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Newsletter

This issue contains information concerning the following points:

- Revision of Examination Guideline for “Amendment that Changes a Special Technical Feature (STF) of an Invention”
- Measures after the filing of an Appeal against a Decision of Rejection

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1 Revision of Examination Guideline for “Amendment that Changes a Special Technical Feature (STF) of an Invention” to Relax Undue Restriction of Amendments

The Japan Patent Office (JPO) announced a revision of the examination guidelines pertaining to “Amendment that Changes a Special Technical Feature of an Invention” and “Requirements of Unity of Invention”.

Amendments that change a special technical feature (STF*) of an invention are prohibited for applications filed on or after 1 April 2007 (Patent Law Section 17^{bis}(4)). Thereafter, possible amendments in response to Office Actions, such as a Notification of Reasons for Rejection and a Decision of Rejection, had been unduly restricted; in particular, if claim 1 subjected to the substantial examination did not have any STF.

[Hereinafter, an amendment that changes an STF of an invention and consequently results in a violation of the requirement of the unity of pre- and post-amendment inventions is referred to as a “**Shift Amendment**” since it is generally so called in Japan.]

The recent revision of the examination guidelines relaxed this strict limitation on amendments.

The revised examination guidelines are applied to the examinations starting from 1 July 2013.

*“STF” = a technical feature that defines a contribution which the invention makes over the prior art; also see Rule 13.2 of the “Regulations under the PCT”

1. Prohibition of “Shift Amendment”

An invention that may be the subject of a single patent application is restricted to the scope that fulfills the requirement of unity of invention. Therefore, an application which is deemed by the examiner to lack unity of invention is not examined for any other requirements of patentability such as novelty and inventive step (hereinafter also referred to as “other requirements”). Patent Law Section 17^{bis}(4) introduced on 2006 extended the requirement of unity of invention to inventions in claims pre- and post-amendment.

To put it concretely, when filing an amendment in response to an Office Action such as a Notification of Reasons for Rejection for applications filed on or after 1 April 2007, all inventions for which the requirements for patentability (such as novelty and inventive step) have been examined pre-amendment and all inventions identified by the matters described in the amended claims must fulfil the requirement of unity of invention. Amendments that do not fulfil the above requirement are deemed to be “Shift Amendments” and are not permitted. Claims amended by a Shift Amendment are not further examined as to the above-mentioned “other requirements” for patentability such as novelty and inventive step.

[Amendments either in response to a Final Notification of Reasons for Rejection or simultaneously filed with an appeal against a Decision of Rejection which are deemed to be Shift Amendments will be dismissed.]

Under Japanese practice, whether a patent application satisfies the requirement regarding unity of invention is determined based on whether the invention of claim 1 and the inventions of other claims have the same or corresponding STF (hereinafter collectively referred to as “the same STF”). When they have the same STF, the application will be deemed to have fulfilled said requirement.

However, even in cases where the above claims do not have the same STF, if they fulfil certain requirements, they will be examined with respect to said “other requirements”, without considering whether the requirement of unity of invention is met.

In a similar manner, an amendment which fulfils certain conditions will not be deemed to be a Shift Amendment even in the case where it does not lead to amended claims having a STF which is the same as that in the claims pre-amendment.

For example, where there is no STF in any of the claims before amendment, it is of course impossible to find an identical STF in claims after amendment. However, if the amendment fulfils certain requirements, it is not deemed to be a Shift Amendment, and thus the amended claims will be examined as to the above-stated “other requirements for patentability”, such as novelty and inventive step. Before the revision of the examination guidelines, however, the above-stated “certain requirements” for such a case, or for the case that pre-amendment claim 1 does not have an STF though claims following claim 1 do, were unduly strict.

By relaxing said “certain requirements”, the revision of the two examination guidelines results in an expansion in the scope of:

- Inventions that shall be examined with regard to “other requirements” for patentability despite not complying with the requirement of unity of invention.
- The possible amendments which are not deemed to be Shift Amendments.

