

**TRIAL AND APPEAL  
PRACTITIONER STUDY GROUP  
REPORT 2016 (SUMMARY)**

*Trial and Appeal Department  
Japan Patent Office*





Trial and Appeal  
Practitioner Study Group

# **REPORT 2016**

(Summary)

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## Preface

As an administrative agency, the Trial and Appeal Department of the Japan Patent Office (JPO) makes final decisions on the appropriateness of the examination results of patents, utility models, designs, and trademarks and on the validity of these rights.

To implement proper trial/appeal examinations, analyzing the actual trial/appeal and court decisions and providing feedbacks to future trials and appeals are useful. Moreover, by widely disseminating the analysis results, the understanding of the examination practices can be shared with the users of the trial and appeal systems.

With this notion in view, since Fiscal Year 2006 the Trial and Appeal Department of the JPO has held the “Trial and Appeal Practitioner Study Group” (originally named the “Case Study on Inventive Step”), in which the trial/appeal and court decisions are reviewed by patent practitioners from various fields, including industry practitioners, patent attorneys, lawyers, and administrative judges, gathered in one place. The department has also been engaging in the activities to widely disseminate the outcomes of the case studies.



Trial court of the JPO

To date, a total of 396 trial and appeal experts have studied 118 cases overall. These outcomes have been utilized in the Trial and Appeal Department of the JPO and are widely recognized by the users of trial and appeal systems.

For the Case Study of this Fiscal Year, we welcomed the judges of the Intellectual Property High Court and the Tokyo District Court as observers and new members to the meeting. As a result, the cases were reviewed anew with judicial perspective, and the discussions at the meeting were more enriching than ever before.

This report is English translation of the abstracts of the report, which was made to disseminate our efforts and the study outcome overseas. It is hoped that the work will promote the understanding of the examination practices in Japan and improve the reliability of the Japanese intellectual property system overseas.

Last but not least, as a chairperson of the case study, 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, whom helped organize the case study, and those who have participated in the study as the review board members and observers.

February, 2017



Chairperson of the Trial and Appeal Practitioner Study Group

**Akira TANJI**

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 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 groups shown in the organization chart on the next page. The group “Patent – General” dealt with cases with discussion points of the interpretation of the law and procedural aspects.

The members of the groups were selected from the industry practitioners (intellectual property division in companies, etc.), lawyers, patent attorneys and the administrative judges of the JPO to give full consideration to the studies from various angles based on the standpoint of each group. In addition, the judges of the Intellectual Property High Court and the Tokyo District Court participated in some of the groups as observers.

Each of 7 groups consisted of 5 to 9 members, and 47 members and 5 observers participated in these groups.

## II. Study Method

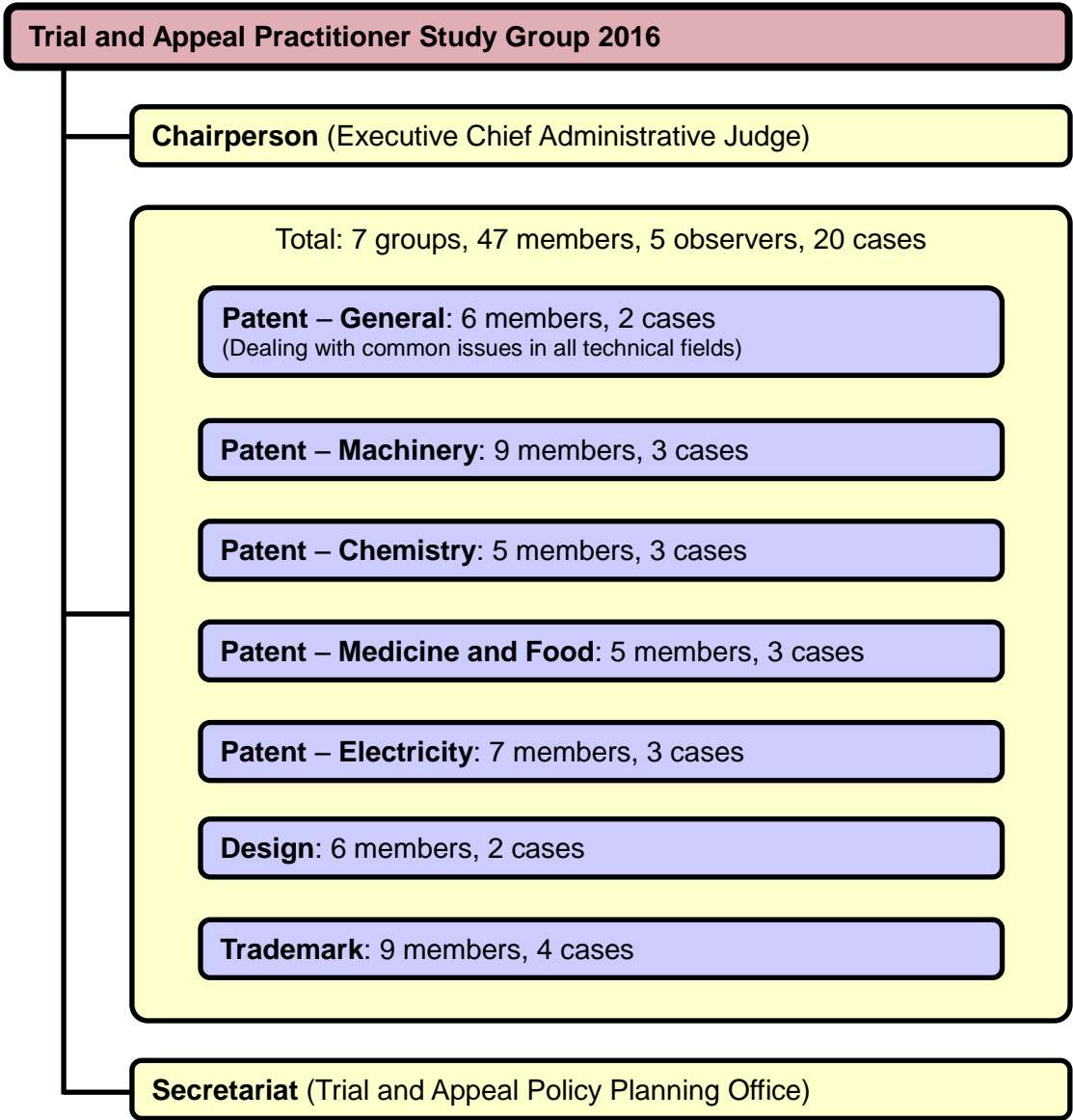
The study of each case was separately conducted by each group. The members arranged the discussion points in advance, and made discussion on decisions, logical composition or background of the conclusion, etc. of trial/appeal decisions and court decisions.

Each group dealt with 2 to 4 cases, and 20 cases were studied.



Plenary meeting held on July 25, 2016





Organization chart of the Trial and Appeal Practitioner Study Group 2016

## Case 1: Patent – General 1

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2014-007822 (Patent Application No. 2009-087031)
Court Docket Number	2015 (Gyo-ke) 10115
Title of Invention	Light source module and display device
Major Issues	Amendment to restrict claims in a limited way

### 1. Outline of the case

This case was a revocation action against an appeal decision which, with regard to a patent application for a light source module and a display device, dismissed the application's amendment, which had been filed when the appeal was requested, on the grounds that the amendment did not fall under those whose purposes are to restrict claims in a limited way, and which had further dismissed the request for the appeal because of the lack of inventive step. While a court in charge of this appeal found that the amendment was intended to restrict the claims in a limited way, and pointed out that the appeal's decision was wrong in this regard. The court did not change the appeal's conclusion that the amendment should be dismissed because it did not satisfy the requirement of independent patentability, maintained the appeal's decision that the invention of the application lacked inventive step, and dismissed the plaintiff's appeal.

Viewed superficially, this amendment of the case was intended to add a statement which stated that a "housing forming a joint" was to be newly added to a light direction-converting element that was a part forming the "light source module" claimed in the application. However, it was disputed whether the amendment fell under those whose purposes are to restrict claims in a limited way.

Grounded on the facts that the housing was said to have a joint function in the amendment and that only an optical function was specified in a portion of the pre-amendment application where the light direction-converting element was directly specified in the amendment, the appeal decision concluded that the "housing" was an "element that did not exist in the pre-amendment invention," and the amendment did not satisfy the requirement for restricting claims in a limited way.

In contrast, the court's decision, while introductorily remarking "in the claims" of the pre-/post amendment inventions, pointed out that with regard to both of the light direction-converting element and a "holder piece" that was attached to the one end of the joint, it was indeed described in the pre-amendment application, as matters to specify the joint, that the "holder piece" was to be installed to the "light direction-converting element" (in a paragraph different from one that directly specified the light direction-converting element), and acknowledged that this other

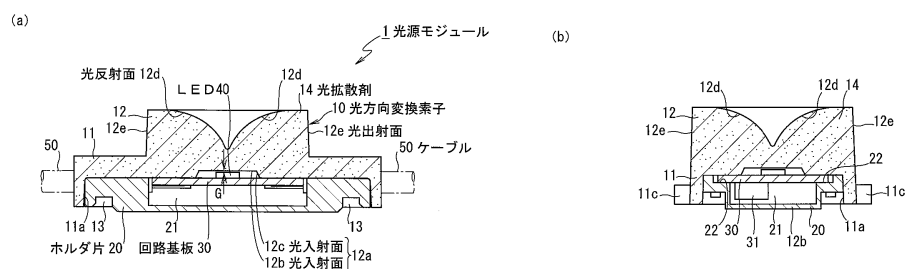
description could be matters necessary for specifying the invention, which could serve as a basis to form the restriction of the claims in a limited way, and that while the “holder piece” was only described as “to be installed to the light direction-converting element” in the pre-amendment invention, the amendment restricted the post-amendment invention to one which adopted a joint configuration. Furthermore, the court’s decision concluded that the pre-amendment invention and the post-amendment invention were identical with regard to whether these amendment inventions were identical in terms of the industrial field and the problem to be solved, as provided for in the parentheses of Article 17-2(5)(ii), and that the amendment satisfied the requirement for restricting claims in a limited way.

## 2. Major issues discussed

Some members commented that the appeal decision sounded logical, while the other commented that the court decision had a point.

