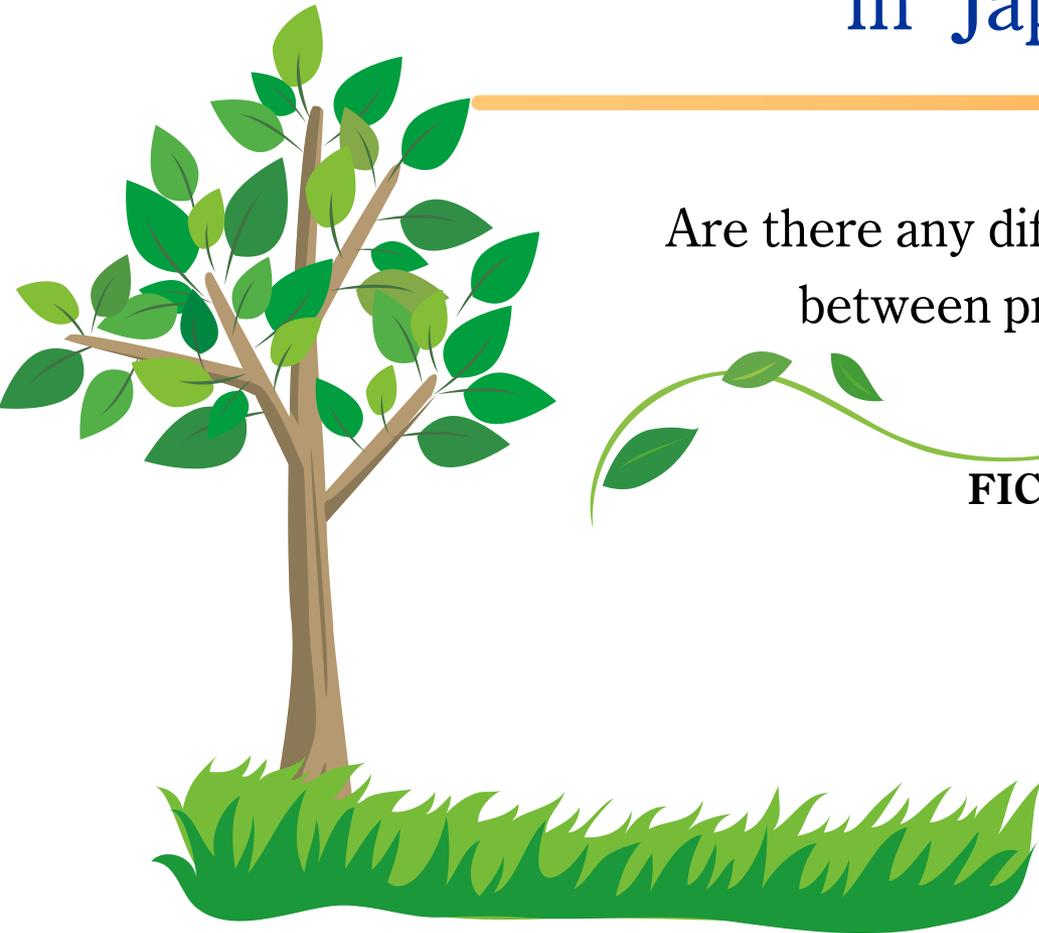


Sufficiency of Disclosure Prosecution vs. Enforcement in Japan



Are there any differences in disclosure requirement
between prosecution and enforcement ?

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Fundamental rule “Prosecution & Enforcement” under the Japanese Constitution



- Legislative power is given to the Diet, administrative power is given to the Cabinet, and judicial power is given to the Court.
- **Prosecution is a procedure in the JPO** (the administrative power).
 - **Patentability** is determined by the JPO.
 - **Validity** of a patent is determined by the JPO by means of an Invalidation Appeal.
- **Enforcement is a procedure in the Court** (the judicial power)
 - Infringement is judged by the Court based on the claimed invention.
 - Basically, **the Court cannot determine validity of patent.**
 - In an patent infringement litigation, **if a patent is considered to be invalidated in an Appeal, the patent is treated not to be enforceable.** Namely, the patent is still valid but may lose the monopoly in the litigation. (Patent Law Art. 104-3)

Why sufficient disclosure is required ?



