

**CASE STUDY  
BY TRIAL AND APPEAL EXPERTS  
REPORT 2015 (SUMMARY)**

***Trial and Appeal Department  
Japan Patent Office***





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## Preface

The trial and appeal department at the Japan Patent Office (JPO) takes an important role that is making final judgements of the government as for appropriateness of examination results or validity of rights of patents, utility models, designs or trademarks. And we consider that it is important to utilize outcomes of analyses of actual cases with trial/appeal decisions or court decisions, in order to make more appropriate judgements in trial/appeal examinations.

Since FY 2006, the JPO has been holding meetings for “Case Study by Trial and Appeal Experts”, where patent practitioners from various fields, such as industry players, patent attorneys, lawyers and administrative judges, gather together for conducting study on trial/appeal decisions and court decisions. The outcomes of these case studies have been widely disseminated.

At the Case Study, meetings are categorized patent, design and trademark were held. For the current fiscal year, with regard to patents, in addition to the technical fields such as “Machinery”, “Chemistry”, “Medicine and Food” and “Electronics”, a “General” field was established for cases handled focusing on the interpretation of the law or procedural aspects, for contributing to the enhancement of the analysis of matters other than technical matters.

With cooperation of Japan Intellectual Property Association, Japan Patent Attorneys Association and Japan Federation of Bar Associations, a total of 50 practical experts gathered together, and held active discussions from various standpoints.

It would be appreciated if this report that consolidates the outcomes of unrestricted discussions based on each standpoint of study members could help domestic and international users of intellectual property rights to understand trial/appeal practices at the JPO.

With utilizing the outcomes of this Case Study, the trial and appeal department at the JPO would enhance trial/appeal examinations continuously.

In closing, I, as a chairperson, would like to express my sincere gratitude for the cooperation of all members of the Case Study who spent their time during the busy schedule.



**Akira Tanji**

Executive Chief Administrative Judge  
Chairperson of Case Study by Trial and Appeal Experts

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## Outline of Study

### I. Study Framework

Studies were made on the judgement, etc. of the JPO and the Intellectual Property High Court based on cases of trial/appeal decision and court decision, by each of the 7 fields, which are “Patent: General”, “Patent: Machinery”, “Patent: Chemistry”, “Patent: Medicine and Food”, “Patent: Electronics”, “Design” and “Trademark”.

"Patent: General" field dealt with cases with discussion points of the interpretation of the law and procedural aspects.

5 to 9 members belong to each field, and totally 50 members joined in this study.

The members conducting the studies were selected from the industry players (intellectual property division in companies, etc.), lawyers, patent attorneys, trial and appeal department at the JPO (administrative judges) to give full consideration to the studies from various angles based on the standpoint of each field.

### II. Study Method

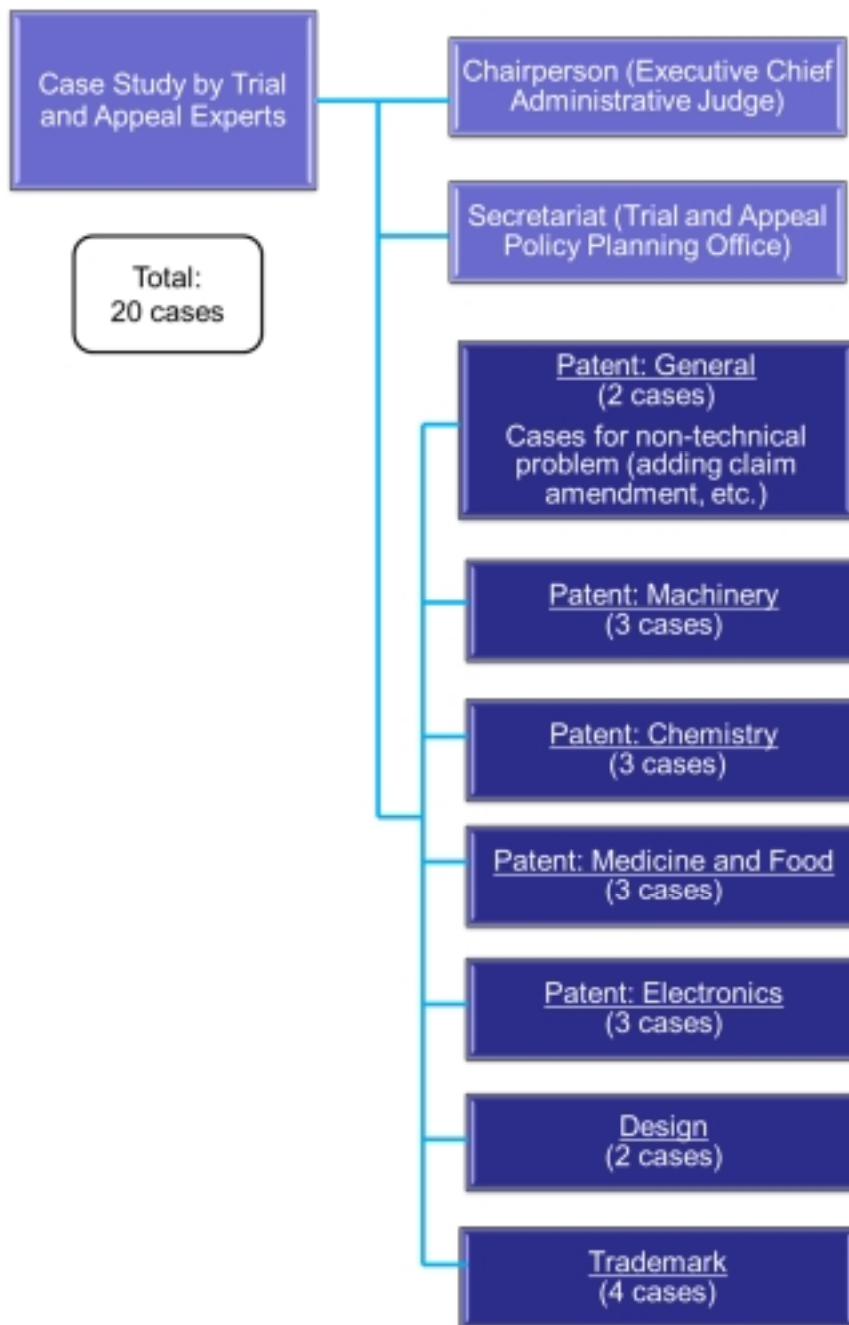
The study of each case is conducted in each field separately. The members arranged the discussion points in advance, and made discussion on judgement, logical composition or background to the conclusion, etc. of trial/appeal decisions and court decisions.

Each field dealt with 2 to 5 cases, and totally 20 cases are studied.



Trial Court





Plenary Meeting

## Case 1: Patent (General 1)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2012-26122 (Patent Application No. 2007-330214)
Court Docket Number	2014 (Gyo-ke) 10057
Title of the Invention	Deposit terminal, Control method of deposit terminal and Program of deposit terminal
Major Issues	Amendment to add claim, Restriction in a limited way of claims

#### 1. Outline of the case

In this case, the amendment made upon filing an appeal against the examiner's decision of refusal was dismissed, since it did not aim at any of the matters listed in Article 17bis(5).

The plaintiff claimed at the court that [1] the judgment dismissing the amendment (the amendment including so called amendment to add claims) on the grounds that it violated the provisions of Article 17bis(5) was wrong; [2] the judgment that the invention before the amendment could be easily made based on the cited invention was wrong; and [3] there was deficiency in the procedures.

With regard to [1], the court pointed out the deficiency in the appeal decision, because it was inappropriate not to specify therein the judgment of which requirement in Article 17bis(5) was not applicable to the amendment. However, the court maintained the appeal decision in conclusion. Moreover, the court dismissed the claims [2] and [3] made by the plaintiff.

#### 2. Major issues discussed (Amendment to add claims)

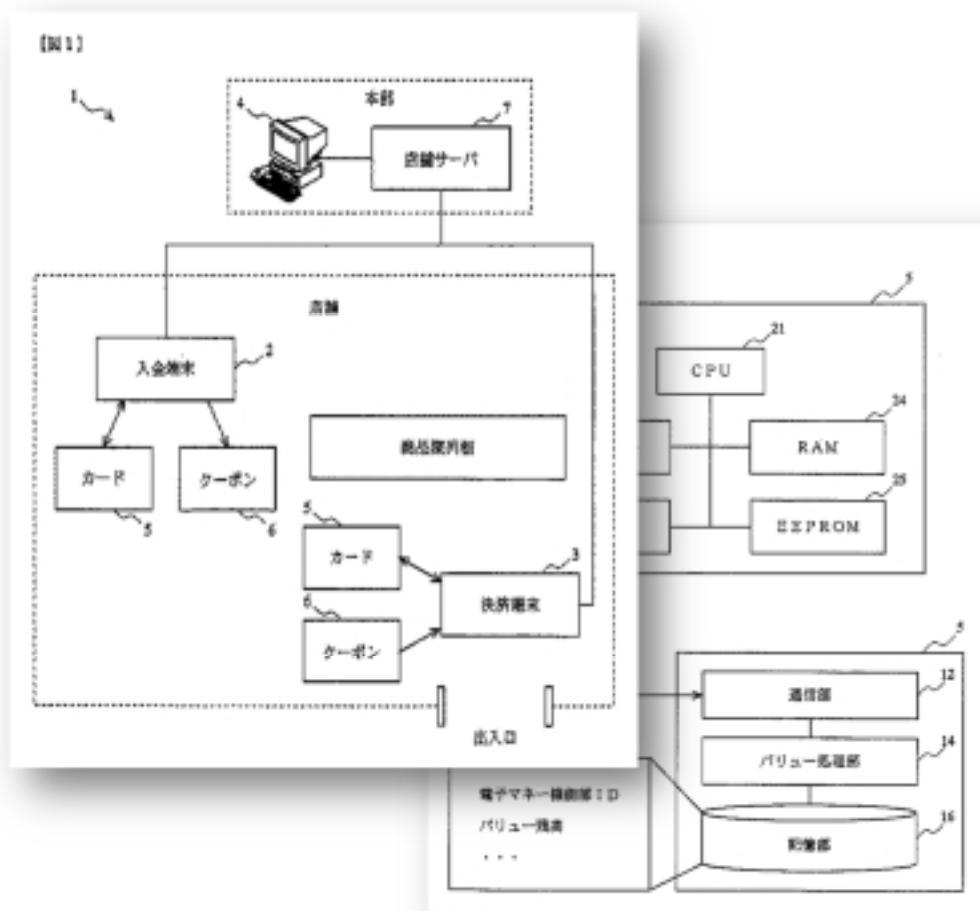
The court decisions made in the past have held that no amendment to add claims falls under, in principle, any of Article 17bis(5)(i)~(iv). However, it is allowed to make an amendment exceptionally in cases where the claims before and after the amendment have a correlation equivalent to a one-on-one relationship.

Furthermore, the court decisions made in the past used to cite, as specific examples of acceptable amendments to add claims, <1> the case where one claim described in the multiple dependent form is made into independent form and <2> the case where one claim in which the constituent components are described alternatively is divided into a

plurality of claims (that is, formal amendment to add claims).