Because in order for an amendment to be deemed as restricting claims in a limited way, the amendment is required to restrict matters specifying an invention, and a pre-amendment invention and a post-amendment invention must be identical in terms of the industrial field and the problem to be solved, participants in the discussion examined the case from the viewpoint of the function and action of matters specified by the case’s amendment, relation between matters specified by the amendment and other parts, “what matters are specifying the invention,” and relation between the technical significance of matters specified by the amendment and the “problem to be solved.”

The members compared the case with a reference judicial precedent (a case called “point control device and its method”) which decided that an amendment introduced another independent method and therefore it was one for other than prescribed purposes in order to examine the case, further discussed the case based on a reference judicial precedent that included mentioning of so-called internal addition and external addition, and they further discussed relation with the legislative purpose of the amendment restriction.



Claimed invention (Fig. 2)

## Case 2: Patent – General 2

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2014-018064 (Patent Application No. 2012-279543)
Court Docket Number	2015 (Gyo-Ke) 10130
Title of Invention	Electric energy saving action sheet
Major Issues	Eligibility for patent

### 1. Outline of the case

The case deals with an appeal against examiner's decision of refusal relating to a patent application for an electric energy saving action sheet. The appeal decision held that the invention claimed in the application did not utilize the laws of nature and therefore it did not fall under such “inventions” as provided for in Article 2(1) of the Patent Act, and concluded the appeal should be dismissed. Also, the court decision dismissed the appeal of a plaintiff for the case on grounds that it could not be said that the invention utilized the laws of nature and therefore the invention did not fall under such “inventions” as provided for in Article 2(1) of the Patent Act.

After having established a norm stipulating that with regard to whether an invention in an application could be regarded as an “invention” or not, “it should be examined as a whole in light of its assumed technical problems, the constitution of its technical means to solve the problems, and consequences derived from the constitution and other technical significance, and, as a result, decision should be made based on whether it fell under the ‘creation of technical ideas utilizing the laws of nature’ or not,” the court decision applied the norm to the case and concluded that the technical significance of the invention in question was solely directed to human mental activities, and therefore it did not fall under such “inventions” as provided for in Article 2(1) of the Patent Act.

### 2. Major issues discussed

(1) Issues discussed 1 (about whether the court’s decision on eligibility for patent is reasonable)

No members commented that they specifically felt uncomfortable about the above norm on eligibility for patent and its application to the case. Patent practitioners participated in the discussion solely commented that it was decided reasonably, and that the court showed matters which were implicitly agreed upon among patent practitioners.

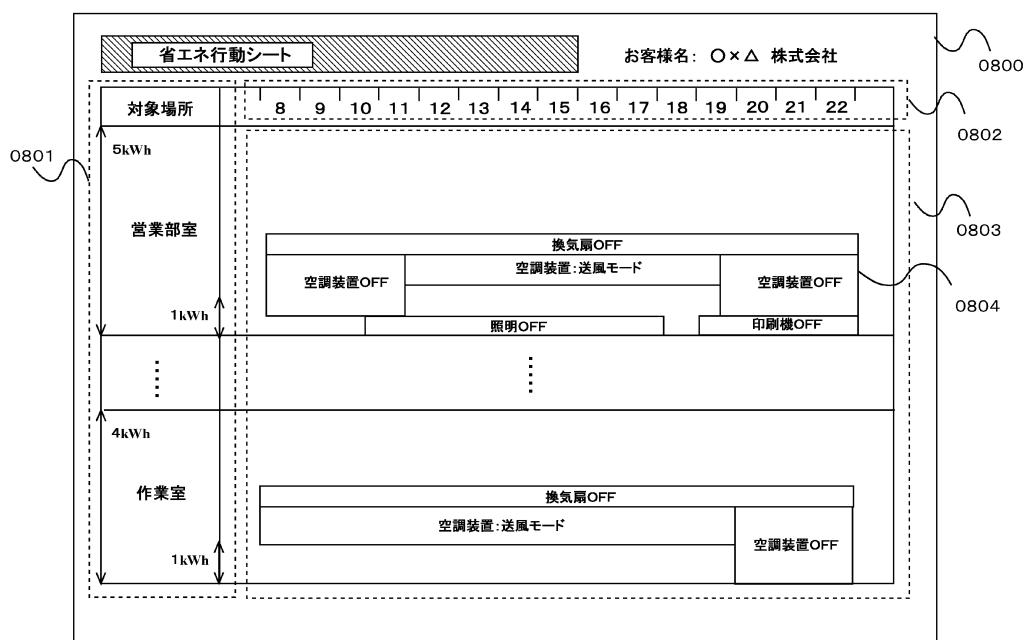
While the court decided that the invention of the patent application could not be deemed as an invention “utilizing the laws of nature,” some members commented that in order to state that an invention “utilizes the laws of nature,” what was important was “how the laws of nature were utilized,” that judgment was made based on whether an invention’s technical significance was

directed toward the laws of nature, and that there was underlying belief that same results should be obtained repeatedly under the laws of nature.

The members discussed the case from the viewpoint that whether the court decision was made based on the purpose of the patent system, the reason why terms such as “technical significance” and “technical” were used, and whether overall description should be considered or whether a decision should be made solely based on claims when deciding a patent application’s eligibility for patent.

(2) Issues discussed 2 (about relation between past judicial precedents concerning eligibility for patent and the case)

The members discussed the case while comparing the case with a judicial precedent where eligibility for patent was acknowledged (2008 (Gyo-ke) 10001 (the consonant dictionary case)). It might be thought that when viewed broadly, the case could share some common aspects with the above judicial precedent. However, the members agreed to the opinion that the court decision on how the laws of nature was utilized depended on whether it was conducted mechanically like humans’ physiological phenomena and reflex action, and whether results varied depending on people like how wide an area was recognized as mentioned in the case.



Claimed invention (Fig. 8)

### Case 3: Patent – Machinery 1

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2012-000225 (Patent Application No. 2004-249234)
Court Docket Number	2013 (Gyo-ke) 10260
Title of Invention	Apparatus for testing substrates
Major Issues	Inventive step (finding of well-known arts, and consideration about an effect)

#### 1. Outline of the case

This case was about a patent application for an invention titled “apparatus for testing substrates.” On the grounds that an appeal decision on an appeal against examiner's decision of refusal of the patent application was wrong in its finding of identical features as well as its finding of and decision on different features, a plaintiff made a revocation action against the appeal decision that dismissed the request. However, the court decided that the plaintiff's appeal was groundless, and dismissed the appeal.

#### 2. Major issues discussed

##### (1) Consideration on background arts when interpreting the wording of claims

Some members commented that, in this case, while it was necessary to investigate the meaning of the term “inspection” to find the invention's gist, it could not be denied that the meaning of the term “inspection” used in the claims might overlap with that of the term “measurement” used in another cited invention because the invention's embodiments provided no specific description to specify the meaning of the term “inspection.” They also commented that it is appropriate to assume that the meaning of the term “inspection” used in the claimed invention might include that of the term “measurement” used in the cited invention after having considered the invention's background arts. Also, another member commented that, with regard to the case, the court made a decision not on the scope of the invention's rights but rather on the meanings of the terms of “inspection” and “measurement” in the said field, and that it is appropriate to consider the invention's background arts in order to understand common general technical knowledge which served as basis for the decision.

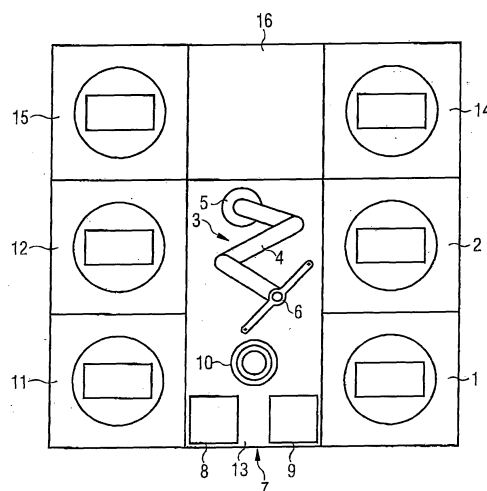
##### (2) Finding of well-known arts (the number of documents to be illustrated as examples)

Some members commented that because, the examination guidelines can be read that it would be preferable to illustrate multiple documents as examples so that well-known arts could be found, it might be necessary to illustrate multiple documents as examples for an appeal decision. Other

members commented that, for this case, it was not necessary to illustrate multiple documents as examples because the terms in this case fell under the common general technical knowledge of a person skilled in the art, but multiple documents should be illustrated as examples if terms did not fall under the common general technical knowledge of a person skilled in the art. Multiple judicial precedents were presented, which demonstrated that a mere single document was not necessarily insufficient to find well-known arts. On the other hand, some members commented that it might be preferable to illustrate multiple documents that indicate well-known arts as examples because it might be an exception to illustrate a single document that indicates well-known arts as the example, and the validity of illustrating a single document as the example of well-known arts might be disputed.

(3) Finding of inseparability of constituent features and description in the description at the time of filing patent application

Some members commented that if two constituent features in an invention were integrated and exerted an operational effect, the invention's inventive step was due to the integration of the constituent features, and therefore inventive step could not be denied by merely citing separate documents that could individually show either one of two constituent features. Another member commented that an effect due to integration might be important, but what might be more important in the field of machinery was the constitution of an invention that could support the validity of such integration. Almost all members in the discussion agreed that in order to argue an operational effect of the integration, the operational effect should be described in the description of a patent application.



Claimed invention (Fig. 3)

## Case 4: Patent – Machinery 2

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2013-015756 (Patent Application No. 2010-229730)
Court Docket Number	2014 (Gyo-ke) 10251
Title of Invention	Pack filter for vacuum suction cleaner
Major Issues	Finding of the cited invention

### 1. Outline of the case

This case deals with the patent application of an invention titled “Pack filter for vacuum suction cleaner.” A plaintiff for the patent application stated that an appeal decision on an appeal against examiner's decision of refusal of the patent application was wrong in its finding of cited inventions and its comparison between and finding of the invention and those cited by the patent application, and made a revocation action against the appeal decision which dismissed the request. However, a court in charge of the case decided that the plaintiff’s appeal was groundless, and dismissed the appeal.

