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The Essentials of Japanese Patent Prosecution

ABA Book Publishing, Chicago 2020, 330 pp., US$ 149.95,
ISBN 978 1 64105 710 3

Lawyers working in international practice will be well aware of the need to maintain a working understanding of jurisdictions beyond their licensure, so as to most effectively bridge the gap between clients and overseas colleagues. Clients based in one country will regularly ask why their representatives in another request certain documents or recommend strategic action which in their own jurisdiction would be at best an unnecessary cost, or at worst professionally negligent. Consequently, resources which can explain in a relatable manner the age-old question of "but why?" will always have a place. This volume attempts to provide exactly such a resource for practitioners and clients prosecuting patent applications in Japan.

OHNUKI is a *bengo-shi* and licensed *benri-shi* with approximately 40 years of experience, who has authored multiple books in Japanese on patent law. PARMELEE is an American lawyer and patent practitioner also with approximately 40 years of experience who is predominantly based in Chicago. YAMAMOTO is a *benri-shi* and licensed patent attorney in Australia and New Zealand. Although never clearly acknowledged (notwithstanding one sentence in the preface), this book appears to be a translation of OHNUKI's popular Japanese text titled *The Basics of Patent Prosecutions*.[1]

The book is divided into three parts. Part I briefly plots the process of patent prosecution in Japan from start to finish, while introducing key terminology and concepts along the way. The bulk of the part, however, is devoted to explaining threshold matters before any patent examination can begin. These include, for example: who conducts the examination (an Examiner at the Japanese Patent Office (JPO)), who can request examination (anyone), the period within which to request examination (three years), what forms of examination are available (ordinary, and various forms of accelerated examination) and the eligibility for same.

Part II covers the various grounds an Examiner may raise in a Notice of Reason for Rejection, and how one might assess and respond to each. Naturally then, this part also doubles as an explanation of the conditions for

1 S. OHNUKI [大貫進介], 特許出願の中間手続き基本書 (4th ed., 2016).

patentability under the Japanese Patent Act (hereafter the Act).[2] This part begins with fundamental conditions of patentability such as novelty (Chapter 2), inventive step (Chapter 3), deficiencies in the specification (Chapter 4), unity of invention (Chapter 5), and patentable subject matter (Chapter 6), before then addressing more particular issues such as double patenting (Chapter 7) and whole-of-contents novelty (Chapter 8).

Finally, Part III covers the more procedural aspect of the prosecution process. Chapters 9 and 10 walk through the various restrictions on amendments, specifically covering timing requirements and the addition of new matters, before moving to more particular restrictions such as shift amendments (Chapter 11) and restricted-narrowing amendments (Chapter 12). The last three chapters focus on an applicant's options once an (unfavourable) outcome has materialised, such as filing divisional applications (Chapter 13), appealing Notices of Rejection (Chapter 14), and requesting interviews with the examiner (Chapter 15).

The authors present all this information in a delightfully logical structure. All topics are presented in a broadly chronological order following the life of an examination from start to finish. Yet, within this, the book is further structured so as to introduce broader or threshold concepts first and narrower concepts later. Each Chapter begins with the relevant legislative provision, accompanied by a brief explanation of the purpose and policy behind it and interpretations of key legislative words. The rest of the Chapter then dissects the given stage of prosecution into its constituent components and concepts, offering explanations through the use of contrasting examples, illustrative case authority and practical insights from OHNUKI's experience. The book is therefore intuitively navigable and perfectly designed as a quick reference tool for practitioners.

Additionally, the examples and case authority offered to illustrate key points are of consistently high quality. Most cases cited are either intermediate appeals (from the Tōkyō HC or IPHC) or Supreme Court decisions, and the extracts given for these typically provide clear statements of the court's interpretation or fact patterns which clearly illustrate the desired point. That is to say, a reader from a common law jurisdiction will feel very comfortable in the belief that these are the 'leading cases' in the field. Moreover, examples devised by the authors themselves are equal parts simple and enlightening (see e.g., pp. 32–35, 228–229) and occasionally include mock-ups of key documents that applicants will interact with, such as a first or final Notice of Reason for Rejection (p. 17) and a Substantive Amendment (p. 19). This text does not purport to be a comprehensive

2 特許法, Act No.121/1959.

commentary to the Act, but it does nonetheless advert to most of the high-level questions that a foreign IP practitioner would likely ask.

