

# Major Differences Between Prosecution at EPO and JPO





Kiyoshi FUKUI Patent & Trademark Attorney Chief Deputy Director General

# HARAKENZO WORLD PATENT & TRADEMARK

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HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM

Intellelution

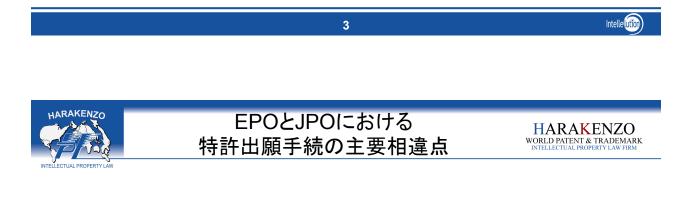
# EPOとJPOにおける 特許出願手続の主要相違点

筆頭副所長 弁理士 福井 清

特許業務法人 原謙三国際特許事務所



- Practice for Determining whether a Claimed Ι. Invention Involves an Inventive Step
- П. Limitations on Amendment
- Treatment of Computer Software-Related III. Inventions



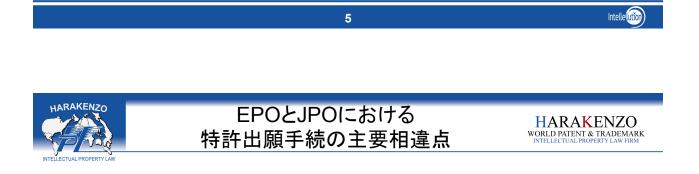
- 進歩性の判断手法 Ι.
- 補正の制限 11.
- コンピュータ・ソフトウエア関連発明の取扱い III.

HARAKENZO





# I. Practice for Determining whether a Claimed Invention Involves an Inventive Step



# I. 進歩性の判断手法



I. Practice for Determining whether a Claimed Invention Involves an Inventive Step

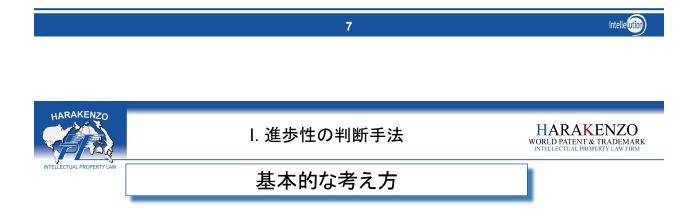
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Principle

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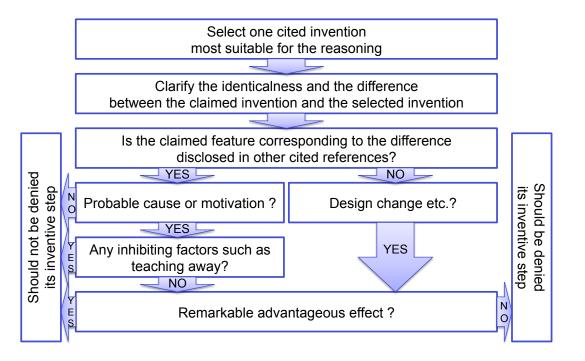
Whether or not a claimed invention involves an inventive step is determined whether the reasoning can be made.

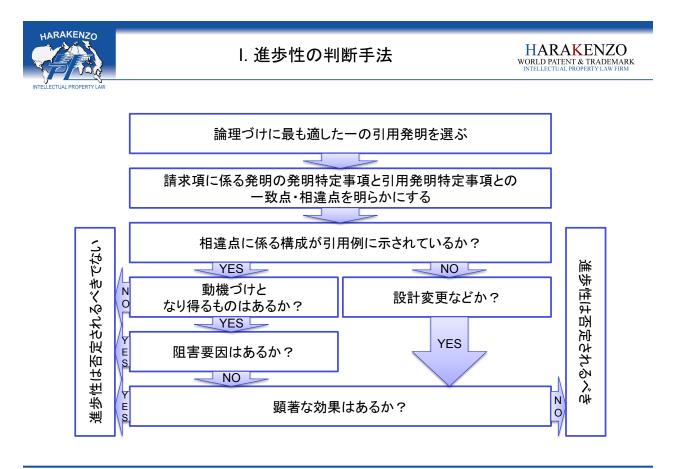
The reasoning is that a person skilled in the art could have easily arrived at a claimed invention based on cited inventions by always taking into account that what the person skilled in the art would do, after precisely comprehending the state of the art in the field to which the present invention pertains at the time of the filing.



