Study Group Practitioner and Appeal Tria

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Trial and Appeal Department (TAD) Japan Patent Office

Trial and Appeal Practitioner Study Group

REPORT 2019

(Summary)

Trial and Appeal Department Japan Patent Office

Preface

The chief administrative judges and administrative judges at the Japan Patent Office (JPO) examine and make final determination as to the appropriateness of examination results on applications for patents, utility models, designs, and trademarks; and on the validity of rights granted.

To properly conduct proceedings, it is important to analyze the actual trial, appeal, and court decisions and provide feedback for future trial and appeal practices. It is also noted that, by disseminating the results of analysis conducted on these decisions and practices, administrative judges can make the trial and appeal practices better understood by users of the trial and appeal systems.

With this notion in view, since FY2006, the Trial and Appeal Department at the JPO has held the "Trial and Appeal Practitioner Study Group" (It originally was named the "Case Studies on Inventive Step"). Trial and appeal practitioners in the study group from various sectors gather in one place to review and discuss trial, appeal, and court decisions.



Trial court of the JPO

The review board of the Study Group consists of corporate IP personnel, patent attorneys, lawyers, and the JPO administrative judges, including the chief administrative judges. To date, a total of 571 trial and appeal experts have studied 161 cases. The Trial and Appeal Department has made use of outcomes of the studies within the JPO and also provided them to the trial and appeal system users. In addition to the above-mentioned members, since 2016 we have welcomed judges from the Intellectual Property High Court and the Tokyo District Court to attend as observers. As a result, this has allowed us to include judicial perspectives in the case review process and made the discussions at the meetings more fruitful than ever before.

The Trial and Appeal Department at the JPO actively shares the outcomes of the study group by publishing English abstracts of the reports. In "The Judicial Symposium on Intellectual Property/TOKYO 2019" held in September 2019, we ran a panel discussion on "Comparison Between Countries on Judgment of Inventive Step for Patent" with the participation of legal professions, mainly judges, from Japan, Australia, China, India, Korea and Singapore using one of the case studies of the "Trial and Appeal Practitioner Study Group Report 2018" as a subject. We hope that our activities will advance greater understanding worldwide about the trial and appeal practices in Japan and further improve the reliability of the Japanese intellectual property system around the world.

Last but not least, as a chairperson of the Study Group, I would like to express my sincere appreciation to the members of the Japan Intellectual Property Association, the Japan Patent Attorneys Association, the Japan Federation of Bar Associations, the Intellectual Property High Court, and the Tokyo District Court, who have helped us organize the case study meetings; and as well to all those who have participated in the study as review board members and observers.

WADA Yuji

Chairperson of the Trial and Appeal Practitioner Study Group Executive Chief Administrative Judge Trial and Appeal Department Japan Patent Office

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Demandant's and Demandee's nameplates in the trial court of the JPO

Outline of Study

I. Study Framework

Studies were conducted by each of the six groups (Patent – Machinery, Patent – Chemistry 1 (General Chemistry), Patent – Chemistry 2 (Pharmaceuticals and Biotechnology), Patent – Electricity, Design, and Trademark) on determinations, etc. made by the JPO and the Intellectual Property High Court focusing on specific cases.

Each group consists of corporate IP personnel, patent attorneys, lawyers as well as Executive Chief Administrative Judge and administrative judges of the JPO. In addition, judges of the Intellectual Property High Court and the Tokyo District Court participated as observers.

The study group was led by Chairperson, Executive Chief Administrative Judge at the Trial and Appeal Department of the JPO, and administered by Secretariat, the Trial and Appeal Policy Planning Office, the Trial and Appeal Division, the Trial and Appeal Department of the JPO.

II. Study Cases

Eleven cases that meet the following criteria and that were considered important for trial and appeal practices were selected as a subject of study; (1) cases selected from appeal against examiner's decision of refusal cases, trial for invalidation cases, trial for rescission of registered trademark not in use cases, or opposition to grant of patent cases, where trial or appeal decisions, or decisions on opposition were already concluded; and (2) rights in dispute do not exist in the end.

The JPO selected cases from candidate cases recommended by the Japan Intellectual Property Association (JIPA), the Japan Patent Attorneys Association (JPAA) and the JPO respectively after giving thorough consideration to a wide variety of issues including type of cases (ex-parte appeal or inter-partes trial), conclusions of court decisions (dismissal of a request, revocation of appeal or trial decision), discussion points.

Each group dealt with one to two cases.

III. Study Method

The study of each case was separately conducted by each group. Each group dealt with one to two cases holding two to three sessions.

The members from the JPO arranged the discussion points in advance, and, at the first session, explained background of the case and discussion points. Following the first session, each member prepared opinions on discussion points, added discussion points, and conducted further research and exploration as necessary.

At the second session, each member presented opinions on discussion points and results of the research. Members discussed cases while giving consideration to background of the case, statements in description, etc., evidence submitted, allegation made by the parties, previous court decisions, examination standards, etc.



Patent - Chemistry 2: Pharmaceuticals and Biotechnology

Organization chart of the Trial and Appeal Practitioner Study Group 2019

Case 1: Patent – Machinery

Unified configuration as a different feature

JPO Docket Number	Trial for invalidation Invalidation No. 2016-800014 (Patent No. 5717955) (March 22, 2017: trial decision to partially maintain the patent → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, May 14, 2018 2017 (Gyo-Ke) 10087 (dismissal of a request, JPO trial decision maintained)
Title of Invention	Building board
Major Issues	The Patent Act Article 29(2) (Inventive step)

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning "Building board."

In the trial decision, the JPO approved the correction and determined that both of Corrected inventions 1 and 2 would have been easily made by a person skilled in the art based on the cited inventions and the well-known arts (trial decision to partially maintain the patent).

The court determined that, although the JPO's decision has an error in specifying the different features, Corrected inventions 1 and 2 still lack inventive steps. Thus, the court dismissed the request by the plaintiff.

2. Major issues discussed

(1) Issue 1 (Why did the JPO and the court find different features in a different way?)

The court supported the conclusion of the JPO's trial decision. However, it determined that different features should be specified from the perspective of the technical problems to be solved by the invention, and accordingly found the "unified configuration" in a different way from the JPO.

The members studied in light of judicial precedents in what cases a "unified configuration" can be found.

A. Definition of "technical significance"

As the term "technical significance" is used in No. 4-3 (1) (e) for the court decision, the members examined the meaning of the said term.

The said term is often used in examinations and appeal practices or in judicial precedents, however, the definition thereof is not uniquely defined.

The members basically reached a consensus that in light of the court's holding the "technical significance" is meant for something meaningful for solving the problem.

B. Concrete content of the technical significance

As in the court decision, if "technical significance" means something meaningful for solving the problem, it can be said that whether there is "technical significance" or not depends on the content of problems.

The members examined how the problem to be solved is found in the judicial precedents below.

The IP High Court decision of 2014 (Gyo-Ke) 10213 – "Inspection probe manufacturing method" case – is concerned with the invention of the method for manufacturing inspection probe by laser welding. In this case, the court did not find a general and abstract problem such as increasing the joining quality of the laser welding.

Some members took up the above case and commented that the more the problem to be solved is found in a general and abstract manner, the more the scope having "technical significance" expands and the easier it gets to find a different feature as a "unified configuration." In contrast, if the problem is found in a concrete manner, the scope having technical significance becomes instead narrow and the different features likely to be found separately.

