) An explanation on the state of working which should specify:

(1.1.1) A working-related act;

(1.1.2) The period of time in which the invention has been worked or a date at which the invention is scheduled to be worked (not exceeding 2 years from the date of the Explanation form); and

(1.1.3) The relationship between the invention and the working-related act.

(1.2) A prior art search and comparative explanation which should include:

(1.2.1) The result of the prior art search and a concise explanation of the relevance of each patent, publication or other information uncovered by the search.

(2) In the case of an application having a foreign counterpart application.

(2.1) Indication of the filing of an application in a foreign country or a region;

(2.2) A prior art search and comparative explanation which should include:

(2.2.1) The results of the prior art search; and a concise explanation of the relevance of each patent, publication or other information uncovered by the search.

When the application has a foreign counterpart filed in a foreign Patent Office which adopts the substantive examination procedure, a search report prepared by the foreign Patent Office may be submitted in lieu of the document listed in the item (2.2) and (2.2.1).

(3) In the case of a small and medium-sized enterprise or an individual-related application.

(3.1) Explanation that the applicant is small and medium-sized enterprise or an individual.

(3.2) Description of any prior art that the applicant has already known.

In this case, a prior art search is not required.

(4) In the case of a green technology related application (under trial).

(4.1) Explanation based on specification that a claimed invention has an effect of saving energy, reducing CO₂, etc.

(4.2) A prior art search and comparative explanation which should include:

(4.2.1) The result of the prior art search and a concise explanation of the relevance of each patent, publication or other information uncovered by the search.

(5) In the case of an earthquake disaster recovery support related application (one year from August 1, 2011).

(5.1) Explanation which should specify one of the following:

(5.1.1) Facts that all or part of applicants has domicile or residence in specified disaster area and has suffered damage due to the earthquake.

(5.1.2) Facts that business office, etc. of judicial person as an applicant is in specified disaster area and has suffered damage due to the earthquake, and the application for accelerated examination involves an invention related to business of this business office, etc.

(5.2) A prior art and comparative explanation which should include:

(5.2.1) The prior art known to the applicant and a concise explanation of the relevance of each patent, publication or other information known to the applicant. No prior art search is required considering that sufficient prior art search may not be conducted due to the damage suffered due to the earthquake.

Q91. What is super-accelerated examination?

A91. The super accelerated examination is a non-statutory expedition and currently under trial run. This is the fastest track and a first OA is issued within one month after filing a request for super-accelerated examination (within two months in the case of PCT applications). However, response to the first OA should be filed within 30 days (normally, 60 days) for domestic applicants and 2 months (normally, 3 months) for foreign applicants. The super-accelerated examination can be requested by a patent applicant under the following conditions:

(1.1) an application that is both "a working-related application" (see previous answer) and "an application having a foreign counterpart application" (see previous answer).

(1.2) an application in which all procedures on or after four weeks before the request are carried out on-line.

Q92. Preferential Examination vs. Accelerated Examination

Which should be prefer, a preferential examination or an accelerated examination?

A92. In most of the cases, the accelerated examination is recommended. While the preferential examination requires a fact that a third party is working the invention without any authority, the accelerated examination requires rather relaxed conditions, stated in A90.

For your information, the number of submissions of accelerated examination in 2005 and 2006 were 6560 and 7663, respectively. The number of submissions of preferential examination in 2005 and 2006 were only 18 and 10.

(iii) Office Action

Q93. Non-final OA vs. Final OA

Are there different types of OA (Office Action)?

A93. Yes, there are two types – a non-final office action and a final office action. A first coming OA is generally non-final. An OA after the non-final OA can be either non-final or final. The final OA is issued when the OA is required solely due to amendment made in response to another OA. Namely, when claim amendments in response to an OA introduce new reason for rejection, forthcoming OA will be final. Note that when responding to a final OA, claim amendment is restricted heavier than in a non-final OA. See also Q103.

Q94. Decision for Dismissal of Amendments

What comes when claim amendments have been done against restriction of claim amendments in a final OA?

A94. Claim amendment as a whole will be dismissed, and thus, a claim or claims before the amendment becomes effective.

Q95. Notice of Reasons for Rejection on Violation of Requirements for Disclosure of Information on Prior Art Documents

What is Notice of reasons for rejection on violation of requirements for disclosure of information on prior art documents?

A95. This Notice may be issued when no prior art is mentioned in a specification even though an applicant had knowledge of prior art at the time of filing. In response, the

applicant may amend the specification to include prior art, or may argue that the applicant did not have knowledge of prior art at the time of filing. The applicant may even file no response since no final rejection is triggered. Failing to respond to this Notice constitutes a reason for rejection in another OA, to which the applicant should respond; otherwise the final rejection is to be issued.