On the other hand, the court decision held that there is no specific restriction on “amendment to add claims.” This court decision presented the requirements that 1) “the amendment constitutes the restriction of claims; 2) it restricts the matters in the claims before the amendment which are necessary for identifying the invention; and 3) the fields of industrial application of and the problems to be solved by the invention in the claims before the amendment and the invention in the claims after the amendment must be the same, and the court held common belief that the amendment is permitted if it satisfies these requirements. Therefore, the court decision is understood to be different from the past court decisions.

Therefore, based only thereon, it is unknown whether or not the method of making a judgment on “amendment to add claims” used in this court judgement sets a standard. We would like to pay attention to future trends of court judgements.



## Case 2: Patent (General 2)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2011-22685 (Patent Application No. 2006-000689)
Court Docket Number	2013 (Gyo-Ke) 10131
Title of the Invention	Phishing fraud prevention system and Program thereof
Major Issues	Dismissal of amendment, Reasons for refusal different from those for the examiner's decision, An opportunity to submit a written opinion

#### 1. Outline of the case

Although the plaintiff made an amendment upon filing a request for appeal against the examiner's decision of refusal, a decision to dismiss the amendment was made in the appeal citing reference documents which had not been cited until the decision of refusal was made, and an appeal decision that the request is groundless was made. The plaintiff filed an appeal against these decisions, claiming that there was a violation of the procedures, because no opportunity to make an amendment was given by issuing a notice of reasons for refusal before the amendment was dismissed. With regard to this point, the court decision of the case held that a notice of reasons for refusal should be issued in order to give opportunities for submitting a written opinion and for making amendments, "in case that any reason for refusal totally different from the reasons for the examiner's decision is found." However, the court decision maintained the appeal decision in conclusion on the grounds that there was no violation therein from the aspect of procedural guarantee in cases where the addition of the Cited Document is only the addition of well-known arts or technical common sense.

#### 2. Major issues discussed

##### (1) Examination of the past court cases

Most of the past court cases held that it is not illegal dismissing an amendment without giving any opportunity for submitting a written opinion as in the case. Some of those court cases are based only on the provisions of the Patent Act or the specific history of procedure. There were opinions in favor of these court cases in consideration of the text of the Patent Act and the object of the revision of the Patent Act in 1993. On the other hand, there were other opinions in opposition to examination practices in the

above court cases due to the difficulty for the applicants to predict a possibility that another document may be cited or the change in the legislative fact of the revision in 1993. Some members commented that the system to remand the case to examination should be utilized.

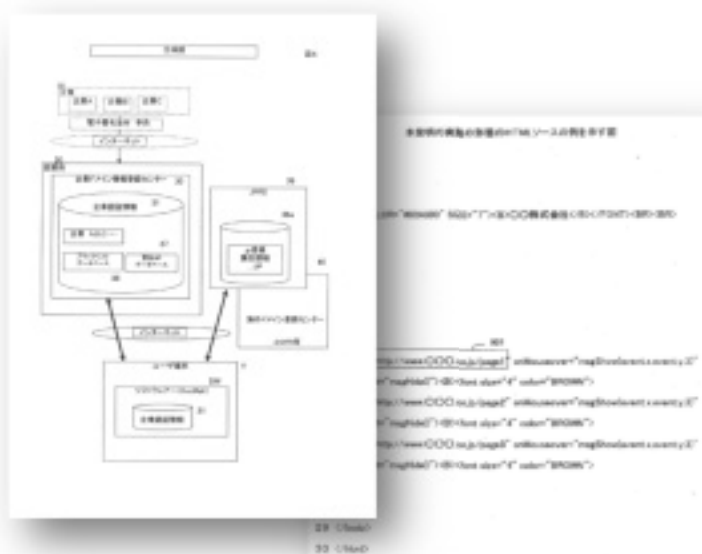
## (2) Reasonableness of the court decision

The majority of members commented that, although the court decision of the case is different from the past court cases in that it highlighted a view of the court as common belief, its legal ground is unknown.

There were other opinions in opposition to the court decision of the case that an idea of giving further opportunities for making amendments without dismissing the amendment violates Article 53 of the Patent Act. On the other hand, other members commented in favor of the court decision of the case that consideration of “the object” may be permitted without any express provisions and that the court decision restricted the discretion of the Patent Office over dismissal of amendments.

## (3) Significance of “the reasons for refusal different from those for the examiner’s decision”

Followings are the points that the court case used to judge that “the reasons for refusal are not different from those for the examiner’s decision”; the main cited documents are the same; substantially new cited documents (Cited Inventions) are not used; the addition of cited documents is only the addition of technical common sense or well-known arts; the gist of the judgment has not been changed; and the procedures for the examination and the appeal are not burdensome for the applicant.



## Case 3: Patent (Machinery 1)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2012-23592 (Patent Application No. 2007-512378)
Court Docket Number	2013 (Gyo-ke) 10319
Title of the Invention	Elevator apparatus
Major Issues	Inventive step (Well-known problems, Well-known arts, Motivation for applying secondary prior art to primary prior art)

#### 1. Outline of the case

This case deals with an invention relating to a signal transmitting method for an elevator apparatus. The plaintiff claimed that the judgment was wrong with respect to the finding of well-known problems and well-known arts based on Evidences A-2 and A-3 (well-known examples), the application of well-known arts (obstructive factors) and the effect of the Amended Invention. However, the court decision denied inventive step by judging that the Amended Invention could be easily made based on the Cited Invention, the well-known problems and the well-known arts.

#### 2. Major issues discussed

##### (1) Finding of the well-known problems and well-known arts

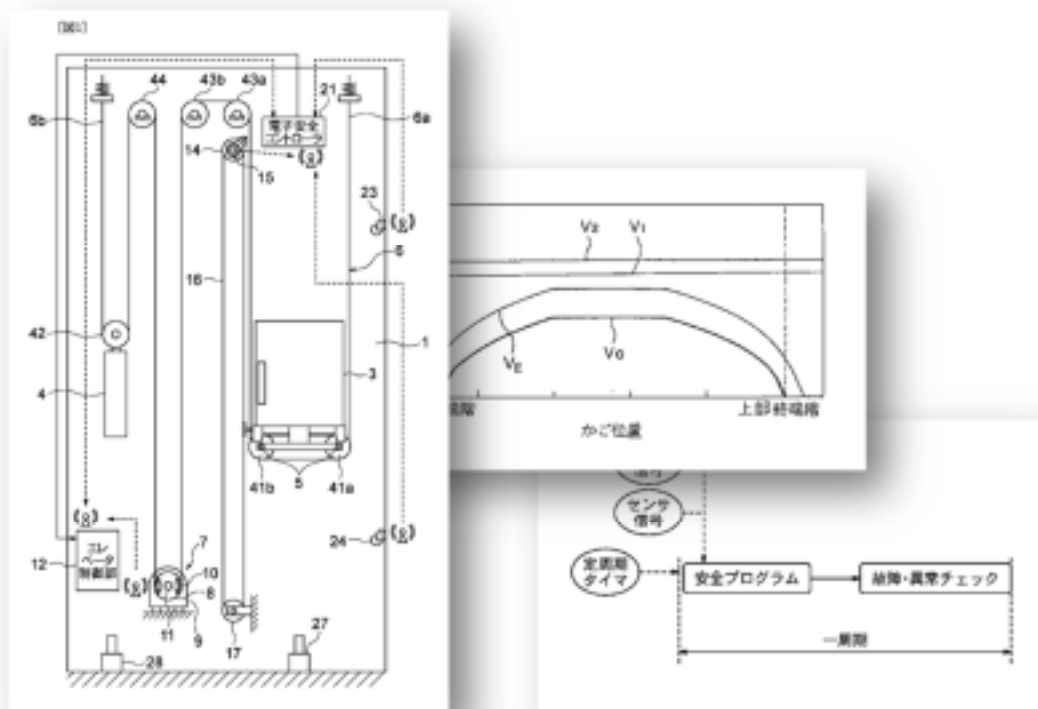
A number of members pointed out that detailed explanations should have been given in the appeal decision in acknowledging the well-known problems and well-known Art 1 which seem to have modified the arts in the evidences A-2 and A-3 to generic concepts. When we look only at the case, there is a situation where the change of signal transmission from wired system to radio system is considered to be well-known regardless of field. However, the defendant (the Japan Patent Office) seemed to claim, at the suit against the appeal decision, the reasonableness of the appeal decision by additionally presenting Evidence B which indicated that signal transmission between baskets and devices other than those in the machine room is carried out by the radio system, and the court decision seems to have been made based on this Evidence B. Some members commented that it was preferable for the collegial body to exemplify the Evidence B in advance at the stage of making the appeal decision.

The majority of members pointed out that it should be understood that well-known

arts cannot be found based on a simple judgement such as the number of example documents, and finding of well-known arts needs detailed explanations based on careful examining of the content in the example documents and the technical background.

(2) Motivation for applying well-known arts to primary prior art

In order to apply well-known arts to a Cited Invention, motivation is required. The court decision only instructed that “a person skilled in the art naturally acknowledges that the above well-known problems exist also in the Cited Invention” and acknowledged the well-known problems corresponding to the well-known arts which are not described in the cited documents, as the motivation. However, some members commented that detailed explanations were needed on whether or not the above well-known problems exist in the Cited Invention. On the other hand, other members commented that there is no special need to add further reasons if the configuration of the Cited Invention can be understood that it includes the technical content allowing the existence of the well-known problems upon filing the patent application, and that it is not required to describe or suggest the well-known problems in the cited documents which are publications before the patent application, and it is enough to prove that the problems are well-known by other documents.



## Case 4: Patent (Machinery 2)

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2011-800218 (Patent No. 4700052)
Court Docket Number	2012 (Gyo-ke) 10340
Title of the Invention	Inspection machine and process
Major Issues	Inventive step (Specifying of the gist, Technical significance, Motivation for applying secondary prior art to primary prior art)

### 1. Outline of the case

The case deals with a trial for invalidation of the patent relating to an inspection machine for sheet printed materials such as securities and to an inspection process.

The trial decision acknowledged the different features 1 to 3 between the invention of “the inspection machine” and the invention described in Evidence A-1 and the different features 4 to 6 between the invention of “the inspection process” and the invention described in Evidence A-3, and held that the request was invalid, since both inventions had inventive step. On the other hand, the court decision revoked the trial decision for all the claims on the grounds that the judgment that the different features 1 and 4 could be easily arrived was wrong (the court decision also pointed out that the finding of the different feature 3 was wrong).

### 2. Major issues discussed

#### (1) Finding of the gist

The trial decision held that three configurations of the Invention 1 in the different feature 1 are combined organically to have technical significance. However, the court decision held that they are only a collection of well-known arts.

Some members commented that the trial decision was reasonable. However, the majority of members commented that the judgment of the court decision was reasonable on the grounds, for example, that the configurations cannot be considered to be combined organically, since the working-effect is not fully disclosed in the descriptions in a specific manner, and that inventive step cannot be recognized from the state of the art of the field regardless of the degree of disclosure.