Based on that viewpoint, one of the members who works as a patent agent commented that his clients often request such description in the specification that allows for the problem to be found in a broad and abstract manner.

Another member pointed out that there has been a tendency to find problems concretely since the case of the IP High Court, 2010 (Gyo-Ke) 10075: "Exhaust fan filter" case.

C. Reason for the different findings in the unified configuration between the JPO decision and the court decision

The original claims included inks of three colors; cyan, magenta and

yellow, and a black ink was added later on as a result of the correction request following the advance notice of a trial decision. One of the members commented that could explain why the JPO regarded the black ink as another, separate different feature.

(2) Issue 2 (So-called "easiness on easiness")

The argument whether a configuration can be found as a "unified configuration" or not is an influence for determining inventive step in the same way as the logic of the so-called "easiness on easiness."

The first assumption was this: two independent different features are found between the primary cited invention and the claimed invention, in other words, two different features do not form a "unified configuration." If there exist Secondary citations 1 and 2 which correspond to Different features 1 and 2 respectively, it would be sufficient to examine whether or not Different features 1 and 2 can be easily arrived from Secondary citations 1 and 2 respectively.

There was another assumption: difference between the primary cited invention and the claimed invention can be considered one different feature as the "unified configuration," instead of two independent different features. In this case, the reasoning to deny inventive step would be like these: Secondary citation 1 is combined with Secondary citation 2 and then the "changed" Secondary citation 1 is combined with the primary citation, or Secondary citation 1 is combined with the primary citation and then Secondary citation 2 is combined with the primary citation which has been combined with Secondary citation 1. This would rise the argument of so-called "easiness on easiness."

Some members commented that there is a tendency in recent judicial precedents to determine that inventive step cannot be denied with the logic of "easiness on easiness," and thus it is necessary to keep a close watch on future court decisions.

Case 2: Patent – Machinery

Addition of new matter in amendment and division

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800135 (Patent No. 4897747) (October 30, 2013: trial decision to maintain the patent (First trial decision) → revoked) (April 5, 2016: trial decision to invalidate the patent (Second trial decision) → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, March 11, 2015 (First court decision) 2013 (Gyo-Ke) 10330 (JPO trial decision revoked) Court decision of the IP High Court, May 10, 2017 (Second court decision) 2016 (Gyo-Ke) 10114 (dismissal of a request)
Title of Invention	Oscillation type planetary gear device
Major Issues	The Patent Act Article 17-2(3) (Addition of a new matter) The Patent Act Article 44(1) (Requirements for divisional application)

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning "Oscillation type planetary gear device."

In the first JPO trial decision, the JPO dismissed the request for a trial (maintain the patent) on the grounds that the amendment of "internal teeth oscillation type inner gearing planetary gear device" in Claim 1 as a generic concept to "oscillation type planetary gear device" did not introduce any new technical matters and therefore it was not unlawful amendment beyond the scope of the original specification, etc. and thus there was no reason for invalidation due to an addition of new matters.

Against the JPO trial decision, in the first court decision, the court determined that the trial decision stating the amendment as legal was erroneous and revoked the trial decision, on the grounds that, among the inventions which were newly included in the scope of the claims by the amendment, a type-1 external teeth oscillation type planetary gear device introduces a new technical matter.

After the case was remanded, the demandee (patentee) requested the correction for restricting the invention only to a type-2 external teeth oscillation type planetary gear device. In the second trial decision, the JPO approved the correction, and found that it was violation against the requirements for divisional application, on the grounds that the corrected invention that includes the external teeth oscillation type planetary gear device was deemed to introduce new technical matters in considering its relationship with matters derived from integrating all the statements in the original specification, etc. of the parent application. Therefore, the JPO determined that the request for a trial was approved (invalidate the patent), since the retroaction of filing date for the present application was not admitted and novelty of the corrected invention was negated by the publication of the parent application.

In the second court decision, the court dismissed the request of the plaintiff (patentee) on the grounds that the trial decision was not erroneous.

2. Major issues discussed

- (1) Issue 1 (Limits of amendment and division)
 - A. Whether the problems to be solved by the invention should be stated in the specification in principle

Regarding the problems, some users mentioned that they paid attention to the fact that an amendment and a correction may not be approved and arise limitations unless the problems are properly established and described when preparing the specification. The members agreed that the problems should be stated in the specification in principle, not limited to this case.

B. Whether the problems should be specified in consideration of common technical knowledge besides the statement in the specification

On the other hand, in court decisions, the court specifies the problems not only from the statement in the specification, but also common technical knowledge is taken into consideration.

Some users commented that if the court specifies the problems even if there is no such description in the specification, it was difficult to predict court's determinations and it sometimes could be hard to ascertain the clearance of other companies' rights. Therefore it would be preferable from the viewpoint of ensuring the predictability of conclusions, to specify the problems based on the specification in principle.

C. Whether the conclusion of the court decision was different, if there was a single line statement in the specification of the parent application, such as that it could also be implemented with external teeth

In the present case, the court concluded that it was violation against the requirements for divisional application, since only the problems based on the structure of the internal teeth were disclosed in the specification of the parent application. For the case, the members basically agreed that the support requirement should have been met, since the type-1 external teeth could be assumed from the specification.

D. Whether they should have disputed on the basis of the doctrine of equivalents, without making the amendment and with reference kept only to the internal teeth type when alleging the rights

Some members commented that the type-2 external teeth may be deliberately excluded in terms of the fifth requirement (special circumstances) of the doctrine of equivalents in this case, but a majority of the members commented that there was no need to forcibly amend it considering the recent global trend on the doctrine of equivalents.

E. Actual practice considering the limits of amendment and correction, in light of the present case

Several members commented that it is extremely effective to include a statement even in a single line in the specification that it is possible to implement the assumable configurations, from the perspective of maintaining the possibility for amendment and division.

(2) Issue 2 (Binding effect of the court decision to revoke the trial decision)

There are other opinions that even if the second trial decision specified the violating of the requirement for divisional application ex officio, the first court decision held the statement of "it was assumable (the configuration of the type-2 device, but~)" thus the second decision should have granted relief at least based on that point.

(3) Issue 3 (The violation of requirement for divisional application after the

correction was approved)

In the present case, the restriction of internal teeth was eliminated by amendment at the examination stage before registration. Accordingly, in the specification when requesting Correction 2 for the case, the patented invention was already not restricted to the internal teeth.

The members agreed that the court had no choice besides approving the request for correction, since the request for Correction 2 of the case was to restrict the claims only to the type-2 external teeth (corresponding to Patent Act Article 126(1)(i)) and that falls within the specification before the request for Correction 2 (See Patent Act Article 134-2(9) and Article 126(5)).

Case 3: Patent – Chemistry 1

Specifying a cited invention against an invention with numerical limitation

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2016-016715 (Patent Application No. 2014- 509693) (October 2, 2017: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision → final and binding)
Date of Court Decision Court Docket Number	Court decision of the Intellectual Property High Court, Dec. 26, 2018 2018 (Gyo-Ke) 10022 (JPO appeal decision maintained)
Title of Invention	Tire with a tread comprising an emulsion SBR having a high trans content
Major Issues	The Patent Act Article 29(2) (Inventive step)

1. Outline of the case

This is a case relating to an appeal against an examiner's decision of refusal regarding a patent application of an invention titled "Tire with a tread comprising an emulsion SBR having a high trans content."

