

Contribution of patent examination to making the patent scope consistent with the
invention: Evidence from Japan

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Abstract

Delineating the patent scope consistent with the contribution of the disclosed invention to the state of the art is one of the crucial requirements for the patent system in effectively promoting innovation. Given the incentive of a firm to claim the scope of the patent right as broad as possible, an important task of the patent office is to narrow the overbroad claims so that they become consistent with the invention. This study empirically analyzes how significantly the patent office delivers this important function through its patent examination. We found that the patent right scope very often (i.e. two thirds of the granted patents) gets narrower as the outcome of patent examination process and becomes more consistent with the invention. Both the incidence and the extent of such narrowing increase when the applicant chooses broader claims, and decrease when the quality of prior art disclosure by applicant is higher. This study covers product inventions in all major technology areas where cascaded type claim structure is dominant (the exceptions being chemical and pharmaceutical sectors).

Key words: Patent scope; Examination; Claim length; Disclosure

JEL: O34, O31, O38