On the other hand, many members commented about the method of making

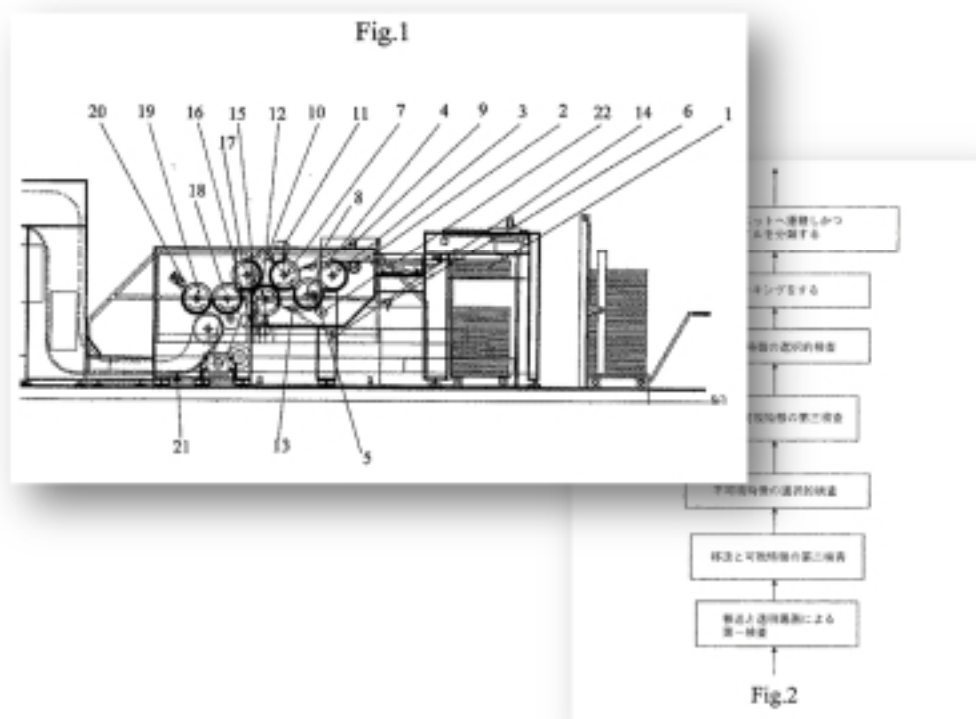


judgment that the trial decision actively acknowledged the technical significance of combining each technical element relating to the different feature 1 and examined the motivation for applying the secondary reference to the primary reference based on the said technical significance, and that this detailed method of making judgment should be highly valued. Several members commented that the conclusion of the court decision was reasonable but no sufficient examinations on individual combinations of the technical elements were made and the description was somewhat rough, giving an impression that the conclusion came first.

Some members commented that the court decision seems to be a bit different from the trend of past court decisions which places emphasis on the motivation for applying secondary prior art to primary prior art and it may set a new trend.

## (2) Motivation for applying secondary prior art to primary prior art

The majority of members commented that the court decision which acknowledged the problem not described directly in A-2 Document and held based on this problem as a motivation that the invention described in Evidence A-2 is applicable to the invention described in Evidence A-1 was reasonable in conclusion. However, some commented that more detailed explanations are expected, since the gist of argument is not easy to understand.



## Case 5: Patent (Machinery 3)

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2011-800136 (Patent No. 3229297)
Court Docket Number	2012 (Gyo-ke) 10129
Title of the Invention	Movable body operation tendency analysis method, Operation control system, Component of same, and Recording medium
Major Issues	Inventive step (Finding of the gist, Well-known arts, Differences in the problems)

### 1. Outline of the case

Case 5 concerns an invention directed to a management system of operational data indicating behaviors of mobile objects such as vehicles and trains. The collegial body, in the trial decision, interpreted the corrected invention at issue in light of the its purpose described in the Description and then denied the request, because the corrected invention at issue could not be easily made by a person skilled in the art on the grounds that the different features are not found in the publications. At appellate stage, the court vacated the trial decision, holding that the corrected invention at issue could be easily made based on the inventions and the well-known art described in the publications with due consideration of the functional aspect of the device.

### 2. Major issues discussed

#### (1) Interpretation of “particular behavior” in the corrected invention

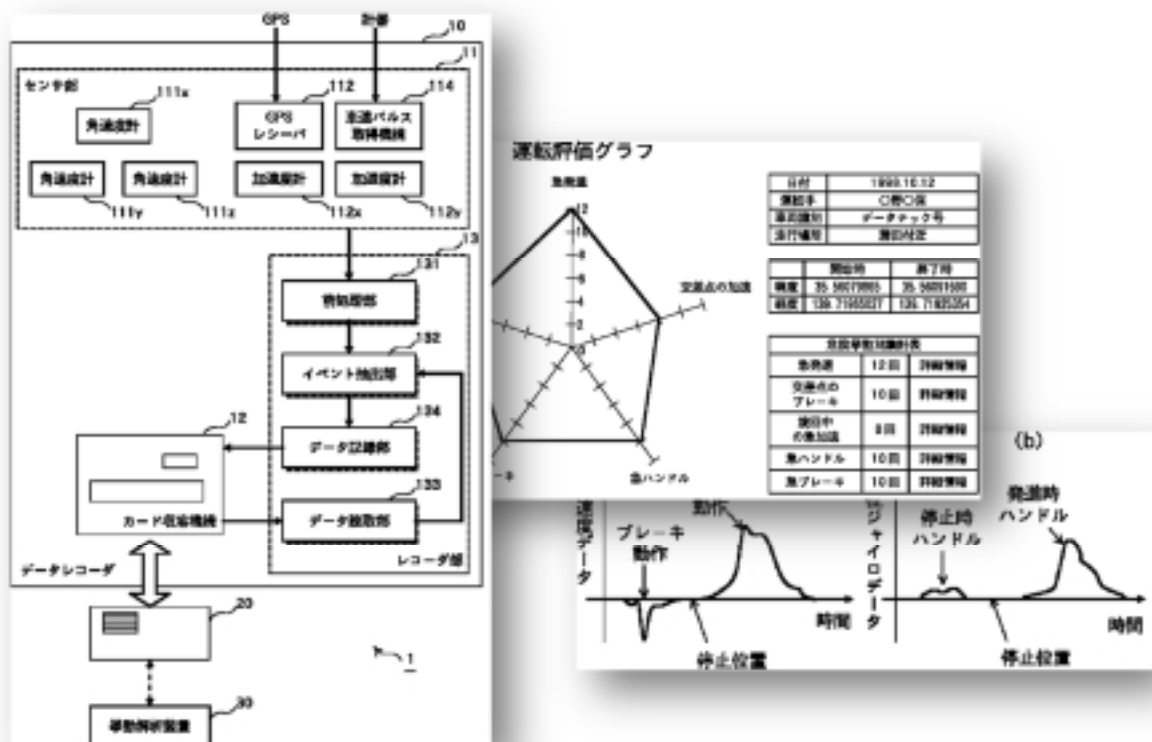
The collegial body, in the trial decision, took some particular description in the Description into consideration and then interpreted “particular behavior” in the corrected invention as “behavior of vehicles along with dangerous operations that may result in an accident.” However, a majority of study members commented that the gist of the invention should be interpreted by finding the claims as they are without consideration of the Description, because the corrected invention is clearly understood by finding the claims as they are, and the above interpretation is, in the first place, not found explicitly in the specifications.

#### (2) Well-known art whose problems to be solved and purposes do not correspond with those of the corrected invention but whose function corresponds with that of the

corrected invention

The collegial body, in the trial decision, found that Evidence A-4 is directed to data collection for maintenance of vehicles and No. 1 to 5 of Evidence A-6 is directed to data recording for ex-post analyses of traffic accidents, and therefore it judged any of the above evidence is not directed to data collection on behaviors before and after the emergence of particular behaviors (behaviors of vehicles along with dangerous operations that may result in an accident). At appellate stage, the court gave due consideration to the function of the device and held that the configuration to collect data on behaviors before and after the emergence of the particular behavior of the invention at issue is not substantially different from the configuration to collect data on behaviors before and after the occurrence of “traffic accidents” in the well-known art described in Evidence A-5 and No. 1 to 5 of Evidence A-6.

When examining the reasonableness of the holdings, a majority of members commented that it was reasonable for the court to decide that the configuration of the invention at issue and that of the well-known art are not substantially different if due consideration of the function of the device was given, given that the claims can include “data collection at the time of accident” because, in the claims of the corrected invention, any configuration corresponding to the problem to be solved of “data collection for prevention of accidents” is not found.



## Case 6: Patent (Chemistry 1)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2012-26151 (Patent Application No. 2008-244190)
Court Docket Number	2014 (Gyo-ke) 10082
Title of the Invention	Micro-pigment mix
Major Issues	Dismissal of amendment, Inventive step (Documents newly cited at the time of making the appeal decision), Handling of experiment results

#### 1. Outline of the case

The case relates to an invention of micro-pigment mix. The plaintiff claimed at the court that 1) the judgment of dismissing the amendment was wrong and 2) the judgment that the invention before the amendment could be easily arrived was wrong. With regard to 2), there are some parts which are not described as different features in the appeal decision. However, the court decision judged that it was not necessary to judge them as substantially-different features. Therefore, the court decision dismissed the claim by the plaintiff. Moreover, with regard to 1), the court decision judged that the appeal decision was correct.

#### 2. Major issues discussed

##### (1) Judgment of dismissing the amendment

Since this amendment includes the matters to delete the constituent element of the invention that “covered with metal soap,” all the members agreed that it is impossible to consider the amendment as the restriction of Claims in the light of the text and technical common sense and that the judgment of dismissing the amendment was reasonable.

##### (2) Inventive step (documents newly cited in the appeal decision)

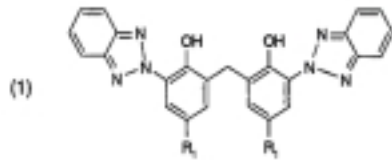
The members basically agreed that the appeal decision was reasonable on the grounds that the documents newly cited in the appeal decision was notified in the examiner’s decision of refusal and there was an opportunity for making amendments upon filing the request for appeal against the examiner's decision of refusal.

Some members commented that there would have been no problem if the court

decision was made by supporting the content of Publication 2 as it is. However, they commented that the search was outsourced at the stage of the trial and the court decision was made based on a fact different from the matter derived from the description in Publication 2 (the court decision describes that “according to the results of the outsourced search and Evidence B-2, it is recognized that the invention exhibits hydrophobic property. In this sense, Publication 2 (publication of unexamined patent application) describes in a way that it has both hydrophilic property and hydrophobic property.) Therefore, some members commented that the court decision was problematic in that it caught the plaintiff by surprise.

(3) Handling of experiment results

Basically, the Cited Invention is acknowledged based on the matters described in the Cited Publications, but not all the matters described in the gazette are correct. Therefore, some members commented that, even if experiment results different from those found in the gazettes are submitted, it is reasonable to adopt them so long as they are correct.