In the appeal decision, the JPO specified an invention described in Publication 1 relating to a tire comprising an emulsion styrene/butadiene copolymer "E-SBR" and silica as a cited invention, and determined that the amended invention of the case could have easily been invented by a person skilled in the art based on the cited invention and well-known arts. Here, it was determined that the amended invention cannot be a selective invention to the cited invention in relation to issues such as the E-SBR and silica, and that these issues do not provide substantial different features between the amended invention and the cited invention. Thus, the JPO dismissed the amendment as violation of the independent requirements for patentability and decided to maintain the examiner's decision of refusal by reason that the claimed invention before amendment lacked an inventive step.

The court dismissed the request on the grounds that there was no error in specifying the cited invention and the different features that had been specified in the appeal decision.

2. Major issues discussed

(1) Issue 1 (Whether be specified a combination of E-SBR and silica from Publication 1)

The members examined whether it could be considered that the combination of E-SBR and silica is described in Publication 1, and whether a person skilled in the art could recognize the combination of E-SBR and silica from Publication 1. The members reached a consensus that, aside from whether the combination of E-SBR and silica was directly described in Publication 1 or not, it could be recognized the combination of E-SBR and silica from Publication 1. The members also reached a consensus that the grounds could be basically found in Claim 7, Claim 14 and Paragraph [0009] of Publication 1.

(2) Issue 2 (Whether be specified a combination of E-SBR and high-content silica from Publication 1)

The members examined whether it could be said that a combination of E-SBR and high-content silica is described in Publication 1, and whether a person skilled in the art could recognize a combination of E-SBR and high-content silica from Publication 1. A majority of the members agreed that the combination of E-SBR and high-content silica was not described in Publication 1 considering that highcontent silica was not used in the Examples in Publication 1. The members reached a consensus that a person skilled in the art could nevertheless employ a combination of SBR and high-content silica from the description of Publication 1.

(3) Issue 3 (Specifying the cited invention based on Claim 7 of Publication 1)

In considering whether it is appropriate to specify a cited invention based on claims instead of the specification, the members examined whether there would be any change in the conclusions of the above Issues 1 and 2 if Claim 7 did not exist and the cited invention had to be specified based on the specification in Publication 1. The members reached a consensus, for this case, that would not change the conclusions.

(4) Issue 4 (Effect of the amended invention)

First, the members discussed the following question: when examining inventive step, which effect should be taken into account: an effect from the different features between the claimed invention and the cited invention, or an overall effect from the claimed invention? Next, the members examined whether the effect of the amended invention of the case could be a remarkable effect compared to that of the cited invention from Publication 1, and whether the appeal decision was appropriate.

A majority of the members commented that an effect to be considered on inventive step was an effect from the different features between the claimed invention and the cited invention. Then, the members examined the effect of the amended invention, and reached a consensus that, as the cited invention comprises E-SBR, the effect of an improved wet grip with E-SBR compared to S-SBR could not be found as a remarkable effect when compared with the cited invention. Some members pointed out that even if the fact that it contains highcontent silica (along with E-SBR) is considered as a different feature from the cited invention, advantageous effects from the different features could not be found by reason that the effects of using high-content silica could not be understood from the Examples of the specification. In conclusion, the members reached that the effects of the amended invention was not remarkable in comparison to that of the cited invention, thus the appeal decision regarding this issue was appropriate.

In addition, the members discussed the following question: if experimental results that show an increased grip performance with silica in an amount of 105 to 145 phr compared to that with other amount of silica had been presented in a certificate of experimental results, how should the effect of the amended invention be considered? Some members commented that in view of the description of Paragraph [0010] and the problems to be solved by the invention, it would be possible to take such experimental results into consideration and thereby the amended invention could be regarded to have a remarkable effect compared with that of the cited invention from Publication 1. On the other hand, other members commented that such experimental results should not be taken into consideration because the specification does not state what effect can be achieved by adjusting the content of silica.

(5) Issue 5 (How the court decision specified the numerical limitation of the amended invention)

The members examined how the court specified the numerical limitation of the silica content in the amended invention. When the court examined the plaintiff's allegations, it considered the description of the Examples and concluded that the technical significance of limiting the content of silica to 105 to 145 phr was not stated in the specification. In related to that, some members commented that the court decision could have been different if a certificate of experimental results had been submitted.

Case 4: Patent – Chemistry 1

Interpretation of disclaimer and assessment of inventive step of disclaimer

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-006211 (Patent Application No. 2015- 542064) (March 27, 2018: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, December 10, 2018 2018 (Gyo-Ke) 10068 (dismissal of request, JPO appeal decision maintained)
Title of Invention	Laminated glass
Major Issues	The Patent Act Article 29(2) (Inventive step)

1. Outline of the case

This is a case relating to an appeal against the examiner's decision of refusal of a patent application titled "Laminated glass."

In the appeal decision, the JPO determined that the claimed invention could have arrived easily by a person skilled in the art based on the cited invention (the invention described in Cited Document 1), and rendered an appeal decision to refuse the patent not having inventive step (decision to maintain an examiner's decision of refusal in appeal decision). The claimed invention has been specified as "excluding those containing plasticizers" in the filed amendment at the examination stage, but whether the amendment to provide the disclaimer can be approved and the clarity, etc. of the claimed invention after amendment do not become a point of issue in the present case.

In the court decision, the court dismissed the request on the grounds that there was no error in determination of the different features between the claimed invention and the cited invention specified in the appeal decision, and that there was no irregularity in procedures.

2. Major issues discussed

(1) Issue 1 (How the expression of "excluding those containing plasticizers" in the claimed invention should be interpreted)

The expression of "excluding those containing plasticizer" concerning the claimed invention was introduced in the examination stage to avoid a reason for refusal due to a lack of inventive step. According to the primary cited document (Japanese Unexamined Patent Application Publication No. H06-144891) cited in the reason for refusal, a "plasticizer" is to be used together with PVB, in particular, triethyleneglycol-di-2-ethylbutyrate, etc. But said "plasticizer" could differ from a "plasticizer" corresponding to the "modified hydrogenated block copolymer [E]" in the claimed invention. Therefore, the members examined how the disclaimer should be interpreted on the "plasticizer" which is a functional description in a sense.

In conclusion, the members reached a consensus that since a "plasticizer" as used in the claimed invention corresponds to the "modified hydrogenated block copolymer [E]," the claimed invention could be interpreted as excluding when containing such a plasticizer.

Furthermore, associated with this matter, the members discussed the clarity of the expression "excluding those containing plasticizers." A majority of the members agreed that it was common in the field of the art pertaining to the invention to define substances by using the term "plasticizers," and thus the expression was clear as a description of the claims.

(2) Issue 2 (Whether the "PVB film" in the cited invention contains a plasticizer)

The members discussed whether the "PVB film" in the cited invention contains a plasticizer.

In conclusion, the members agreed that it was specified "the PVB film which is not certain to contain a plasticizer" due to no description in Cited Document 1 regarding whether the PVB film contains a plasticizer, and reached a consensus that whether it actually contains a plasticizer depended on the common technical knowledge taken into account.