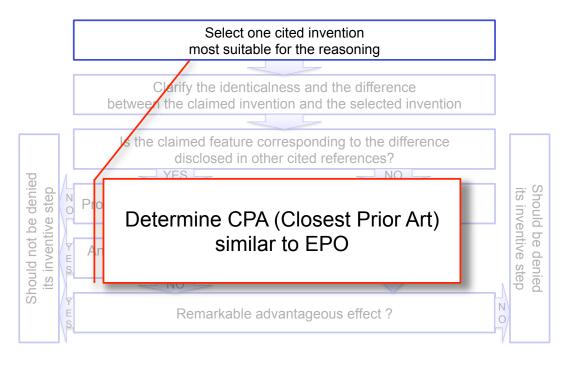
進歩性の判断は、本願発明の属する技術分野における出 願時の技術水準を的確に把握した上で、当業者であればど のようにするかを常に考慮して、引用発明に基づいて当業 者が請求項に係る発明に容易に想到できたことの論理づけ ができるか否かにより行う。







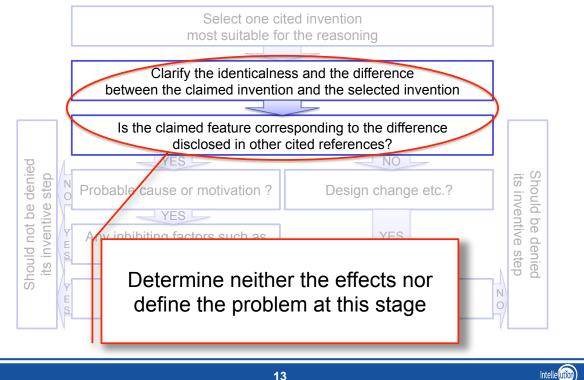




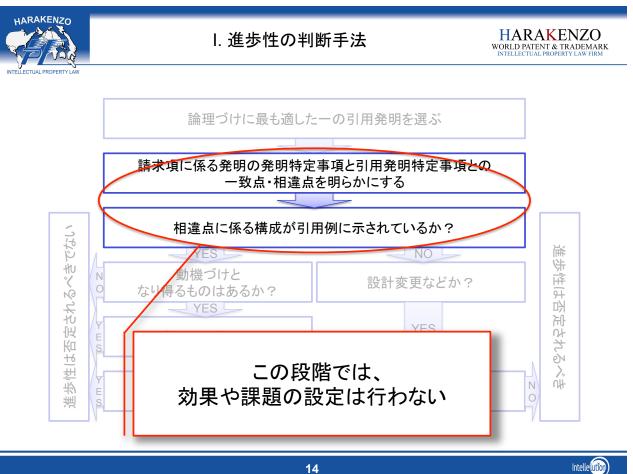
HARAKENZO HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM I. 進歩性の判断手法 論理づけに最も適した一の引用発明を選ぶ る発明の発明特定事項と引用発明特定事項との 請求項に 一致点・相違点を明らかにする 相違点に係る構成が引用例に示されているか? 歩性は否定されるべきでない 進歩性は否定されるべき EPOにおける 最も近い先行技術(CPA)の決定 と同じ N O ES 顕著な効果はあるか? 進