Purpose of the Patent Law (Article 1)

- **To encourage development of industry by means of ;**
 - Protecting an invention by **giving an applicant a monopoly** for a limited time, and
 - **Opening it to the public** in exchange for the monopoly.
- **To make the scope of monopoly clear.**
 - The monopoly is given to the claimed invention. In order to make the scope of monopoly clear, **claim(s) must be sufficiently and clearly written.** (Art. 36, Para. 5 and 6)
- **To make the invention clear so as to be practically used by others.**
 - **The specification and drawings must be sufficiently and clearly written** so that others having ordinary skill can understand and use the invention, when the application is opened to public. (Art. 36, Para. 4)

Disclosure requirement of specification (The Japanese Patent Law Art. 36, Para. 4)



- **Patent Law Article 36, Paragraph 4 includes ;**
 - enablement, clarity and sufficiency requirement (Item 1) and
 - prior art statement requirement (Item 2).

- **Enablement requirement ;**
 - The specification must describe the invention (embodiments) clearly and sufficiently so that **a person skilled in the art to which the invention pertains can make and use it.**

(Art. 36, Para. 4, Item 1)

- **Prior art statement requirement ;**
 - The specification must include **a statement about prior art documents that the applicant(s) knows of** when filing the application.

(Art. 36, Para. 4, Item 2)

Disclosure requirement of specification (Patent Law Art. 36, Para. 4, Item 1)



Enablement requirement

(Art. 36, Para. 4, Item 1)

- **Enablement requirement :**
 - **Who :** A person skilled in the art to which the claimed invention pertains.
 - **What :** The claimed invention can be made and used.
 - **How :** Based on the specification and drawings, and based on ordinary technical knowledge.
 - Incorporation by reference is not effective or available.
- **Best mode requirement :**
 - Embodiment(s) that the applicant considers to be the best is preferably described.
 - The best mode requirement is applied generously, i.e. it is not applied to lead to a rejection in prosecution or to lead to an invalidation after granted.

Disclosure requirement of specification (Patent Law Art. 36, Para. 4, Item 1)



Enablement requirement

- **A preferable way to describe the specification is exemplified.**
- **When an apparatus invention is claimed, the specification must include:**
 - **explanations about the apparatus** itself,
 - **descriptions how to make or manufacture it** (by any person skilled in the art), and
 - **descriptions how to use it** (by any person skilled in the art).
- **When a method invention is claimed, the specification must include:**
 - **explanations about the method** itself, and
 - **descriptions how to use it** (by any person skilled in the art), and
 - **descriptions how to make the item to be made by means of the method** (the manufacturing method).

Disclosure requirement of specification (Patent Law Art. 36, Para. 4, Item 1)



Enablement requirement

- **The relationship between claims and the specification.**
 - When the scope of claim is broad :
 - It is **not necessary to describe all the embodiments included in the scope** (although it is preferable to describe all the embodiments as far as possible).
 - But if there is a clear reason that **an embodiment which is included in the scope of the claims but not described in the specification cannot be made or used**, the specification is considered not to satisfy the enablement requirement.
 - When the invention is defined using a **Markush style claim**:
 - If there is a clear reason that **any recited member in claim but not described in the specification cannot be made or used**, the specification is considered not to satisfy the enablement requirement.

Disclosure requirement of specification (Patent Law Art. 36, Para. 4, Item 1)



Enablement requirement

- **Failure to satisfy the enablement requirement.**
 - If the description does not meet with the enable requirement (defined in Art. 36, Item 1), **a Notice of Rejection (an Office Action)** will be sent to the applicant in the course of prosecution. After grant, **the patent can be invalidated** by an invalidation appeal.
- **Failure to satisfy the best mode requirement :**
 - There is **no statutory best mode requirement** in the Japanese Patent Law. Accordingly, even if it is clear that **the best mode that the applicant considered is not written, no rejection is raised** during prosecution.
 - There is **a possible disadvantage that the scope of claim(s) may be interpreted differently or narrowly** based on a specification which does not include the best mode embodiment.