### 2. Major issues discussed

#### (1) Finding of cited inventions

The appeal decision was made that finds the cited inventions of the patent application without including characteristic technical matters of a “constitution where a bag section’s air permeability changes” which was described in the patent application’s cited documents, and members discussed whether the finding was appropriate. They also compared the case with Court Docket Number 2006 (Gyo-ke) 10138, where a court made a judgment that an appeal decision that finds cited inventions without including essential constituent features was wrong. With regard to the case, while one member commented that the finding of the cited invention was appropriate in that it did not include the “constitution where the bag section’s air permeability changes” because a desired operational effect could be exerted without the constitution, another one commented that the finding should have included the constitution.

#### (2) Comparison with Court Docket Number 2013 (Gyo-ke) 10248

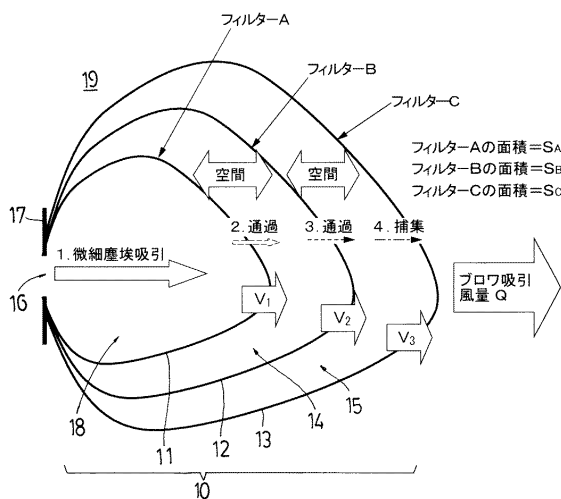
The members compared the case with Court Docket Number 2013 (Gyo-ke) 10248, where a court made a judgment that an appeal decision that finds cited inventions without including essential constituent features was wrong. One commented on an idea that a finding of cited invention should include essential constituent features if the existence of such essential constituent features could differentiate the claimed invention from the cited invention whereas a



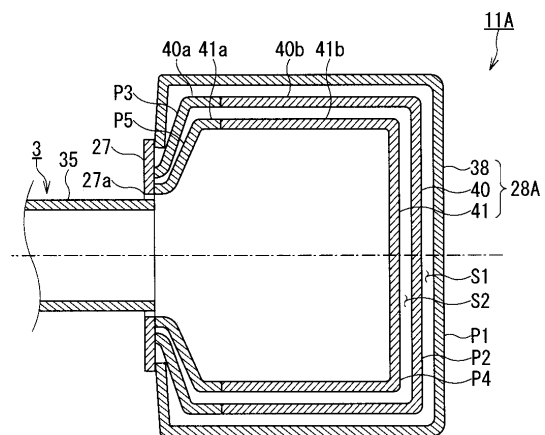
finding of the cited invention did not need to include essential constituent features if the existence of such essential constituent features could not differentiate the claimed invention from the cited invention, and that the idea could justify the court decision above. Another member commented that, in order to find the cited invention, constituent features in the cited invention should not be selected intentionally, but rather, technical ideas behind individual constituent features had to be understood precisely first.

(3) Finding of cited inventions when deciding novelty and inventive step

While the court decision on the case indicated a finding of cited inventions when deciding novelty, it also indicated that decision method used when deciding novelty is different from that of cited inventions when deciding inventive step. Then, the members discussed whether a finding of cited inventions when deciding novelty could be treated differently from that of cited inventions when deciding inventive step. After their discussion, the members agreed that it was appropriate to conclude that the same decision method should be applied to both a finding of cited inventions when deciding novelty and that of cited inventions when deciding inventive step.



Claimed invention (Fig. 1)



Cited invention (Fig. 4)

## Case 5: Patent – Machinery 3

JPO Docket Number	Trial for invalidation Invalidation No. 2011-800263 (Patent No. 4700817)
Court Docket Number	2012 (Gyo-ke) 10398
Title of Invention	Vibration control framing
Major Issues	Inventive step (finding of different features, and decision on different features)

### 1. Outline of the case

The case relates to the patent application of an invention titled “Vibration control framing.” On the grounds that a trial decision on a trial for invalidation was wrong in its decision on different feature 1 and its decision that a person skilled in the art could have easily arrived at different feature 2, a plaintiff made a revocation action against the trial decision that invalidated the patented invention of claim 1 and dismissed the request concerning the patented invention of claim 2. The plaintiff also demanded that the court acknowledge the patent application’s amendment in the first place. However, the court decided that the plaintiff’s appeal was groundless, and dismissed the plaintiff’s request.

### 2. Major issues discussed

#### (1) Finding of different features (where “is designed” was not found as a different feature)

The majority of members commented that the court decision, which did not find the expression “is designed so that the location of its center of rigidity and that of its center of gravity are different from each other” in the patent application’s claim 1 as a different feature, was reasonable because, as Evidence A No. 1 described “a building where multi-story shear walls are located asymmetrically on a plane, and the location of its center of rigidity and that of its center of gravity are different from each other,” it could be said that Evidence A No. 1’s building “was designed so that the location of its center of rigidity and that of its center of gravity were different from each other.”

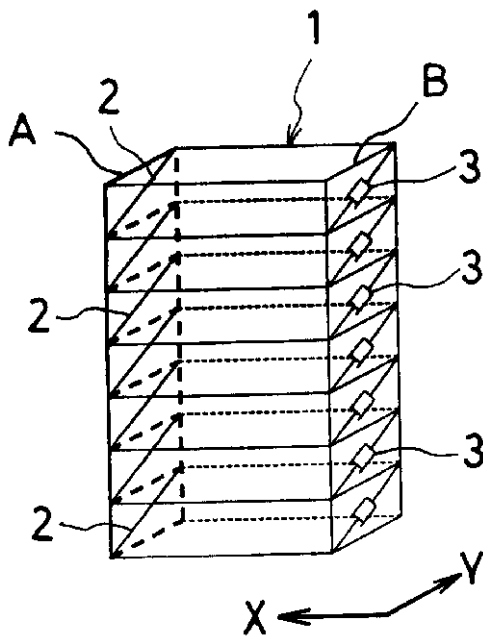
Moreover, the majority of them commented that although, as one of the reasons why the court did not find claim 1’s feature as a different feature, the court decision cited the fact that claim 1 of the patent application did not have the expression “as designed for the purpose of vibration control,” such a conclusion that claim 1’s feature could not be found as a different feature would not have changed even if claim 1 of the patent application had have the expression “as designed for the purpose of vibration control.”

(2) Decision on the different features

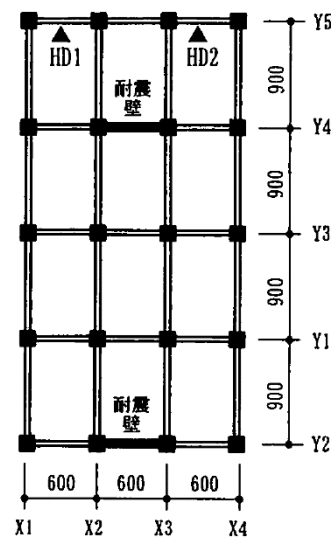
Several members commented that because hysteretic and velocity-dependent dampers were very common, the court decision, which held that a person skilled in the art could easily adopt a velocity-dependent damper in place of a hysteretic damper described in Evidence A No. 1, was reasonable.

On the other hand, multiple members commented that because Evidence A No. 1 could infer a technical idea preferring to increase a hysteretic damper's yield strength or to widen earthquake-resistant areas, no motivation to adopt a velocity-dependent damper in place of a hysteretic damper described in Evidence A No. 1 could be justified.

Also, one commented that the plaintiff should have stated that the patented invention 1 had more superior effect and should have insisted on the inventive step of the patented invention 1. That is because, while Evidence A No. 1 described about an effect that could obtain the same earthquake resistance as that of a building with the identical positions of its center of rigidity and its center of gravity, the patent gazette described that a building, which locations of its center of rigidity and its center of gravity were different from each other as mentioned in the patented invention 1, was not equivalent to one with the identical positions of its center of rigidity and its center of gravity, and could attain a better earthquake-damping effect than the latter.



Patented invention (Fig. 1)



Cited invention  
(Excerpt from Fig. 1 in Evidence A No. 1)

## Case 6: Patent – Chemistry 1

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800199 (Patent No. 4777471)
Court Docket Number	2013 (Gyo-ke) 10250
Title of Invention	Polyimide film and copper clad laminate using the film as base material
Major Issues	Enablement requirement

### 1. Outline of the case

The case deals with the invention titled the patent (the Invention) “Polyimide film and copper clad laminate using the film as base material” owned by the defendant. The plaintiff filed a request for a trial for patent invalidation. However, the Japan Patent Office rejected the appeal as the Invention fulfilled the requirements of Article 36(4)(i) (Enablement requirement) and of Article 36(6)(i) (Support requirement). In response to the decision, the plaintiff filed a request to revoke the decision. The court decision revoked the trial decision on the grounds that there was an error in the judgment of the enablement requirement and support requirement.

### 2. Major issues discussed

#### (1) Judgment on the enablement requirement

Most of the members agreed that the court decision would make sense based on the notion that the burden of proof of the claim of the enablement requirement was on the rights holder.

#### (2) Matters required to fulfill the enablement requirement

Some members commented that it should have included the scope of experimental results including the coefficients of thermal expansions of the two-component polyimide film containing 4,4'-ODA/BPDA in the Invention 9 and the document that disclosed the values more similar to the coefficients of thermal expansions of the Invention 9 with regard to the two-component polyimide film containing 4,4'-ODA/BPDA as evidence.

According to the court decision, all possible combinations need to be included in the original description. However, a majority of the members agreed that such action would not be realistic. Some members commented that in practice it might be possible to take measures, such as describing the conditions for the implementation in the original description and later including additional experiments for those that could be implemented.

### (3) Comparison to other court cases

The conclusion that had reached in the reference court case (2012 [Gyo-ke] 10020) differed from this case. Some members commented that each case would differ from the other in the technical content, difficulty of the implementation, and degree of disclosure in the description or that of known technology, all which were subject to the decision, and thus each judgment would be made on a case-by-case basis.