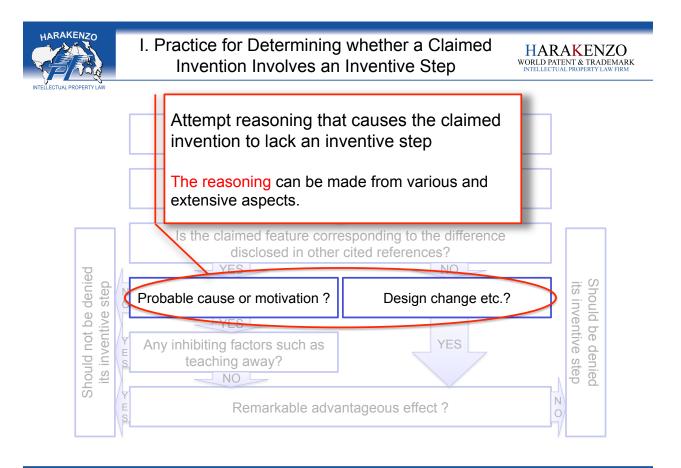


HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM

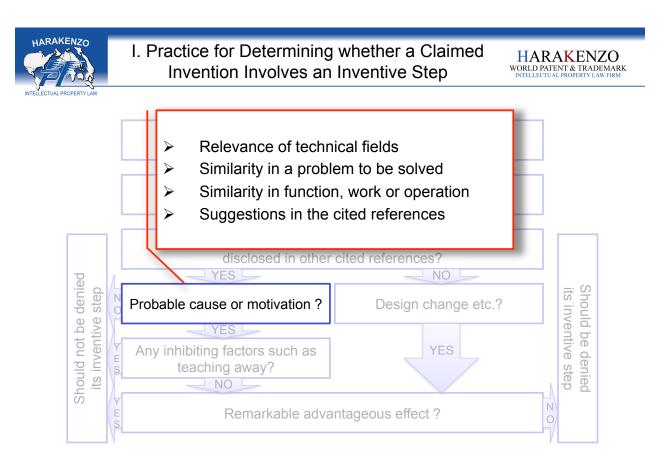


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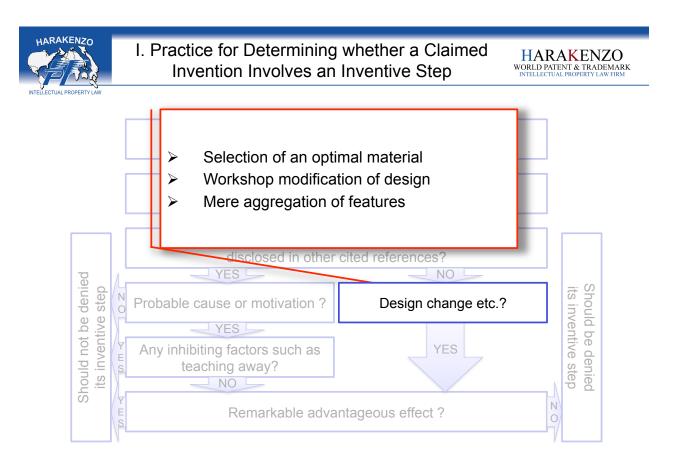




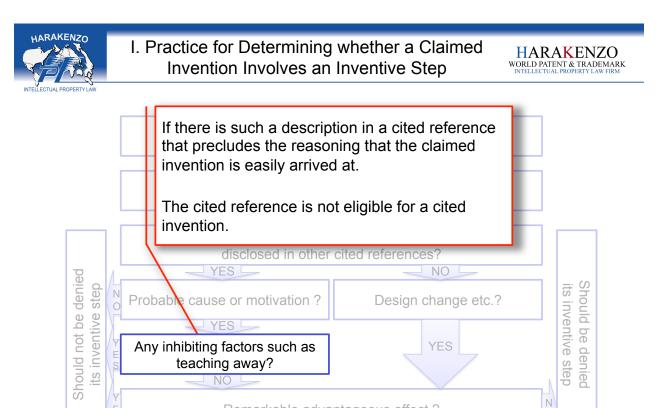
HARAKENZO HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM 進歩性の判断手法 進歩性の存在を否定し得る論理の 構築を試みる 論理づけは、種々の観点、広範な観点から行う  $\mathcal{O}$ ことが可能である。 相違点に係る構成が引用例に示されているか? 歩性は否定されるべきでない 進歩性は否定される 動機づけと 設計変更などか? なり得るものはあるか? YES 阻害要因はあるか? NO ), M Ν ES 顕著な効果はあるか? 進







HARAKENZO HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM I. 進歩性の判断手法 最適材料の選択  $\geq$ 設計変更  $\triangleright$ 単なる寄せ集め 進歩性は否定されるべきでない 進歩性は否定される NO 動機づけと 設計変更などか? なり得るものはあるか? YES 阻害要因はあるか? NO ), M Ν ES 顕著な効果はあるか?



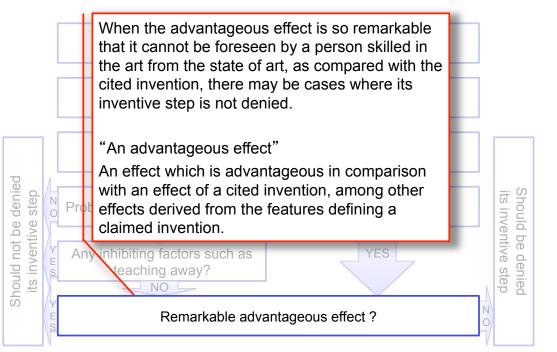
Remarkable advantageous effect ?

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HARAKENZO HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM I. 進歩性の判断手法 刊行物中に請求項に係る発明に容易に想到するこ とを妨げるほどの記載があれば、引用発明としての 適格性を欠く。 歩性は否定されるべきでない 進歩性は否定される NO 動機づけと 設計変更などか? るものはあるか? なり YES 阻害要因はあるか? NO ), N Ν ES 顕著な効果はあるか? 進

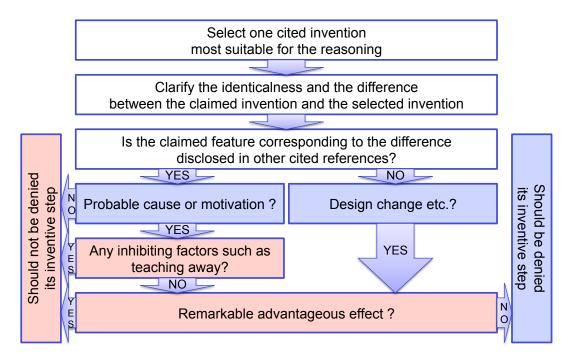
Intellelution





HARAKENZO HARAKENZO 進歩性の判断手法 WORLD PATENT & TRADEMARK 引用発明と比較した有利な効果が、技術水準から予 測される範囲を超えた顕著なものであることにより、 進歩性が否定されないこともある。 "有利な効果" 発明を特定するための事項によって奏される効果 歩性は否定されるべきでない 進歩性は否定される (特有の効果)のうち、引用発明の効果と比較して有 利なものをいう。 FS 日害要因はあるか? NO ), \/ 顕著な効果はあるか? 進