Disclosure requirement of specification (Patent Law Art. 36, Para. 4, Item 2)



A prior art statement requirement

- **The specification must include a statement about prior art documents that the applicant(s) knows of when filing an application.** (Art. 36, Para. 4, Item 2)
 - This requirement can be satisfied by a statement about **only a part** of the prior art documents. It is **not required to show all the documents** that the applicant knew at the time of filing.
 - If this is not satisfied (for example, no statement is included), the Examiner sends a Notification about it and **gives the applicant a chance to file an Argument and an Amendment.**
 - If this requirement is **still not satisfied** after filing them, a **Notice of Rejection will be sent** to the applicant.
 - However, **after grant, no invalidation appeal can be filed** based on a failure to satisfy this requirement.

Requirements of claims

(Patent Law Art. 36, Para. 5 and 6)



- **Art. 36, Para. 5 :**
 - Each claim must include **all necessary features to define an invention** respectively. It is allowable to **define the same inventions in different claims (in different ways of expression)**.
(Art. 36, Para. 5)
- **Art. 36, Para. 6 : In claim(s),**
 - 1) the claimed invention sought to be patented **must be supported by the specification** (Item 1) ,
 - 2) the claimed invention sought to be patented **must be clearly defined** (Item 2) ,
 - 3) the way of description in each claim **must be concise** (Item 3) , and
 - 4) each claim must be written in accordance with the **Regulation of the Ministry of Economy and Industry** (Item 4) .

Requirements of claims

(Patent Law Art. 36, Para. 6)



- **Art. 36, Para. 6, Item 1 : Support requirement**
 - The claimed invention **must be supported by the originally filed specification**. The originally filed specification **includes the PCT original specification** (even if it is written in foreign language), but **not includes the Convention priority specification**.
 - Support is determined **in combination with the general technology** at the time of filing.

- **Art. 36, Para. 6, Item 2 : Clarity requirement**
 - Each claim must define the features of invention clearly. If it is not clear enough to understand the invention, **the application will be rejected and can be invalidated**.

Requirements of claims

(Patent Law Art. 36, Para. 6)



- **Art. 36, Para. 6, Item 3 : Conciseness requirement**
 - If duplicated expressions are used in one claim to make it ambiguous or vague, a rejection based on this Item 3 may be made.

- **Art. 36, Para. 6, Item 4 : Requirements by the Regulation**
 - Each claim must be defined by **using claim number(s)**.
 - Claim numbers must be put **in a sequential order**. Accordingly, when some claims are added or deleted, the whole claims **must be re-numbered in each time**.
 - **Dependent claim(s) must be put after the independent claim** from which the dependent claim(s) depends.
 - Multiple dependent claim(s) which **depends from multiple dependent claim(s) can be used**.

Amendment



Voluntary amendments

- Voluntary amendment can be filed **until receiving a first O.A.**
- Any amendments are allowed to the extent **being supported by the disclosure in the original documents.**
 - Amendments to **broaden the scope** of claims, to **change the subject or category**, and to **add claims** are allowed.

Amendments after a first O.A.

- Amendments to **change the subject of invention** (which is called as “**shift-amendments**”) is not allowed.
- But amendments to **change the category**, to **broaden the scope** of claims and to **add claims** are allowed, although they must be supported by the original disclosure.

Amendment



Amendments after a final O.A.

- Amendments only to **narrow or restrict the scope** of claim(s) are allowed.
 - Amendments to **change the subject or category** , to **broaden the scopes** of claims and **to add claim(s)** are not allowed.
- Amendments to **correct errors** in claims and the specification is allowed.
- Amendments to **clarify ambiguous expressions** in response the rejection reasons are allowed.

Amendment



Amendments after a Decision of Rejection

- Amendments only to **narrow or restrict the scope** of claims are allowed.
- Amendments to **correct errors** and to **clarify ambiguous expressions** in response to the rejection reasons are allowed.

Divisional patent application

- A divisional patent application can be filed **within the same period as an Amendment can be filed**.
- For the applications **filed after April 1, 2007**, a divisional application can also be filed **when a Notice of Allowance is sent**.