Having said this, though, there are numerous deficiencies which quickly undermine confidence in the accuracy of the book's contents. Easily the most concerning of these is the frequent inability to provide citations or otherwise explain the basis for some pivotal claims. For example, early on the authors introduce three avenues for accelerated examination: "normal accelerated examination", "super accelerated examination", and the "patent prosecution highway" (pp. 10–11). Over the next four pages, the authors meticulously detail the requirements and procedures for each such process, including: (i) who can apply, (ii) in what circumstances, (iii) what kind of documents must be filed (iv) whether any additional fees apply, and (v) statistics regarding the number of requests made and the average turnaround time for such examination (pp. 10–13). Yet, nowhere is there any indication of the source of these requirements. The consequences of such an omission are already manifest: accelerated examination is in fact set by JPO guidelines, and the guidelines providing for "normal accelerated examination" were substantially revised only months after this book was published.[3] Instead, the best approximation of a citation is a claim that "[a]ccelerated examination is implemented by the patent office's discretionary power" (p. 10). What is the source of this power? What is its scope? These are fundamental questions that the intended reader (whether practitioner or client) will undoubtedly ask, and this book offers no answer. When the book does provide citations, they tend to be inconsistent. The most obvious example of this is the representation of subsections to the Act which frequently alternate between parentheses and brackets, often on the same page (see, eg., pp. 25, 207, 212–213, 221, 223, 236, 250).

Similarly, in the context of Novelty, the authors draw careful distinction between the "filing date" and "time of filing" of applications. The potential significance of this distinction is of course self-evident, but the authors offer no legal source warranting such a distinction, nor any cases or instances where such a distinction has ever been of any consequence in practice (pp. 25–28). This is particularly concerning for two reasons: firstly, the legislative provision being discussed (Art. 29(1) of the Act) makes no such distinction whatsoever,[4] and secondly, the authors state in the subsequent

3 The requirements for normal accelerated examination are provided for in the JPO's "Guidelines for Accelerated Examination and Accelerated Appeal Examination of Patent Applications" [特許出願の早期審査・早期審理ガイドライン]. These guidelines were substantially revised in May 2021.

4 See, e.g., Arts. 29(1)(i)–(iii) and 29(2), all of which use the words "prior to the filing of the patent application":「特許出願前」.

paragraph by way of contrast that "the time of day is irrelevant for applications with international filing dates or Paris Convention priority dates" (p. 26). It is easy to imagine clients choosing to structure their domestic and PCT filings based upon perceived (albeit minute) differences in calculation standards that may in fact not exist.

Likewise, in the context of Inventive Step, the authors claim that, of the multiple inventions which the examiner may cite against the patent application, "the examiner selects a single cited invention (called the *main cited invention*) that is most suited for reasoning for lack of an inventive step of the claimed invention". This is immediately followed by a note (presumably from PARMELEE) explaining that, in contrast, US Practice "does not require specifically identifying a particular reference as a 'main' reference" (p. 42). At no point does the book explain where this requirement comes from or, more importantly, why or when it is of any consequence in the prosecution process.

In yet another example, the authors draw attention to Art. 48-3 of the Act which allows any person to request examination of a patent application. They advise that it "may therefore be strategic to anonymously request examination of applications by competitors" (p. 7). However, Art. 48-3 does not specifically provide for anonymity and the authors do not expand further upon this strategic advice. Accordingly, a reader may justifiably become confused to learn that the subsequent provisions (Arts. 48-4 and 48-5) in fact require that any person requesting examination provide their name and domicile to the Commissioner of Patents, who then publishes the fact of the request to both the official Gazette and the patent applicant.

While the above examples are all found in only the first three chapters, they are representative of countless such claims (and omissions) found throughout all of this book. It is likely that many such instances are in fact principles or lessons drawing from OHNUKI's practical experience, but to the extent this is so, some transparency would still be appreciated. Knowledge gained from experience is just as useful a tool as any legislative or scholarly source, but without proper attribution a reader cannot be expected to properly apply that knowledge in context.

At each turn, then, the reader is asked to simply trust the authors' word. It is difficult to be so generous, however, when mixed among these unverified claims is the occasional piece of (slightly *Nihon-jin-ron-esque*) conjecture. Take for example the passing remark that "[i]ncidentally, it is generally considered that the quality and uniformity of examination by the examiners of the Japan Patent Office are significantly better than those of the examiners of many foreign patent offices" and that the Japanese Examination Guidelines are drafted so as to ensure that JPO decisions are "fair and rational" (pp. 5–6). One wonders how these views are to be reconciled with

the authors' more diplomatic advice that applicants take note of the particular examiner's name and tailor any correspondence to their personal whims, while also refraining from being too assertive or antagonistic lest one damage the examiner's ego (pp. 5–6, 13).

