

Preface

I have practiced patent law for more than 40 years. The bulk of that activity involves patent practice in the United States, but much also includes a more international practice. Viewed broadly, there are certain concepts I've seen at least most major patent systems seemingly apply in common. Things like unity of invention, novelty, nonobviousness (aka inventive step, more or less), amendment practice, and prohibitions against new matter will strike all global patent practitioners as being familiar ground. And yet, most patent systems also often have their own unique procedures or sometimes even their own unique substantive standards by which patent applications are analyzed and measured.

Japan's patent system is an excellent example in the latter regards. Japanese patent practice employs the idea of unity of invention, for example, in procedurally important ways that can at least mildly annoy or even baffle a U.S. practitioner. And while claim amendments are a normal and expected part of prosecuting a patent application in Japan, the U.S. practitioner may be surprised by how merely mirroring U.S. practice in these regards can paint oneself into a Japanese procedural corner that can be expensive or impossible to escape. As yet one more example, when prosecution with the examiner reaches loggerheads, filing an internal appeal at the Japanese patent office also curiously includes the procedural opportunity to present yet another amendment (or, viewed another way, at this point in Japanese prosecution, the only way to file yet another amendment in that application is to also file an appeal).

The foregoing examples only begin to skim the surface of what swims in the waters of Japanese patent prosecution. Herein you will find strange tales regarding such things as whole-of-contents novelty, shift amendments, and restricted-narrowing amendments, as well as the all-important special technical feature.

This book offers a thorough and well-parsed review and explanation of the Japanese patent system as viewed through the eyes of an experienced Japanese patent practitioner. There is both law and sage practical counsel here. There are definitions, explanations, historical context, examples, and a rich offering of well-chosen court decisions that guide, inform, and exemplify the author's points.

The original Japanese editions of this book (also translated into Mandarin and Korean) serve the everyday practitioner of Japanese patent law. The thoroughness and practicality of the book's contents well bespeak that purpose. But these materials are also of significant value to practitioners who only occasionally find themselves involved with the prosecution of a Japanese patent application as well as those who are simply interested in patent system alternatives to the U.S. paradigm.

I have known and collaborated with the author, Shinsuke Ohnuki, for well over half of my own career. We have spent many a meal and other opportunities chatting with each other and comparing the finer points of U.S. and Japanese patent practice. Shin has deep experience in writing and prosecuting patent applications in Japan, as well as enforcing and licensing the resultant patents in Japan and elsewhere. He has lived and worked long in the trenches of Japanese patent prosecution and well understands through personal experience the consequences of various prosecution approaches. I can think of no better person to write the present book than Shin.

Steven G. Parmelee, 2020