There were opinions that it would be necessary to indicate on filing that the implementation was not impossible. Others also commented that the implementation might have been judged possible as the description included the passage indicating that it could be implemented in future. After filing, the document, which described that the experiment had actually been performed, was submitted. Although this was done after the filing, it might have contributed to the judgment that the implementation was possible.

## Case 7: Patent – Chemistry 2

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2014-008720 (Patent Application No. 2011-511476)
Court Docket Number	2015 (Gyo-ke) 10114
Title of Invention	Tire
Major Issues	Inventive step (motivation for applying the secondary prior art to the primary prior art, finding of the different features, and remarkable effect)

### 1. Outline of the case

This case deals with an appeal against the examiner's decision of refusal of the patent application for the tires. The appeal decision rejected the request on the grounds that the claimed invention could be easily arrived from the cited invention by a person skilled in the art, and no remarkable effect could be obtained by the invention. In response, the plaintiff filed an appeal, claiming an error in the decision on each different feature being easily arrived and that remarkable effect was overlooked. However, the court supported the trial decision, noting that there were no grounds.

### 2. Major issues discussed

(1) Major issue discussed 1 (grounds for revocation 1, decision on whether or not the different feature 1 could be easily arrived)

The members reached a consensus that in general if there is similarity of a problem to be solved across two cited documents, it would be reasonable to decide that it was easy to employ these solutions together.

(2) Major issue 2 discussed (grounds for revocation 2, decision on whether or not the different feature 2 could be easily arrived)

The members reached a consensus that in general if configuration became the same although a different cause or motivation was combined, then one must conclude that the combination was easy to achieve.

While the trial decision finds that a feature described in a secondary cited document is different from that described in a principle cited document, the plaintiff claimed that the feature was not a different feature, because it was indicated in the primary cited document. However, such claim would essentially be invalid. For the ingredient that was not used in the Example of the principle cited document, one might argue that the principle cited document did not disclose the details of the invention, which used the ingredient. However, a majority of the members agreed

that the argument might be reasonable from the novelty standpoint, but would not discredit the decision that the invention could be easily arrived by a person skilled in the art.

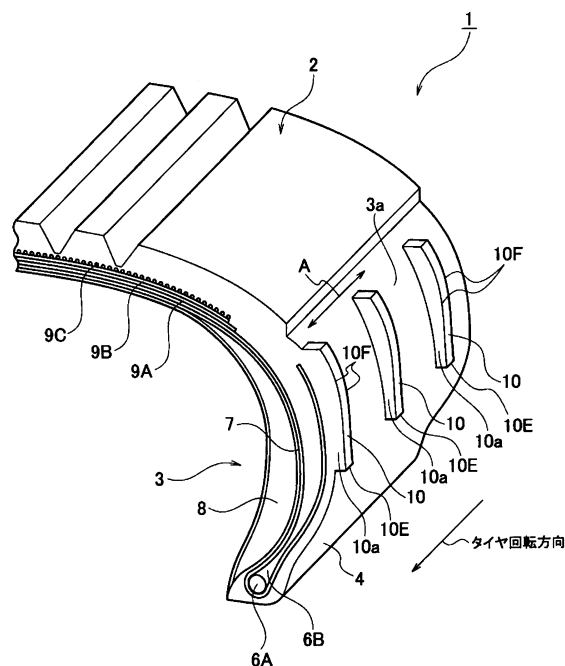
(3) Major issue discussed 3 (grounds for revocation 3, decision on whether or not the different feature 3 could be easily arrived)

The members reached a consensus that the scope of claims of the secondary cited document that extends beyond that of the principle cited document was not considered to be a different feature.

Many members pointed out that the case selected the numerical range in the same direction as that suggested in the cited document. Therefore, majority of members pointed out that, even if the experimental data had been submitted, it would have been difficult to make a valid objection.

(4) Major issue 4 discussed (rounds for revocation 4, overlooking the remarkable effects)

If the configuration is easy to arrive, the invention is not patentable unless there is a remarkable effect. In consideration of this point, the effects should be sufficiently claimed. Some members commented that even if there were mere few percentages of effects existed, it might be considered as a remarkable effect compared to the state of the art at the time of filing. Hence, how to present the remarkableness of the effect would be a key.



Claimed invention (Fig. 1)

## Case 8: Patent – Chemistry 3

JPO Docket Number	Trial for invalidation Invalidation No. 2011-800120 (Patent No. 4082734)
Court Docket Number	2012 (Gyo-ke) 10387
Title of Invention	Stabilized brominated alkane solvent
Major Issues	Clarity requirement, Support requirement, and Secret prior art (finding of the cited invention)

### 1. Outline of the case

This case deals with a revocation action against the trial decision for request for a trial for patent invalidation. The issues are 1) the appropriateness of the decision with regard to the existence or non-existence of clarity, 2) the appropriateness of the decision with regard to the existence or non-existence of the fulfillment of the support requirement, and 3) the appropriateness of decision with regard to the existence or non-existence of the identity of the invention of a secret prior art. The trial decision decided that for the above 1) “stabilized solvent composition” was not clearly described, that for the above 2) the problems of the patented inventions could not be solved in the entire scope of the patented inventions 9 and 10, and the patented inventions 5 and 8 could not be said as “the invention described in the detailed description of the invention,” and that for the above 3) a feature different from that of the invention of the secret prior art was not a substantially different feature. The trial decision, therefore, decided that the patent was invalid. Although the court decision decided that for the above 2) there was an error in the decision that the support requirement was not fulfilled in the patented inventions 5 and 8-10, it dismissed the request by the plaintiff (the demandee in the trial for patent invalidation) on the grounds that there was no error in the trial decision for the above 1) and 3).

### 2. Major issues discussed

#### (1) Violation of the clarity requirement

The trial decision and the court decision found the violation of the clarity requirement in the scope of claims on the grounds that the phrase “stabilized solvent composition” was not clear as to under what conditions it would delay metal corrosion. While some members raised that this was a harsh decision for the patentees, a majority agreed that both trial and court decisions were reasonable.

#### (2) Violation of the support requirement

The trial decision decided that the patented invention did not fulfill the support requirement



on the grounds that it is highly probable that the patented invention will result in no effect depending on the existence or non-existence of the phrase “stabilized solvent composition” in the scope of the claims. In response, the court decision decided that the support requirement was fulfilled on the grounds that the patented invention was to solve the problem by investigating the best compositions between n-propyl bromide solvent and its stabilizer system, and such chemical substances were described in the scope of the claims. Most of the members agreed that the court decision was reasonable.

(3) Secret prior art

The trial decision and the court decision pointed out a different feature between the patented invention and the description of the earlier application, as the patented invention did not use 1,4-dioxane, whereas the earlier application described that 1,4-dioxane could be used as a stabilizer in combination. However, since it was obvious that 1,4-dioxane was not to be used when another stabilizer was used, this feature was decided as substantially the same. As a result of the review, the many opinions were that the both decisions were reasonable.

## Case 9: Patent – Medicine and Food 1

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2013-007030 (Patent Application No. 2001-585739)
Court Docket Number	2014 (Gyo-ke) 10045
Title of Invention	Use of zoledronate for the manufacture of a medicament for the treatment of bone metabolism diseases
Major Issues	Inventive step (finding of the problems of the invention, selection of the primary cited invention, decision as to whether a person skilled in the art can easily arrive, and motivation for applying secondary prior art to primary prior art)

### 1. Outline of the case

This case deals with a revocation action against an appeal decision that rejected an appeal against the examiner's decision of refusal. The appeal decision decided that the different feature between the patented invention and the cited invention disclosed in the cited document 1 as "to administer zoledronic acid intravenously over a period of time specified on minute basis," which was "5 minutes" in the cited invention and was "15 minutes" in the claimed invention. However, since the patented invention could be easily achieved by a person skilled in the art based on the cited invention and the inventions disclosed in the cited documents 2 and 3, the appeal decision decided that the patent shall not be granted under the provisions of Patent Act Article 29(2). In response, the court decision decided that it was difficult to identify the motivation in further extending the administration time from that in the cited invention and revoked the appeal decision on the grounds that there was an error in the decision that the different feature could be easily achieved.

### 2. Major issues discussed

#### (1) Selection of the primary cited invention and finding of the problems of the claimed invention

In consideration of the state of the art at the time of filing when specific safety issues of zoledronic acid on the kidneys had not been recognized, the review was conducted to determine whether specific motivations that could achieve the configuration of the claimed invention was identified in the state of the art at the time of filing with finding that the drug used to administer 2.4 mg zoledronic acid intravenously over 20 minutes to a patient with average weight of 60 kg described in the cited document 2 was used as the primary cited invention and that the problems of the claimed invention were "to identify more effective dose within the range in which intolerable adverse reactions do not occur and to identify shorter administration time from the standpoint of patient convenience and reducing burden."

(2) Decision as to whether a person skilled in the art could easily arrive

The members agreed that at least the authors of the cited documents 1 and 2 did not view the intravenous administration of 4 mg zoledronic acid over 5 minutes as a problem from the safety standpoint, and as long as the problem of the claimed invention was assumed to be “the improvement of safety on the kidneys,” it was difficult to identify the motivation in further extending the 5-minute administration time of 4 mg zoledronic acid in the cited documents 1-3.

(3) Decision of advantageous effects

The members agreed that in order to decide the existence or non-existence of advantageous effect of the claimed invention compared to the cited invention, it would require comparisons not only with the drug used to administer 4 mg zoledronic acid intravenously over 5 minutes, but also at least with the drug used to administer 2.4 mg zoledronic acid over 20 minutes.