成分																			
酸化剤																			
カリウム過マンガン酸塩 2%~8%																			
セチルアルコール/ジセチルオキシド/セチルステアレート 2%~8%																			
アトリエルステアリン酸エステル 1%~2%																			
セチルアルコール/ペントリモノウムメトサルフェート 1%~3%																			
カチオン系界面活性剤 1%~8%																		X	
ジメチルソルビトール/アクリルアミド/グリセリン/ポリグリセリン 1%~4%																			X
ステアレス/ステアレス-21 2%~8%																			X
ポリグリセリンメチルグルコシドステアレート 1%~4%																			X
還元剤/チトロン酸/チトロン酸 1%~30%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
界面活性剤/アルコール/エタノール/ステアレート 1%~8%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
増粘剤(水溶性増粘剤) 0.2%~1.2%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
染料類 0.2%~1%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
キレート剤(EDTA系) 0%~0.2%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
緩衝液(0.05%~0.2%)		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
阻イオン剤 0.1~0.5%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
香料 0.1%~0.4%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
試験管内に懸濁されるようなUV吸収剤 1%~30%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
試験管内に分散されるようなUV吸収剤 0%~30%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X

成分																			
キレート剤(EDTA系) 0%~0.2%																			
緩衝液(0.05%~0.2%)		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
阻イオン剤 100%になるまでの量		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
試験管内に懸濁されるようなUV吸収剤 1%~30%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
試験管内に分散されるようなUV吸収剤 0%~30%		X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X

## Case 7: Patent (Chemistry 2)

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2011-800130 (Patent No. 4725533)
Court Docket Number	2012 (Gyo-ke) 10111
Title of the Invention	Scintillator panel
Major Issues	Inventive step (Selection of materials, Consideration of effect)

### 1. Outline of the case

The case relates to an invention in the field of scintillator panels to form radiological images. The point of issue was whether or not a different feature between the Invention and the Cited Invention, “forming an acicular crystal film of CsI:Tl on a reflection layer consisting of white pigments of titanium oxide and binder resins by direct deposition,” could be easily implemented by a person skilled in the art.

Evidence A-7 describes an art to “form a scintillator having the columnar crystal structure in which Tl-doped CsI developed by the deposition method on an Al film as a reflection film.” However, the trial decision judged that the matter relating to the different feature could not be easily implemented by a person skilled in the art based on the description of Evidence A-7 on the grounds that it was a common matter for a person skilled in the art whether or not the success of the development of the film depends on the material and structure of a surface on which it is deposited.

On the other hand, the court decision held that depositing phosphor layers on reflection layers is well known, and that Evidences A-7 and A-38 do not describe “specific conditions” for depositing columnar crystals CsI:Tl on reflection layers so that depositing CsI:Tl having the columnar crystal structure on the Al film or a resin substrate was not particularly difficult. Therefore, the court decision judged that the different feature above does not require much ingenuity.

### 2. Major issues discussed (Inventive step)

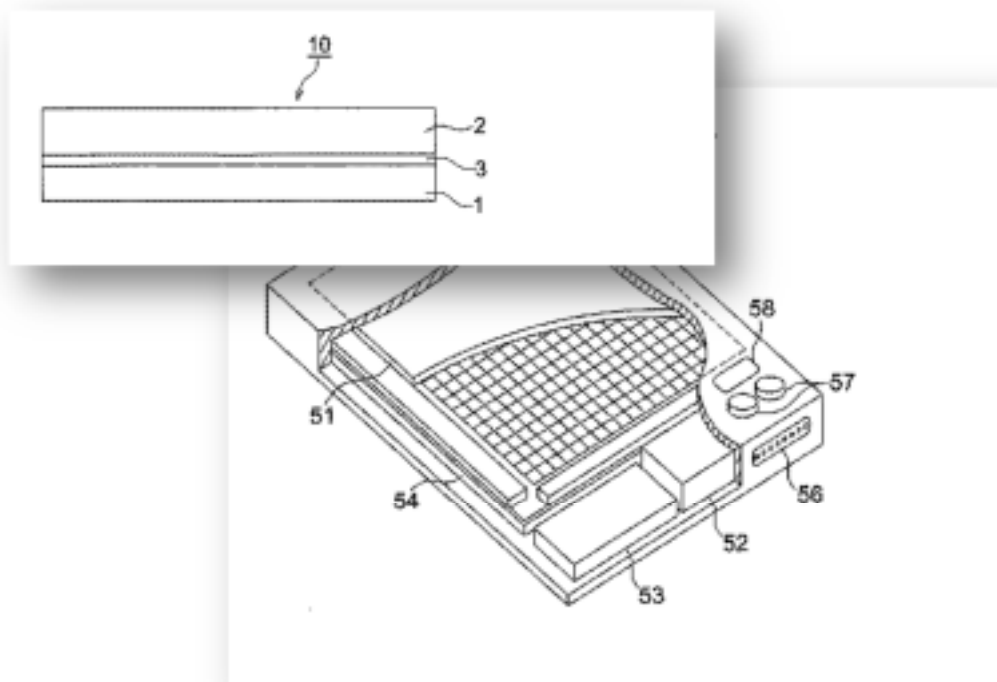
The majority of members commented that the judgment of the trial decision was reasonable from the point of view of persons skilled in the art. Evidence A-7 does not disclose that the diffusion reflection layer in the Cited Invention is “formed with white pigments of titanium oxide and binder resins.” Therefore, some members commented that it is inappropriate to overturn the conclusion of the trial decision citing a

well-known document which only describes that “there are various types of deposition methods and an appropriate method may be used depending on material and structure of the deposited material.”

On the other hand, the majority of members commented that Evidences A-8 A-38 and A-39 disclose the method of obtaining phosphor layers by depositing them on reflection layers composed of resins containing the similar titanium oxide as in the case of the Invention so that the conclusion of the court decision is unavoidable.

In general terms, some members expressed their concerns about the technique of making a judgment that, in the field of inventions relating to materials, a new effect obtained as a result of selecting different materials has new technical significance so that it is understood that the structure has been unchanged without examining any effect at the time of judging inventive step.

Furthermore, the members reached a consensus that the technique of judging that any deposition is a matter of design on the grounds that “specific conditions are not described” in well-known documents cannot convince the applicants (patentees).



## Case 8: Patent (Chemistry 3)

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2010-800114 (Patent No. 4331782)
Court Docket Number	2011 (Gyo-Ke) 10118
Title of the Invention	Process for forming resin surface, Process for producing article having mixture of recessed parts different in size in surface, This article, Process for producing glove, and Glove
Major Issues	Inventive step (Consideration of effects of the invention, Recognition of cited invention, Interpretation of drawings)

### 1. Outline of the case

The case deals with an invention relating to the process for producing articles having mixture of recessed parts different in size in surface. The plaintiff (patentee) claimed that 1) the invention has a particularly distinguished effect in terms of abrasion resistance and grip performance by limiting the values of a quantity of air bubbles (5~30 vol%) and an average diameter of the air bubbles (less than 50  $\mu$  m). The plaintiff (patentee) also claimed that the different features were wrongly recognized because 2) the Cited Document 1 does not describe at all the process for producing foam materials, and the quantity and the diameter of the air bubbles; and 3) the size of opening of the air bubble is larger than 200  $\mu$  m in Drawing 3 in the Cited Document 1.

The court decision maintained the trial decision which judged the patent is invalid. The court decision did not adopt the claims concerning the different features (2) and 3)), and held the judgment of the trial decision on the different features (1)).

### 2. Major issues discussed (Inventive step)

#### (1) Consideration of effects of the invention

Some members commented that the trial decision was reasonable in the following reasons: 1) there is any correlation between the quantity of the air bubbles and the diameter thereof, 2) two independent parameters are not prescribed if the diameter of the air bubbles is set when the quantity of air bubbles is decided, and 3) it is easy to raise the abrasion resistance itself by maintaining the quantity of the air bubbles to be 5~30 vol% because the Cited Document 2 discloses that the preferred air content is 15~30% and that higher abrasion resistance can be obtained by lower air content. Other



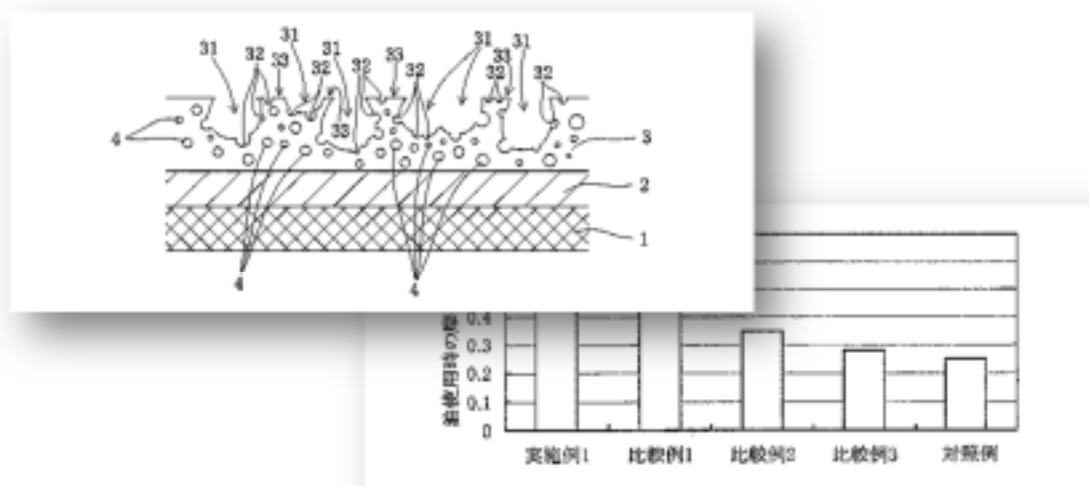
members commented that it is necessary that at least the quantity of the air bubbles in Table 3 and the average diameter thereof in Table 4 fall within the scope of claims in order to take the effects into consideration although the quantity of the air bubbles and the average diameter thereof are not required to be constant in all examples.

(2) Lack of description about the process for producing foam materials, and the quantity and the diameter of the air bubbles in the Cited Document 1

The majority of members commented that the recognition in the court decision that the structures are the same even if foam materials are used, since the methods of formation in the Cited Document 1 and Claim 1 are not different was unreasonable. However, most of members commented that the conclusion of the court decision itself that the double structure of concave parts having different sizes are supposed to be formed in cases where foam materials are used in addition to corpuscles was reasonable.

(3) Description about Drawing 3 in the Cited Document 1

The majority of members commented that the court decision which did not adopt the description of Drawing 3 was reasonable, since the content of disclosure thereof is unclear. They argued that it is likely that what appears to be a closed air bubbles shown in Drawing 3 do not show air bubbles but corpuscles (salt) which could not be incorporated into the layer or dissolved.



## Case 9: Patent (Medicine and Food 1)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2011-14812 (Patent Application No. 2004-129590)
Court Docket Number	2014 (Gyo-ke) 10059
Title of the Invention	A package containing a dry liposome pharmaceutical composition containing iodophor holes and A method for applying said composition
Major Issues	Inventive step (Finding of different features, Obvious problems)

#### 1. Outline of the case

The case deals with an invention relating to a package with the preservation stability including a liposome composition containing povidone-iodine, and the Claims thereof describe that “in the package made of plastics materials, paper or cardboards.” The plaintiff claimed that the appeal decision was wrong in that 1) it did not acknowledge “made of paper or cardboards” as a different feature, but only acknowledged the part “made of plastics materials” as a different feature with regard to the different feature (A); 2) it judged that the different feature (A) could be easily achieved; and 3) it held that the existence or non-existence of the particular of including (preserving) in “the package equipped with preservation stability” (Different Feature (B)) was not recognized as a substantially-different feature. Although the court decision admitted that the judgment of 3) was wrong, it dismissed the request for appeal, holding that the said judgment does not affect the conclusion.