Supreme Court Decision regarding prosecution



- **Suit by an applicant against the JPO's final rejection made in the course of prosecution:**
- **Supreme Court Decision (the lipase decision in 1991) :**
 - **The Tokyo High Court admitted to interpret the meaning of "lipase" in claim to limit to "Ra-lipase" based on the knowledge of ordinal skill, though on support exists in the specification except Ra-lipase.**
 - **But, the Supreme Court denied it, which means that claims must be examined based on what it is defined in prosecution.**

Enforcement



- **Enforcement is proceeded by the Court (the judicial power)**
 - Infringement is judged by the Court **based on the claimed invention.**
 - Basically, the Court **cannot determine validity of patent.**
- **Patent Law Art. 104-3 ;**
 - In an patent infringement litigation, if the patent is **considered to be invalidated in an Appeal**, the patent is treated **not to be enforceable.**
Namely, the patent is still valid but may **lose the monopoly in the litigation.**
- **Invalidation Appeal** based on violation of the above requirements can be filed before the JPO (by the plaintiff).
- **Correction Appeal to amend or correct claims** can be filed before the JPO (by the patentee).

Enforcement



- In prosecution procedures, the Examiner **tends to request to the applicant to amend claims within the disclosed embodiments**, which often makes the scope of claim narrow, and then allows the amended claims.

Does this affect enforcement ?

- In enforcement procedures, the court judges an infringement based on claims with reference to the specification and drawings.
 - The scope of claim is determined based on claim, but it can be determined referring the specification and the drawings. (Art. 70)
 - That is, the court assesses whether the claims are supported by the specification, and therefore sufficiency of disclosure is considered by the court in an infringement litigation.



Recent court decisions

1. Navigation Apparatus for Automobile

- Decision made by **the Tokyo District Court**
- Patent No. 2891795 (& No. 2891794)
- Patentee (plaintiff) : Pioneer Co., Ltd.
- Defendant : Navi-time Japan
- Summary
 - Patent infringement litigation based on the patent “Navigation apparatus **for automobile**” against “Navigation system applied to **a cellular phone** with a navigation display system having a wireless connection with a server”.
 - The court admitted that the accused Navigation system of Navi-time Japan **uses almost all the features** of the patent **except the car-equipped feature**.
 - But the court **denied the infringement** based on the difference between **the car-equipped apparatus and the cellular phone system**.

Recent court decisions

1. Navigation Apparatus for Automobile



- **Summary of claimed invention of 2891795:**
 - A) A navigation apparatus **for an automobile** which can show a map on a display, comprising
 - B) **a first memory** having a plurality of service facility data and map coordinates data of them,
 - C) **data displaying means** to show the plurality of service facility data on the display,
 - D) **designating means** to designate one of the service facility data shown in accordance with an operation by an operator,
 - E) **reading means** to read and pick up a coordinate corresponding to the designated service facility location,
 - F) **a second memory means** to memorize the coordinate, and
 - G) **location displaying means** to show the memorized coordinate on a map shown on the display.

Recent court decisions

1. Navigation Apparatus for Automobile



➤ **Accused product :**

- A navigation unit **equipped with a cellular phone connected to a server, and comprising ;**
- **the same elements (B) – (G)** as those of Pioneer’s patent.
- The cellular phone has **a display to show a map.**

➤ **Decision by the Tokyo District Court :**

- The patent infringement is **not admitted.**
- **Reasons :**

The patented apparatus comprises **“a navigation unit” for an automobile,** while the accused product comprises **“a cellular phone with navigation display system”** having **a wireless connection with a server.**

Both have the same elements (B) – (G) and a display. The only difference is that the patent is **used in an automobile** while the accused product is **used in a cellular phone system.**

Recent court decisions

1. Navigation Apparatus for Automobile



- **Consideration about the decision :**
 - There will be a possibility that **a doctrine of equivalent applied and an infringement is admitted**, when this case is brought to the IP High Court.
 - The one main reason is that :
 - The Court admitted that **the accused cellular phone navigation system uses the composing features (B) – (G) of the patent.**
 - The only one different feature **exists in an application** that the features (B) – (G) are **used in an automobile in the patent**, while they are **used in a cellular phone system in the accused product.**

