

CONTENTS OF THIS ISSUE	PAGE
<b>New Examination Guideline for Unity of Invention and Restriction of Amendment in Response to the Rejection of Lack of Unity of Invention</b>	<b>1</b>
<b>Trends in Patent Litigation Against JPO Decisions as to Novelty and Inventive Step in the First Half of 2013</b>	<b>5</b>

## **New Examination Guideline for Unity of Invention and Restriction of Amendment in Response to the Rejection of Lack of Unity of Invention**

### **1. Introduction**

In July 2013, Japan Patent Office published new examination guideline regarding the range of substantial examination beyond the range that satisfies the unity of invention requirement. All the patent application currently pending are to be examined in accordance with this new guideline.

This paper first explains the difference in the basic concept of the unity of invention among Japan, USA and EPO.

Further, it explains the summary of the new guideline as to the range of substantial examination beyond the range that satisfies the unity of invention requirement, followed by the explanation about the countermeasure to be taken in response to the issuance of lack of unity rejection.

### **2. The difference in the basic concept of the unity of invention among Japan, USA and EPO**

The followings are our brief comparison about unity of invention in USA, EPO and Japan

#### **2.1 USA**

MPEP stipulates as follows:

802.01 Meaning of “Independent” and “Distinct” [R-5]

##### **I. INDEPENDENT**

The term “independent” (i.e., \*\*>unrelated<) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions.

MPEP is not concerned with “technical contribution” of the claimed invention over prior arts. It is only concerned with connection in design, operation, and effect of the claimed inventions.

#### **2.2 EPO**

EPC Rule 44 stipulates as follows:

Unity of invention

(1) Where a group of inventions is claimed in a European patent application, the requirement of unity of invention under Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

EPC is concerned with “technical contribution” of the claimed invention over prior arts.

### 2.3 Japan

Article 25octies of Regulations under the Patent Act stipulates as follows:

- (1) The technical relationship defined by Ordinance of the Ministry of Economy, Trade and Industry under Patent Act Article 37 means a technical relationship in which two or more inventions must be linked so as to form a single general inventive concept by having the same or corresponding special technical features among them.
- (2) The special technical feature provided in the former paragraph stands for a technical feature defining a contribution made by an invention over the prior art.
- (3) The technical relationship provided in the first paragraph shall be examined, irrespective of whether two or more inventions are described in separate claims or in a single claim written in an alternative form.

Japanese Patent Act Article 25octies is concerned with “technical contribution” of the claimed invention over prior arts.

At JPO the range that the Examiner examines is limited as explained below, which includes small addition to the range of unity explained above.

## 3. A Summary of New Guideline

Under the new Guideline, the Examiner examines the

existence of novelty of all the inventions of the claims and also examines the existence of feature(s) shared by invention of all the claims that makes the invention novel [being referred to as “Special Technical Feature (STF)” by JPO].

(a) If the Examiner determines that the invention of all the claims share the feature in common that makes all the invention in the claims novel, he/she further examines the invention of all the claims in terms of inventive step, clarity, enablement etc [hereinafter referred to as “substantial examination”].

(b) If the Examiner determines some of the inventions in the claims lack novelty or do not share feature(s) in common that make(s) the invention novel, then he/she conducts substantial examination for

(b-1) the invention of the group of claims that satisfy the condition of (a), the top claim of the group having smallest claim numbering in the initially filed claims [corresponding to claims 3, 7 and 9 in Fig. 1 below];

(b-2) the invention of the claims that share the same or corresponding feature(s) that make(s) the invention novel [corresponding to claims 4 and 8 in Fig. 1 below]

[the explanation of what concretely means “corresponding” has not been expressly published]

; or

(b-3) the invention of the claims that share all the feature of the smallest claim numbering in the initially filed claims, which have same category [e.g., apparatus, method] therewith, and the examination to which is possible without incurring substantial and additional prior art search or additional legal determination [corresponding to claims 5, 6 and 10 in Fig. 1 below]