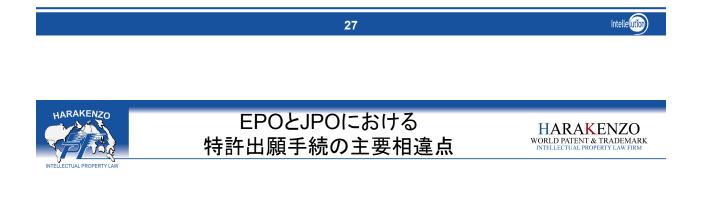




HARAKENZO HARAKENZO WORLD PATENT & TRADEMARK INTELLECTUAL PROPERTY LAW FIRM I. 進歩性の判断手法 論理づけに最も適した一の引用発明を選ぶ 請求項に係る発明の発明特定事項と引用発明特定事項との 一致点・相違点を明らかにする 相違点に係る構成が引用例に示されているか? 進歩性は否定されるべきでない 進歩性は否定されるべき VES -動機づけと N 設計変更などか? 0 なり得るものはあるか? \_\_\_ YES \_\_ YES Е 阻害要因はあるか? NO 🖵 Ν E S 顕著な効果はあるか? 0



# **II. Limitations on Amendment**



# II. 補正の制限

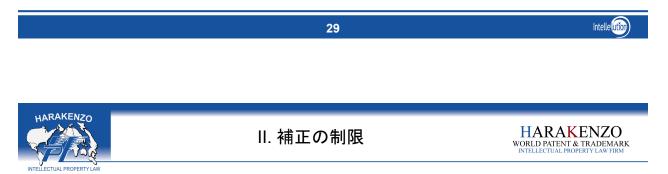




- a) Amendment containing new matter ~ Prohibited [EPC123(2)]
- b) Amendment of claims relating to unsearched subject-matter
  ~ Prohibited [Rule 137(5)]

# **پر**

- a) An amendment containing new matter ~ Prohibited [JPA17-2(3)]
- b) An amendment of claims after notice of reasons for refusal
  ~ Restricted [JPA17-2(4)]
- c) Amendment of claims after final notice of reasons for refusal ~ Further Restricted [JPA17-2(5)]



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- a) 新規事項の追加 ~禁止 [欧州特許付与に関する条約 第123条(2)]
- b) サーチされていない主題に係るクレーム補正 ~ 禁止 [規則 第137条(5)]

# **گر**

- a) 新規事項の追加 ~ 禁止 [特許法第17条の2(3)]
- b) 最初の拒絶理由通知後の特許請求の範囲についての補正
  ~制限 [特許法第17条の2(4)]
- c) 最後の拒絶理由通知後の特許請求の範囲についての補正
  ~ さらなる制限 [特許法第17条の2(5)]





An amendment of claims after notice of reasons for refusal

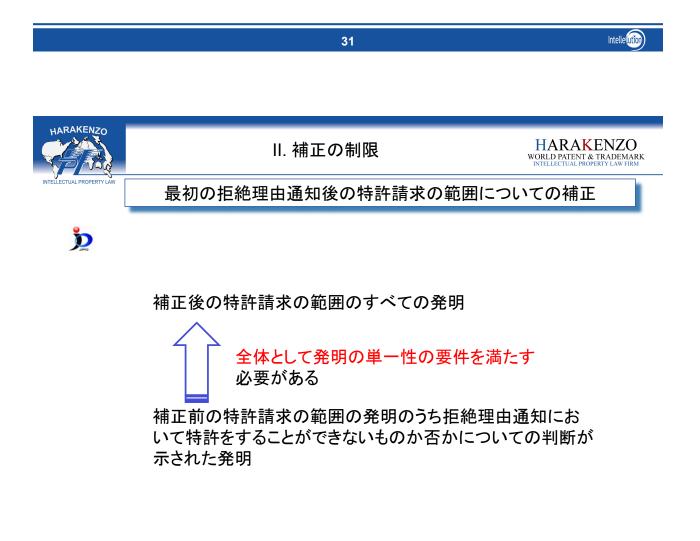
**گ**ر

# All of the amended claims

Shall meet requirements for unity of invention as a whole

# The pending claims

for which determinations are made as to whether they are not patentable in the notice of reasons for refusal issued prior to such amendments