## Case 10: Patent – Medicine and Food 2

JPO Docket Number	Trial for invalidation Invalidation No. 2007-800192 (Patent No. 3546058)
Court Docket Number	2012 (Gyo-ke) 10419
Title of Invention	Use of carbazole compounds for the treatment of congestive heart failure
Major Issues	Inventive step (finding of the cited invention, decision on the different features, and remarkableness of effects)

### 1. Outline of the case

This case deals with a revocation action against a trial decision that rejected a trial for invalidation. In this case, the trial decision decided that the patented invention could not be easily arrived (the trial decision that rejected a trial for invalidation) based on the invention described in Evidence A No. 1. The different feature between the patented invention and the cited invention disclosed in Evidence A No. 1 was the treatment period, etc. with which 1) the description was not considered to suggest that carvedilol treatment was to be continued for a long period of time, 2) the effect of carvedilol in reducing the number of deaths caused by ischemic congestive heart failure could not be presumed, and 3) even if there were questions regarding the effect in reducing the number of death as described in the description of the patent, according to the matter described in the document of Evidence A No. 26, it was clear that carvedilol had an effect in reducing the number of death caused by ischemic congestive heart failure, and therefore, the effect of the patented invention was not considered to be unremarkable. In response, the court decision revoked the trial decision by deciding that a person skilled in the art could have easily arrived at the patented invention in contemplating from the well-known art in the invention described in Evidence A No. 1 and that the effect by the patented invention in reducing the number of deaths caused by ischemic congestive heart failure was not considered to be particularly remarkable.

### 2. Major issues discussed

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

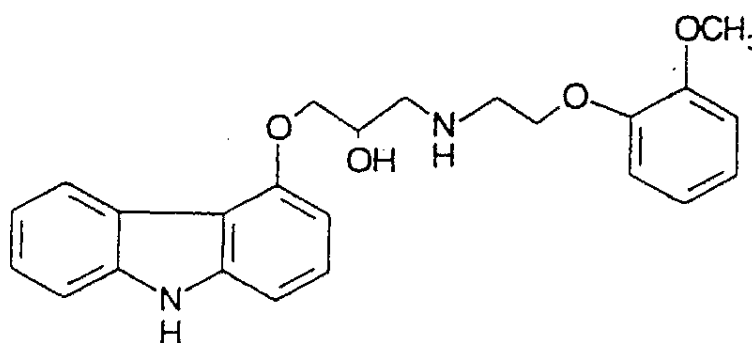
Decision criteria of the court decision, “In order to say that medicinal invention is disclosed in a document, as long as the pharmacological test described in the document is a test that can be used to logically infer the medicinal use of the chemical substance (*i.e.* the active ingredient of the drug) in question, it is sufficient,” was reasonable. In addition, the error in the considerations regarding the mechanism of the action in the cited document would not affect finding of the cited invention.

(2) Decision that the different features could be easily arrived

Because the court decision found the common general technical knowledge after comprehensively deciding the description in each document, it is a reasonable finding. Since a person skilled in the art can easily arrived at the different features between the patented invention and the cited invention (the difference in carvedilol treatment period and the effect of improving the mortality due to carvedilol), based on the said common general technical knowledge, the conclusion reached in the court decision is reasonable.

(3) Remarkableness of the effect

As pointed out in the court decision, in order to assess the reliability of the test described in the description, there is no problem in using the document that has become publicly known after the priority date. It is also allowed to verify the effect described in the description using another test that has been performed after the priority date. However, for the prior art which effect is compared to that of the patented invention, it is necessary to find it in accordance with the publicly known fact as of the priority date. Those documents that have become known after the priority date should only be used as supporting facts.



Chemical formula described in Claim 1

## Case 11: Patent – Medicine and Food 3

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800076 (Patent No. 3938968)
Court Docket Number	2013 (Gyo-ke) 10172
Title of Invention	Method for masking astringency
Major Issues	Refusal of correction, and Clarity

### 1. Outline of the case

The case deals with a registered patent “Method for masking astringency” of the defendant. The plaintiff requested a trial for invalidation of the patent registration, but the trial decision decided to revoke the request. The plaintiff, in response to this decision, filed a revocation action against trial decision. In this case, the court decision revoked the trial decision that the request of the trial for invalidation did not hold because of the following reasons. With regard to the trial decision of the patented invention, there is no error in the decision that accepted the correction. However, even if the measuring method of the sweetness threshold value is not described in the corrected description, the method of limits cannot be considered to be a general measuring method of the sweetness threshold, and therefore the person skilled in the art will not necessarily recognize that the method of limits was used. Therefore, it is not clear what the “amount not exceeding the sweetness threshold value”, more specifically, the “amount not exhibiting sweetness” means in relation to the range of the sucralose amount described in the claims ranging between 0.0012 to 0.003 weight percent. Based on this view, the court decided that there is an error in the trial decision on the clarity requirement of the patented invention since “the amount exhibiting sweetness” does not satisfy the clarity requirement of Patent Act Article 36(6)(ii).

### 2. Major issues discussed

#### (1) Decision that found the correction

The members agreed that the correction to add the condition of “not exhibiting sweetness” will reduce the numerical range of “0.0012 to 0.003 weight percent” and that the trial decision was reasonable in that it viewed it as not an introduction of a new technical matter. Furthermore, in relation to the claim that the correction is not aimed at restricting a scope of the claim since it is highly probable that sweetness will be exhibited in the entire numerical value range, the members agreed that the trial decision that allowed the correction was reasonable since this correction invention does not have a factor of the condition, and it cannot be considered that sweetness will not be exhibited in the said entire scope of the claim.

(2) Decision on the clarity requirement.

The majority of the members agreed that the court decision was reasonable in that it viewed the trial decision that the correction invention cannot be considered to be unclear, is wrong. Some members commented that it is not clear how much level the sweetness threshold is required to be when measured by the method of limits, and that there was room for discussion as to what the required level for it to be self-evident. On the other hand, as regards the point that it is not clear whether uniform clarity requirements will be met when the result obtained by the sensory test is regarded as matters specifying the invention, some members commented that sensory tests can vary in the first place and that they cannot be considered to be clear, while depending on the test items to be measured, there may be cases where the error may not be as much as the corrected invention, so it cannot be considered that it is uniformly unclear.

## Case 12: Patent – Electricity 1

JPO Docket Number	Trial for invalidation Invalidation No. 2013-800007 (Patent No. 3552539)
Court Docket Number	2014 (Gyo-ke) 10107
Title of Invention	Thermal fuse with resistance
Major Issues	Inventive step (finding of the cited invention, interpretation of the claims, and combination of the cited inventions)

### 1. Outline of the case

This case deals with a trial for invalidation of the patent relating to a “thermal fuse with resistance.” The trial decision held that 1) by finding the disclosure of Evidence A No. 15 with reference to the prior art stated in the description of the patent, the different feature 2 between the patented invention 1 and the cited invention was neither stated nor implied in Evidence A No. 15 and there was no motivation to apply, and 2) Evidence A No. 5 differed from the patented invention 2 in its purpose, working, and structure, and even if Evidence A No. 5 was applied to the cited invention, the different feature 3 between the patented invention 2 and the cited invention was not easy to arrive. On the other hand, the court decision held that, 1) by finding the disclosure of Evidence A No. 15 with reference to Evidence A No. 35 and Evidence A No. 36, Evidence A No. 15 disclosed the different feature 2 concerning the patented invention 1 and there was a motivation to apply, and 2) the technology relating to the different feature 3 concerning the patented invention 2 was disclosed in Evidence A No. 5, and the technical field and problem of Evidence A No. 5 were the same in generic concepts as those of the cited invention, and therefore there was a motivation to apply Evidence A No. 5, when applying to Evidence A No. 3 to the cited invention to achieve the different feature 1 between the patented invention 2 and the cited invention, and it was easy to arrive at the different feature 3 concerning the patented invention 2.

### 2. Major issues discussed

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

The majority of members commented that relating to the determination of the novelty and the inventive step, finding the disclosure of the cited documents with reference to common general technical knowledge and well-known arts is generally proper, but in this case, it was difficult to treat the feature not explicitly stated in Evidence A No. 15 as its disclosure, even with reference to common general technical knowledge and well-known arts, and that it was enough only to consider the inventive step concerning this feature.



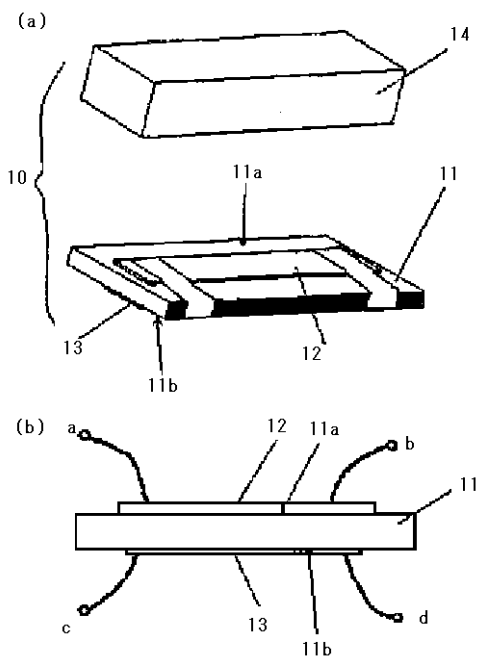
(2) Major issues discussed 2: Interpretation of claims and combination of the cited inventions

(a) Interpretation of the claims

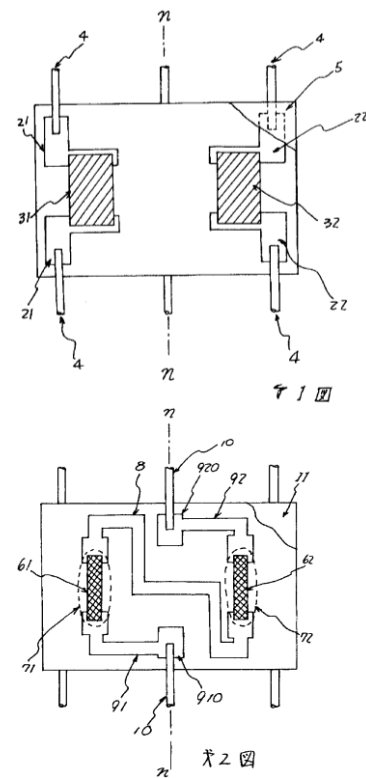
The majority of members commented that, in general, the claims should be interpreted broadly, and that the patented invention 2 included the invention in which a good thermal conductor also served as an electrode for the middle section of a low-melting alloy.

(b) Combination of the cited documents

The majority of members commented that the reasoning of the court decision was understandable with regard to applying Evidence A No. 5, when applying to Evidence A No. 3 to the cited invention, if the court decision was made on the premise that it was easy to arrive at the different feature 1 concerning the patented invention 2. They also commented that it was reasonable that the court decided that, based on the cited invention, Evidence A No. 3 and Evidence A No. 5, it was easy to arrive at the different feature 3 concerning the patented invention 2 that the middle section of the low-melting alloy was supported by the good thermal conductor arranged on a ceramic substrate.