Despite providing "interpretations" of legislative provisions at the outset of each chapter, most are really no more than a direct paraphrasing of the legislative text. They therefore add no further insight into the meaning or application of the legislative provisions than can be gained by simply reading the Act. Illustrating this are the following "interpretations" of Art. 29-2 in Chapter 8 (p. 208) as offered against the constituent phrases in the text of the Article itself:

Legislative Text	Interpretation
If an invention claimed in a patent application is identical to …	
– *an invention described in the specification, claims or drawings*	"The claimed invention of the later application is compared with the invention described in the specification, etc. as a whole of the earlier application"
– *as originally filed with a patent request of another [earlier filed] patent application …*	"The whole-of-contents prior art is the matter described in the specification, etc. at the time of filing of the earlier application"
– *… (except where the inventor(s) of the invention of said patent application is the same as the inventor(s) of the invention of the earlier invention)*	"If the inventor(s) of the invention of the later application is the same as the inventor(s) of the invention of the earlier application, s 29-2 does not apply"
… the invention cannot be patented notwithstanding the provisions of s 29(1).	

Another curious feature of this book is the sporadic addition of comments (typically highlighted in a separate text-box and couched in parentheses) noting comparisons with US patent practice. While not expressly acknowledged, these are presumably written by PARMELEE – the only one of the authors with any licence or practice experience in the US. Although such notes for an English-speaking readership would be good in theory, the execution leaves much to be desired. Almost every note is one or two short sentences comprising words to the effect of "yes the US does that too" or "this is different from the US" (see, eg., pp. 101, 120, 150, 185, 219, and 231). On the one hand, there are no such notes in areas where they would be quite valuable – Chapters 5 (Unity of Invention) and 8 (Whole-of-

Contents Novelty) have not even a single note, despite representing major points of conceptual similarity and difference between the two jurisdictions. On the other hand, many of the notes which are offered tend to be unhelpful. For example, upon explaining that the default fee for requesting examination is JPY 118,000, one note adds "(102 yen = 1 USD, as of July 2014)" (p. 8). Given that this exchange rate was nearly six years old *at the time of publication*, its inclusion not only does not answer any question about the relative value of the currency, but instead raises a broader question about the currency of information in the book generally.[5] In any case, the total amount of these notes comparing Japan to US practice is incredibly minimal (probably two pages worth over the full 330 pages). The experience of encountering these notes is rather like one has personally borrowed PARMELEE's copy of OHNUKI's text and found it to contain the odd post-it note or comment scribbled in the margin.

Furthermore, despite the brilliant structuring and taxonomy of concepts across the book as a whole, it is disappointing to notice that the actual drafting quality within this structure is rather poor. Passages are verbose, awkwardly worded, and unnecessarily repetitive. The combined effect is (unfortunately) to further obfuscate the message. At pp. 14–15 for example, the authors take almost two pages to explain the following very straightforward points:

i. There are only two forms of Notices of Reason for Rejection: First Notices and Final Notices
ii. A Final Notice notifies the applicant of rejection grounds which arose from an amendment made in response to a First Notice.
iii. There can be any number of First Notices.
iv. If an applicant does not overcome the objection in a First Notice, the Examiner will issue a Notice of Rejection.

These are not particularly difficult things to explain, but the writing style often makes extracting this information unnecessarily difficult. It is ironic that this book claims to "explain strategies for prosecution using simpler language without compromising accuracy" (p. 7) and yet occasionally appears to achieve the exact opposite. One could probably halve its length without sacrificing content.

With respect to all of the above criticisms, however, it is difficult to appropriately describe how they have arisen. It could be that every issue identified above is merely an inherited feature resulting from a "faithful translation" of OHNUKI's original work. This would certainly provide some sym-

5 For added context, the most recent edition of OHNUKI's Japanese text was published in 2016, and the previous in 2014.

pathetic context to the drafting issues, US annotations, and even the lacking citations. However, the book dances around the subject, and never actually identifies the original OHNUKI work from which it derives.

Ultimately, though, this volume must be evaluated for what it is rather than by reference to its original Japanese-language parent. It is an excellently structured reference with detailed explanations of Japanese patent prosecution written by practitioners with a wealth of relevant experience across multiple jurisdictions. Yet, it is also clearly still a first draft. Once the predominantly formal drawbacks are revised, subsequent editions of this book will no doubt become an invaluable addition to any practitioner's library.

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