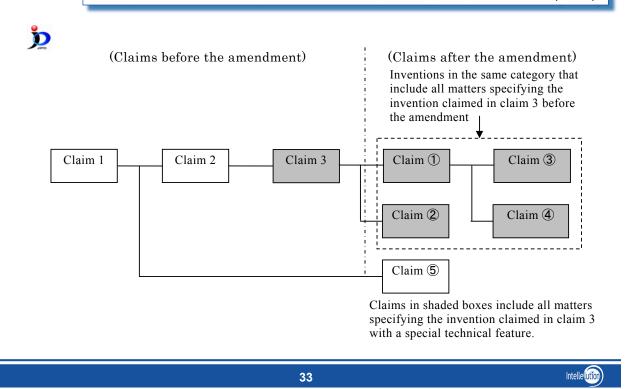


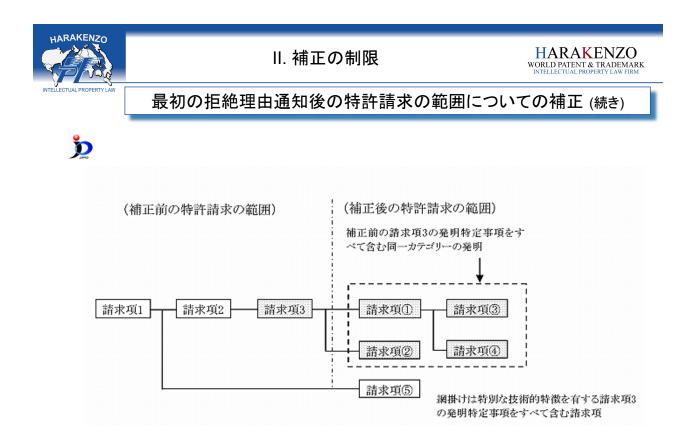


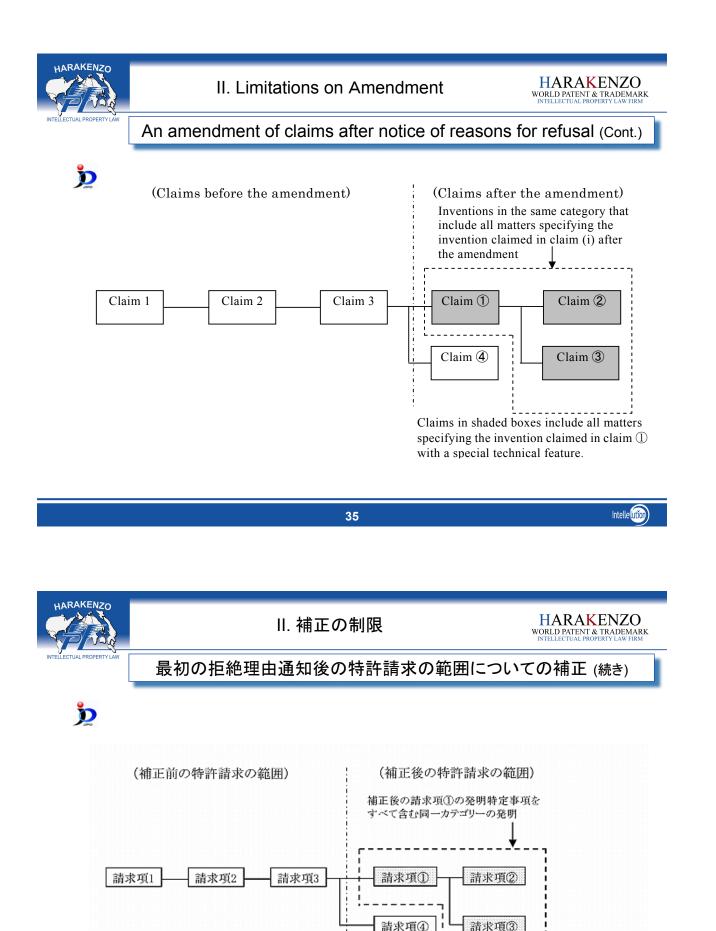
## II. Limitations on Amendment



An amendment of claims after notice of reasons for refusal (Cont.)







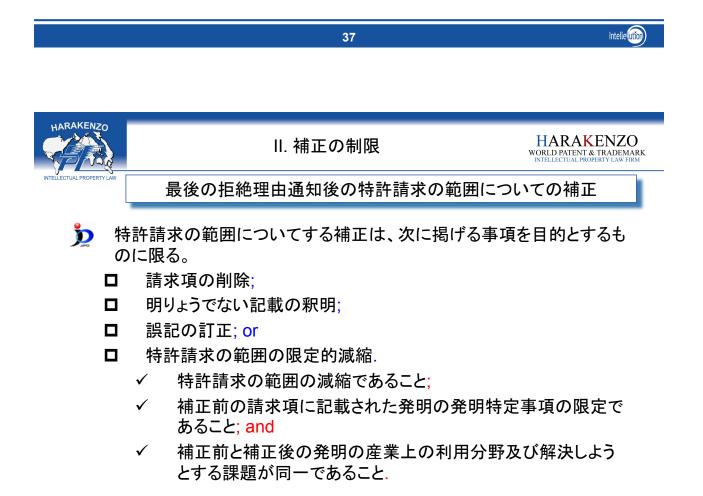
網掛けは特別な技術的特徴を有する請求



An amendment of claims after final notice of reasons for refusal

Amendment to pending claims shall be limited to those for the following purposes:

- $\Box$  Cancellation of claim(s);
- **D** Clarification of ambiguous description;
- Correction of errors in description; or
- **D** Restrictive limitation on claim(s).
  - $\checkmark$  Shall be limitation on claim(s);
  - Shall be limitation on features specifying the pending claim(s); and
  - The industrial applicability and problems to be solved by the amended claims shall be the same as the pending claims.