#### 2. Major issues discussed

(1) Finding of the different feature (“Made of paper or cardboards” was not acknowledged as a different feature)

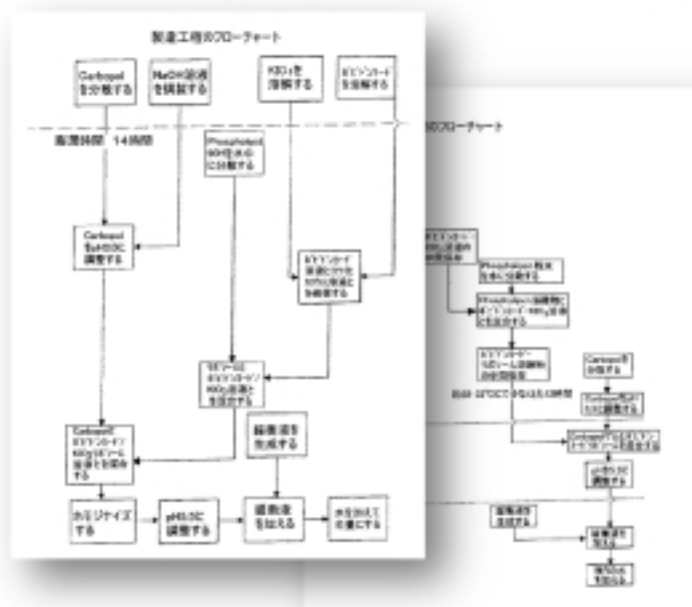
The appeal decision acknowledged, compared and judged the different feature only for the package “made of plastic materials” among three types of materials with regard to materials used for the package of the Invention. As the court decision also supported the judgment, it is reasonable. However, considering that the appeal decision acknowledged three types of materials altogether in the Invention, it would have been more appropriate if the Invention and the finding of different features correspond.

(2) Judgment on whether or not the different feature (A) could be easily achieved

The court decision acknowledged the examination of putting pharmaceutical preparations in a container which allows them to be preserved stably for a long period of time as an “obvious problem” which is not described in Cited Documents. The finding of such an “obvious problem” itself has been adopted in past court cases and complies with the Examination Guidelines of the Japan Patent Office. However, it is important to note that the court decision acknowledged, different from the appeal decision, some of technical common knowledge based on evidences before making the said acknowledgment. On the other hand, the court decision did not particularly acknowledge how “povidone-iodine included in freeze-dried liposome solid” is similar to “powder” in a specific manner. More easy-to-understand explanations on this point would have been needed, since it is the basis of applying the secondary Cited Document to the principal Cited Document.

(3) Judgment on the different feature (B)

The Invention does not identify whether “what is featured by the preservation stability” is the whole package including the composition or the composition itself included in the package, and this may be a reason for different interpretation of the Invention between the appeal decision and the court decision. Some members commented that, although the court decision that the judgment of the appeal decision is correct in conclusion was reasonable, the judgment of the court decision can gain an understanding more easily compared to the judgment of the appeal decision.



## Case 10: Patent (Medicine and Food 2)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2010-9107 (Patent Application No. 2007-538605)
Court Docket Number	2012 (Gyo-ke) 10421
Title of the Invention	A method for fortifying food stuff with phytonutrients and Food products obtained thereby
Major Issues	Inventive step (Finding cited invention, Obviousness of problems)

#### 1. Outline of the case

The case deals with an invention relating to a method of increasing nutritional values of food by means of the effective amount of health benefit of dietary phytonutrients of tomatoes. The appeal decision acknowledged that the Publication 1 describes an invention relating to “a method of adding lycopene extracted from tomatoes as natural carotenoid and obtained as 6% oily dispersion liquid under the product name “Lyc-O-Mato®” to food as food additives with the aim of preventing health risks.” It held that the appeal against the examiner's decision of refusal was rejected, since the two different features between the said invention and the Invention could be easily achieved by a person skilled in the art or they are not substantial. In response to the appeal decision, the plaintiff filed an appeal against the appeal decision, claiming that the finding cited invention was wrong, the judgment that the two different features could be easily achieved was wrong, and the effect of the Invention was falsely recognized. However, the court decision dismissed the request filed by the plaintiff based on the judgment that no error was found in the conclusion of the appeal decision.

#### 2. Major issues discussed

##### (1) Finding cited invention

Since the appeal decision and the court decision acknowledged the Cited Invention based on the description in the column of Prior Art in the Publication 1, there is no direct problem even if no Example is disclosed. In addition, some members expressed positive comments that it is natural to interpret that Lyc-O-Mato® is used when lycopene is added to food, as it is,. Further, the plaintiff claimed that the decision was wrong in that it equated or confused lycopene with tomato oleoresin taking advantage of

the description in the Publication 1 of Lyc-O-Mato® as an example of lycopene. However, the appeal decision should be interpreted to have acknowledged the invention in which Lyc-O-Mato®, tomato oleoresin, is added to food as a preparation containing lycopene.

(2) Obviousness of problems

The members agreed that the court decision was reasonable in that it viewed the examination of obtaining both nutritional functions and flavor as an obvious problem in cases where dietary nutrients with particular flavor such as ingredients of tomatoes are added to food in the technical field of food. Some members commented that the problem of obtaining both nutritional functions and flavor could be judged to be well known in the discussion over inventive step, because the application does not relate to an invention identifying the specific amount of addition of Lyc-O-Mato® (tomato oleoresin), which may ruin flavor, in order to optimize the balance between nutritional functions and flavor, but only describes the amount to be added conceptually.

成分	含有量 (%)
Simulsoil 1294 (水素化ヒマシ油 PEG-60)	10.42
オレオレジン 2% (BN005030)	5.80
酢酸トコフェロール	1.93
糖エステル PS750	1.93
水	77.22
グリセロール	2.70
0.1% リコピンのマイクロエマルション	5.200
パイナップル風味 23078	0.110
オレンジ風味 3355040	0.055
水	219.375
合計	266

## Case 11: Patent (Medicine and Food 3)

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2011-800233 (Patent No. 4767719)
Court Docket Number	2012 (Gyo-ke) 10299
Title of the Invention	Method of producing liquid seasonings
Major Issues	Correction requirement (Specifying of the problems of the inventions), Enablement requirement, Support requirement

### 1. Outline of the case

The case deals with an invention relating to a method of producing liquid seasonings. The plaintiff claimed that the finding of the correction requirement, enablement requirement and support requirement were wrongly judged. In this case, the court decision partially revoked the trial decision because of the following reasons. The Inventions 1, 5 and 9 are described in the detailed description of the invention in the specifications. However, regarding the Inventions 1, 5 and 9, it cannot be acknowledged that a person skilled in the art could solve the problems based on the detailed description of the invention or solve the problems by means of referring to the technical common sense upon filing the application.

### 2. Major issues discussed

#### (1) Finding of the problems of the Inventions in judging the correction requirement (new matter)

It is obvious that providing seasonings which immediately exercises the blood-pressure-lowering effect is not the problem to be solved by the Inventions. Also, the blood-pressure-lowering effect of ACE inhibitors, etc. is well known. Therefore, the members reached a consensus that, in conclusion, there is no problem in the finding of the problems of the Inventions in the court decision.

#### (2) Enablement requirement

Whether or not there is medical usage (working-effect) can be questioned in judging the enablement requirement in the case of any invention for medical usage, but the Inventions are not for medical usage. Therefore, it is reasonable to make a judgment based only on whether or not an invention of process can be used or an invention of

product can be used or manufactured. However, some members commented that there remained a question, because the trial decision held that seasonings could be used, though it was not clear whether they solved the problem of “improving the change of flavor.”

### (3) Support requirement

Some members commented that the Inventions should follow the judgment criteria of the Flibanserin Case (Intellectual Property High Court 2009 (Gyo-ke) No. 10033), since the Inventions are not the descriptions identified by means of parameters. On the other hand, other members commented that it was reasonable that the court decision was made in line with the criteria of the Case of Changed Method of Producing Films (Intellectual Property High Court 2005 (Gyo-ke) No. 10042), because substances contained in ACE-inhibitory peptides range widely and have different characteristics.

The court decision judged, with regard to the consideration of test results submitted after the filing of the application, first the support requirement based on the description in the specifications that the improvement of change in flavor of liquid seasonings (the solution of the problem) in the case where ACE-inhibitory peptides are used is not described in the specifications, and judged that the test results submitted after the filing of the application are not taken into consideration, since the support requirement was violated. The court decision is in line with court cases in recent years with regard to the consideration of test results after the filing of applications in judging the support requirement.

	加熱処理条件		風味評価結果			
			ホウレン草のお浸し		金目鮎の煮付け	
	加熱温度	加熱時間	血圧降下物 質の風味	風味パ ランス	血圧降下物 質の風味	風味パ ランス
対照品a	なし		D	2	A	4
試験品1	80℃	30分	A	4	A	4
試験品2	〃	60分	A	4	A	4
試験品3	〃	120分	A	3	A	4
試験品4	60℃	30分	B	3	A	4
試験品5	〃	60分	A	4	A	4
試験品6	〃	120分	A	4	A	4
試験品7	40℃	30分	C	2	A	4
試験品8	〃	60分	C	2	A	4
試験品9	〃	120分	C	2	A	4
試験品10	40℃	30分	D	2		
試験品11	〃	60分	C~D	2~3		
試験品12	〃	120分	C	3		
試験品13	60℃	30分	B~C	3		
試験品14	〃	60分	B	3~4		
試験品15	〃	120分	A	4		
試験品16	80℃	30分	A	4		
試験品17	〃	60分	A	4		
試験品18	〃	120分	A	3		

## Case 12: Patent (Electronics 1)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2012-08250 (Patent Application No. 2008-519702)
Court Docket Number	2013 (Gyo-ke) 10210
Title of the Invention	Complete power-management system implemented in single surface-mount package
Major Issues	Inventive step (Well-known documents Obstructive factor), Violation of the procedures, New matters in the original text

#### 1. Outline of the case

The right to obtain a patent was transferred from the original applicant to the plaintiff. The plaintiff received a decision of refusal,. In response, the plaintiff filed a request for appeal against the examiner's decision of refusal and made an amendment to the scope of claims (the Amendment), but the appeal decision held that the request was invalid, dismissing the amendment. The plaintiff, in response to this decision, filed a request for revocation of the appeal decision, claiming that the specifying of the corresponding features between the invention relating to the Amendment (the Amended Invention) and the Cited Invention was wrong, that the different features were overlooked (Ground for revocation 1) and that the Examination Guidelines were violated (Ground for revocation 2), because the administrative judges overlooked a new matter not described the original text included in the Amended Invention due to incorrect translations and failed to notify reasons for refusal so that an opportunity for correcting the reasons for refusal to obtain a patent was lost. The court decision did not accept the claims made by the plaintiff and dismissed the request.