Q96. Decision of rejection

Explain about decision of rejection.

A96. Decision of rejection is an OA to finally reject an application at examination phase. This OA is issued when a response to a final or non-final OA does not overcome a reason for rejection in the OA.

To this decision of rejection, an appeal to appeal board can be filed for further prosecution.

Q97. Decision to Grant a Patent

Explain about decision to grant a patent.

A97. Decision to grant a patent is an OA to grant a patent for an application at examination phase. This OA is issued when no reason for rejection is found.

Q98. Declarations to Support Broad Claims

In the U.S., broad claims can be supported by later filed declarations. Can broad claims in a Japanese application be supported by later filed declarations showing operability of an invention?

A98. For the purpose of meeting the disclosure requirement, it suffices to disclose only one example which is covered by the scope of the claimed invention. However, Examiner may reject a broad claim based on belief that the claim covers a non-operable portion. In this case, the Applicant may submit test data by a declaration to show operability of the invention.

(iv) Extension of Time

Q99. Extension of Time for Responding to OA

Is it possible to have an extension of time for responding to an OA? If so, how long is the extended period of time? Can we file an extension of time more than once? How much does it cost to file an extension of time?

A99. Yes, it is possible to have an extension of time for responding to an OA. As of April 1, 2007, you can enjoy the following:

(1) A one-month extension is obtainable by filing a request for extension of time. The official fee is JPY2,100.

(2) It is possible to file a total of three requests, separately or simultaneously. There is no rise up of the official fee in later filed request. Thus, at most, you can have a three-month extension with the official fee of JPY6,300 in total.

Q100. Request for Extension of Time

Can a request for extension of time be submitted afterward?

A100. No, the request must be submitted within a time period for responding to an OA.

(v) Amendments

Q101. When can amendments be filed?

A101. Amendment can be filed in the following time frames.

- (1) From filing an application to a first OA;
- (2) After an OA, a response period specified in the OA; and
- (3) After a decision of rejection, at the time when filing an appeal to appeal board.

Q102. Requirements for Amendment in response to non-final OA

Explain requirements for amendment after first OA

A102. No new matter must be introduced.

For an application filed on or after April 1, 2007, unity of invention between examined claims and amended claims must be satisfied. See Q110 also.

Q103. Requirements for Amendment after Final OA

Explain requirements for amendment after final OA

A103. In addition to above answer, when responding to final OA, claim amendment is restricted to any one of the following purposes.

- (1) Cancellation of a claim or claims
- (2) Restriction of the scope of claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims, and the industrial applicability and the problem to be solved of the invention stated in the said claim or claims prior to the amendment are identical with those after the amendment)
- (3) Correction of errors; and
- (4) Clarification of an ambiguous statement (limited to the matters stated in the reasons for rejection in the OA).

For the purpose of item (ii) above, the amended claim must be patentable.

Q104. Requirements for Amendment When Filing an Appeal against Decision of Rejection

Is there any restriction on amendments when filing an appeal against decision of rejection?

A104. The same restriction on claim amendment as in the final OA is applied.

Q105. Amending Junior Application to Have it Read on Senior Application (Senior application and Junior application)

Can the scope of the claims of a junior application cover (“read on”) the practice of the invention as described in the senior application? (Is it a good way of defining allowability of junior application claims?)

A105. It may happen in some cases that the scope of the claims of a junior application cover the practice of the invention described in the senior application. However, since such a practice is disclosed or suggested in the senior application, the junior application will be rejected under Art.29-2 (whole content approach) of the Patent Law.

Therefore, it is not considered to be a good way for defining allowability of junior application claims to cover the practice of the invention as described in the senior application.

Q106. Amending Japanese claims to Parallel Issued Foreign Claims

Facts: An applicant has a first filed foreign application and a later filed Japanese application claiming priority to the foreign application. The applicant would be ultimately satisfied with the Japanese claims having the same scope as claims that issued in the foreign case.

QUESTION: In that case, is it advisable to amend the Japanese claims when requesting examination to parallel the issued foreign claim? Or should the applicant wait until the Examiner has issued the first Office Action before amending the claims?

A106. It would normally be unnecessary to restrict the claims in a Japanese application to the scope of the issued foreign claims. Examination in Japan is done entirely independently of the U.S. or European or any foreign prosecution. The applicant is not currently obligated in Japan to report any prior art references uncovered in other countries. Therefore, it would be rather wise to try to obtain a maximum scope of the patent protection in Japan regardless of claims in other countries if a maximum scope of protection is desired in Japan.

