Contents

Preface .................................................................................................................... ix

PART I Introduction ................................................................................................. 1

Chapter 1: Introduction ............................................................................................ 3
  1.1. Procedures Pertaining to the Examination of a Patent Application ............ 3
  1.2. Examination by Examiner (Patent Act, s47) ........................................... 5
  1.3. Request for Examination of Application (Patent Act, s48-3) ................. 7
  1.4. Accelerated Examination ...................................................................... 10
  1.5. Notice of Reason for Rejection (Patent Act, s50) ................................. 13
  1.6. Amendment (s17) .................................................................................. 18
  1.7. Argument .............................................................................................. 20
  1.8. Other Kinds of Responses to Notice of Reason for Rejection .............. 22

PART II Response to Notice of Reason for Rejection ............................................ 23

Chapter 2: Novelty (Subsection 29[1]) ............................................................... 25
  2.1. Provisions and Interpretation of s29(1) ................................................ 25
  2.2. Steps for Assessment of Novelty (Invention Described in Publication) .................................................................................. 28
  2.3. Response to Objection: Lack of Novelty .............................................. 36
  2.4. Exception of Loss of Novelty (s30) ....................................................... 37

Chapter 3: Inventive Step (Subsection 29[2]) ....................................................... 39
  3.1. Provisions and Interpretation of s29(2) ................................................ 39
  3.2. Steps for Assessing Inventive Step ...................................................... 40
  3.3. Examples of Reasoning ........................................................................ 44
  3.4. Functional Claims .............................................................................. 51
3.5. Product-by-Process Claims ............................................... 51
3.6. Considerations for Assessment of Inventive Step ...................... 52
3.7. Response to Objection: Lack of Inventive Step ....................... 54
3.8. Ordinary Nonstrategic Argument .................................. 77
3.9. Strategic Argument.............................................. 81
3.10. Strategic Amendment............................................ 98
3.11. Other Considerations ........................................... 107

Chapter 4:
Deficiency in Description in the Patent Specification (s36) ..................... 111
4.1. Insufficient Description in Claims (s36[6]) ............................ 112
4.2. Insufficient Description in Specification (s36[4][i]) .................. 134
4.4. Requirements Pertaining to the Disclosure of Prior Art Documents (s36[4][iii]) ................................................. 148

Chapter 5:
Unity of Invention (s37) ......................................................... 153
5.1. Provisions and Interpretation of s37 .................................. 153
5.2. Assessment of Unity of Invention ..................................... 155
5.3. Basic Types of Unity of Invention .................................. 159
5.4. Types Where Multiple Inventions Have a Specific Relationship ........ 161
5.5. Intermediate Product and Final Product .............................. 163
5.6. Assessment of Unity of Invention .................................. 164
5.7. Response to Objection for Lack of Unity of Invention ................ 172
5.8. Consideration for Unity of Invention .................................. 176

Chapter 6:
Patentable Subject Matter and Industrial Applicability
(Subsection 29[1], First Paragraph) ........................................ 179
6.1. Provisions and Interpretation of s29(1), First Paragraph ............... 179
6.2. Types of Nonstatutory Inventions and Responses .................... 181
6.3. Computer Software–Related Inventions and Responses ............... 185
6.4. Types of Inventions That Are Not Industrially Applicable and Responses ......................................................... 188
6.5. Response to Notice of Reason for Rejection:
“Statutory Invention” and “Industrial Applicability” .......................... 195

Chapter 7:
Double Patenting (s39) .......................................................... 197
7.1. Provisions and Interpretation of s39 .................................. 197
7.2. Inventions to Which s39 Applies ....................................... 199
7.3. Applications Not Constituting the Earliest Application ................. 199
Chapter 7: Application Procedure

7.4. Filing Date of Applications .................................. 201
7.5. Steps for Assessment of Identical Invention .................. 201
7.6. Applicant of the Earliest Application, or Discussion .......... 203
7.7. Response to Objection: Double Patenting ..................... 205