An amendment of claims after final notice of reasons for refusal (Cont.)

"Limitation on features specifying the pending claim"

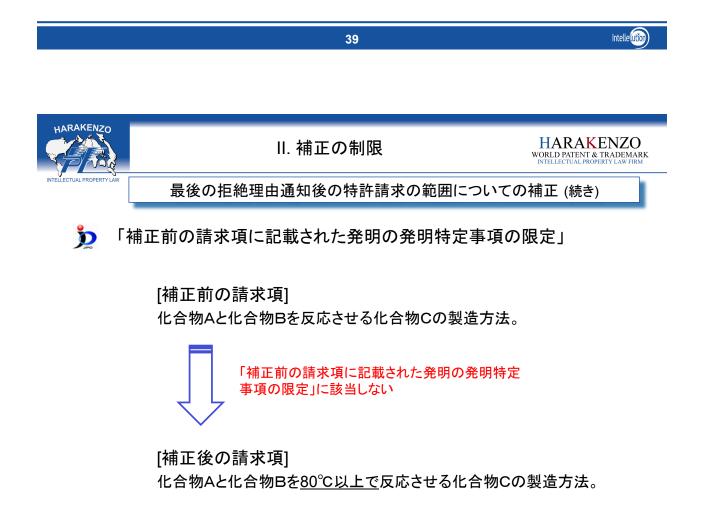
# [Pending Claim]

A production method of compounds C comprising reacting compound A to compound B.



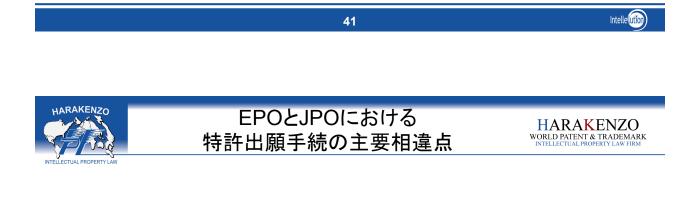
# [Amended claim]

A production method of compounds C comprising reacting compound A to compound B <u>at the temperature above 80</u>.









# III.コンピュータ・ソフトウエア関連発明 の取扱い



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# Patentable inventions

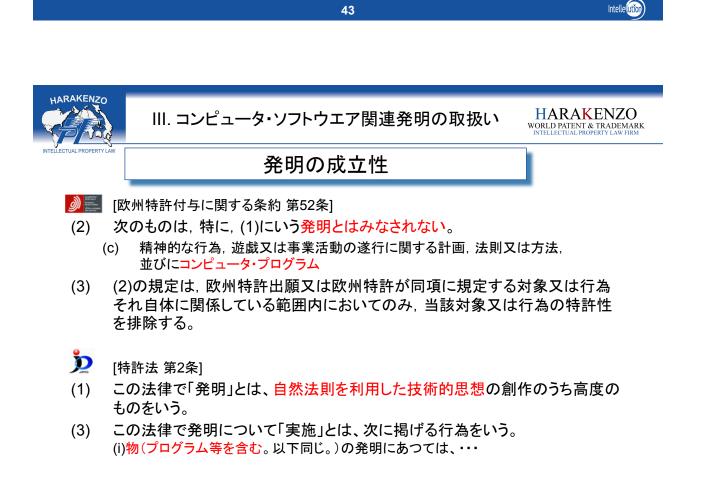


- (2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
  - (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (3) Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.



- [Patent Act Article 2]
- (1) "Invention" in this Act means the highly advanced creation of technical ideas utilizing the laws of nature.
- (3) "Working" of an invention in this Act means the following acts:

(i) in the case of an invention of a product (including a computer program, etc., the same shall apply hereinafter), producing, using, assigning, etc. ...





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Patentable Inventions (Cont.)

# Guidelines

Mart C - Chapter IV 2.3.6]

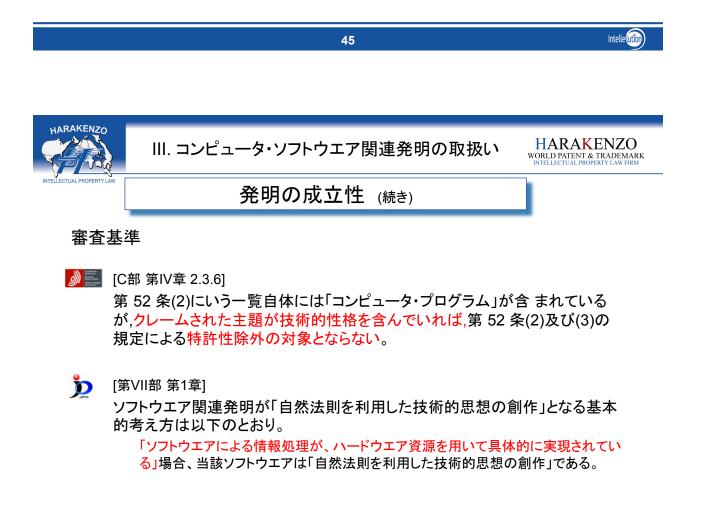
While "programs for computers" are included among the items listed in Art. 52(2), if the claimed subject-matter has a technical character it is not excluded from patentability by the provisions of Art. 52(2) and (3).