We believe that the applicant should wait till the first official action before amending the claims. However, it is quite conceivable that restricted claims would lead to quick issuance of a patent or to a stronger patent in view of a possible Invalidation Trial against the

patent after grant, particularly when the prior art references cited in the foreign application are very close references.

Q107. Advantage of Paralleling Issued Foreign Claims

Will the fact that Japanese claims are amended to parallel the issued foreign patent claims be given any weight by the Japanese Examiner?

A107. No. Amending the claims as in the issued foreign patent and informing the Japanese Examiner of the fact do not generally help the application or improve the Examiner's impression about the case. Rather, it is possible to offend the Examiner if the foreign prosecution is given too much weight by the applicant, because the Japanese Examiner is expected to make an independent judgment based on Japanese Examination Guidelines and prior art references uncovered in Japan.

Q108. Further Narrowing the Paralleled Claims

By narrowing the claims to parallel the issued U.S. claims, will the Japanese Examiner require that the narrowed Japanese claims be narrowed even more to be allowed.

A108. Yes, it is possible.

During the prosecution in Japan, there may be a possibility of the narrowed Japanese claims being requested to be amended further for at least one of the following grounds:

(1) More pertinent prior art may be cited by the Japanese Examiner and the applicant may find it necessary to introduce further limitations into claims in order to overcome the rejection by the Japanese Examiner; and

(2) The narrowed Japanese claims may be rejected even under the prior art which has already been considered by the U.S. Examiner because of the difference in criteria for the "inventive step" or "un-obviousness".

Q109. New Matter

How is the new matter determined?

A109. An amendment including matters beyond "the scope of features of the description, patent claim(s) or drawing(s) originally attached to the request", in other words, an amendment including a new matter is not allowed (Patent Law Section 17-3(3)).

According to the Examination Guidelines, "matters which are originally disclosed in the specification and the like" includes not only "matters which are disclosed in the specification and the like originally" but also "matters which are unambiguously derivable from the matters originally disclosed in the specification and the like". Here, "the matters

which are unambiguously derivable from the matters originally disclosed in the specification and the like” indicate matters which can be recognized by a person skilled in the art without description in the specification and the like originally attached to the request that the matters are clearly derived from matters disclosed in specification and the like in view of technical knowledge available to public at the time of filing the request and considered to be nothing less than disclosed in the specification and the like.

For more detail or examples, see the Examination Guidelines, Part III (http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm).

Q110. Amendment Changing Special Technical Feature

Explain the new rule regarding a prohibited amendment which changes the special technical feature of invention.

A110. Since the revised patent law in 2006 has come into force, an amendment which changes the special technical features of invention is prohibited once after receipt of an OA (The Patent Law Section 17-2(4)). The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions makes over the prior art.

Criteria of restriction of amendment depend on cases.

(1) STF found in claim 1

Amended claims must contain the STF included in the original claim 1.

(2) Claim 1 lacks STF and STF found in subsequent claim

Amended claims must contain all the features of the subsequent claim which have included the STF.

(3) Claim 1 lacks STF and no STF found in the claims

Amended claims must contain all the features of the last claim in which the Examiner have examined its patentability.

This means lack of STF (= lack of novelty) in the first claim will bring more strict restriction on later filed amendment.

For more detail or examples, see the Examination Guidelines, Part II (http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm).

Q111. Amendments Challenged by Third Parties

Can amendments be challenged by third parties? How and when?

A111. (1) Before publication

A patent application in Japan is automatically laid open to public inspection as a “KOKAI” publication after the lapse of 18 months from the filing date or, in the case of a

patent application with a convention priority, from the priority date. Before the publication, no one can have access to the official file. Therefore, third parties cannot challenge any amendments filed in relation to the application during this period.

(2) After publication and before grant of patent.

After a patent application is published and a publication thereof is issued, anyone can inspect the file wrapper and furnish the Examiner with necessary information in writing. The information which a third party can submit includes not only prior art serving to negate the novelty or inventive step of the invention, but also information on an amendment of the specification or drawings including new matter introduced after the filing of the application. The applicant is informed of the fact that information has been submitted. Whether or not the submitted information has been considered in the examination will be reported to the party who submitted the information, if the party informs the JPO to that effect. Since the party who submitted the information is not engaged with the examination, he or she is unable to communicate with the Examiner by means of, e.g., an interview.

Under the Patent Law, the applicant can amend the specification and/or drawings at any time until a first Office Action is issued from the JPO.

(3) After grant of patent

After a patent has granted, anyone can initiate a procedure of Invalidation Trial. Through the procedure of the Invalidation Trial, the plaintiff of the Trial can challenge the amendments made by the applicant during prosecution.

(vi) Argument (Remarks)

Q112. Time Frames for Reply to OA

When can reply to an OA, including argument, be filed?