[the explanation of what concretely means “without incurring substantial and additional prior art search or additional legal determination” has not been expressly published]

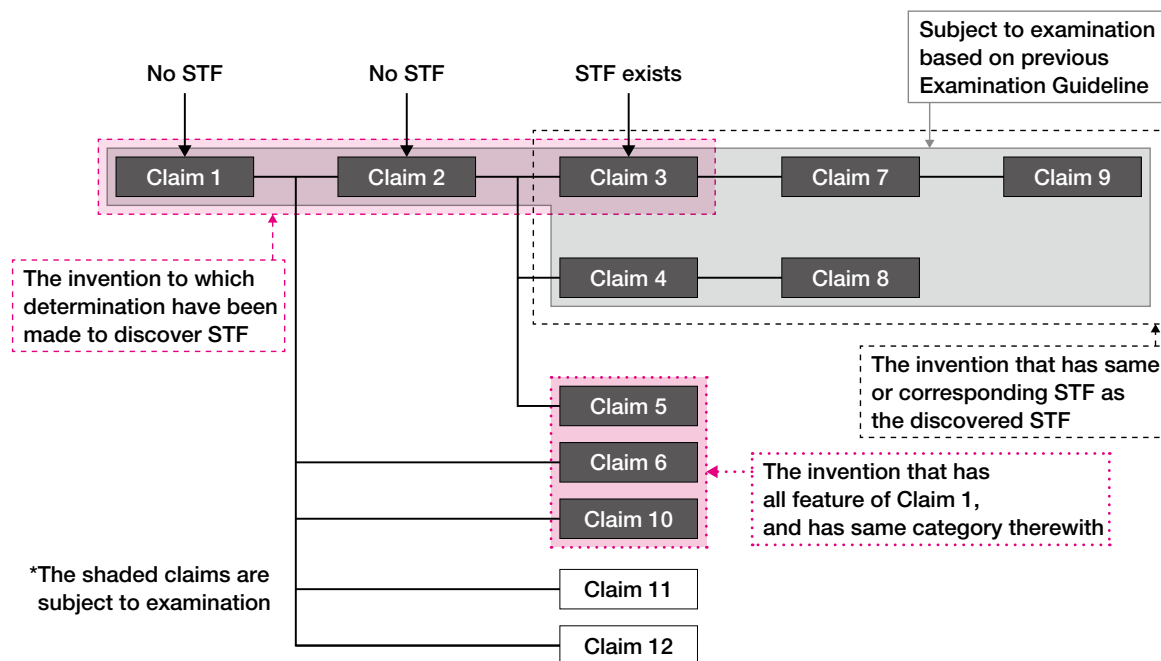


Fig. 1

#### 4. Freedom of amendment after receiving first Official Action

##### (4-1) For the case none of the invention of the claims has novelty in the first Official Action

As illustrated in Fig-2, one can file amendment to the claims:

- That has only one independent claim (i) that has all the limitations of the narrowest claim that depend on previous claim 1 as well as all the limitations of the intermediate claims between claim 1 and the narrowest claim, and the limitations of claim 1, the dependency being selected in a manner that smallest claim numbering determined when next dependent claim is chosen, wherein the new independent claim (i) should

entail additional feature (i-add) that makes the invention of the claim novel.

[This (i-add) should be drafted in a manner that already existing claim element (each step or each means) is further limited in scope. Please refer to the following section “4-3” for the meaning of “further limiting the scope of each element”]

- That may include dependent claims that depend on claim (i).

If you add claim (iv) that does not have novelty, it is not further examined, and adding such claims will constitute independent reason for rejection.