Patented invention (Fig. 1)



Cited invention (Figs. 1 and 2)

## Case 13: Patent – Electricity 2

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2010-027554 (Patent Application No. 2006-317644)
Court Docket Number	2012 (Gyo-ke) 10251
Title of Invention	Organic light emitting display device
Major Issues	Inventive step (finding of the claimed invention, and comparison with the cited invention), and Need for relief

### 1. Outline of the case

This case was a revocation action against an appeal decision of which conclusion was that the appeal was groundless, with regard to an application in which the title of the invention is “Organic light emitting display device.” The plaintiff, which was also the applicant and the demandant for appeal, claimed as reasons for the revocation that the appeal decision recognized the scope of the “reinforcement truss” of the claimed invention unreasonably widely, and therefore there were errors regarding the comparison and judgment with “multiple beams” of the cited invention, and also regarding the judgment that the claimed invention could have been easily arrived. However, the court decision dismissed the claim by the plaintiff that none of the claimed reasons for revocation can stand.

### 2. Major issues discussed

(1) Issues discussed 1: Inventive step (finding the claimed invention and comparing it with the cited invention)

(a) Specifying the claimed invention (in particular, the scope of the “reinforcement truss”)

There was no particular objection that, the “reinforcement truss” of the claimed invention was interpreted as including a lattice shape by the appeal decision and the court decision, taking into consideration the description and the drawings, even though “truss” generally means a triangle-shape structure that can rotate at the joint.

(b) Comparing the claimed invention with the cited invention (in particular, finding the cited invention)

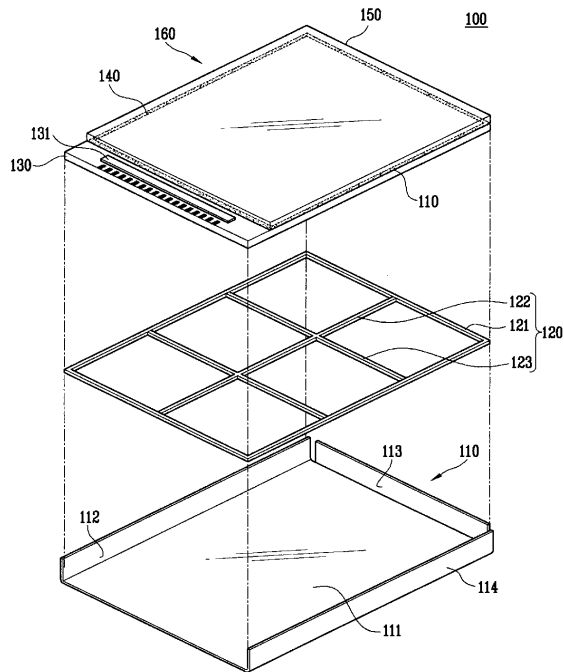
There were some opinions in objection from technical viewpoints to the appeal decision to find the cited invention by extracting only “the multiple beams” from the “reinforcement structure” and excluding “base plate (supporting substrate)” described in the cited document 1.

On the other hand, almost all members reached a consensus that since “reinforcement truss” in the claims at the time of the appeal decision is not sufficiently specified, the “multiple

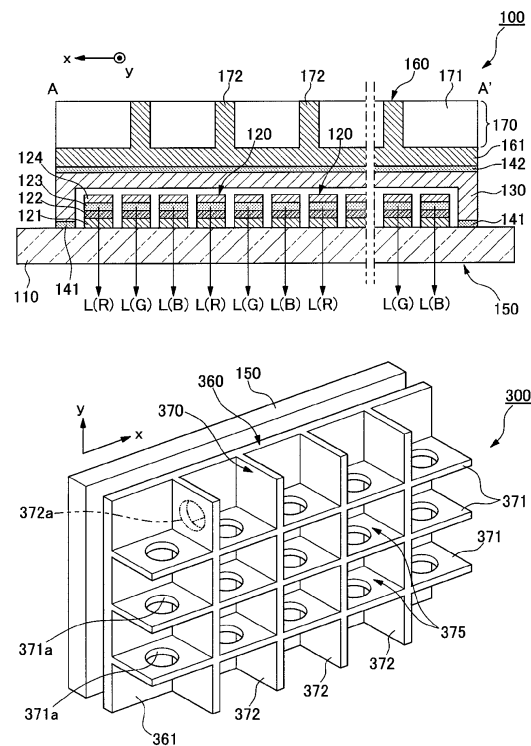
beams” with a “base plate (support substrate)” is also not excluded from the claimed invention, and that the appeal decision and the court decision were reasonable as a conclusion.

(2) Issues discussed 2: need for relief (Regarding the draft amendment proposed in the response to the inquiry with dispatch of the examiner's reconsideration report)

Regarding the draft amendment proposed by the demandant for appeal in the response to the inquiry with dispatch of the examiner's reconsideration report, which clarifies the point that the “reinforcement truss touches” the bottom surface of the bezel and the display panel, the majority of the members therefore reached a consensus that, even if an amendment according to this draft amendment had been made, the patentability would not have been satisfied and the original decision would have been maintained, and that it was reasonable that no opportunity for amendment prior to the appeal decision was given.



Claimed invention (Fig. 2)



Cited invention (Figs. 2 and 4)

### Case 14: Patent – Electricity 3

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800218 (Patent No. 4453017)
Court Docket Number	2013 (Gyo-ke) 10347
Title of Invention	Method for manufacturing a quartz crystal unit
Major Issues	Inventive step (interpretation of the claims, finding of the publicly-used manufacturing method, and decision as to whether the invention could be easily arrived)

#### 1. Outline of the case

This case deals with a trial for invalidation of the patent relating to a “method for manufacturing a quartz crystal unit” where the trial decision of patent maintenance (found to be invalidity dismissal) was revoked. The trial decision concluded that there are two different features between the corrected invention at issue and the publicly-used manufacturing method and that neither of the two different features could be easily arrived by the person skilled in the art. On the other hand, the court decision concluded that the different feature 1 does not exist and that the different feature 2 is only a matter that can be easily arrived by the person skilled in the art.

#### 2. Major issues discussed

(1) Issues discussed 1: Interpretation of “the process of determining B to satisfy the magnitude relationship A” described in the claims

Some members commented that the interpretations of the trial decision and the court decision were practically the same. On the other hand, other members commented that different claim interpretations were adopted. Some members also commented that interpretation of the claims including subjective intention should not be allowed, while other members commented that in some cases interpretation of the claims including design intent should be permitted.

(2) Issues discussed 2: Finding of the publicly-used manufacturing method from a publicly-used product

The majority of members commented that the explanation of the court decision about the judgment on the causal connection between the dimensions of the tuning fork, the groove and the electrode, and the magnitude relationship between  $M_1$  and  $M_2$  was not sufficient.

(3) Issues discussed 3: Determination of whether the different feature 1 could be easily arrived

Some members commented that the court decision, after finding the existence of the different feature 1, could have decided that the different feature 1 could be easily arrived. Others commented that since the motivation for the different feature 1 has not been proved, the different feature 1 could not be easily arrived.

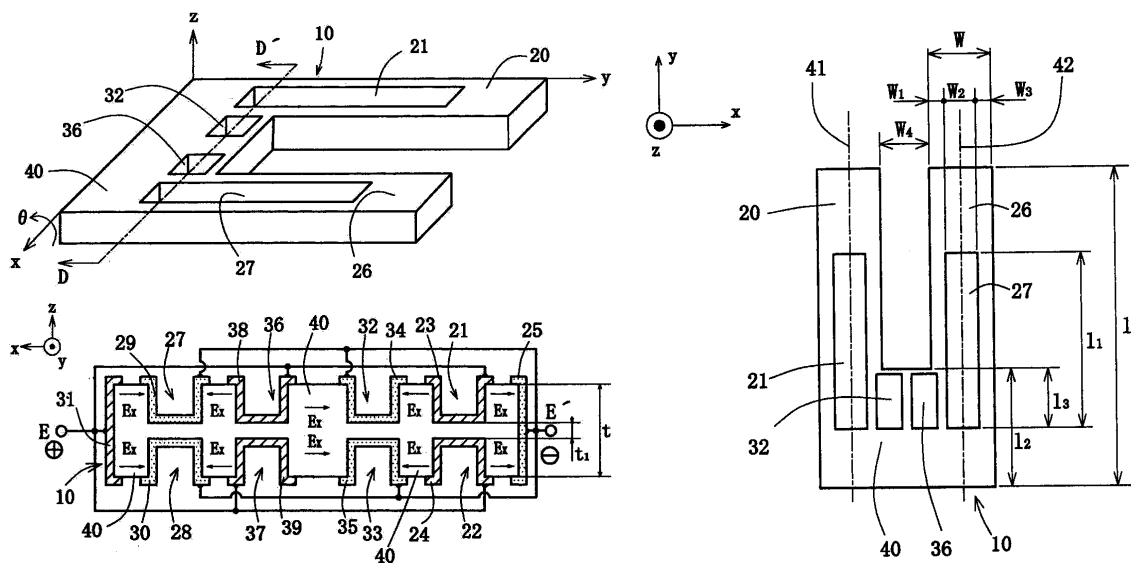
(4) Issues discussed 4: Determination of whether the different feature 2 could be easily arrived

(a) Changing the number of the grooves from 1 groove to 2 grooves

The majority of the members commented that the judgment of the court decision, that the relation of  $M_1 > M_2$  was kept when changing the number of the grooves in the tuning fork arm 1 groove to 2 grooves, was reasonable.

(b) Numerical limitation of the partial width

The majority of the members commented that it is not stated in the description that only the numerical limitation of the partial width has some effect, and it cannot be found that it has technical significance, therefore the judgment of the court decision was reasonable. Other members also commented that, if the numerical limitation on the ratio of the width and the thickness of the groove and the thickness of the tuning fork arm were specified in the claim, the court decision may have decided that the different feature 2 could not be easily arrived.