(3) Issue 3 (Whether the interlayer film of Cited Document 2 contains a plasticizer)The members discussed whether the interlayer film of Cited Document 2

contains a plasticizer.

In conclusion, the members reached a consensus that the interlayer film without containing a plasticizer can be specified in Cited Document 2, considering such reasons that a plasticizer is not described as a compounding agent, that the film can be formed without adding a plasticizer.

(4) Issue 4 (Whether a person skilled in the art can easily arrive to substitute the interlayer film of Cited Document 2 for the interlayer film of PVB of the cited invention)

The members discussed whether a person skilled in the art could easily arrive to substitute said interlayer film.

In conclusion, the members reached the consensus that the substitute of the interlayer film could be easily arrived by a person skilled in the art. The grounds for this were the commonality of the technical fields and problems between the two inventions, the commonality of functions and structures between the two inventions, and the fact that there were no unexpected or extremely significant effects because of the substitute.

(5) Issue 5 (What is a "disclaimer" that satisfies the amendment requirements and has inventive step?)

The invention is claimed with a "disclaimer" having matters specifying the invention of "excluding those containing plasticizers." While such "disclaimer" is often used only to eliminate the overlapping part of the cited invention and the claimed invention when novelty or the like (Article 29(1) (iii), Article 29(2), or Article 39) is denied for that reason, it is sometimes, as in the invention of the present application, used to avoid the reason for refusal of inventive step. Therefore, the members examined what a "disclaimer" having inventive step (which must comply with the amendment requirements as an obvious premise) would be, assuming the following examples.

- A. When excluding the essential components appearing in Claim 1 of a primary cited invention
- B. When excluding the essential (or likely as such) components in the example, although not appearing in Claim 1 of a primary cited invention
- C. When excluding the essential components of a secondary cited invention (for

example, when the present application includes A, B, and D, a primary cited invention includes A and B, and a secondary cited invention includes A, C, and D, "A, B, and D, although C is excluded")

The members shared the recognition that a determination whether a disclaimer satisfies the amendment requirements should be firstly made in terms of whether it introduces new technical matters, and then the other determination should be separately made for inventive step. Nevertheless, the members did not reach a conclusion as to what "disclaimer" generally would comply with the amendment requirements and would have inventive step, since whether the amendment requirement was complied with and whether it had an inventive step depended on the specific contents of each case.

Case 5: Patent – Chemistry 2

Violation of the enablement requirement due to inconsistency in specification and deletion of its statement

JPO Docket Number	Opposition to grant of patent Opposition No. 2015-700019 (Patent No. 5694588) (August 3, 2016: decision to revoke → final and binding)
Date of Court Decision Court Docket Number	Court decision of the Intellectual Property High Court, June 14, 2017 2016 (Gyo-Ke) 10205 (dismissal of a request)
Title of invention	Processed food and drink and packed drink
Major Issues	The Patent Act Article 36(4) (i) (Enablement requirement)

1. Outline of the case

This is a case relating to an opposition to grant of patent titled "Processed food and drink and packed drink."

The opposition was filed by reason that the patented invention violates the Patent Act Article 36(4) (i) and (6) (ii).

In the decision on opposition, the JPO approved the correction and determined that the detailed description of the invention in the specification was not clearly and sufficiently stated to the extent that a person skilled in the art could implement the corrected inventions 1 to 9 and therefore it failed to meet the requirements stipulated in the Patent Act Article 36(4) (i), and that descriptions of the claims of the corrected inventions 1 to 9 failed to meet the requirements stipulated in the Patent Act Article 36(6) (ii) (decision to revoke).

The patentee filed a suit against the decision, and, as a result, the request of the plaintiff (patentee) was dismissed on the grounds that the detailed description of the invention in the specification is not sufficiently clear and complete in a manner that a person skilled in the art could implement the present invention, therefore there was no error in the JPO's decision to fail to meet the requirements stipulated in the Patent Act Article 36(4) (i).

2. Major issues discussed

 Issue 1 (Validity of the decision on the method measuring the proportion of insoluble solids [violation of the enablement requirement] and possibility of making points at issue in violation of the clarity requirement)

The members basically reached a consensus that it was appropriate of the court to decide that the present invention violates the enablement requirement, by reason that the processed food and drink according to the present invention could have a certain degree of viscosity and it could cause the invention not to be implemented.

On the other hand, some members commented that the court should have decided mainly on the grounds that the description of the claims failed to meet the clarity requirement: in the patent specification Paragraph [0036] states that a definition of insoluble solids together with the measurement method while Paragraph [0038] states that proper washing with water and correct measurement is necessary if "still having viscosity" even after dilution with water according to the definition, and eventually, from these statements, the method for measuring insoluble solids cannot be specified and it is unclear what the insoluble solids exactly are.

(2) Issue 2 (Deletion of Paragraph [0038])

The members examined whether it could be permitted if the patentee had delated the description of Paragraph [0038] by a correction request. A majority of the members commented that it would be unlikely for such correction to be permitted under such assumptions that the court anticipated that the processed food and drink according to the present invention could have a certain degree of viscosity. The main reason was that, while the purpose of the correction could be classified as clarification of an ambiguous description, Paragraph [0038] states that the insoluble solid content cannot be measured accurately unless the subject method is adopted and therefore the meaning for the insoluble solid would change if the description had deleted, and the result of the correction would substantially fall within enlargement or modification of the claims.

On the other hand, some members commented that such correction could be accepted if the deletion of description was conducted as amendment at the examination stage. In addition, the members examined other measures that could had been taken by the patentee to avoid the violation of the enablement requirement, aside from deleting the paragraph. Some members commented that the patentee could have explained more thoroughly that a person skilled in the art could usually determine whether insoluble solids which would normally pass through a sieve had remained in the sieve since it still had viscosity, then could have alleged that it is possible to implement the invention even with the current description.

Meanwhile, other members commented that it would have been difficult for a patentee, who insisted that there are only very few cases that exhibit viscosity, to make a detailed explanation about a case that is assumed to be very rare, considering the balance with the overall allegation. Also, some members pointed out that the patented invention according to the claims covers a wide range of food and drink, and that ease of sieving is considered to depend on such factors as whether fibrous or not, so that the difficulty to discuss such a wide range of food and drink uniformly would explain why the allegation of the patentee was not adopted.

(3) Issue 3 (Description of the initial specification to meet the enablement requirement)

Some members pointed out that Paragraph [0038] should have stated more details about the criteria for determining whether "still having viscosity" and the criteria for requiring "washing with water" in the initial specification in order to avoid being regarded as violation of the enablement requirement.

All members reached a consensus that the court would judge the patent to meet the enablement and clarity requirements if Paragraph [0038] did not exist from the beginning. Still, some members commented that there remains a possibility of violation of the support requirement or enablement requirement by the following reason: when the measurements were not made accurately, for reasons such as the insoluble solids which would normally pass through had aggregated into lumps in sieving, it could lose roughly-strained food texture, which the invention had been pursuing.