A112. Reply to the OA can be filed in a response period specified in the OA. Amendments can be bundled.

Q113. Affidavits to Evidence the Knowledge of a Person Skilled in the Art

Can an Applicant argue, if Examiner rejects an additional example? Should affidavits be submitted to evidence the knowledge of one of ordinary skill in the art?

A113. Under the amendment to the Patent Law in 1993, new matter, which is not described or shown in the original specification or drawings, cannot be added. Accordingly, addition of an example or an embodiment of the invention is not allowed in most cases. According to Art.36(4), for the purpose of meeting the disclosure requirement, at least one example needs to be shown. This means that the disclosure requirements are met if the application includes one example which is covered by the scope of claimed invention if the

scope of the invention is broad. Therefore, there is no longer any basis for Examiner to reject an application on the ground that a sufficient number of examples are not presented, and thus there would be no need to add an example after the filing of the application.

(vii) Interview

Q114. Interview Recommended

Is the interview process the recommended procedure to expedite examination?

A114. Yes, the interview with the Examiner is the recommended procedure to expedite examination. It is very effective to hold an interview with the Examiner at any stage to obtain a result favorable to the applicant. It is recommendable to have a interview after fully discussing with a Japanese patent attorney how to proceed.

Q115. Recommended Strategy

Assume you have a case of critical importance to your client. What strategy do you recommend?

- a. Seek an early interview with Examiner?
- b. If so, do you wait until after First Office Action or should you try to see the Examiner before the Examiner studies the case and perhaps forms adverse opinion?
- c. What about preferred or acceleration examination (if conditions met?)

A115. In such a case, we recommend seeking an interview with the Examiner in charge. An Examiner is to conduct an interview with respect to an application on which the Examiner has started or is about to start the examination, while an Examiner is not to conduct an interview with respect to the following applications:

- An application for which a request for examination has not been filed;
- An application which has not reached the time for initiating the examination;
- An application for which a decision of granting a patent has been drafted and approved within the JPO; and
- An application for which a Decision of Rejection has been drafted and approved within the JPO (an application under reconsideration by the Examiner before the examination in the Appeal Board is excluded).

In view of the current interview practice with the Examiner described above, you are advised to wait until after the Examiner's first Office Action is issued.

(viii) Donation of Information

Q116. When can the information be submitted?

A116. The information can be submitted at any time including after the patent granted under the 2003-revised patent law.

Q117. Who can submit the information?

A117. Anyone may submit the information. Submission by anonymity is also possible.

Q118. What kind of information can be submitted?

A118. Not only information relating to the novelty or inventive step of inventions but also information relating to the lack of specification disclosure requirements and to an amendment including the introduction of new matter, etc. can be submitted.

Q119. Feedback of Donation of Information

How is the feedback to the provider of the information done?

A119. If requested by the provider of the information, the JPO will inform the provider in writing whether the submitted information has been used by the Examiner in the examination procedure.

Q120. Notification to Applicant of Donation of Information

How to inform an applicant of the submission of the information?

A120. The JPO will send a letter informing of submission of prior art under Rule 13-2 to the applicant. If the applicant wants to know what kind of information was submitted, he or she has to request for inspection of files.

Q121. Effect of Donation of Information

Is the information submission system effected?

A121. Yes, it is. 76% of the submitted information has been used in the examination procedure.

Q122. Disadvantages of Donation of information

Are there any disadvantages?

A122. The provider of the information is not permitted to contact the Examiner. Therefore, the provider cannot add the explanation of the submitted information directly to the Examiner. On the other hand, when such prior art information was submitted, the applicant will be aware of importance of the claimed invention for the provider. So, the applicant may try to overcome the possible Office Action based on the submitted prior art. Once the patent

is granted, it will be very difficult to invalidate the patent in the Invalidation Trial based on the same prior art that was submitted.

(ix) Appeal against Examiner's Decision of Rejection

Q123. Filing an Appeal against Examiner's Decision of Rejection

How and when to appeal against Examiner's decision of rejection?

A123. By filing a written appeal to the JPO within three months (for domestic) or four months (for foreign) from a date of a transmittal of Examiner's decision of rejection. The written appeal must contain names and domiciles/residences of an appellant and a representative, a case identification, and a purport and reasons of the appeal. The reasons of the appeal can be complemented afterward.

Q124. Amendments

Can a set of claims, a specification or drawings be amended when filing an appeal against Examiner's decision of rejection? If yes, are there any requirements upon amendments?

A124. Yes, you can amend the set of claims, the specification and the drawings. All amendments must be filed together with the appeal. There are requirements same as in a case of a final-OA. See Q103.