Patented invention (Figs. 4 to 6)

## Case 15: Design 1

JPO Docket Number	Trial for invalidation Invalidation No. 2012-880005 (Design Registration No. 1406548)
Court Docket Number	-----
Article to which the design is applied	Clip storage box for office use
Major Issues	View on different features in determining similarity of the designs, and Exception to lack of novelty

### 1. Outline of the case

This case deals with a trial for invalidation of the registered design relating to “clip storage box for office use” and the trial decision held that the registration of the design was invalidated on the ground of Article 3(2) of the Design Act.

### 2. Major issues discussed

#### (1) Decision on whether the registered design has an ordinary form

The lateral sides of the registered design are flat and ribs are placed on the lateral sides of Evidence A No. 1 Design. Regarding the determination of similarity of the designs, the lateral ribs of Evidence A No. 1 Design was decided to constitute an “extremely novel form.” On the other hand, regarding the decision on whether the ribs cannot be easily created, it was decided that placing the flat lateral sides in the registered design is an “ordinary form” and that replacing the lateral sides with flat ones could be easily arrived. Therefore, we examined whether it could be decided that the flat lateral sides of the registered design have an ordinary form and do not attract attention and that it is possible to determine that the registered design is similar to Evidence A No. 1 Design. As a result of the determination of similarity of both designs, we have come to a conclusion that it is difficult to view that the flat lateral sides constitute an ordinary form based only on one example of publicly known design (Evidence A No. 2) which lateral sides are flat although it is necessary to evaluate the different features from the cited design from the perspective of consumers.

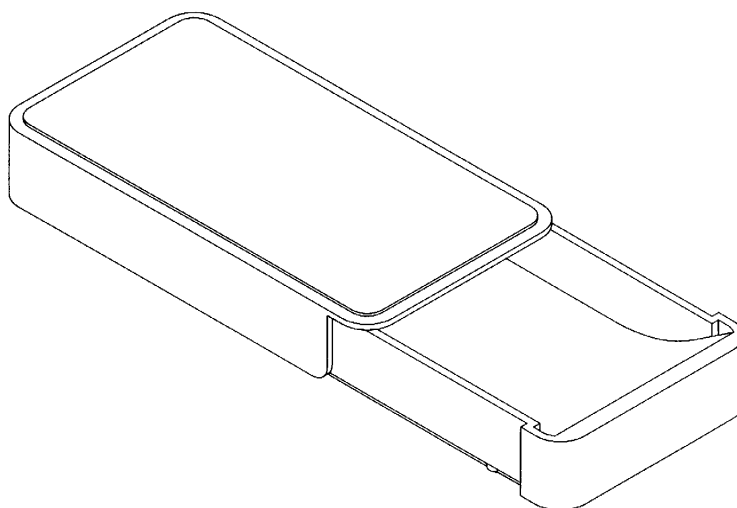
#### (2) Decision on whether or not there are ribs

The panel decided that the registered design and Evidence A No. 1 design are not similar on the ground that “grounds for decision are different from those of the related design” although there are other examples in which the principal design and the related design were decided to be similar because the only difference between them is the existence of ribs. We examined whether this judgment was reasonable. The registered design does not have ribs, while Evidence A No. 1

Design has ribs on its lateral sides extensively. Hence, some members commented that the decision by the panel that the two designs are not similar is appropriate since those ribs have a strong impact on aesthetic impression. On the other hand, other members commented that it would be fine to decide that the two designs are similar if the non-slip effect of those ribs, etc. is focused and the existence of ribs is considered as the existence of function. Thus, the members' opinions were divided.

### (3) Decision on exception to lack of novelty

As for exception to lack of novelty, the requirements for application of the provisions of Article 4(1) of the Design Act are stipulated in 31.1.2 of the Examination Guidelines for Design. According to the provisions of the Guidelines, it is enough to decide who is entitled to design registration of Evidence A No. 1 Design and to declare that "this design is not found to have been created by the demandee." However, the trial decision mentions similarity between Evidence A No. 1 Design and the registered design and this mention is considered to be unreasonable.



Design: Perspective view in an opened state

## Case 16: Design 2

JPO Docket Number	Trial for invalidation Invalidation No. 2013-880020 (Design Registration No. 1381318)
Court Docket Number	-----
Article to which the design is applied	Motorcycle wheel
Major Issues	Reasonableness of finding of the cited design, and Reasonableness of determination of similarity

### 1. Outline of the case

This case deals with a trial for invalidation of the design relating to “motorcycle wheel.” The demandee made an allegation that a method of determination of similarity of the designs is unlawful, even though the back and lateral sides constituting the cited design are invisible. In response, the Japan Patent Office decided that the demandee’s allegation has no reasons.

### 2. Major issues discussed

#### (1) Issue discussed 1: Reasonableness of finding of the cited design

We examined whether the decision, that finds the cited design by presuming the forms of invisible parts, by considering the characteristics of the field of the article and prior designs even though the back and lateral sides constituting the cited design are invisible, was reasonable.

We assume that “presumption” is not “evaluation/decision” of the design but “finding” of the design. It is impossible, therefore, to find a design without “presumption.” Unreasonable presumption results only in wrong finding. Hence, we consider that the question is whether the presumption is appropriate from the perspective of those skilled in the art and whether the finding is correct. Though the description of the trial decision does not proactively find unclear parts, the “cited design” may be described as “xxx is clear while yyy is unclear.”

The trial decision has only to find the cited design within the scope required in relation to the registered design. The finding within the required scope refers to the finding of common features and different features in comparison with specific features to the extent that allow us to determine similarity between the registered design and the cited design. Therefore, we think that that it is enough if such finding can be made.

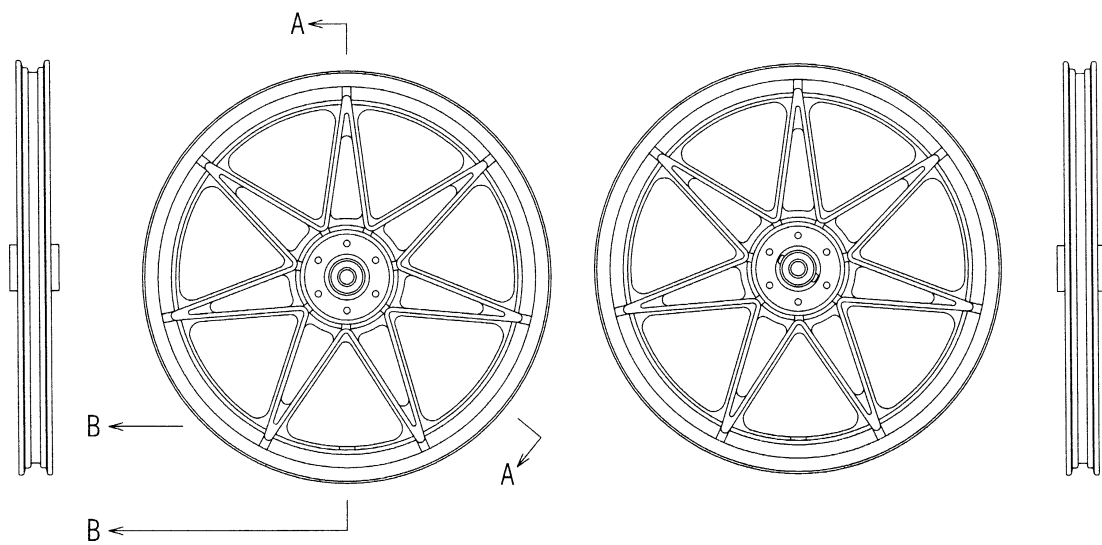
#### (2) Issue discussed 2: Reasonableness of determination of similarity

We examined whether the decision that the different features have little impact on determination of similarity between the designs was reasonable. The decision was made on the grounds that the back and lateral sides are invisible when the design is in use, they are usually



invisible parts, these parts relate to obscure details, etc.

From the perspective of consumers, we may consider that the different features should be decided not only “when goods are used” but also “when they are purchased” and that it is inappropriate to make a decision based on the grounds that “those parts become invisible” focusing only on the time when goods are in use. However, deciding the different features in consideration of only when goods are used does not cause a problem even if decision is not made in consideration of “when they are purchased” because consumers purchase goods thinking “their forms in use.” There is another way of description to limit consumers by explaining “for those engaged in installation” instead of “when goods are in use.” Furthermore, it is also possible to describe that the back and lateral sides are evaluated as “minor since they have an ordinary functional form” focusing on whether they constitute a “functional” part of the article.



Design: Left-side, front, rear and right-side view (from left to right)

## Case 17: Trademark 1

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2013-014191 (Trademark Application No. 2012-071381)
Court Docket Number	2014 (Gyo-ke) 10056
Trademark	(Refer to the next page.)
Major Issues	Mark used to distinguish relevant goods from others and whether the registered trademark falls under a “trademark consisting solely of a mark indicating the quality of service (content) in a common way

### 1. Outline of the case

In this case, the plaintiff made a revocation action against the appeal decision which dismissed the plaintiff’s request in the appeal against the examiner's decision of refusal. The court decision dismissed the plaintiff’s appeal on the ground that the appeal has no reasons, because the trademark at issue falls under Article 3(1)(iii) of the Trademark Act so that it is not entitled to be registered as a trademark.

### 2. Major issues discussed

#### (1) Criteria for deciding eligibility under Article 3(1)(iii) of the Trademark Act

Many people seem to support a theory that the recognition of consumers is not required to determine reasonableness of trial and appeal decisions held. On the other hand, some members commented that at least a possibility of recognition is required, because there is the Supreme Court decision of the “GEORGIA Case” (Decision made by the First Petty Bench on January 23, 1986, Collection of Supreme Court Decisions No.147, p.7).

Moreover, some members commented that this court decision only needed to hold that the trademark is an appropriate and necessary indication to indicate and describe such characteristics as the quality of any goods or services at the time of rendering this appeal decision and that it was enough to merely describe that “there is no need that consumers actually exist” regarding the issue of who recognizes the trademark, therefore, they commented that there was no need to include the future.

It should be noted that the members reached a consensus that services will not be actually necessary in response to the plaintiff’s allegation that the trademark at issue is a coined word and there are no examples in which it is used.