Case 6: Patent – Chemistry 2

How to specify primary and secondary cited inventions, and how to describe problems to be solved by the invention

JPO Docket Number	Trial for invalidation Invalidation No. 2015-800095 (Patent No. 2648897) (July 5, 2016: trial decision to maintain the patent → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, April 13, 2018 2016 (Gyo-Ke) 10182 [First case] 2016 (Gyo-Ke) 10184 [Second case] (dismissal of a request, JPO trial decision maintained)
Title of Invention	Pyrimidine derivatives
Major Issues	The Patent Act Article 29(2) (Inventive step) The Former Patent Act Article 36(5)(i) (Support requirements)

1. Outline of the case

This is a case relating to a trial for invalidation of a patent titled "Pyrimidine derivatives."

In the trial decision, the JPO did not approve the correction, and found that Reason for Invalidation 1 relating to inventive step and Reason for Invalidation 2 relating to support requirements both have groundless, regarding claims 1, 2, 5, and 9-12 specified after correction in the previous irrevocable trial decision (Invalidation No. 2014-800022) (Trial decision to maintain the patent).

The revocation action against the trial decision filed by the demandant of a trial had the following disputed issues: (1) benefit of the action, (2) presence or absence of inventive step, and (3) presence or absence of any violation of the support requirement. In the court decision, the court first approved the benefit of the action, but dismissed the request of the plaintiff on the grounds that the claimed invention had inventive step and satisfied the support requirements.

2. Major issues discussed

(1) Issue 1 (Determination of inventive step)

A. "A huge number of options" and "Circumstances to be positively or preferentially selected"

The members discussed a perspective of the holding indicated in the court decision that it is impossible to extract specific technical ideas "as long as there is no circumstance to positively or preferentially select technical ideas related to specific options when the compound is described as a general formula in the publication and such general formula has a huge number of options."

In the above holding, the members reached a consensus that the criteria of "a huge number of options" and "the circumstances to be positively or preferentially selected" was not clear and difficult to determine. The members shared the opinion that in the court decision it was not clear as to whether to determine that there was "circumstances to be positively or preferentially selected" even in the instance that it was only stated as an "especially preferable" option without any examples or there were many options to be "especially preferable."

B. How to specify a primary cited invention and a secondary cited invention

The court decision held that the method of specifying a primary cited invention is equally applicable to a secondary cited invention.

On the other hand, in an actual practice, when more than one documents are combined, the primary cited invention is specified from the primary cited document, while some trial decisions specified technical matters such as the technical common sense or well-known technology instead of the invention from the secondary cited document, and thereby, reasoning of the combination is sometimes made without clearly specifying the secondary cited invention. The members agreed with as above.

C. Differences in reasoning of determination between Trial decision and Court decision

In the trial decision, the JPO focused that in the invention of Evidence A No. 1 there is no motivation for substituting "dimethylamino group" with "- N (CH₃) (SO₂CH₃)" based on the statement in Evidence A No. 2. On the other hand, in the court decision, the court determined that "a specific compound in which the group at the 2-position of the pyrimidine ring is substituted with "- N (CH₃) (SO₂R')" cannot be specified as the secondary

cited invention." The members also discussed the reasoning of determination different in the decisions.

The present invention and the invention of Evidence A No. 1 both relate to compounds that have HMG-CoA reductase inhibitory activity, wherein the examples in Evidence A No. 1 include the compound having a common backbone with the present invention in terms of "(Ring-opening) lactone having a specific structure substituted with pyrimidinyl." On the other hand, Evidence A No. 2 does not include a compound having a (ring-opening) lactone backbone, and although there is a general description that a substituted pyridine compound exhibits HMG-CoA reductase inhibiting activity, there are no description such as in examples identifying said activity. Under such circumstances, some members pointed out that in the trial decision, the JPO would have examined whether it could be achieved that the substituent of the imino group was substituted from the methyl group with the alkylsulfonyl group in Evidence A No. 1 invention in light of technical common sense in the chemical field.

- (2) Issue 2 (Determination of support requirements)
 - A. Determination of Trial decision and Court decision of the case

The members reached a consensus that there basically was no objection to the determination of support requirements in the trial decision and court decision. In particular, they agreed, regarding the difference of the determination criteria in support requirements and inventive step, that the determination was appropriate, in that specifying the problems to be solved by the invention in the support requirements should be based on the description in the specification, but should not require providing a compound with superior effects to that of the prior art as is the case of determining the inventive step.

B. How to state a problem to be solved by the invention in a specification

Concerning how to state the problem in the specification, if stating a highlevel problem, it could make higher possibility to be accused of violating a support requirement, whereas if stating a low-level problem, it could make lower possibility to be accused of violating said requirement but higher possibility to be determined that the invention was minimally effective and no inventive step. In this regard, the members pointed out it was important to take into consideration the balance between both in preparing a specification.

Furthermore, some members commented that it was often disputed about an invention in the chemical field having numerical range limitations whether a problem had been solved over the entire numerical range.

Case 7: Patent – Electricity

Motivation for combination of prior arts and determination procedure

JPO Docket Number	Trial for invalidation Invalidation No. 2017-800011 (Patent No. 6035579) (August 21, 2017: trial decision to maintain the patent (the first trial decision) → revoked) (September 25, 2018: trial decision to invalidate the patent (the second trial decision) → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, March 28, 2018 2017 (Gyo-Ke) 10176 (JPO trial decision revoked)
Title of Invention	Registration identification information protection seal
Major Issues	The Patent Act Article 36(6) (i) (Support requirement) The Patent Act Article 29(2) (Inventive step)

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning "Registration identification information protection seal."

In the first trial decision (hereinafter referred to as "the trial decision"), the JPO determined that the description in the present claims meets the support requirements, and that the claimed invention could not have been easily arrived at by a person skilled in the art based on the cited inventions and well-known technical matters, in view of the features different from the cited invention (trial decision to maintain the patent). An action against revocation of the trial decision was filed, and the court determined that the reason for revocation (errors in the determination concerning the differences between the present invention and the cited inventions) requested by the plaintiff (demandant of the trial) was well-grounded, resulting in revocation of the trial decision.

In the second trial decision, the JPO determined that the above-mentioned differences in the claimed invention could have been easily arrived at based on the cited inventions and well-known technical matters (trial decision to invalidate the patent).

2. Major issues discussed

(1) Reason for invalidation 1 (Support requirement)

The members examined whether the "included example" alleged by the defendant is actually included in the present invention from the following two perspectives: (i) the problem to be solved, and (ii) whether the claimed invention exceeds the scope of solving the problem.

A majority of the members agreed that the court decision was appropriate in that the present problem was same as that of the prior art of the "included example" and therefore it could be also found in the "included example."

Regarding the plaintiff's allegation that the claimed invention goes beyond the scope of solving the problem, some members supported the allegation, while others commented that, even so, it could not be deemed as violation of the support requirement. Another member commented that there was a logical leap in the allegation because the "included example" was not essentially stated in the specification.

Regarding Reason 1 for invalidation, the members also examined whether they could have established the following hypothetical allegation: due to the functional description in the claims, the present invention includes matters other than those described in the specification.

(2) Reason for invalidation 2 (Inventive step)

The members examined this issue, focusing on the following perspectives such as A) technical field, B) problems to be solved, C) motivation for applying prior arts, and D) differences in effects and functions in relation to the different features.

A. Technical field (Use of Evidence A No. 3 Invention)

The trial decision determined that the invention of Evidence A No. 3 is used for "postcards." In this regard, a majority of the members agreed that it did not mean to limit the use of the invention to "postcards."