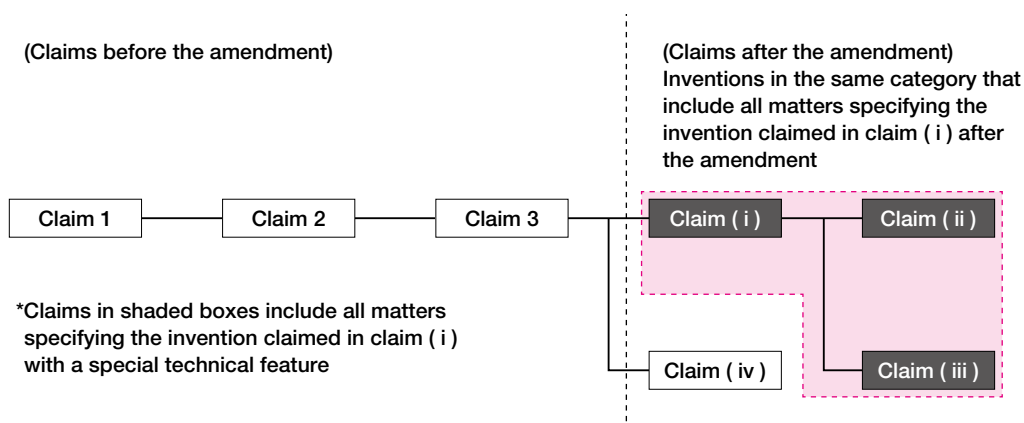


Fig. 2

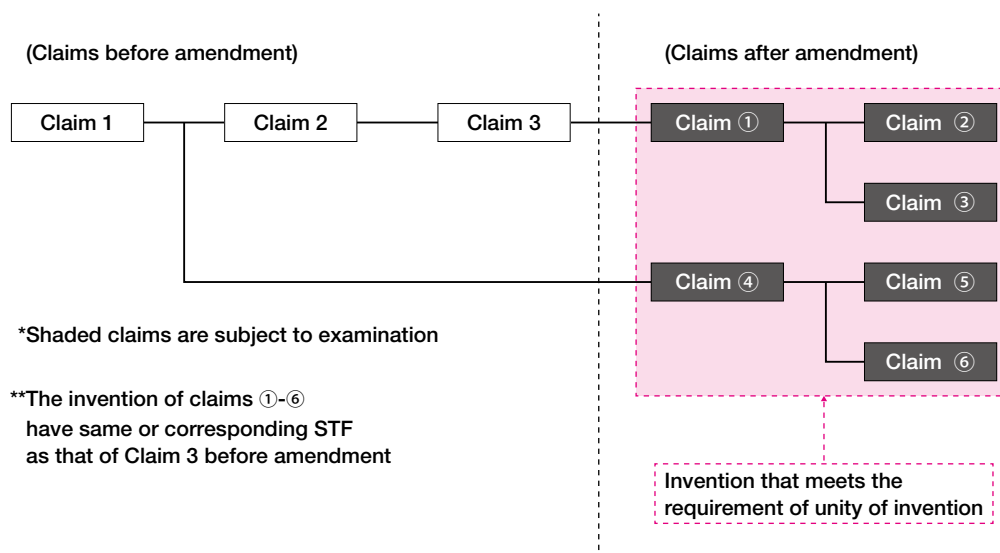


Fig. 3

**(4-2) For the case some of the invention of the claims has novelty in the first Official Action**

As illustrated in the above drawing, in which previous claim 3 has novelty, we can file amendment to the claims in a manner:

(manner A: corresponding to claims ①,② and ③)

- That has as many independent claims like claim ① above, **that has all the limitations of claim 1 through 3**, as possible.
- That may include dependent claims that depend on claim ①.

(manner B: corresponding to claims ④,⑤ and ⑥)

- That has as many independent claims like claim ④, which has same or corresponding STF [\*d] as that of claim 3 before the amendment  
[the explanation of what concretely means “corresponding” has not been expressly published];
- That may include dependent claims that depend on claim ④.

**(4-3) Repercussion for not abiding by the above restrictions**

Filing the claim amendment that does not meet the above requirement would trigger final rejection to which freedom of amendment is extremely limited.

[By having in the application the amended claims not abiding by the above restriction, even for the claims abiding by the restriction face the following restriction when tries to file further amendment. Only remedy for

this is filing divisional application.]