2. Determination on Whether an Amendment Falls Under a Shift Amendment According to Revised Examination Guidelines

Under the revised examination guidelines, the following amendments represented by A) and B) in response to Office Actions are permitted (i.e., are not deemed to be Shift Amendments).

Please note that the below-described amendments are amendments which are permitted in terms of the prohibition of a Shift Amendment. This does **not** mean that claims amended by an amendment according to any one of A) or B) would be granted a patent. For example, as can be seen from the following A), even if claim 1 is amended to an invention which has been determined as having no STF, the amendment would not be deemed as a Shift

Amendment. However, it is likely that the amended invention would be rejected due to the lack of novelty and inventive step since it still does not have any STF.

Amendments which are not Shift Amendments (i.e., are permitted):

- A) An amendment which results in an invention for which it has already been determined whether or not there is any STF, or which results in an invention having any STF which is the same as an STF found in the pre-amendment claim(s) (if any);**
- B) An amendment resulting in an invention which can be efficiently examined together with the invention described in the above A).**

For example:

- (1) An amendment resulting in inventions in the same category that include all the technical features of the invention of pre-amendment claim 1.**

However, the following amendments are excluded:

- (i) An amendment resulting in an invention having added technical features whose problem to be solved has little relevance to the problem to be solved by the invention of pre-amendment claim 1;**
- (ii) An amendment resulting in an invention having added technical features which have low technical relevance to the technical features of the invention of pre-amendment claim 1;**
- (2) An amendment resulting in an invention for which an examination may be made without conducting additional substantial prior art searches and making an additional determination.**

For further details, please also refer to website of the Japan Patent Office.

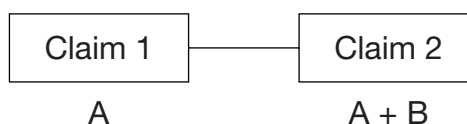
http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm

(Part III Amendment of Description: Sections I, II, III “Amendment of Description, Claims and Drawings”; and Part I Description and Claims: Chapter 2 “Requirements of Unity of Invention”)

The following figure and tables show whether typical claim amendments in response to Office Actions such as Notification of Reasons for Rejection in a patent application are permitted or not in terms of a Shift Amendment. A simple example with two claims is offered for easy reference. Claim 1 contains feature “A”, while claim 2 contains features “A + B”.

Please note that the following tables only show whether the respective amendments described therein are permitted or not from the perspective of the prohibition of a Shift Amendment, and thus the phrase “permitted” in the tables does **not** mean that the amended invention would be deemed patentable. For example, in the case where neither of claims 1 and 2 have an STF, it is possible to amend the invention of claim 1 to “A + B” (i.e., the amendment is not deemed as a Shift Amendment). However, the amended invention “A + B” still does not have an STF, and thus it is likely to be rejected due to the lack of novelty and inventive step.

Claims before amendment

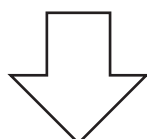


Before Revision

Amended to:	STF present in Claim 1	STF present in Claim 2	No STF in either Claim 1 or 2
A + B	Permitted	Permitted	Permitted
A + B + α	Permitted	Permitted	Permitted
A + B + β	Permitted	Permitted	Not Permitted
A + α	Permitted	Not Permitted	Not Permitted
A + β	Permitted	Not Permitted	Not Permitted

α : Technical feature which is only described in the specification and which has high technical relevance to the invention of claim 1 (e.g., “ α ” is a technical feature whose problem to be solved has high relevance to the problem to be solved by the invention of claim 1 before the amendment.)

β : Technical feature which is only described in the specification and which has low technical relevance to the inventions of claim 1 and 2 (e.g., “ β ” is a technical feature whose problem to be solved has low relevance to the problem to be solved by the inventions of claims 1 and 2 before the amendment.)