B. Problems to be solved (Present invention, Evidence A No. 1 invention, Evidence A No. 3 invention)

The members reached a consensus that the present problem is not a special problem, but rather a well-known problem for a registration identification information protection seal, and that there is no difference in the decision structures between the trial decision and the court decision.

C. Motivation for applying prior arts

The members studied the reason why the conclusions were different between the trial decision and the court decision, in determination of the existence of motivation.

A majority of the members agreed that the difference between the conclusions was referred from the two points in the trial decision: the present problem was not obvious in Evidence A No. 3 invention; and there was no common problem between Evidence A No. 1 invention and Evidence A No. 3 invention.

Some members commented that the JPO examined carefully whether the motivation exists or not in the trial decision, but they could have reached to the opposite conclusion if it was determined based on the logic of the "well-known problem" or "obvious problem intrinsic thereto" using Evidence A No. 9.

Other members gave their opinions on the court decision, in which, on the premise that the present problem is well-known, those skilled in the art would have devised so that the adhesive layer does not adhere on the registration identification information, and the present problem could have solved by applying Evidence A No. 1 invention to Evidence A No. 3 invention. This rather seemed to be a determination where the conclusion had already been made before it began to discuss, and it seemed to be hindsight, according to their opinions.

There was also an opinion that it could be a case where a publicly known example was not found because it was too common.

The members ended up agreeing with the conclusion of the court decision on the whole.

D. Differences in effects and functions in relation to the different features (How to consider the fact that the functions and effects of Evidence A No. 3 invention [the secondary cited invention] are not directly corresponding to those of the present invention).

Some members commented that Evidence A No. 3 does not state repeated attaching and stripping, but states that the adhesive layer should not applied to the region with confidential information. Regarding to Reason 2 for invalidation, the members also discussed the concept of a "person skilled in the art" indicated in the court decision.

In addition, the members supplementary discussed the clarity of the claims, which was not mentioned in either the trial decision or the court decision.

Case 8: Patent – Electricity

Determination based on even earlier prior art than the arts in the cited references

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-000433 (June 5, 2017: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, March 26, 2018 2017 (Gyo-Ke) 10148 (dismissal of a request, JPO appeal decision maintained)
Title of Invention	Provision device, information processor, and program
Major Issues	The Patent Act Article 29(2) (Inventive step)

1. Outline of the case

This is a case relating to an appeal against an examiner's decision of refusal of a patent application titled "Provision device, information processor, and program."

In the appeal decision, the JPO determined that each different feature between the claimed invention and the cited inventions could be appropriately arrived at by a person skilled in the art, based on the cited inventions and well-known technical matters (decision to maintain the refusal in appeal decision).

Against the JPO's determination, a trial for revocation of appeal decision was filed. The court determined, in the determination of Different Feature 2, that the appeal decision was valid as a conclusion on grounds that Different Feature 2 could be easily arrived, although the appeal decision was erroneous in that it is suggested that "temporal information" of the cited invention is "fixed information" of the claimed invention (JPO's appeal decision maintained).

2. Major issues discussed

(1) Issue 1 (Whether Different Feature 2 could be easily arrived)

The members examined the followings: the determination of the court that "the provision device receives 'fixed information' from the communication terminal" was the "even earlier prior art" than the arts in the cited reference 1 and the cited reference 2; whether it presented a new determination criteria that this "even earlier prior art" was appropriate for a person skilled in the art to derive the constituent of Different Feature 2; and whether any obstructive factor existed in taking "temporal information" in the cited reference 1 as "fixed information."

In conclusion, a majority of the members commented that in the court decision, the art of which the provision device receiving the "fixed information" such as customer account information, account numbers, etc. from the communication terminal was found as the "even earlier prior art" than the inventions described in the cited references 1 and 2, and it was an unprecedented expression, but that its meaning can be understood as being even earlier prior art. However, a majority of the members commented that it could not be said to present a new determination criteria.

The comments of the members were as follows:

- It seems to have been specified based on the experience of the court judges as an older and more primitive technology than the problem of the cited reference 1 ("the experiment in which account transactions are performed using a mobile terminal device such as a mobile phone instead of a card") and the technology in the cited reference 2 ("transmitting information that requires high level of security, such as account numbers, to an ATM via NFC communication [short-range wireless communication]");
- Seeing from the paragraph 7 as well as t Examples 1 and 4 in the specification of the claimed invention, it seems that the plaintiff himself admits that it is an "even earlier prior art";
- The expression of "fixed information" would give the impression it was difficult to derive from "temporal information" of the cited invention and therefore it was included in the claim in amendment afterwards;
- The expression of "even earlier prior art" in the court decision could be intended the technology was even not needed looking into the documents; and
- The obstructive factor generated in the combination process originally occurs in the main constituent of the claimed invention. However, in the present case, it did not occur in the essential constituent of the invention

that "temporal information" of the cited invention was taken as "fixed information," and thus it seemed that the obstructive factor would not be taken into consideration.

(2) Issue 2 ("Suggestion" and "Substantial difference")

In the appeal decision, the JPO found that generating "temporal information" of the cited invention as "fixed information" was "suggested" in the cited reference 1, and that "fixed information" of the claimed invention and "temporary information" of the cited invention were "not substantially different." In contrast in the court decision, the court refused both of them. In this regard, the members discussed whether there is any other way for deriving "suggestion that should have been made to arrive at the features of the invention" from the cited reference 1.

The comments of the members were as follows.

- Based on the description of paragraph 7 in the cited reference 1, the primary cited invention of "an automatic cash transaction device which acquires customer account information stored in mobile terminal devices and performs transactions based on this customer account information" could be specified., Then, the different features of the primary cited invention from the claimed invention were considered as two matters:

 whether the fixed information is received from the first information processing device via the network and, (2) whether the provision device receives the fixed information from the communication terminal by direct communication using the HF Band RFID. Then, it could be reasonably said from the specification and the differences that the invention would be easily arrived without any obstructive factors;
- When the primary cited invention of "receiving cash card information (account number, etc.) from the mobile communication terminal and charging if the cash card information is correct," was specified from the cited reference 2, it is considered that the different features from the claimed invention can only be whether the "fixed information" is received from the first information processing device via the network; and
- It was stated in the claimed invention that "the communication terminal and the provision device received 'fixed information' directly from the

first information processing device in order to make the property available." On the other hand, in the cited invention, it was stated that "the communication terminal and the provision device received 'temporary information' and converted into 'fixed information'." If this is considered to be Different Feature 2, there could be suggested that "temporary information" corresponds to "fixed information" and that there was no substantial difference between the two. Therefore, it seems to be easy to say that "directly receiving 'fixed information'" without intervention of a conversion process from "temporary information" of the cited invention represents the claimed invention would be easily arrived from the cited invention.

(3) Issue 3 (Regarding the cited reference 2)

In the appeal decision, the JPO applied the cited reference 2 to prove the statement that "performing direct communication at short distance using HF Band RFID" is well-known in determining Different Feature 1, while in the court decision, the court considered the statement in determining Different Feature 2. In this regard, the members discussed whether applying the cited reference 2 accordingly meant that the plaintiff lost the opportunity for procedural security.

A majority of the members commented that it could not be said that the opportunity for procedural security was lost.