#### 2. Major issues discussed

##### (1) Judgment of the corresponding features using well-known documents

Some members commented that the Cited Document is sufficient without using the well-known documents, since it is obvious that the cited invention is substantially surface-mounted, although the Cited Document does not use an expression of “surface mounting.” On the other hand, other members commented that the citation of the well-known documents itself is not a particular problem, since “surface mounting” is shown as technical common sense in order to make sure that the Cited Document is



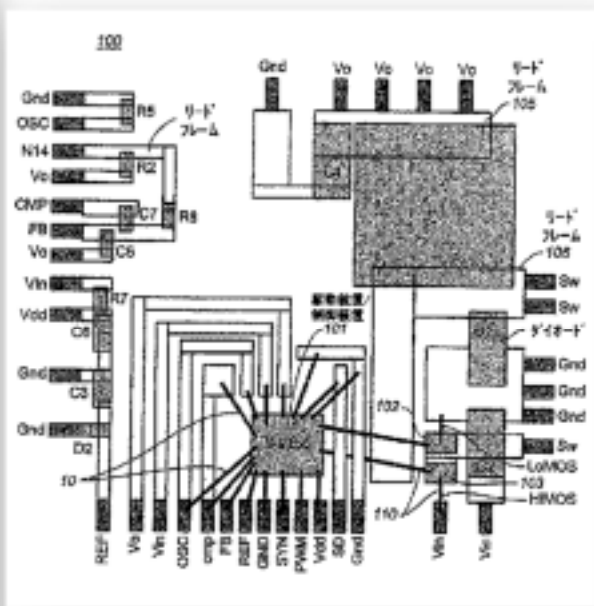
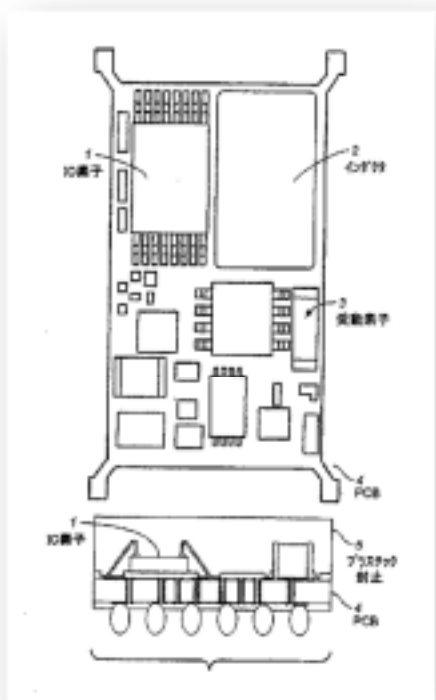
supported, and that it would have been better to use the expression, "technical common sense," in place of "well-know art."

(2) Obstructive factor

Paragraph 0020 in the Cited Document describes that "a condenser, resistance or coil etc. may be used for passive devices of the Invention." Therefore, some members commented that the claim by the plaintiff that there is an obstructive factor in the use of coils as passive devices in the Cited Invention is unreasonable.

(3) Violation of the procedures

The plaintiff claimed an advantageous effect of describing in the written request for appeal "unleaded," and claimed that there was no motivation for adopting the "unleaded" configuration based on the description in the Cited Document in a response letter to the inquiry from the collegial body. Therefore, the majority of members agreed that the claim by the plaintiff that the defendant violated the procedures is unreasonable, although the defendant did not take notice that the description of "unleaded" was erroneous.



## Case 13: Patent (Electronics 2)

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2010-25131 (Patent Application No. 2007-009247)
Court Docket Number	2012 (Gyo-ke) 10386
Title of the Invention	Multimedia messaging method and system
Major Issues	Procedural due process violation, Inventive step (Finding cited invention, Different features between claimed invention and cited invention)

#### 1. Outline of the case

The plaintiff claimed that there was procedural due process violation; the finding of cited invention, corresponding and different features between claimed invention and cited invention was wrong; and the judgment that Different Feature 4 could be easily arrived was wrong. The court dismissed the request filed by the plaintiff, holding that, although the appeal decision wrongly found the cited invention, and different features between claimed invention and cited invention, it does not affect the conclusion of the appeal decision that the claimed invention could be easily arrived.

#### 2. Major issues discussed

##### (1) Procedural due process violation

There is no problem in that the panel found Document 2, which was found as one of the secondary cited documents by the decision of refusal, as one of the well-known arts. Although the decision of refusal made a judgment principally on the invention relating to Claim 1, the appeal decision made a judgment on the invention relating to Claim 3. Some members commented that, since there are some uncommon configurations between Claim 1 and Claim 3, the appeal decision was questionable in that the appeal decision did not reveal its relationship with the decision of refusal.

##### (2) Finding cited invention, different features, and corresponding features

Many members commented that no particular problem was found in finding the cited invention in the appeal decision, because a person skilled in the art can understand, from the description in the specifications of the principal cited document, that the cited invention transfers not only images called “icons” but also “information

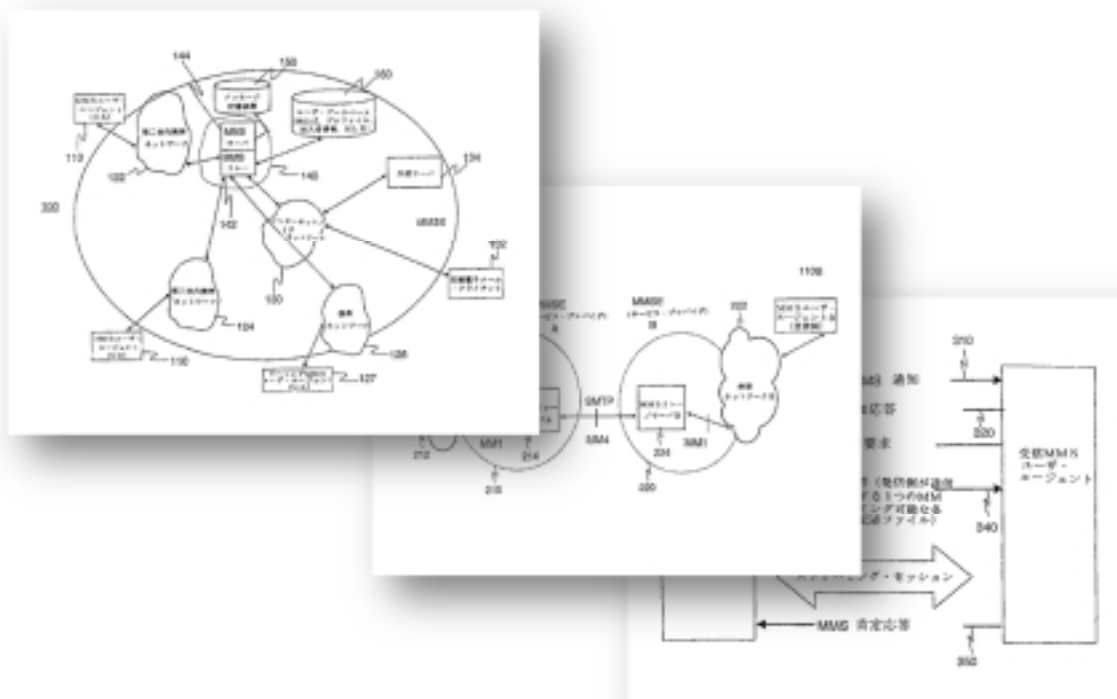
which allows the reception user agent to start a streaming session and search for the streamable media component” other than icons as in the case of the finding the different features in the appeal decision.

Some members commented that the court decision may have judged with caution that “it is unknown whether or not any information is transferred together with icons” from the descriptions in the cited document, and that the transfer of session description files in the main body of mails together with icons could be easily arrived by the well-known arts.

“Technical common sense” is a multivocal term which may include from very basic technical skills to well-known specific configurations. Assumed the latter case, in general, it is appropriate to deal with “information” as a different feature, not to include it in finding the cited document, so as to judge whether it could be easily arrived to apply the technical common sense which discloses the configuration of the different feature to the primary cited document. Therefore, the view shown in the court decision seems to be reasonable.

### (3) Judgment on whether the Different Feature 4 could be easily arrived

The panel judged whether it could be easily arrived to replace an icon itself with a session description file. Some members commented that, in this sense, the court decision was more appropriate, because it judged whether it could be easily arrived to add the session description file to the icon.



## Case 14: Patent (Electronics 3)

(Trial for invalidation)

JPO Docket Number	Appeal No. 2007-800070 (Patent No. 3569522)
Court Docket Number	2008 (Gyo-ke) 10002
Title of the Invention	Displaying device
Major Issues	Inventive step (Finding of the different features, Judgment of the different features)

### 1. Outline of the case

The plaintiff claimed that the finding and the judgment of the different features were wrong. The court decision held the finding of the different features in the trial decision was not wrong in so far as it pointed out a difference that the different feature was not acknowledged based on the means for “entering black signals in full screen,” and acknowledged technical significance that a person skilled in the art who contacted Evidence A No.7 “switches off both light sources for the left eye and the right eye” of the invention described in the principal Cited Document (Evidence A No.6). Therefore, the court decision concluded that the explanation in the trial decision was wrong and that the request was accepted on the grounds that there is no inventive step since there is a sufficient motivation for applying the invention described in Evidence A No.7 to the invention described in the principal Cited Document to replace this configuration with the configuration of “entering black signals in full screen” described in Evidence A No.7 in order to form a configuration relating to the different feature of the Patented Invention.

### 2. Major issues discussed

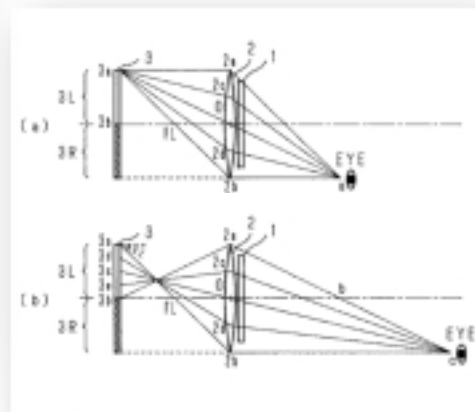
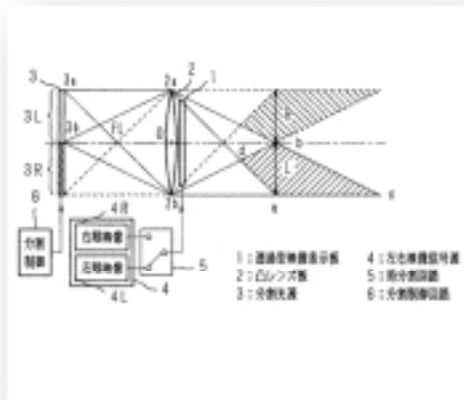
#### (1) Finding of the different features

Many members commented that the finding of the invention described in the principal Cited Document shown in the court decision that “LCD is equipped with the configuration of full-screen black display by switching both linear light sources LL1 and LL2 while displayed images change” was reasonable. Moreover, a number of members commented that the court decision was reasonable in that it interpreted with good intention that the phrase of “such” in the finding of the different features in the trial decision includes the object, “by means of the method of entering black signals in full

screen,” acknowledged “the point that Evidence A No.6 does not describe such a thing (that is, by means of the method of entering black signals in full screen) of having full LCD screen displayed in black” as a different feature, and it judged that the configuration of “by means of the method of entering black signals in full screen” could be easily arrived.