After Revision

Amended to:	STF present in Claim 1	STF present in Claim 2	No STF in either Claim 1 or 2
A + B	Permitted	Permitted	Permitted
A + B + α	Permitted	Permitted	Permitted
A + B + β	Permitted	Permitted	Not Permitted
A + α	Permitted	Permitted	Permitted
A + β	Permitted	Not Permitted	Not Permitted

α and β are as as described above.

[Note: Whether an added technical feature has high relevance or low relevance to the invention of pre-amendment claim 1 is determined case by case by individual Examiners, in terms of prior art searches, by taking into consideration matters described in the specification and common general knowledge at the time of filing. Basically, if the addition of a technical feature requires an additional prior art search, unrelated to the existing prior art search, said added feature would be deemed by Examiners to have low technical relevance.]

When pre-amendment claim 1 has an STF

As shown in the tables, provided that claims after the amendments have the same STF, any amendments are permitted.

When pre-amendment claim 1 does not have any STF

Before the current revision, it was not permitted to amend the invention of claim 1 to incorporate a technical feature described in the specification but not in the original claims. This was the case regardless of whether the technical feature was of high (α) or low (β) technical relevance to the invention of pre-amendment claim 1.

It was therefore necessary to incorporate “B” into the claim as well as the technical feature (again regardless of the feature’s technical relevance). As a result, even if only technical feature “ α ” can accentuate differences between the present invention and the prior art cited in an Office Action, and does so regardless of the existence of “B”, the applicant was compelled to unduly limit the claimed invention by the addition of the unnecessary feature “B” ($A + B + \alpha$).

In contrast, after the current revision, this type of undue limitation is no longer required, and thus, this is one important aspect of the revision. Under the revised examination guidelines, incorporating a feature of high relevance (α) to the feature “A” of the invention of pre-amendment claim 1 is permitted (though “ $A + \alpha$ ” is basically required to belong to the same category as pre-amendment claim 1). However, it should be noted that addition of a feature of low technical relevance to the invention of pre-amendment claim 1 ($A + \beta$) is still not permitted.

As can be seen from the above, the requirements regarding what is permissible in claim amendments in response to Office Actions were relaxed by the examination guidelines revision. Nevertheless, if claim 1 subjected to the substantial examination does not have any STF, the possible amendments when responding to Office Actions are more restricted when compared to cases where claim 1 does have an STF. For example, in the former case (i.e., no STF in claim 1), an amendment for changing the invention of claim 1 from “A” to “ $A + \beta$ ” is not permitted. In contrast, when claim 1 does have an STF, its amendment from “A” to “ $A + \beta$ ” is permitted.

Thus, despite the examination guidelines revision, it is important that claim 1 contain an STF prior to the commencement of the substantial examination. Thus, we recommend checking whether or not claim 1 fulfills said requirement. This is especially true if Search Reports/Office Actions that have been issued for corresponding applications show that claim 1 does not contain any STF. Thus in all cases we recommend checking for the existence of, and if necessary incorporating, an STF into claim 1 before the initiation of substantial examination, for example when filing a Request for Examination.

In Japan, an Appeal against a Decision of Rejection regarding a patent application can be filed with the JPO within 4 months of the date of dispatch of said Decision of Rejection (domestic applicants: 3 months). An Amendment of the description, patent claims and figures can also be filed together with the Appeal. Thus, it is possible not only to argue against the rejection of the application, but also to conduct amendments based on the judgement of the examiner as given in the Decision of Rejection.

This possibility to file an Amendment along with the Appeal is an effective tool for obtaining a patent right and has advantages for the applicant as explained below.

1. Further Examination by the previous Examiner (“Preliminary Examination”)

Advantages:

- The examiner in charge of the application examines the application once more.
- The application is dealt with more swiftly.

An appeal examination in Japan is conducted by a team of Appeal Examiners. The appeal examination involves inspecting the whole application again thoroughly from the beginning, a process which takes time.