Case 9: Design

Identity of the cited design and the published design attached to the certification on the provision of exception to lack of novelty of design

JPO Docket Number	Trial for invalidation Invalidation No. 2016-880020 (Design Registration No. 1537464) (November 21, 2017: trial decision to invalidate the design registration → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, July 19, 2018 2017 (Gyo-Ke) 10234 (the request dismissed, JPO trial decision maintained)
Article to the design	Coat
Major Issues	The Design Act Article 4(2) (Exception to lack of novelty of design)

1. Outline of the case

This is a case related to a trial for invalidation of a design registration in which an article to the design is "Coat."

In the trial decision, the JPO determined that the cited design (Evidences A No. 13-1 and A No. 13-2) accessible to the public on the Internet before the application of the registered design is similar to the said registered design. In the light of this finding, the JPO compared the cited designs with the published design (Evidence A No. 2) described in the certification under Article 4(3) of the Design Act by the demandee, and determined the both designs are not deemed identical. Consequently, the JPO determined that Article 4(2) of the Design Act cannot be applied and the registration should be invalidated (trial decision to invalidate the registration of the design).

The court also denied the application under Article 4(2) of the Design Act and dismissed the request of the plaintiff (demandee) (the court decision to dismiss the request).

2. Major issues discussed

(1) Issue 1 (Finding of the designs [states of a combination of the individual parts])

Based on the finding of the designs in the trial decision and the court decision, the members examined the finding of the registered design, the published design and the cited design respectively: while they raised the finding of the registered design and the published design in light of the presentation of the drawings and the characteristic of the field pertaining to the designs, the members had the common understanding that the same approach as the trial decision and the court decision should be employed for the finding of the cited design.

(2) Issue 2 (One design or multiple designs)

The members examined whether the registered design consists of one design or multiple designs. Seeing the states of individual parts presented in the registered design in light of the situations, such as that the field of the article to the registered design is "Coat," and that it is distributed in the market in combination with a hood and fur, a majority of the members reached that it consists of one design.

- (3) Issue 3 (Application of exception to lack of novelty of design (Article 4(2) of the Design Act)
 - A. The members discussed what kind of description in the certification could have specified the form in which "the fur is present on the hood portion." A majority of the members agreed that the court decision would not have changed even if it had been described that "the fur is present on the hood portion," because the certification at hand could not lead the specific form of the fur as well as the specific relationship between the fur and the hood portion in the published design of this case.
 - B. The members examined if it can be found that the published design contains the form of "a coat in which the fur is lined on the hood" based on the evaluation of the trial decision and the court decision. A majority of the members agreed with the trial decision and the court decision in the point that it cannot be said that the published design and the cited design are identical.

C. Finally, the members discussed what we can learn from this case about the design application practice. The members reached a consensus as follows: (i) it is a major premise that the applicant should file an application before disclosing their design to the public, and therefore the applicant should consider Article 4(2) of the Design Act only as an extreme measure; (ii) if the applicant seeks the application of Article 4(2) of the Design Act out of necessity, they must take the responsibility upon embracing the cost of gathering sufficient information about the disclosure; and, (iii) the applicant should first seek for the application of Article 4(2) of the Design Act if there is any possibility that their design is subject to receive a reason for refusal due to the disclosure of their own product prior to the filling.

Registered design

[Perspective view]

[Perspective view showing the coat with the fur attached to the neck] [Reference perspective view showing the coat with a brooch attached and without the hood and fur]







The cited design



The published design



Case 10: Trademark

Similarity among foreign character trademarks and between goods and services

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-017053 (Trademark Application No. 2016- 021294) (May 11, 2018: decision to maintain an examiner's decision of refusal → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, December 20, 2018 2018 (Gyo-Ke) 10085 (dismissal of a request, JPO trial decision maintained)
Trademark	Violet
Major Issues	Trademark Act, Article 4(1) (xi) (Similarity between other registered trademarks)

1. Outline of the case

This is a case relating to an appeal against an examiner's decision of refusal concerning the trademark "Violet" and whose designated goods or services are those belonging to Class 9 "Electronic publications," Class 16 "Magazines, Books," Class 35, Class 41, and Class 45.

In the appeal decision, the JPO determined the request was rejected since the trademark in the application fell under Article 4(1) (xi) of the Trademark Act. The trademark in the application and the cited trademark " $\sqrt[3]{iolet}$ " are similar and likely to cause confusion with each other and the designated goods of the said trademark was similar to the designated services of the cited trademark (the services retail or wholesale in Class 35).

In the court decision, the request of the plaintiff was dismissed on the ground that the said trademark fell under Article 4(1) (xi) of the Trademark Act: the trademark in the application is similar to the cited trademark and used in goods that are similar to the designated services of the cited trademark.

2. Major issues discussed

- (1) Issue 1 (Determination of similarity between trademarks)
 - A. Concerning the pronunciation of the trademark in the application, some members commented that if the findings of the court decision deemed right, it would be necessary to establish such findings based on evidences for the actual business transactions as well as the fact relating to the understanding, attentiveness, etc. of consumers and traders, otherwise the findings cannot be persuasive. On the other hand, no opposing opinions gave against the court's finding method of the pronunciation of the cited trademark.

Concerning the similarity of the pronunciation generated from the both trademarks, the court determined that although it would be possible to pronounce the trademark in the application " $\forall \land \land \lor$ " (vjole), the pronunciations of the trademark in the application and the cited trademark "could not be said similar." A majority of the members agreed that the court should have given a more detailed explanation in this regard.

- B. Concerning the finding method of a pronunciation of a trademark consisting of a two-column description: it was conceivable that, admitting that "Violet" was the main feature of the cited trademark, the court found the pronunciation of the concerned European characters in the cited trademark " $\vec{n} \prec \vec{n} \lor \vec{n} \lor \vec{n}$ " (vjole). A majority of members agreed with the conclusion that the main feature of the cited trademark is the said European characters.
- C. Concerning the finding of concept: some members pointed out that the court may have determined that the concept of "Violet" was identical or similar as a kind of purple color in both English and French languages.
- D. Concerning the finding of appearance: the court found "Violet" as a common feature of appearance between both trademarks. On the other hand, the JPO determined that the both were similar in appearance, although approving they had the different features in the overall appearance. One of the members commented that it would have been difficult for this case to avoid designation of similarity in appearance unless some highly stylized design solution lacking in readability had been applied to the characters "Violet." Other members pointed out that the similarity of the appearance must be the primary factor in the decision, since it referred first in the court decision when explaining the reasons for the determination in similarity of both trademarks.

E. Concerning the finding of actual business transactions (attentiveness of consumers): actual business transactions had not found in detail in finding similarity of the trademarks either in the trial decision or in the appeal decision. With regard to this, some members pointed out that (i) the reason could be that the plaintiff did not allege this point, and (ii) it appeared to be a normal practice not to find actual business transactions in an appeal decision anyway.

(2) Issue 2 (Determination of similarity of goods and services)

Some members pointed out that the reason why there are few judicial precedents holding the similarity of goods and services would be that, in many cases, it is not necessary to make the determination of similarity of goods and services when trademarks were not considered similar. Some members pointed out the following points: considering that most manufacturers are responsible for both manufacturing and retailing of their goods, it would be understandable even if the goods and the retail or wholesale services for such goods are determined to be similar. However, rather than uniformly deciding them to be similar, there should be some cases to consider dissimilar according to the actual business transactions for each of the individual goods and the retail or wholesale services for the goods.