# ١

#### [Part VII Chapter 1]

The basic concept to determine whether software-related invention constitutes "a creation of technical ideas utilizing a law of nature" is as follows.

Where "information processing by software is concretely realized by using hardware resources", the said software is deemed to be "a creation of technical ideas utilizing a law of nature."





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Patentable Inventions (Cont.)

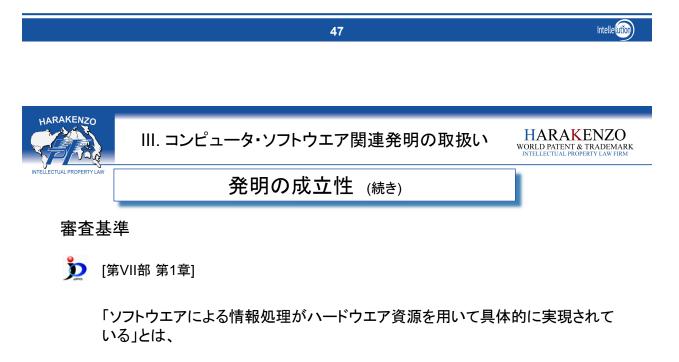
# Guidelines

Diract VII Chapter 1]

"information processing by software is concretely realized by using hardware resources,"

means that,

as a result of reading the software into the computer, the information processing equipment (machine) or operational method thereof particularly suitable for a use purpose is constructed by concrete means in which software and hardware resources are cooperatively working so as to realize arithmetic operation or manipulation of information depending on the said use purpose.



ソフトウエアがコンピュータに読み込まれることにより、ソフトウエアとハードウエア 資源とが協働した具体的手段によって、使用目的に応じた情報の演算又は加 エを実現することにより、使用目的に応じた特有の情報処理装置(機械)又は その動作方法が構築されることをいう。





Patentable Inventions (Cont.)

# Examples



## D [Claim 1]

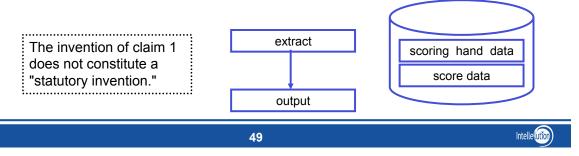
A card game program executed in a computer which includes a storage device,

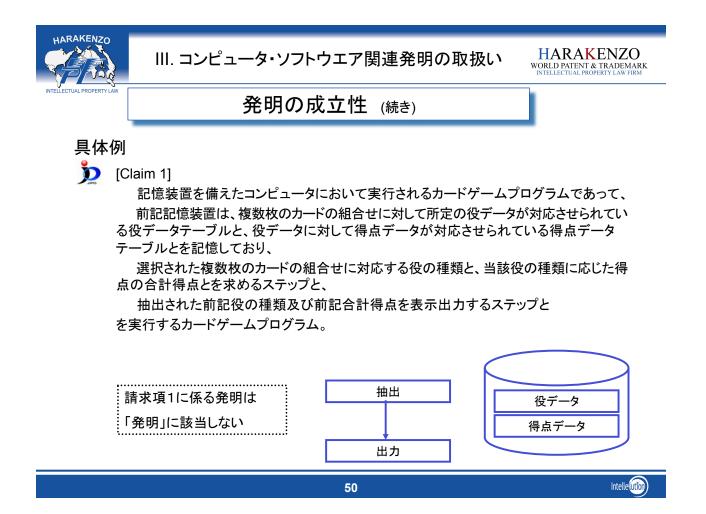
the storage device storing (i) a scoring hand data table in which specific scoring hand data correspond to a combination of a plurality of cards and (ii) a score data table in which score data correspond to the specific scoring hand data,

said card game program executing the steps of:

finding (i) a type of an extracted scoring hand which corresponds to a combination of a selected plurality of cards and (ii) a total score which is set in accordance with the type of the extracted scoring hand; and

outputting a display of the type of the extracted scoring hand and the total score thus found.







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Patentable Inventions (Cont.)