However, if an amendment has been filed along with the appeal, before such an appeal examination begins, the examiner previously in charge of the application once again examines the application (hereinafter referred to as “preliminary examination”). Thus, by filing an amendment along with the appeal, it is possible to have the application examined an additional time.

If, in the preliminary examination, the examiner comes to the conclusion that the reasons for rejection are resolved, he or she will issue a Decision of Grant. Since it is possible that the previous examiner, being sufficiently familiar with the invention, may subsequent to this preliminary examination of the application immediately issue a Decision of Grant, the patent may be obtained in a shorter period of time. If the examiner still deems the application to be not patentable after the preliminary examination, the process moves towards the appeal examination conducted by the appeal board (though see below for additional steps).

If no amendments are conducted when filing the appeal, the aforementioned preliminary examination will not be carried out. Instead, the Appeal proceeds directly to the appeal examination by the appeal board.

2. Written Inquiry from the Appeal Board based on the report on the preliminary examination

Advantages:

- Further opportunity to present arguments.
- Arguments can be based on the result of the preliminary examination.
- Proposals for amendments can be presented together with the arguments.

If a patent cannot be granted following the preliminary examination, the examiner informs the President of the JPO accordingly, who then appoints a team of appeal examiners in charge of the appeal examination. In the appeal examination, the previous examiner’s report on the preliminary examination serves as a reference for the appeal board.

Generally, the appeal board will then send the applicant a Written Inquiry accompanied by the preliminary examination report. The applicant can then file a Written Reply with Arguments against the judgement stated in said report, and also can present proposals for amendments. (An actual Amendment cannot be filed at this time.)

This Written Reply will be consulted by the appeal examiners during the appeal examination procedure.

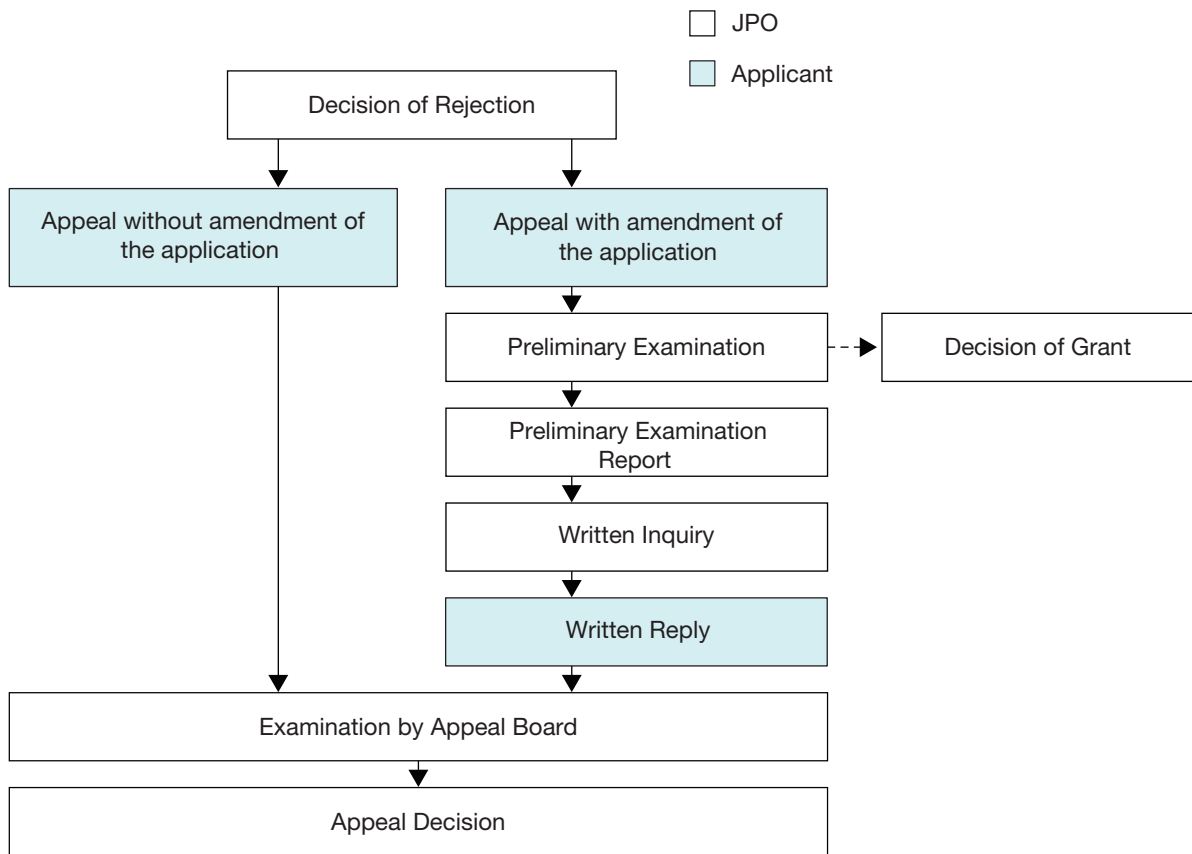
However, if no Written Reply is filed, this fact itself cannot be held against the applicant in the appeal examination.