Chapter 8:
Whole-of-Contents Novelty (s29-2) ..................................... 207
8.1. Provisions and Interpretation of s29-2 .......................... 207
8.2. Assessment of Whole-of-Contents Novelty ...................... 209
8.3. Difference with Prohibition of Double Patenting (s39) ......... 212
8.4. Response to Objection: Whole-of-Contents Novelty .......... 212

Chapter 9:
Restrictions on Amendments ........................................... 217
9.1. Timing for Filing Amendments .................................. 217
9.2. Restrictions on Contents of Amendments ....................... 219

Chapter 10:
Addition of New Matters (Subsection 17-2[3]) ....................... 223
10.1. Provisions and Purpose of Prohibition of Addition of New Matter 223
10.2. Basics of Prohibition of the Addition of New Matter .......... 224
10.3. Types of Claim Amendments .................................... 226
10.4. Types of Specification Amendments ............................ 230
10.5. Amendment of the Drawings .................................... 231
10.6. Duty of Explanation by the Applicant ......................... 232
10.7. When an Amendment Is Found to Include the Addition of New Matter ........................................... 233
10.8. Response to Objection: Addition of New Matter .............. 233

Chapter 11:
Shift Amendment (s17-2[4]) ............................................. 235
11.1. Provisions and Purpose of the Prohibition of Shift Amendments 235
11.2. Basics of s17-2(4) ............................................. 236
11.3. Amended Claims to Be Examined Where Claim 1 Before Amendment Has an STF: Example 1 237
11.4. Amended Claims to Be Examined Where a Claim Other than Claim 1 Is Found to Have an STF: Example 2 239
11.5. Amended Claims to Be Examined Where an STF Was Not Found Before Amendment: Example 3 242
11.6. Considerations Regarding Shift Amendments ................ 244
11.7. Procedures Relating to Shift Amendments ...................... 245
11.8. Response to Objection: Shift Amendment ...................... 246
Chapter 12:
“Restricted-Narrowing” Amendment (s17-2[5]) .......................... 249
12.1. Provisions and Purpose of s17-2(5) ................................. 249
12.2. Deletion of Claims (s17-2[5][i]) .................................. 251
12.3. Restricted-Narrowing of Claims (s17-2[5][ii] and [6]) ............ 251
12.4. Correction of Errors (s17-2[5][iii]) ................................. 256
12.5. Clarification of Ambiguous Description (s17-2[5][iv]) ............ 256
12.6. Procedures for Amendments in Breach of s17-2(5) ............... 258
12.7. Strategies Relating to s17-2(5) ..................................... 259
12.8. Procedures for Impermissible Amendments at Different Stages of Prosecution ............................. 262

Chapter 13:
Divisional Applications (s44) ............................................. 265
13.1. Provisions for Divisional Application ................................. 265
13.2. Requirements for a Divisional Application .......................... 268
13.3. Procedures for Divisional Application ............................... 273
13.4. Effects of Divisional Application ............................... 274
13.5. Strategies for Divisional Applications ............................... 276
13.6. Considerations for Divisional Applications .......................... 278

Chapter 14:
Appeal Against Notice of Rejection (s121) ................................. 283
14.2. Appellant ........................................................................ 284
14.3. Period for Filing Appeal ............................................. 285
14.5. Pre-appeal Examination ............................................. 288
14.6. Examination by Appeal Examiners ................................ 290
14.7. Appeal Decisions .................................................... 299
14.8. Strategies and Considerations for Appeal Against Notice of Rejection ............................. 300

Chapter 15:
Interviews with Examiners .................................................. 303
15.1. Who Can Request and Attend Interviews ........................... 303
15.2. Subject of Interview, Timing, Venue ................................. 304
15.3. Contents of Interview ................................................ 304
15.4. Effects of Interview .................................................. 305
15.5. Considerations for Interviews ....................................... 305

About the Authors ....................................................... 307
Index ................................................................. 309