

## New Judgments on Product-by-Process Claims

On June 5, 2015, the Supreme Court reached a judgment regarding claims according to inventions of products described by the manufacturing (production) process of the product, i.e., product-by-process claims.

Shortly thereafter, the Japan Patent Office (JPO) elucidated the manner in which product-by-process claims should be handled for examinations and appeals. The following are considered interim procedures as to how examinations on patent applications which have been filed or which will be filed are to be conducted and handled.

### Examinations

The Examiner will notify a reason for refusal when the invention of a product describes the production process of that product in a manner in which the invention of the product is unclear or ambiguous. According to the JPO, "this will not be the case when the Examiner can find that the invention involves 'impossible or impractical circumstances'".

The JPO goes on to define "impossible or impractical circumstances" as any circumstance which makes it "impossible or utterly impractical to define the product based on its structure or characteristics at the time the subject application for such product was filed."

Through the contents of the reasons for refusal, the applicant has the chance to provide evidence of "impossible or impractical circumstances" and submit an argument and an amendment. This should prevent situations in which a granted patent also contains the grounds by which the patent may be invalidated, or in which third parties could be harmed.

In an amendment and/or argument, the applicant may

- a) delete any claim,
- b) amend any claim into a claim(s) according to an invention

- of a process for producing a product,
- c) amend any claim into a claim(s) according to an invention of product which does not include a production process, and/or
  - d) assert and provide evidence of the presence of "impossible or impractical circumstances" in an argument.

It is the responsibility of the applicant to convince the Examiner of the presence of "impossible or impractical circumstances".

#### Appeals & Trials

Appeals, trials, etc., of inventions according to product-by-process claims will be examined and handled in the same manner as stated above for Examinations.

In an appeal against an Examiner's decision of refusal, the appeal examiners will notify a reason for refusal when the claim according to the invention of a product describes the production process of that product in a manner in which the invention of the product is unclear or ambiguous. According to the JPO, "this will not be the case when the appeals panel can clearly find that ... 'impossible or impractical circumstances' do exist".

#### Revision to Examination Guidelines and Examination Handbook

The JPO released a revised Examination Guidelines and Examination Handbook in October 2015, which reflects the recent judgments on product-by-process claims and how examinations, trials, appeals, etc., are to be conducted in the case of product-by-process claims.