If no Amendment was filed along with the appeal and, therefore, no preliminary examination was conducted, the appeal board will not receive a report from the former examiner and, accordingly, will not send a Written Inquiry to the applicant. This means that an applicant who has not filed an amendment along with the appeal misses a valuable additional opportunity to present arguments and proposals for amendments, in which, importantly the last judgement of the former examiner could have been taken into account.

As a general rule of the JPO, said proposals for amendments are not to be considered during the appeal examination. Nevertheless, to accelerate the procedure, it is within the discretion of the appeal board to take such proposals into account if it becomes clear that the proposed amendment would lead to the grant of a patent. In such a case, the applicant would receive a Notification for Reasons of Refusal and thus an opportunity to file the amendment with the JPO.

The above system provides the applicant with an additional opportunity to raise his or her chances of getting a patent granted. We therefore recommend making use of the possibility to amend the application when filing an appeal.

Flow of the Appeal Examination (simplified):



3 Others

1. System to review a Patent Right after its Grant

Currently, the only effective means to invalidate a granted patent right in Japan is to file for a patent invalidation trial (see also our Newsletter E-189 of December 2012). However, the restoration of an opposition system is under discussion.

Nonetheless, at the session of the Diet in April 2013, no Proposal for this type of revision of the Patent Law was submitted.

According to the newspaper “Nihon Keizai Shimbun”, the intention is to submit such a proposal for a revised patent law during the ordinary session of the diet next year and to introduce the new system in 2015.

However, it remains unclear when we can expect the (re-)introduction of an opposition system based only on written procedures.

2. Revision of the Employees' Invention System

A committee studying the possible revision of the Employees' Invention System was established at the Japan Patent Office.

Under Japanese Patent Law, the right to obtain a patent primarily belongs to the employees who have made the invention.

The committee is to discuss the possibility of reverting the right to obtain a patent for an employees' invention to the employer, as well as the criteria for the payment of remuneration to the employees, and other points. An outline of a revision is intended to be drawn up within the fiscal year 2014, and a proposal for a revision is submitted at the ordinary session of the diet in 2015, at the earliest.

3. Frequently Asked Questions regarding Trademark Applications

Q: Why are different goods (services) determined to be similar and what does “describing too much variety of goods (services)” mean?

A: The JPO has its own system for determining similar goods and services. Although Japan has adopted the International Classification System under the Nice Agreement, the JPO classifies all goods and services into groups, regardless of the International Classification System, and assigns a “similar group code” to each group. Goods/services with a similar group code (meaning goods/services in the same group) are determined to be similar. When a class contains eight or more similar group codes or two or more non-similar retail and wholesale services are designated in class 35, the Examiner will raise the ground of refusal of “describing too much variety of goods (services)”.