Recent court decisions

1. Navigation Apparatus for Automobile



- **Was it possible to broaden the scope during prosecution ?**
 - Was it possible to **delete the feature “automobile-equipped”** so as to cover “cellular phone navigation system” ?
- **Enablement requirement :**
 - In the specification and drawings, only a navigation apparatus for an automobile is disclosed. Generally speaking, if claim is **defined without the automobile-equipped feature** and if a person skilled in the art **can imagine usages for other field**, claim **without the automobile-equipped feature will be allowed**.
- **Support requirement :**
 - If claim was amended to **delete the automobile-equipped feature after filed**, a rejection to reject the amendment might have been issued in this case. Because **the broadened feature is not supported by the original disclosure**.

Recent court decisions

2. Hollow golf club head



- Decision made by the **IP High Court** (& approved by the **Supreme Court**)
- Patent No. 3725481
- Patentee (plaintiff) : Yokohama Rubber Co., Ltd.
- Defendant : YONEX Co., Ltd.
- Summary
 - Patent infringement litigation based on the patent “**Hollow golf club head**” against “golf clubs manufactured and sold by YONEX”.
 - The disputed feature is the wording “**sewing member**” used to **connect the metallic lower shell and the FRP upper shell** at the upper front part.
 - The Court admitted that the feature “**sewing member**” **includes the short belt-shaped fragments** of YONEX’s product, and concluded that the golf club head of YONEX **infringes the patent of Yokohama**.

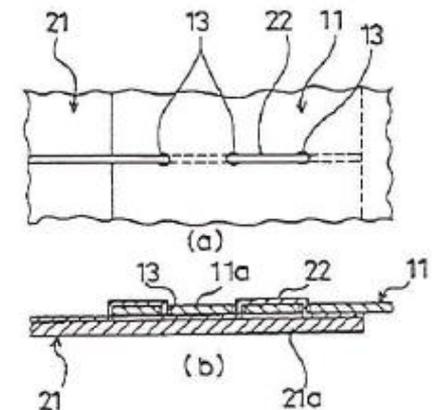
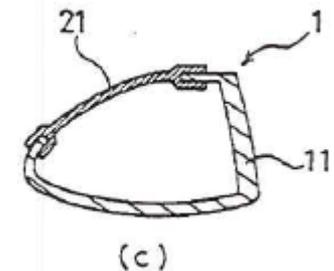
Recent court decisions

2. Hollow golf club head



➤ Summary of claimed invention :

- A hollow golf club head, comprising
- A) a metallic lower shell (11),
- B) a FRP upper shell (27), and
- C) a FRP sewing member (22), wherein
- D) a plurality of holes (13) are formed on the metallic lower shell (11) at the connecting portion to the FRP upper shell,
- E) the sewing member (22) is provided on the metallic lower shell (11) passing through the holes (13), and
- F) the lower and the upper shells (11,27) are glued with each other at the connecting portion by the help of the sewing member (22).