We can only either:

- (a) Cancel claims,
- (b) Further limit the scope of each element (each step or means) of the claims,
- (c) Correct typographical error
- (d) Rephrase unclear description.

Further limiting the scope of each element of the claims means something like the following:

- Amending “heating the material with high temperature” to “heating the material with 100-200 degree” is allowed.
- We cannot add new element “cooling the material” as new element, even such element is disclosed in the specification.
- The aim of this restriction is to avoid re-searching by the Examiner.

**(4-4) Safe harbor for the claims that do not meet the above requirement**

Only way out for us for the claims that do not meet the above requirements to be substantially examined is to file a divisional application covering such claims.

**5. Conclusion**

As illustrated in Fig. 1, range of substantial examination has been somewhat relaxed from the previous Guide-

line, although still being not comparable with U.S. and European counterpart.

If we are to give you one advice, it is to file claims that have at least novelty over the potential references, if not inventive step, where the element that makes the claims novel being shared by all the claims.

The concept of the unity of invention, the range of substantial examination and allowable range of claim amendment in response to the issuance of lack of unity rejection are quite complicated.

We are more than happy to provide you with additional explanation thereof.

Shogo Nakamura (Mr.);  
Patent Attorney of the Patent Division

## Trends in Patent Litigation Against JPO Decisions as to Novelty and Inventive Step in the First Half of 2013

### I. Introduction

Novelty and inventive step are important issues in patent litigation. This article aims to provide a brief overview of trends in patent litigation against appeal/trial decisions by the Japan Patent Office (JPO) as to novelty and inventive step in the first half of 2013.

The Japanese courts provide a database of court judgments (<http://www.courts.go.jp/>). It includes judgments rendered by the Intellectual Property High Court (IP High Court) in litigation seeking for revocation of JPO decisions.

Although it does not include all the cases, it provides the latest information about trends in IP High Court judgments over JPO decisions as to novelty and inventive step in the first half of 2013.

### II. IP High Court judgments over JPO decisions as to novelty and inventive step

Using the database, judgments in patent litigation against JPO decisions are extracted from IP High Court judgments rendered from January 1, 2013 to June 30, 2013. In patent litigation against JPO decisions, many allegations are made in relation to novelty, inventive step, description requirements, procedural violations, etc. This article selects cases where substantial judgment was made regarding JPO decisions as to novelty or inventive step. Cases where other patent requirements or procedural matters were the main issues in the judgments are not selected.

Among the selected cases, the IP High Court revoked JPO decisions that did not grant patents or invalidated patents by denying novelty or inventive step more frequently than JPO decisions that did not invalidate patents by recognizing novelty and inventive step.

## 1. IP High Court judgments over JPO decisions that did not grant patents or invalidated patents by denying novelty or inventive step

These are (1) IP High Court judgments over JPO decisions that did not grant patents by denying novelty or inventive step in appeals (appeals against examiner's decisions of refusal at the JPO) and (2) IP High Court judgments over JPO decisions that invalidated patents by denying novelty or inventive step in invalidation trials (trials for patent invalidations at the JPO).

Results	Number of cases
IP High Court affirmed JPO decisions	59
IP High Court revoked JPO decisions	21
Revocation rate: 26%	

As shown above, the IP High Court revoked about 26% of JPO decisions that did not grant patents or invalidated patents by denying novelty or inventive step. In more detail, the above judgments are classified into the following two categories.

### (1) IP High Court judgments over JPO decisions that did not grant patents by denying novelty or inventive step in appeals

These are judgments over JPO decisions of refusal in appeals as to novelty or inventive step.

Results	Number of cases
IP High Court affirmed JPO decisions	53
IP High Court revoked JPO decisions	18
Revocation rate: 25%	

As shown above, the IP High Court revoked about 25% of JPO decisions that did not grant patents by denying novelty or inventive step in appeals.