(2) Reasonableness of the finding and decision that the trademark is applicable to Article 3(1)(iii) of the Trademark Act

The members reached a consensus that it can be found that “ネットワークおまかせサポート” (hereinafter referred to as the “Network Customer Support”) is recognized by traders or consumers if there are any examples of use of “ネットワークサポート” (“Network Support”) and “おまかせサポート” (“Customer Support”), since people can nowadays understand what “Network Customer Support” means.

In response to the plaintiff’s allegation that the trademark at issue is uniformly integrated, some members commented that all words therein are clear and constitute a descriptive trademark when they are combined.

(3) Balance with examples of other registered trademarks

The plaintiff gives some examples of registered trademarks that have characters of “Support” or “Customer” and common designated services. Some members commented that the plaintiff should make an allegation by focusing on examples without distinctiveness, since some of those examples clearly have distinctiveness.

In conclusion, the members agreed that the decision made through the appeal proceeding was reasonable on the grounds that the decision for those examples of registered trademarks was made on a case-by-case basis at the time and they may not be necessarily registered at this moment, even if there are similar registrations, because circumstances are not always the same as they are now.



Trademark: “Network Omakase Support”  
(Network and Support in *katakana* characters and Omakase in *hiragana* characters)

## Case 18: Trademark 2

JPO Docket Number	Appeal against the examiner's decision of refusal Appeal No. 2013-011560 (Trademark Application No. 2012-020934)
Court Docket Number	2013 (Gyo-ke) 10342
Trademark	(Refer to the next page.)
Major Issues	Finding of features of the composite trademark, Distinctiveness, and Consideration of actual trade conditions

### 1. Outline of the case

In this case, whether the trademark at issue is similar to the cited trademarks (“**ライフストア**”, etc.) was disputed. The examination and the appeal decision affirmed similarity between the trademark at issue and the cited trademarks, and therefore refused the trademark application. The plaintiff filed an appeal against this decision, claiming that the trademark at issue is not similar to each of the cited trademarks (grounds for revocation). The court decision dismissed the plaintiff’s appeal on the ground that the trademark at issue and the cited trademarks are similar.

### 2. Major issues discussed

#### (1) Finding of features of the composite trademark (whether they may be observed separately)

The parts “B: MING” and “LIFE STORE” in the trademark at issue are different in terms of not only the size of characters, but also their layouts and colors. Therefore, there was no objection to the decision method used to render the court decision that the trademark is not found to be uniformly integrated and that the part “LIFE STORE” is decided to be a feature by extracting it separately. Moreover, there was no objection to the conclusion shown in the court decision. In this respect, it was pointed out that there is an example in which a trademark (Registration No. 5617880) consisting of the characters in single line “B: MING LIFE STORE” was registered.

Some members commented that, the part “LIFE STORE” may not be decided to be a feature if it is described additionally in small size, even if it is observed separately.

#### (2) Distinctiveness of the part “LIFE STORE”

The members have reached a consensus that the trademark’s distinctiveness cannot be denied on the grounds that “LIFE STORE” is a registered trademark and that we cannot recognize those characters as a common name based on the submitted evidence, even though the characters “LIFE STORE” do not have a strong distinguishing function vis-a-vis other marks.

On the other hand, the court could have made a decision that a part indicating the quality may not constitute a feature in finding the features of composite trademarks. Some members expressed

their opinions that the court decision was strict in this respect.

(3) Consideration of actual trade conditions

This case targets Class 25 “clothing” and envisages general consumers who lack attention. However, some members commented that, in the “RUNE case (a judgment made by the Intellectual Property High Court on June 11, 2015),” reasonable attention is found for consumers of the same category (“clothing”). In response to this opinion, other members commented that, though there is the limited number of consumers in particular industries, “general consumer” is a very broad concept so that attention may be found differently in individual cases. Moreover, it was pointed out that actual trade conditions tended to be revealed easily in the RUNE case, since it was a trial for invalidation (inter-parties trial).



Trademark: “B: MING LIFE STORE”

### Case 19: Trademark 3

JPO Docket Number	Trial for invalidation Invalidation No. 2012-890054 (Trademark Registration No. 5494262)
Court Docket Number	2013 (Gyo-ke) 10065
Trademark	(Refer to the next page.)
Major Issues	Features of the composite trademark, Well-knownness of the trademark, Risk of causing confusion about the source, and Unfair purposes

#### 1. Outline of the case

In this case, the plaintiff requested for a trial for invalidation on the grounds that the registered trademark falls under Article 4(1)(vii), (xi), (xv) and (xix) of the Trademark Act. However, the case was dismissed, since the panel of administrative judges found no reason. The plaintiff filed an appeal against the trial decision, claiming grounds for revocation against all grounds for the request. The court decided that the registered trademark falls under Article 4(1)(xi) of the Trademark Act so that it should be invalidated without evaluating other grounds.

#### 2. Major issues discussed

(1) Issue discussed 1: Appropriateness of the decision of applicability of the trademark to Article 4(1)(xi) of the Trademark Act

As for whether the part of the trademark can be observed separately, the question is if the meaning of “Raffine” could be recognized. There was no objection to the court decision deciding that only the part of “Raffine” is a mark for distinguishing the source.

Moreover, there was no specific objection to the decision that the word “Style” itself has low distinctiveness. However, some members commented that any mark consisting solely of “Style” may have distinctiveness depending on goods or services, for example, in the apparel industry.

(2) Issue discussed 2: Appropriateness of the decision of applicability of the trademark to Article 4(1)(xv) of the Trademark Act (trial decision)

The trial decision held, after finding that the plaintiff’s cosmetic brand is not well-known, that it is similar to the cited trademark. In response, some members questioned if prominence would affect the decision of similarity and if there is a possibility that Article 4(1)(xv) of the Trademark Act applies in cases where trademarks are not similar, even if the defendant made an allegation that, regarding the scope of application of item (xv), its trademark does not fall under item (xv) on the ground that trademarks are not similar.

When “risk of causing confusion” is decided, the scope of application of item (xv) is decided

comprehensively by taking into account well-knownness and prominence of the indication of another person and the degree of similarity between the trademark and the indication of another person. The members reached a consensus that the method of making decision used in this case has no problem, since the decision that “there is no risk of causing confusion” was made based not only on similarity between the plaintiff’s trademark and the cosmetic brand.

(3) Issue discussed 3: Appropriateness of the judgment of applicability of the trademark to Article 4(1)(xix) of the Trademark Act (trial decision)

The plaintiff made an allegation that the trademark falls under Article 4(1)(xix) because the defendant filed an application for trademark, although the defendant receive a letter of warning from the plaintiff. The trial decision held that no unfair purpose was found upon receipt of the letter of warning. All members agreed that the trial decision is reasonable on this point. On the other hand, some members commented that it may be difficult to find unfair purposes.

**Raffine**  
**Style** 

Trademark: “Raffine Style”

**RAffINE**

Cited trademark: “RAffINE”

## Case 20: Trademark 4

JPO Docket Number	Trial for invalidation Invalidation No. 2013-890038 (Trademark Registration No. 5506879)
Court Docket Number	2015 (Gyo-ke) 10025
Trademark	(Refer to the next page.)
Major Issues	Well-knownness of the trademark, Features of the composite trademark, Risk of causing confusion about the source, and Decision of similarity between trademarks

### 1. Outline of the case

In this case, the plaintiff requested for a trial for invalidation of registration of the trademark at issue. However, the trial decision to dismiss the case was rendered by the Japan Patent Office. In response, the plaintiff made an revocation action, claiming that the registered trademark, which is a composite trademark including the same characters as the trademark of “赤帽” (hereinafter referred to as “Akabo” (name of a transportation company)), falls under “a trademark which is likely to cause confusion” as prescribed in Article 4(1)(xv) of the Trademark Act. The above-mentioned trial decision was revoked in response to this revocation action.

### 2. Major issues discussed

#### (1) Finding of well-knownness and prominence of the plaintiff’s trademark “Akabo”

Although the word “Akabo (red hat)” is entered in dictionaries, it cannot be said that this word is known as a common name nowadays. However, the members reached a consensus that the trademark of “Akabo” is famous in the transportation industry so that most consumers recognize “Akabo” as services provided by the plaintiff.

Even if the trademark used by the plaintiff includes Roman characters and Japanese syllabary characters other than the trademark “Akabo,” it should not be distinguished in view of commonality of the meaning. In this case, some members commented that, there would not have been any problem even if prominence of the trademark “Akabo” had been found taking into account this trademark to be for the main use.

#### (2) Whether the fact that “Akabo” is not a coined word shall be emphasized in deciding under Article 4(1)(xv) of the Trademark Act

Whether a trademark is a coined word or an existing word is a matter of examination in deciding the prominence of the trademark. However, what is important is an actual trade condition regarding the use of the said trademark. Therefore, some members commented that whether the trademark is a coined or existing word does not have effect as long as it is actually well-known



and has the function for indicating source, while other members commented that a judgment should not be made based only on meanings of a word in dictionaries but it is necessary to examine in consideration of several points of view such as whether the word has a capability to distinguish or exclusive adaptability.

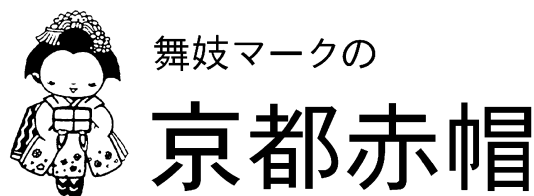
(3) Is only “Akabo” observed separately from the trademark at issue?

There were some comments that, if the general idea is that a geographical name does not have distinctiveness, it is natural to conclude that only “Akabo” is observed separately from the trademark at issue.

Moreover, in a trial decision, some members commented that a viewpoint of how consumers recognize the characters of “Akabo” and the organizational structure of the Akabo Group should have been examined more carefully.

(4) Eligibility for the trademark to Article 4(1)(xi) (possibility of similarity between trademarks)

While some members expressed their opinions that there would have been no problem in applying item (xi) as long as “Akabo” is a well-known trademark and the character part of “Akabo” is observed separately from “京都赤帽 (Kyoto-Akabo),” many other members commented that it would be easier to explain and more convincing if Article 4(1)(xv) of the Trademark Act which has a wider scope of application is applied in order to decide as in this court decision.



Trademark: “Kyoto-Akabo” (in *kanji* characters)



Trial and Appeal Practitioner Study Group  
REPORT 2016 (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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