It was also pointed out that the individual actual business transactions in the determination of similarity should be more concretely alleged in a trial and appeal as well as in a lawsuit phase.

There was also an opinion that some companies have an intellectual property strategy in which, instead of specifying products handled by the company as designated goods, they comprehensively specify the services for the retail or wholesale pertaining to said goods as designated services when filing an application. This might also be the case with the cited trademark at issue.

(3) Issue 3 (Trademarks comprising foreign characters)

In connection with European characters, the members also discussed about features of trademarks comprising simplified Chinese characters, which have become popular recently. The members shared awareness of the issue in which, even though those trademarks share the same feature with Japanese trademarks comprising the same Chinese characters, their pronunciation and concept could be different from those of Japanese trademarks. Some members pointed out that when filing an application of a trademark comprising foreign characters such as Chinese characters with the JPO, one possible solution would be to disclose the meaning or the transliteration of the trademark in the application form. Some members pointed out that as the trademark is to be used in Japan, it should be assumed that the consumers are generally residents in Japan, and therefore such reading (pronunciation) and meaning (concept) used in China should not be considered as the primary condition during the examination of similarity, unless there is a good reason to do so.

Case 11: Trademark

Distinctiveness by nature and distinctiveness by use of threedimensional trademarks

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2012-005098 (Trademark Application No. 2010- 100464) (August 27, 2012: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, June 27, 2013 2012 (Gyo-Ke) 10346 (dismissal of a request, JPO appeal decision maintained)
Trademark	Three-dimensional trademark in the shape of a joint box
Major Issues	The Trademark Act Article 3(1) (iii) (Distinctiveness by nature) The Trademark Act Article 3(2) (Distinctiveness by use)

1. Outline of the case

This is a case relating to an appeal against an examiner's decision of refusal of the trademark in the Application, which consists of a "three-dimensional trademark in the shape of a joint box" and for which the designated goods filed as class 9 "joint box." In the examiner's decision, the examiner specified the three-dimensional shape of the present trademark just as a cover of the box used for connecting parts such as wiring, i.e., a joint box, used in a common way, and determined that it falls under the Trademark Act, Article 3(1) (iii), but the provisions of the Trademark Act, Article 3 (2) were not applied. The appellant was dissatisfied with the appeal decision and requested an appeal against an examiner's decision of refusal, but in the appeal decision, the JPO determined the appeal against the examiner's decision, but in conclusion, the court maintained the JPO's appeal decision and dismissed the plaintiff's request.

2. Major issues discussed

- (1) Issue 1 (Applicability of the Trademark Act, Article 3(1) (iii) (Distinctiveness by nature))
 - A. In the past appeal decisions and court decisions, it was determined that in cases such as where the three-dimensional shape is recognized entirely within the scope of the shape of the designated goods itself, it falls under the Trademark Act, Article 3(1) (iii). A majority of the members had no special objection to the method for specifying such distinctiveness, and appreciated that this court decision was determined within the conventional framework.
 - B. The members expressed no objection to the point that such cases are extremely limited among three-dimensional trademarks that the distinctiveness of the three-dimensional shape associated with the "function" is approved, as the present trademark case. Some members pointed out that the reason of the limitation could be that the value judgment acted more strongly under the situation in which it would be undesirable to give a permanent protection and a monopoly to a specific company based on the trademark right.
 - C. The members discussed about the tools for checking whether the shape is common for an actual practice. Such tools include, as options, search for goods using design publications and Internet information, as well as trade magazines, goods catalogs of competitors, and goods encyclopedias.
- (2) Issue 2 (Applicability of the Trademark Act, Article 3(2) (Distinctiveness by use))
 - A. The members had no special objection to the method of specifying a wellknown trademark according to the Trademark Act, Article 3(2) was determined by comprehensively considering the use situation that has been established in practice.
 - B. In the present case, a questionnaire survey was conducted, and the evaluation of the results of the survey was carefully determined by both appeal decision and court decision. For this reason, the members discussed the questionnaire survey from multiple perspectives.
 - (A) Some members pointed out that although questionnaire surveys were becoming increasingly popular as one of the means of proving a

trademark being well-known, objective data and evaluation by third parties are considered to be important for proving a trademark being well-known, and it was necessary not to put too much importance on a questionnaire survey. Also, they pointed out that the decisive factor as to why the Trademark Act, Article 3(2) was not applied in this case is that the proving based on the objective evidence was not established enough prior to conducting the questionnaire survey. The majority agreed with this.

(B) The appeal and court decisions indicated that the scope of target persons for the questionnaire (the target includes only electrical equipment contractors and electrical equipment wholesalers) was inappropriate. A majority of the members agreed this indication since it was understood that consumers of the product of the present trademark also included wholesalers, retailers and construction contractors and the like.

Some members commented that it was often more difficult with B to B goods compared to B to C goods since it is necessary to include both traders and general consumers as the target for the survey and also establish specific ranges for each target.

- (C) A majority of the members commented that as for the questions of the questionnaire, the manner, of which showed only the three-dimensional shape without any characters and asked what goods comes to mind, would be the least inductive and most reliable. A majority of the members commented that this case employed the similar method, so the survey could be evaluated as reliable to some extent in terms of only question items.
- (D) A majority of the members commented that the reference of the court decision that no comparison was made with other companies' products was made considering the conditions specific to the present case, and such comparison with other companies' products would be not necessarily a generalizable perspective. Concerning this point, some members commented that if the reason for this was explained in a little more detail, it would be easy for companies to follow as a future guideline.
- C. Some members commented that in the appeal and court decisions, a state of

use (advertisement) of the goods would sometimes affect the determination of distinctiveness, and for this case, the 13 valve elements, a feature of the goods, were inconspicuous in terms of a form of use (advertisement) and so the effect was negative. They further commented that when aiming for obtaining the right of a three-dimensional trademark, it was important to select a form of use (advertisement) so as to emphasize a feature part of the trademark so that consumers focused on that part separately from characters.

- D. A majority of the members commented that it is often more difficult for B to B goods compared to B to C goods to prove a trademark being well-known. Some members also commented that each company that handles B to B goods could devise measures such as regularly collecting and recording information of objective materials on the goods which tend to be dispersed.
- (3) Issue 3 (Relationship with other rights (patent and utility model rights, and design rights))

Patent and design rights have been registered for the product used in this case, and it is surmised that the Appellant (plaintiff) filed a trademark application upon the expiration of the protection period of these rights, but in conclusion, the protection under the trademark right was not approved. Such independent determination of the protection of other rights and trademark right was considered reasonable from the purport of each right and protection period, and the members expressed no objection on this issue.

Trial and Appeal Practitioner Study Group REPORT 2019 (Summary)

Contact details for inquiries:

Trial and Appeal Policy Planning Office Trial and Appeal Department Japan Patent Office

3-4-3 Kasumigaseki, Chiyoda-ku Tokyo 100-8915, JAPAN TEL: +81-3-3581-1101 (ex: 5856) FAX: +81-3-3584-1987 E-mail: PA6B00@jpo.go.jp http://www.jpo.go.jp/index.htm





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