(2) Reasonableness of the judgment of the different features

Some members commented that the relation between “double images can be seen momentarily by the eyes” with “deterioration of images,” “contrast” and “decrease” in Evidence A No.7 is unknown so that it is questionable whether or not “the means for switching off both the light source for the left eye and the light source for the right eye in a short period of time when one image is replaced with another” and “the means for blanking scan to put LCD in the dark (black) state when the above replacement of images” can be considered as “the parallel means which are mutually replaceable.” For the same reasons, some members commented that “blanking scan” is not considered as a technical means for solving the problem that “double images are seen momentarily by the eyes” and that there is no motivation for combining the invention described in the principal Cited Document with the invention described in Evidence A No.7. On the other hand, some members commented that there was sufficient motivation for applying the invention described in Evidence A No.7. to the invention described in the principal Cited Document, if the temporal overlap of images before and after the replacement results in deterioration of image quality in a stereoscopic image displaying device when the left image and the right image are replaced and this is technical common sense and well-known problem, and other members commented that it would have been necessary to present evidences proving that the problem was well known.



## Case 15: Design 1

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2008-880022 (Design Registration No. 1300582)
Court Docket Number	2009 (Gyo-ke) 10208
Article to which the design is applied	Golf ball
Major Issues	Finding of the cited design, Eligibility for citation

### 1. Outline of the case

This case deals with a design relating to a golf ball. The plaintiff claimed that 1) the finding of the cited design and 2) the comparison were wrong in the appeal against the trial decision in response to the trial decision which invalidated the registration based on ground of novelty (Article 3(1)(iii) of the Design Act). However, the court decision judged that the judgment of the trial decision was not wrong.

### 2. Major issues discussed

#### (1) Finding of the cited design

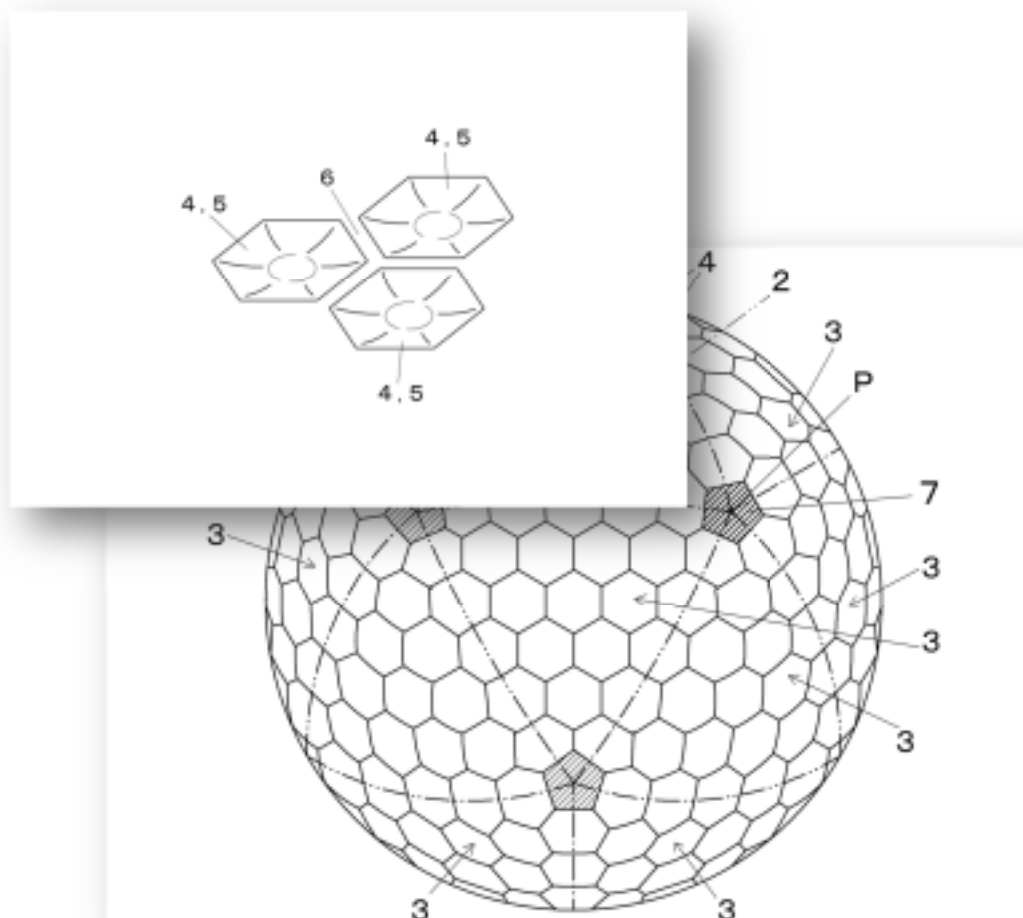
In response to the claim by the plaintiff that “the cited design expresses dimples of golf balls which are normally circular by deforming them to the hexagonal shape,” the judgment of the court decision dismissing the plaintiff’s claim is considered to be reasonable, because it is not necessary to find the cited design based on information except on the publication. The court decision was made on the grounds that, “as it is obvious from the phrase in Article 3(1)(ii) of the Design Act, the novelty should be judged by comparing the design in the application and the design described in the publication, not comparing with the shapes of actual goods.”

Moreover, in response to the claim by the plaintiff that “the cited design expressing the surface of golf balls in a plain by cutting a part thereof is not applicable to spherical objects as it is and the entire shape of golf balls cannot be grasped,” the judgment of the court decision dismissed the plaintiff’s claim on the grounds that “the cited design can be an actual design by adjusting the size and shape of dimples as needed in a way that they are contained in the spherical surface.” The judgment is considered to be reasonable taking into account the fact that it is possible to imagine straightforwardly golf balls on which hexagonal dimples are closed arrayed, although it is physically

impossible to closely array them in a way that the sides are shared.

(2) Eligibility for citation

The plaintiff claimed that “the cited design is inappropriate, since it only cuts a part of the surface of the golf ball to express it in a plain and the entire shape cannot be identified.” However, taking into account the fact that design examinations which may cite publicly known designs in which the back side is not expressed have been judged to be valid, it is reasonable to think that it is sufficient to find the configuration of the features when designs are compared. Based on this view, the cited design is characterized in that the hexagonal dimples are closely arrayed and it is easily understood that this is the feature of the design. Therefore, the judgment of the court decision holding that the cited design has the eligibility for citation was roughly reasonable.



## Case 16: Design 2

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2010-880005 (Design Registration No. 1380365)
Court Docket Number	2011 (Gyo-ke) 10051
Article to which the design is applied	Expansion valve for air conditioning system
Major Issues	Method of determination of similarity of the designs

### 1. Outline of the case

This case deals with a design relating to an expansion valve for automotive air conditioning system. The trial decision held that the common features of the registered design and the cited design in the basic forms and the specific forms give a strong impression of common sense of the two designs, while it held that the different features such as the angle of gradient of the inclined surface, the diameter ratio of the inclined surface to the vertical surface, and the position of the frontal upper large-diameter hole are minor. The trial decision concluded that both designs are similar. In response to this decision, the plaintiff (demandant) filed an appeal, claiming the revocation of the trial decision, but the court decision upheld the conclusion of the trial case and judged that both designs are similar.

### 2. Major issues discussed (Method of determination of similarity of the designs)

#### (1) Finding required to determinate similarity

The court decision found the features of the designs without finding the common features and the different features, but accurately found the designs. The court decision may have been made on the grounds that a judgment can be made sufficiently without finding the common features and the different features in this case. However, generally speaking, there is a risk that the necessary finding of the common and different features can be omitted, if only the features are found without finding the common and different features.

On the other hand, the trial decision first found the common and different features of the registered design and the cited design in the same way as the method used to determinate similarity described in 122.3(2)3) of the Examination Guidelines for Design and then examined their effect on the determination of similarity. Many members



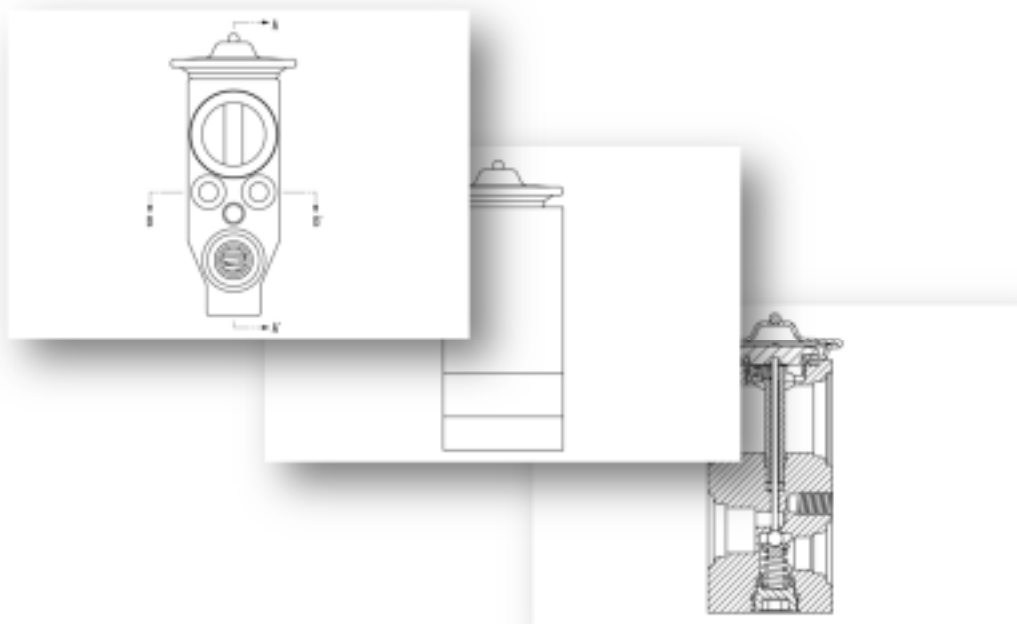
commented that the method used in the trial decision to determinate similarity allows the common and different features of the designs to be comprehensively checked so that accurate determination of similarity can be made and free from prejudice thought.

## (2) Features of the design

Moreover, some members commented as common belief about “the features of the design” as follows.

The term “the features of the design” does not appear in the Design Act or the Examination Guidelines for Design, and there is no clear definition thereof. Therefore, the definition of “the features of the design” differs depending on a person who uses this term and discussion may go nowhere. In order to avoid this situation, in determining similarity, the method of finding only the features of the designs should be avoided.

Furthermore, “the features of the design” may change, as time passes. For example, according to the theory of false recognition and confusion, any configuration of a part of the design for which the application was filed ten years ago which came to constitute the feature of the design, because it was new at the time of the filing of the application, may not constitute the feature of the design in determining similarity after a certain period of time has passed, because the said part becomes familiar for consumers. If any feature of the design for which the right has been established ceases to constitute the feature as time passes, there is a concern that the significance of existence of the design system is questioned.



## Case 17: Trademark 1

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2013-8335 (Trademark Application No. 2012-32926)
Court Docket Number	2013 (Gyo-ke) 10332
Trademark	浅間山 (Asamayama)
Major Issues	A mark indicating the place of production, Prominence, monopoly acceptability, Function for distinguishing relevant products from others

#### 1. Outline of the case

In this case, what was disputed was whether or not the applied trademark “浅間山 (Asamayama)” falls under a trademark consisting solely of a mark indicating the place of production or the place of sale of products in a common way. The appellant claimed that 1) it is impossible to identify the trademark as the place of production or sale, since there exists a plurality of mountain names (Asamayama); 2) there is no fact that local beer or mineral water is produced and sold in the surrounding areas of Mt.Asama; and 3) the appeal decision ignores the fact that there are a number of examples in which mountain names are registered as trademarks. However, the court decision maintained the judgement made in the appeal decision, holding that, in cases where consumers come into contact with products having the Trademark, they recognize the products as those produced in the surrounding areas of Mt.Asama which is situated in the border between Nagano Prefecture and Gunma Prefecture.