# Examples



## D [Claim 2]

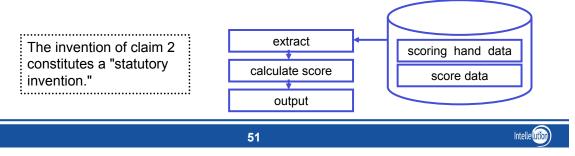
A card game program executed in a computer which includes a storage device,

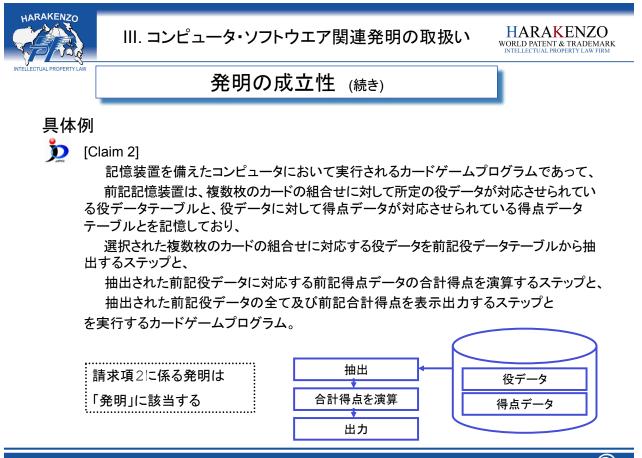
the storage device storing (i) a scoring hand data table in which specific scoring hand data correspond to a combination of a plurality of cards and (ii) a score data table in which score data correspond to the specific scoring hand data,

said card game program executing the steps of:

extracting, from the scoring hand data table, scoring hand data which correspond to a combination of a selected plurality of cards;

finding a total score of the score data corresponding to the scoring hand data thus extracted; and outputting a display of all of the scoring hand data thus extracted and the total score thus found.







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# **Inventive Step**

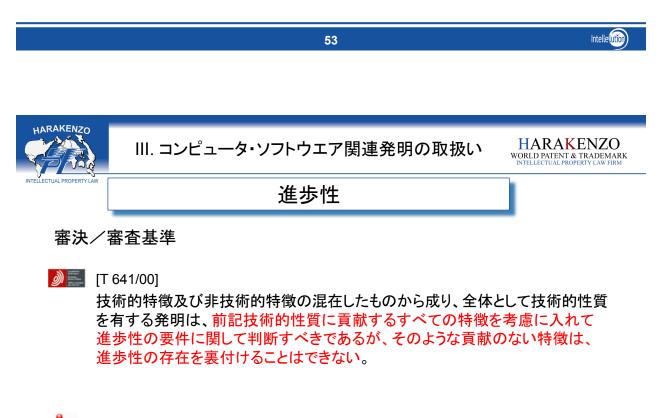
#### **Decisions/Guidelines**

### 🌒 🏪 [T 641/00]

An invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features which contribute to said technical character whereas features making no such contribution cannot support the presence of inventive step.

# [Part VII Chapter 1]

Since the invention should be viewed as a whole, it is inappropriate to identify the claimed invention by separating the aspect of artificial arrangement and that of automation technique.



# **〕** [第VII部 第1章]

請求項に係る発明を、人為的取決め等とシステム化手法に分けて認定するの は適切ではなく、請求項に係る発明を全体としてとらえることが求められる。





Inventive Step (Cont.)

# Guidelines

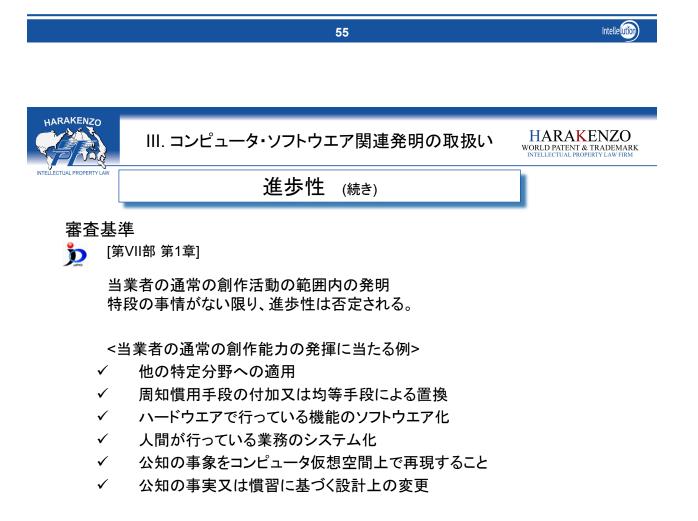
p [Part VII Chapter 1]

An invention being within the exercise of an ordinary creative activity of a person skilled in the art.

The inventive step is not affirmatively inferred unless there exist special circumstances.

<Examples>

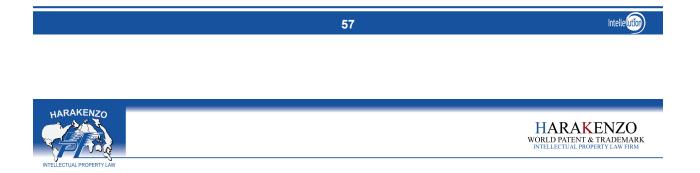
- Application to other fields
- ✓ Addition of a commonly known means or replacement by equivalent
- Implementation by software of functions which are otherwise performed by hardware
- ✓ Systematization of human transactions
- Reproduction of a known event in computerized virtual space
- ✓ Design modification on the basis of known facts or customs





# Thank you for your attention.

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# ご清聴ありがとうございました

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