Q125. Reconsideration by Examiner before Appeal

Explain reconsideration by examiner before appeal.

A125. Reconsideration by examiner before appeal is an examination carried out by an Examiner, usually same one in a previous examination, to judge whether or not a decision of rejection shall be annulled. The reconsideration shall be executed when claims, specifications or figures have been amended together with the filing the appeal.

The Examiner will grant a patent when the previous decision of rejection should be annulled, while, if it is not the case, he won't make a final decision and entrusts the appeal case to the appeal examination by appeal examiners.

Q126. Shin-Jin (questioning/interrogation by an appeal board)

What is Shin-Jin (questioning/interrogation by an appeal board)? Sometimes a paper titled such may be sent from the JPO in an appeal.

A126. Generally, Shin-Jin means given opportunity of making a statement individually to the party concerned by an appeal board. In a case of an appeal against Examiner's decision of rejection, Shin-Jin is often sent to an appellant to confirm his will whether the case shall

proceed further or not when an Examiner have made a negative report in the reconsideration. Replying to this is not a duty but strongly recommended, because appeal examiners might consider the appellant have lost his will to proceed further.

Q127. Documentary Proceeding

Is there any summons, like oral proceedings in the EPO, expected in an appeal against Examiner's decision of rejection?

A127. Generally, no. An appeal against Examiner's decision of rejection is conducted in which the appeal is examined by document by proceeding in principle.

Q128. Appeal Decision

What kinds of appeal decision do an appeal board provides?

A128. Grant a patent, rejection or remand to an Examiner's examination. The appeal decision of rejection can be sued.

(x) Suit against Appeal Decision

Q129. General Requirements for Suit against Appeal Decision

Explain general requirements for suit against an appeal decision of rejection.

A129. Jurisdiction: The Intellectual Property High Court (Tokyo), exclusive.

Term of limitation: 30 days for statutory period and additional 90 days for foreign plaintiff from a transmittal date of the appeal decision of rejection. No extension of time is permitted.

Nominal defendant: The commissioner of the JPO.

Q130. Amendment, Divisional Application

Can I amend a set of claims or a specification of an application when suing against an appeal decision? How about a divisional application?

A130. No. Neither an amendment nor filing a divisional application is permitted.

Q131. Complaints against the IP High Court Decision

Can I file complaints against the IP High Court Decision?

A131. Yes, you can appeal to the Supreme Court. This is final appeal. Note that grounds for final appeal are legally restricted to certain situations.

(xi) Registration, Term and Maintenance of Patent Right

Q132. Registration

How to register granted patent?

A132. To pay annual fees of the first three years within 30 days from transmittal date of an Examiner's decision of grant or an appeal decision of grant a patent. This period can be extended by 30 days by filing a petition beforehand.

Q133. Term and Maintenance of Patent right

How long can a patent right sustained?

A133. A term of a patent right starts from its registration and expires 20 years from its filing date. No adjustment of Patent Term, like in U.S., can be applied. The patent right requires annual fees for every year after its grant. Annuities for the first three years must have paid at the time of registration, and annuities for the fourth year or after must be paid before the year covered thereby. Six months delay in payment is permitted with additional surcharge equal to the annuity. In case of delay caused by a reason outside its patentee's control, further six months period of payment can be permitted. Before the grant of the patent, no annuity, e.g. maintenance fee in European patent system, is required.

Q134. How to Know Maintenance / Expiration of Registration

How to know maintenance / expiration of registration?

A134. Several ways are available.

(1) Make a request for inspection of files to the JPO. You can check the patent register thereby, thus this is most reliable and up-to-date way. Certain amount of official fees is needed. Online inspection is available, by e-filing software provided by National Center for Industrial Property Information and Training (INPIT).

(2) Use Industrial Property Digital Library (IPDL), which is web-based online library provided by INPIT (<http://www.ipdl.inpit.go.jp/>). The IPDL provides legal status search. You can check a status of payment of annuity of certain patent right. Note that IPDL have some delay, usually about one month, thus the information is not up-to-date but neither fees nor special e-filing software is necessary. The service is provided only in Japanese language.

(3) Use certain commercial database services. Costs and reliability are depending on each service provider.

Q135. Registration of Extension of Term of Patent Right

Can a term of patent right be extended beyond statutory 20 years?

A135. Yes, By filing an application for registration of an extension of the term of a patent right, the term can be extended. This extension is permitted only when the patent right is concerning medical drugs or agricultural chemicals, and there have been unexploitable

period due to the Pharmaceutical Affairs Act or the Agricultural Chemicals Regulation Act.
Extendable period is limited up to five years.