Grounds for revocation included errors in recognition of a cited invention, errors in recognition of identical and different points between a claimed invention and a cited invention, etc. as well as errors in judgment concerning whether an invention could easily have been made regarding different points.

Regarding errors in judgment concerning whether an

invention could easily have been made, the most frequently mentioned points in the judgments was the lack of motivation (motivation to combine references, motivation to apply well-known arts, or motivation to modify references). Differences in the purpose of inventions were often mentioned in relation to the lack of motivation. Other major points that were mentioned included advantageous effects, obstructive factors in combining or modifying references, errors in recognition of well-known arts, being unable to obtain the claimed invention even if references were combined, etc.

### (2) IP High Court judgments over JPO decisions that invalidated patents by denying novelty or inventive step in invalidation trials

These are IP High Court judgments over JPO decisions that invalidated patents in invalidation trials as to novelty or inventive step.

Results	Number of cases
IP High Court affirmed JPO decisions	6
IP High Court revoked JPO decisions	3
Revocation rate: 33%	

As shown above, the number of samples was very small.

## 2. IP High Court judgments over JPO decisions that recognized novelty and inventive step

These are IP High Court judgments over JPO decisions that did not invalidate patents in invalidation trials as to novelty or inventive step. They do not include IP High Court judgments over JPO decisions that granted patents in appeals because if the JPO grants patents in appeals, it is not allowed to file litigation seeking for revocation of the appeal decisions.

Results	Number of cases
IP High Court affirmed JPO decisions	24
IP High Court revoked JPO decisions	5
Revocation rate: 17%	

### III. Trends in IP High Court judgments over JPO decisions as to novelty and inventive step in the first half of 2013

From the above data regarding the selected cases, the IP High Court revoked about 26% of JPO decisions when the decisions did not grant patents or invalidated patents by denying novelty or inventive step. On the other hand, the court revoked about 17% of JPO decisions when the JPO decisions did not invalidate patents by recognizing novelty and inventive step. The number of cases is small and the above data shows only a rough trend in the first half of 2013.

The trend in IP High Court judgments over JPO decisions as to novelty and inventive step in the first half of 2013 shows that the IP High Court revoked JPO decisions that did not grant patents or invalidated patents by denying novelty or inventive step more frequently than JPO decisions that did not invalidate patents by recognizing novelty and inventive step.

Trends in IP High Court judgments can change due to

various factors including a change of judges or a change in policies at the JPO, etc. To follow such changes, it will be necessary to monitor IP High Court judgments in the latter half of 2013.

### IV. Conclusion

It was not uncommon in the first half of 2013 for the IP High Court to revoke JPO decisions in relation to novelty or inventive step, especially when the JPO decisions denied novelty or inventive step.

If the JPO denies novelty or inventive step or other patent requirements in appeal/trial decisions, it is worth considering checking JPO decisions in light of revocation in the IP High Court before abandoning patents or patent applications.

Yoshinori Okamoto (Mr.);  
Attorney-at-Law of the Law Division

## YUASA<sub>AND</sub>HARA

LAW, PATENT, TRADEMARK & DESIGN and ACCOUNTING

Section 206, New-Ohtemachi Building, 2-1, Ohtemachi 2-chome  
Chiyoda-ku, Tokyo 100-0004, Japan

HOME PAGE ADDRESS: <http://www.yuasa-hara.co.jp>

Chief editor: YABE, Kozo

Assistant editor: TERACHI, Takumi

Editorial staff: ITO, Reiko; OKAMOTO, Yoshinori;

HIROSE, Shinobu; ARAI, Noriyuki;

TAKEYAMA, Naoharu;

AOSHIMA, Emi; NAKAMURA, Shogo;

UEDA, Mitsuru

*This newsletter pertains to general information and should not be taken as offering either legal advice or opinion relative to specific situations. The newsletter is intended to inform our clients and friends about matters of recent interest in the field of Intellectual Property Laws. If readers have any questions regarding topics in the newsletter, please contact the editor-in-chief, at the Law Division of our firm.*