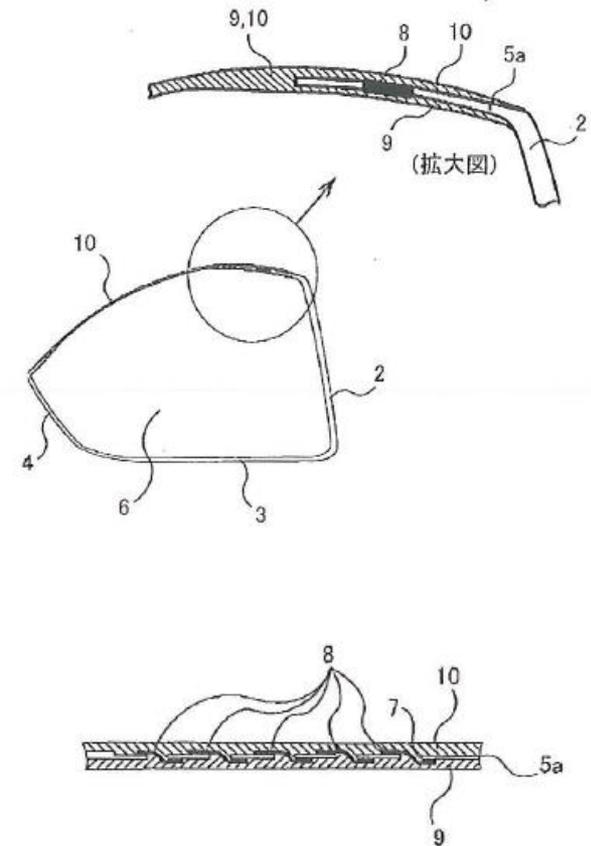
Recent court decisions

2. Hollow golf club head



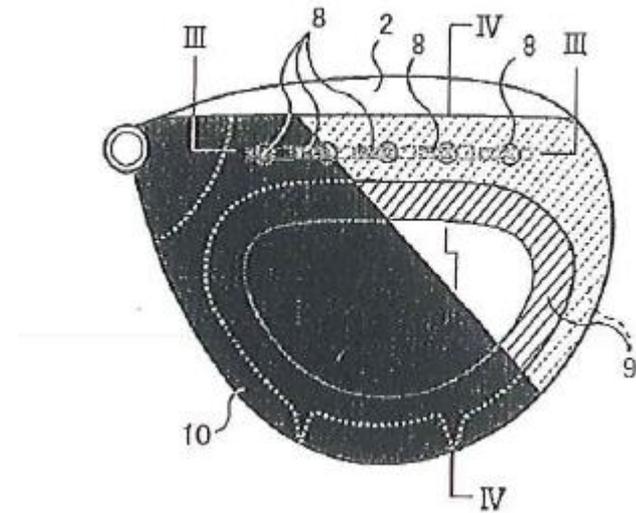
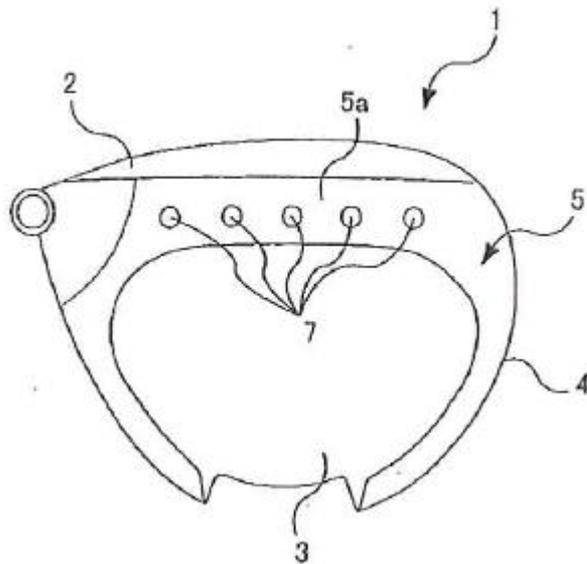
➤ Accused product :

- A hollow golf club head, comprising
- A) a metallic lower shell (2,3,4),
- B) a FRP upper shell (10), and
- C) a plurality of short belt-shaped fragments (8), wherein
- D) a plurality of holes (7) are formed in the metallic lower shell (2) at the connecting portion (5a) to the FRP upper shell,
- E) the short belt-shaped fragments (8) are respectively provided on the metallic lower shell (2) passing through the holes (7), and
- F) the lower and the upper shells (2,10) are glued with each other at the connecting portion by the help of the fragments (8).



Recent court decisions

2. Hollow golf club head



Recent court decisions

2. Hollow golf club head



- **Consideration about the decision :**
 - The main disputed issue is the **meaning of “sewing member”** of the patent.
 - Does the “Sewing member” of the patent **include the short belt-shape fragment ?**
- Was it possible to **change the term “sewing member” to a different term** to correctly define it ?
 - It will probably be **able to amend it to “connecting member”** for example **in the course of prosecution.**
- The IP high Court interpreted the meaning of “sewing member” **in view of its role or function regardless of the original meaning of the word “sew”.**
 - The adhesive strength of FRP with FRP is stronger than that of FRP with metal.

Thank you for attending and listening

I hope you learned something about Japanese patent prosecution and enforcement. If you have any questions, please contact me at the following address.



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