#### 2. Major issues discussed

(1) Conditions for and scope of a mark in which a mountain, river or lake indicates the place of production of designated goods

Generally speaking, in cases where a certain connection between a mountain name and designated goods is evoked, the mountain name may fall under a mark indicating the place of production, even if it is not the place of production or sale of the designated goods. In making this judgment, it is necessary to take actual trade condition in the surrounding areas into consideration. The judgment of the court decision itself is reasonable.

(2) Judgment criteria and judgment materials for prominent of the mountain name

There is no doubt that “Mt.Asama” is famous nationwide, so that the judgment of the court decision is reasonable. In recent examination practices, a mountain name known in one region tends to be adopted as a reference material for examinations. Some members were in favor of such examination practices from the standpoint of protecting the public of the region, while other members commented that the registration should be permitted, if the name is famous only in small region.

(3) Object of refusing the registration of the mountain name which is the place of production

It was questioned whether or not the trademark was not registered because it does not function as a mark for distinguishing relevant products from others or it does not have monopoly acceptability. Some members commented that, concerning the court decision, the judgment that “the trademark is recognized as the place of production” includes not only the object that “it does not function as a mark for distinguishing relevant products from others” but also the judgment of value that “it does not have monopoly acceptability.”

(4) Relation with other registered examples of mountain names

The existence of mountain names registered in the past itself does not have any effect. A judgment should be made based on actual trade condition and specific circumstances at the time of making a decision or an appeal decision. Therefore, it is unknown whether or not any case close to the Applied Trademark in question submitted as an evidence by the plaintiff constitutes a valid evidence.

## Case 18: Trademark 2

### (Appeal against the examiner's decision of refusal)

JPO Docket Number	Appeal No. 2012-00422 (Trademark Application No. 2011-4144)
Court Docket Number	2013 (Gyo-ke) 10045
Trademark	カガミクリスタル\江戸切子 (KAGAMI CRYSTAL\Edo Kiriko)
Major Issues	Judgment of similarity of the regional collective trademark, Primary part of the composite trademark, Well-knownness, A likelihood of causing confusion about the origin of goods

#### 1. Outline of the case

In this case, whether or not the applied trademark “カガミクリスタル 江戸切子 (KAGAMI CRYSTAL EDO KIRIKO)” (hereinafter referred to as “the trademark in the Application”) is similar to a regional collective trademark “江戸切子 (Edo Kiriko)” (hereinafter referred to as “the Cited Trademark”) was disputed.

The examination’s decision and the appeal decision affirmed similarity of the trademark in the Application and the Cited Trademark and judged that the trademark in the Application may be liable to cause false recognition or confusion in relation to the Cited Trademark. The plaintiff filed an appeal against this judgment, claiming that the trademark in the Application and the Cited Trademark are not similar (Ground for revocation 1) and that the trademark in the Application is not liable to cause false recognition or confusion in relation to the cited trademark (Ground for revocation 2). The court decision dismissed the request for appeal on the grounds that the trademark in the Application and the Cited Trademark are similar.

#### 2. Major issues discussed

##### (1) Judgment criteria for similarity with the regional collective trademark

The members reached a consensus that similarity should be judged in the same way as normal cases, since there is no special provision in the Trademark Act for judgment of similarity even if a cited trademark is a regional collective trademark.

##### (2) Observation of the primary part in the composite trademark

The court decision judged that the primary part of the trademark in the Application

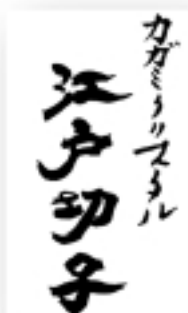
is the part of “江戸切子 (Edo Kiriko)” with an emphasis on elements in appearance such as a positional relationship between the part of “カガミクリスタル (KAGAMI CRYSTAL)” and the part of “江戸切子 (Edo Kiriko)”, the size of characters and legibility. There was no objection to the method used to make a judgment of the court decision which judged primarily the elements in appearance and the conclusion thereof based on the configuration of the trademark in the Application.

In response to the claim by the plaintiff that the fundamental distinctiveness of the term “江戸切子 (Edo Kiriko)” is so weak that it cannot be recognized as a primary part, some members commented that, in order to claim that the part of “江戸切子 (Edo Kiriko)” in the trademark in the Application is not a primary part, it is not sufficient to point out its fundamental weakness of distinctiveness and it has no distinctiveness at the present moment. Therefore, there was no objection.

(3) Well-known of the cited trademark and a likelihood of causing confusion about the origin


Some members commented that, if the ground for revocation 2 is judged in the court decision, a likelihood of causing confusion about the origin cannot be denied, and that the goods are traded only by means of the part of “江戸切子 (Edo Kiriko)” cannot be denied, as long as “江戸切子 (Edo Kiriko)” is well-known, even if “カガミクリスタル (KAGAMI CRYSTAL)” is well-known. There was no objection to this argument.

Moreover, with regard to a point that the appeal decision determined the well-knownness of the cited trademark based only on the ground that the cited trademark is a regional collective trademark, “well-knownness” required at the time of filing an application for regional collective trademark and “well-knownness” at the time of judging a likelihood of causing confusion about the origin do not always correspond. Therefore, the members reached a consensus that the appeal decision needed to judge “well-knownness” of the cited trademark again at the time of making this judgment not based on well-knownness of it at the time of making the examination decision for registration.



## Case 19: Trademark 3

(Trial for invalidation)

JPO Docket Number	Invalidation No. 2012-890024 (Trademark Registration No. 5378262)
Court Docket Number	2012 (Gyo-ke) 10334
Trademark	
Major Issues	Judgment of similarity of trademarks, Trademark consisting of characters and figures, Specifying of pronunciation

### 1. Outline of the case

In this trial, similarity between the above trademark (hereinafter referred to as “the Trademark”) and the cited trademarks “BEAMS” and “ビームス” was the issue in dispute. The trial decision judged that the Trademark is not similar to each of the cited trademarks on the grounds that the trademark only generates the pronunciation of “eams” but does not cause specific meaning. On the other hand, the court judged that the Trademark and each of the cited trademarks are similar on the grounds that the Trademark generates the pronunciation of “beams” and the meanings of “joist or light,” and that the pronunciation and the meaning correspond to those of the cited trademarks.

### 2. Major issues discussed (Similarity of the trademarks)

(1) Is the trademark recognized as “figure + eams” or “Beams?”

Some members commented that the figure part is not seen as “B” when the Trademark is looked at without knowing the outline of the case, while other members commented that the Trademark is seen as “Beams” even when it is looked at without bias. Moreover, some members commented that persons who understand the figure as “Beams” cannot understand the figure part as “B” based only thereon and recognize it as “Beams,” because there is “eams” next thereto.

Furthermore, some members expressed their opinions that the fact that there is an English term (beams) meaning “joist or light” affected the conclusion in this case and that the conclusion would have been different if an English term called “eams” had been existed.

(2) What is the pronunciation generated by “eams” in cases where the Trademark is acknowledged as “figure + eams?”

Some members commented that only the pronunciation of “eams” is generated and the pronunciation of “e-a-m-s” which is difficult to pronounce is not generated. On the other hand, some members commented that the pronunciation of “e-a-m-s” may be generated, because no English term “eams” exists.

(3) Should “the surname or name of the holder of trademark right” or “actual pronunciation” be taken into consideration?

Some members commented that, according to the provisions of Article 27 of the Trademark Act, any pronunciation should be acknowledged based purely on “the trademark in the application form” eliminating the influence of “the surname or name of the holder of the trademark right (applicant)” and “actual pronunciation” at the stage of examination and trial/appeal, and it is not reasonable to consider the name of the applicant in the specifying of pronunciation. The reasonableness of examining “the surname or name of the holder of the trademark right (applicant)” and “actual pronunciation” was also considered as “actual trade condition” which is an element taken into consideration to judge similarity of trademarks. However, the members reached a conclusion that it is not reasonable to consider such elements, because this is nothing but a situation of the applicant’s side, not a general or regular actual trade condition



## Case 20: Trademark 4

### (Trial for revocation of trademark registration)

JPO Docket Number	Revocation No. 2012-300403 (Trademark Registration No. 2523496)
Court Docket Number	2013 (Gyo-ke) 10164
Trademark	<b>PEARL</b> パール
Major Issues	Distinctive source indicator regarding relevant products, Identical trademark from common sense perspective, Procedural due process violation

#### 1. Outline of the case

The JPO held, at the trial for revocation of registration under Article 50(1) of the Trademark Act, that the trademark at issue was not revoked. Upon receiving the decision, the plaintiff appealed to a court to vacate it. The court vacated the trial decision on the grounds that the trademark of “パールフィルター” and “PEARL FILTER” used in any of the advertisements before the court cannot be found to be identical with the trademark at issue from common sense perspective and therefore the trademark at issue is not found to be used in any of the advertisements.

#### 2. Major issues discussed

(1) Whether the trademark at issue is used as a distinctive source indicator regarding relevant products

Some members commented that it is difficult to support the JPO’s finding that “パールフィルター” is distinctive regarding relevant products merely based on evidences where “キラキラきらめくパールフィルター (sparklingly shining pearl filter)” was used. With respect to the judgment in the court decision that “パールフィルター” was used as a secondary brand, some members commented that an idea provided by the court makes sense, since there are trademarks such as technology brand names in addition to brand names indicating product names.

(2) Whether “キラキラきらめくパールフィルター (sparklingly shining pearl filter)” or “パールフィルター (pearl filter)” is identical with the trademark of “PEARL/パール” from common sense perspective

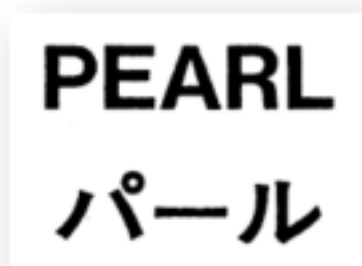


Regarding the court decision that “パール (pearl)” and “パールフィルター (pearl filter)” are not identical from common sense perspective, some members commented that the court decision stating that they are not identical is correct, since “パールフィルター (pearl filter)” is integrated well. Regarding this issue, some members commented that the court would find that they were used as trademark if “®” is affixed to “パール (PEARL).”

In addition, some members commented that the court should have found that “パール (pearl)” was used based on the use of “パールフィルター (pearl filter)” once “フィルター (filter)” for cigarettes was found to be not distinctive in both the trial decision and the court decision. Other members commented that the court decision is correct because lack of distinctiveness of “フィルター (filter)” for cigarette is not decisive regarding distinctiveness of “パールフィルター (pearl filter).”

### (3) Procedural due process violation

The statement in the JPO’s inquiry that “it is inevitable to revoke the trademark at issue where there is no evidence to confirm the fact that the trademark is used for designated goods” does not amount to procedural due process violation (is not illegal), but the JPO should have not stated that improvidently in order to avoid misleading the parties concerned.



**Case Study by Trial and Appeal Experts  
Report 2015 (Summary)**

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