

SAEGUSA IP UPDATE (No. 2) – August 2015

1. Supreme Court Decision Regarding Product-by-Process Claims

Case Nos. 2012 (Ju) 1204 and 2658^{*1}

Appellant: Teva Gyógyszergyár Zártkörűen Működő Részvénytársaság

Appellee: Kyowa Hakko Kirin Co., Ltd. (No. 1204); Tohri Company Ltd. (No. 2658)

On June 5, 2015, the Supreme Court (SC) of Japan made a decision regarding a product-by-process (PBP) claim (i.e., a claim defining a product in terms of a process of manufacture), and reversed the decision of the Grand Panel of the Intellectual Property High Court (IPHC) of 2012.

The Grand Panel of the IPHC held that a PBP claim should, in principal, be construed as limited to a product actually manufactured by the process recited in the claim when determining the patentability or the scope of protection thereof.

However, the SC held that a PBP claim should be construed as the product per se, i.e., covering a product having the same structure, characteristics, etc., as the one actually manufactured by the process recited in the claim. The SC also held that claim construction should be done in this manner when determining the patentability or the scope of protection thereof.

Furthermore, the SC stated, in light of the clarity requirement (requirement under Article 36 (6) (ii) of the Patent Act), that a PBP claim will be allowed only if there exist circumstances where it was impossible or utterly impractical to directly specify the product by its structure or characteristics at the time of filing the application.

For these reasons, the SC reversed the decision of the Grand Panel of the IPHC, and remanded the case to the IPHC to determine whether the above-mentioned circumstances exist, i.e., whether the clarity requirement is met.

2. Change in Examination Guidelines of the Japan Patent Office

In view of these SC decisions, the Japan Patent Office (JPO) is currently revising the Examination Guidelines for Patent and Utility Model (Requirements for Description and Claims) concerning a PBP claim. The revised Examination Guidelines are scheduled to be released around the beginning of October 2015.

For the time being, the Interim Handling Procedures^{*2} announced by the JPO apply to examination of applications, appeals/trials, oppositions, etc. According to the Interim Handling Procedures, when a claim is directed to a product defined in terms of a process of manufacture, the Examiner or Appeal/Trial Examiner will notify a reason for rejection of the claim for lack of clarity, except in a case where the Examiner or Appeal/Trial Examiner can find that there exist circumstances where it was impossible or utterly impractical to directly specify the product by its structure or characteristics at the time of filing the application.