III PATENT RIGHTS

III.1 Infringement

Q136. Implementation

Explain the definition of Implementation in Japanese practice.

A136. Implementation of an invention in this Law means the following acts:

- (1) In the case of an invention of a product, acts of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease - hereinafter the same) of, the product;
- (2) In the case of an invention of a process, acts of using the process;
- (3) In the case of an invention of a process of manufacturing a product, acts of using, assigning, leasing, importing or offering for assignment or lease of, the product manufactured by the process, in addition to the acts mentioned in the preceding paragraph.

Q137. Remedies for Patent Infringement

What kind of recourse is available for patent infringement in Japan?

A137. With regard to civil recourse for patent infringement, a patentee can seek an injunctive order, demand damages, demand restitution for unjust enrichment, and seek measures for recovery of reputation.

1) Injunctive Order

A patentee can require a person who is infringing or is likely to infringe the patent right to stop or prevent such infringement.

2) Demanding Damages

A patentee can demand damages from a person who has intentionally or negligently infringed the patent right. The Patent Law has some provisions relating to such damages, including Art. 102 (presumption of amount of damage), Art. 103 (presumption of negligence), Art. 104 (presumption of manufacture by patented process), and Art. 105 (production of documents).

3) Demanding Restitution for Unjust Enrichment

Under certain circumstances, a patentee may demand restitution for unjust enrichment from a person who has infringed the patent.

4) Measures for Recovery of Reputation

Upon request of a patentee, the court can order a person who has damaged a patentee's business reputation to take measures to recover the damaged reputation.

Q138. Injunction

What is required to grant an injunction against infringement of a patent?

A138. A patentee can require a person who is infringing or is likely to infringe their patent to stop or prevent such infringement under the Patent Law Art. 100. A patentee can seek an injunctive order even if he/she is not carrying out the patented invention. No willfulness or negligence is required to grant an injunction. Nevertheless, the likelihood of infringement needs to be proved objectively clear.

At the same time, a patentee can also demand measures necessary for the prevention of such infringement including disposal of infringing products and removal of facilities used for the infringement.

Q139. Damages

How is the award of damages calculated in Japan?

A139. The Patent Law has provision for presumption of amount of damage (Art. 102). According to the Patent Law Art. 102, a patentee can select one of the following three methods to calculate damages caused by infringement.

- 1) A patentee can demand the amount of profit per unit of patented products that would have been sold by the patentee but for the infringement, multiplied by the quantity of patented products sold by the infringer. In this case, the award of damages shall not exceed the patentee's capability to produce or sell such patented products.
- 2) When an infringer has earned profits from the act of infringement, a patentee can demand the amount of profits earned by the infringer as damages caused by the infringement.
- 3) A patentee can demand the amount of a royalty the patentee would have been entitled to receive for the patent.

Q140. Monetary Recovery Before the Issuance of the Patent

Can a patentee seek monetary recovery for an infringer's act carried out before the issuance of the patent?

A140. Yes. Once a patent is granted, a patentee can demand compensation for an infringer's act carried out before the issuance of the patent if the patentee provided a given warning with documents stating the contents of the claimed invention after the laid-open publication of the application. If an infringer knowingly infringed the claimed invention after the laid-open publication of the application, a patentee can demand compensation without a given warning. The amount of compensation shall be equivalent to the amount of a royalty the patentee would have been entitled to receive for the claimed invention.

Q141. Defendant's Defense

What can a defendant do if a patentee files a suit for patent infringement?

A141. If a patentee files a suit for patent infringement, a defendant has some options: First, the defendant may counterclaim that the alleged patent is invalid. Alternatively, the defendant may file a trial to invalidate the patent. In some circumstances, the defendant may file a suit for declaratory judgment that the patentee has no right to sue the defendant.

Q142. Claim Interpretation

How does the Japanese court interpret a claim?

A142. In assessing whether a claim reads on an accused product or process, the court first considers the explicit claim language under the Patent Law Art. 70(1). However, if the claim language is indefinitely vague and ambiguous, the court can consult the specification and the drawings, wherein the court may consider the object, advantages and/or individual embodiments. Basically, the essence of the claimed invention does not reside in the object and/or advantage but in the structure. On December 26, 1991 in the “Lightweight Coated Paper Case,” the Tokyo High Court held, in favor of the plaintiff (patentee), that the accused product was different in its objective from the patent’s but had the same technical features as those recited in the claims.

Defendants often try to defend themselves by insisting that their product or process achieves no such advantages expected by the patent. However, the advantages mentioned in the specification are not always intended to delimit the invention. The advantages are arbitrary predictions rather than facts, lacking the objectivity. The alleged advantages should be distinguished from “industrial applicability (utility)” as one of the requirements for patentability.

Specific embodiments or examples are generally provided for illustrative purposes and are not considered to limit the scope of the invention, except when the claim language is unreasonably broad beyond the description. The excessively broad scope of the claim will be contrary to the policy of the patent system where a patent is given in return for disclosure of the invention to the public. In cases where the scope of the claim is indefinite in light of the embodiments and/or prior art, defendants often refer to the prosecution history.

Q143. Doctrine of equivalence

Is the doctrine of equivalence available in Japan?

A143. In view of the fact that Japan adopts a statutory law system, and therefore every statute is supreme as the primary legal source. Therefore, the Patent Law Art. 70 is absolute. Judicial judges were hesitant to adopt the doctrine of equivalents to find infringement beyond the letter of a claim. In fact, until 1998 the courts had never held an infringement

under the doctrine of equivalents. However, on February 24, 1998, the Supreme Court has provided a guideline in favor of the doctrine of equivalents. Specifically, the following five requirements must be satisfied for successfully asserting the doctrine of equivalents:

- 1) The part replaced is an insubstantial part of the claimed invention;
- 2) The replacement of the part achieves the object of the claimed invention and produces the same result as the claimed invention;
- 3) The replacement of the part would have been obvious to a skilled person at the time of making the accused product (the time of infringement);
- 4) The accused product was novel and non-obvious at the time when the application was made, which means that the accused product could be patentable; and
- 5) There is no proof showing that the applicant intentionally excluded the accused product from the claimed invention during the prosecution. This requirement corresponds to the file wrapper estoppels established in the U.S. courts.

Q144. Prosecution history estoppels

Is the doctrine of prosecution history estoppels available in Japan?

A144. Generally, the doctrine of prosecution history estoppels is also available in Japan. For example, the matter the patentee intentionally excluded during prosecution is excluded from the scope of protection.

Q145. Doctrine of Claim Differentiation

Is the doctrine of claim differentiation or its equivalent available in Japan? Specifically, in a case where different words or phrases are used in different claims, are those claims presumed to have different scopes?

A145. Japan does not have the doctrine of differentiation or its equivalent.

In this regard, the Patent Law Art. 36(5) provides that separate claims can be directed to substantially the same invention in the same application. This provision is intended to guide claim drafting but not to govern claim interpretation.

Q146. Emphasis of Advantageous Effect

Does emphasis of advantageous effect narrow the scope of the invention? (Q84)

A146. The Patent Law Art. 70(1) stipulates that the technical scope of a patented invention must be determined according to the description of a claim. Art. 70(2) stipulates that the claim language can be interpreted with reference to the specification and drawings. In principle, however, no advantages are permitted to be described in the claims. If advantages are described in the claims, they may be ignored at the court. If the claim

language is too indefinite and obscure, the court may consider those advantages upon claim interpretation. Judicial court judges may read potential structural elements underlying a claimed invention through advantages. However, such cases are very rare. See, e.g., Osaka Appellate Court, decided on November 22, 2002, Case No. H13(ne) 3840.

Q147. Reference Numerals in Claims

Can we include reference numerals in claims?

A147. Yes. You can include reference numerals in claims. The use of reference numerals is not mandatory.

Reference numerals in claims are not regarded as a limitation to claims or are not considered to cause file wrapper estoppels. Nevertheless, there is no court decision where the presence of reference numerals in a claim was at issue.

III.2 Trial for Patent Invalidation

Q148. Trial for patent invalidation

What is a trial for patent invalidation?

A148. A trial for patent invalidation is an administrative procedure to invalidate a patent. When a trial for patent invalidation is requested, a panel consisting of three or five trial examiners examines the patent based upon ex officio proceedings. In principle, oral proceedings are used in a trial for patent invalidation.

Q149. Grounds for Patent Invalidation

What kind of grounds can be asserted in a trial for patent invalidation?

A149. A trial for patent invalidation can be requested on the following grounds:

- 1) Any amendment that was made to the patent application does not comply with the requirements as provided.
- 2) The patent violates the provision of the enjoyment of rights by foreign nationals, patent eligibility, novelty, inventive step, novelty over later-published prior art, co-application by co-applicants, and double patenting.
- 3) The patent violates a treaty.
- 4) The patent has been granted on a patent application not complying with the requirements for description of the patent application.
- 5) When the application was filed in a foreign language, the disclosure of the patent is not within the scope of foreign language documents.
- 6) The patent application was filed by a person who is not the inventor and has not succeeded to the right to obtain a patent for the invention.

7) After the grant of a patent, the patentee has become unable to hold a patent right under the provision of the enjoyment of rights by foreign nationals, or the patent has become in violation of a treaty.

8) Any correction that was made to the patent does not comply with the requirements as provided.

Q150. Who can request a trial for patent invalidation?

A150. Generally, anyone can request a trial for patent invalidation. However, only an interested party can request a trial for patent invalidation if the trial is requested on the grounds that the patent application was not jointly filed by co-applicants or that the patent application was filed by a person who is not the inventor and has not succeeded to the right to obtain a patent.

Q151. When can a trial for patent invalidation be requested?

A151. A trial for patent invalidation can be requested anytime after a patent has been issued. A trial for patent invalidation can be requested even after a patent has been expired.

Q152. Amendments

Can a patentee amend claims during a trial for patent invalidation?

A152. A patentee may request for amendment (correction) of claims during a trial for patent invalidation. Such request can be made within the time limit designated for a patentee's response to a written request for the trial or to an examination result in a case where the panel has examined any grounds not pleaded by a party.

Such correction shall be made within the disclosure of the patent application as filed. Furthermore, such correction shall not substantially enlarge or alter the scope of claims. Additionally, such correction shall be limited to the following purposes:

- 1) To limit the scope of claims;
- 2) To correct any error in the description or any incorrect translation; and
- 3) To clarify an ambiguous expression.

Q153. Complaints against a Trial Decision

What kind of action can be taken against a decision of a trial for patent invalidation?

A153. Either party who cannot accept the decision of the trial for patent invalidation may appeal the case to the IP High Court. Such appeal must be made within 30 days from the date on which the decision of the trial has been served. This time limit may be extended for

a party in foreign countries.

III.3 Trial for Correction

Q154. Trial for Correction

What is a trial for correction?

A154. A trial for correction is an administrative procedure to correct the description, scope of claims or drawings attached to the application of the patent. When a trial for correction is requested, a panel consisting of three or five trial examiners examines the advisability of these corrections.

Q155. What kind of correction can be requested?

A155. The corrections are limited to the followings:

- 1) Restriction of the scope of claims;
- 2) Correction of errors or incorrect translations; and
- 3) Clarification of an ambiguous statement.

Please note that the correction of the description, the scope of claims or the drawings have to remain within the scope of the matters disclosed in the description, the scope of claims, or the drawings attached to the application of the patent (in the case of correction target of the errors or the incorrect translations, the description, the scope of claims and the drawings originally attached to the application of the patent (in the case of a patent with regard to a foreign language written application, foreign language documents)). Further, the correction of the description, the scope of claims or the drawings cannot substantially enlarge or alter the scope of claims.

Q156. Who can file a request for a trial for correction?

A156. The patentee (patent owner) can only file the request. Please note that, when a request for the trial is filed regarding the patent of the joint ownership, all of joint owners have to jointly file the request. Further, if there is a non-exclusive licensee under Art. 35(1), 77(4) or 78(1) of the Japanese patent law, an exclusive licensee, or a pledgee, the patent owner needs the consent of the said person in order to file the request.

Q157. When can a trial for correction be requested?

A157. A trial for correction cannot be requested from the time the relevant trial for patent invalidation has become pending before the Patent Office to the time the trial decision has become final and binding.

Q158. Complaints against a Trial Dismissal

What kind of action can be taken against a decision to dismiss the request?

A158. The patent owner who cannot accept the decision to dismiss the request for the trial for correction can appeal the case to the IP High Court. Such appeal must be made within 30 days from the date on which the decision of the trial has been served. This time limit may be extended for a party in foreign countries.

III.4 Administrative Opinion, others

Q159. Administrative Opinion

What is an administrative opinion?

A159. An administrative opinion is a judgment of the JPO on the technical scope of a patented invention. When an administrative opinion is requested to the JPO, a panel consisting of three trial examiners judges the technical scope of a patented invention. Specifically, the administrative opinion includes the judgments whether or not disputed property (or method) between parties is included within the technical scope of a patented invention, as well as whether or not the disputed property (or method) is equivalent to the patented invention under the doctrine of equivalents. Please note that the administrative opinion is non-legally binding.

Q160. Who can request an administrative opinion to the JPO?

A160. Anyone can.

Q161. Complaints against an Administrative Opinion

What kind of action can be taken against an administrative opinion?

A161. No appeal can be available against the administrative opinion.

Q162. Trial for Invalidation of Registration of Extension of Term of Patent Right

What is a trial for invalidation of Registration of Extension of Term of Patent Right

A162. A trial for invalidation of registration of extension of term of patent right is an administrative procedure to invalidate the extension registration. See Q135.

Q163. Retrial

What is a retrial?

A163. The retrial is an administrative procedure to re-examine a final and conclusive trial decision. Please note that grounds for the retrial are strictly limited.

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/>