

Trial and Appeal Practitioner Study Group
REPORT 2018
(Summary)

*Trial and Appeal Department
Japan Patent Office*



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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 Study 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 JPO administrative judges, including Chief Administrative Judges. To date, a total of 510 trial and appeal experts have studied 150 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 actively shares the outcomes of the study group by publishing English abstracts of the reports. Furthermore, in 2018, we made reports on the cases taken up by the Study Group at the Japan-China-Korea User Seminar held in Korea and China, as well as the Judicial Symposium on Intellectual Property/TOKYO 2018, in which judges, administrative judges, and others from the United States and Europe participated (Two cases were studied at each event). 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.

Yuji WADA

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

Twelve 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/appeal decisions or court decisions 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/inter-partes trial), conclusions of court decisions (dismissal of a request/revocation of appeal/trial decision), and discussion points.

Each group dealt with one to three cases.

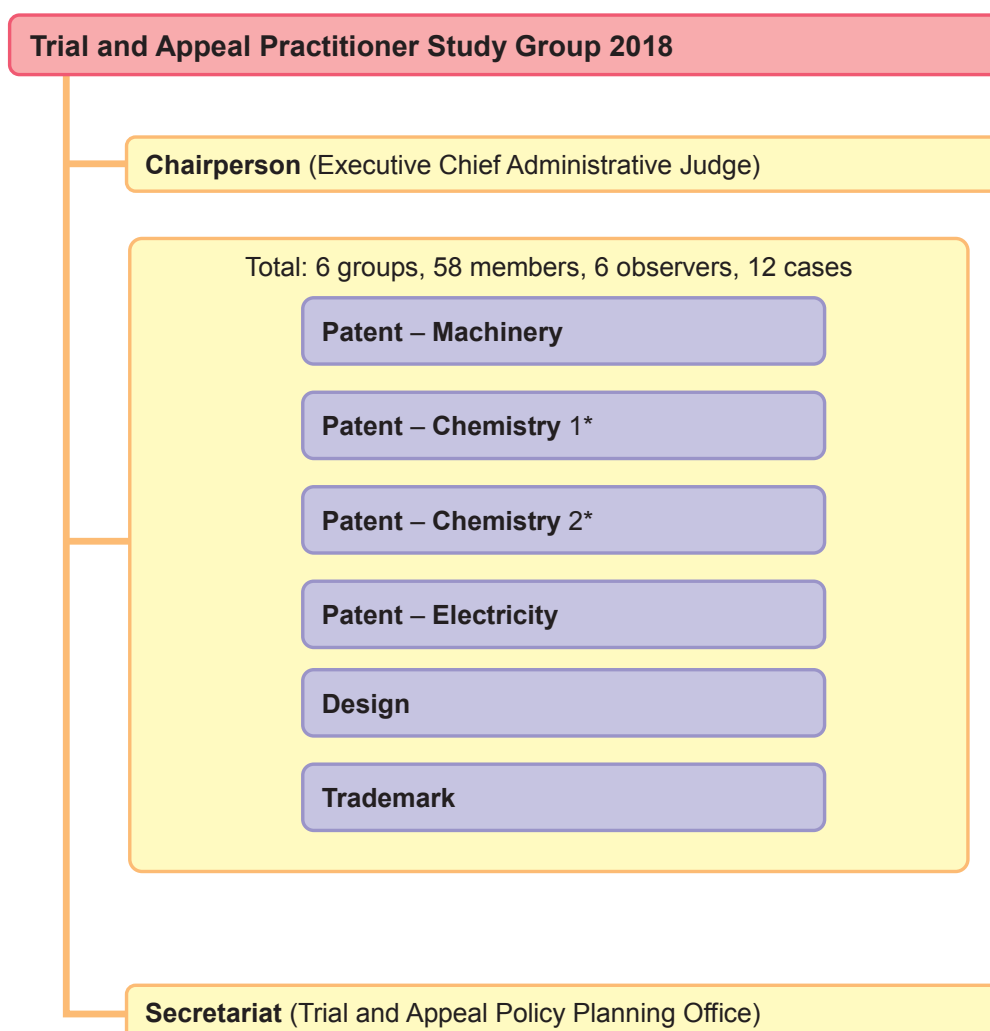
III. Study Method

The study of each case was separately conducted by each group. Each group dealt

with one to three cases holding two to five 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 1: General Chemistry

Patent – Chemistry 2: Pharmaceuticals and Biotechnology

Organization chart of the Trial and Appeal Practitioner Study Group 2018

Case 1: Patent – Machinery

JPO Docket Number	Trial for invalidation Invalidation No. 2014-800036 (Patent No. 5137153) (Dec. 17, 2015: trial decision to partially maintain the patent; revoked) (Jul. 5, 2017: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, December 26, 2016 2016 (Gyo-Ke) 10026 (JPO trial decision revoked)
Title of Invention	Grout injection method and device
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Independence of different features (technical matters); finding of well-known art

I. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning “grout injection method and device.”

In the trial decision, the JPO first approved the correction and then determined, in relation to the invention concerning Claim 1 (Invention 1 (invention of a method)), that the feature concerning Different Feature 2 could not have been easily arrived at by a person ordinarily skilled in the art and recognized involvement of an inventive step, and also dismissed the request for a trial for invalidation. As the basis of the determination, the JPO found that part of the feature concerning Different Feature 2 (the feature wherein “deciding a flow rate in advance, measuring ground resistance pressure”; hereinafter referred to as the “feature (a)”) is neither well-known art nor described in the cited documents. On the other hand, regarding the invention concerning Claim 2 (invention of a product), the JPO denied involvement of an inventive step and ruled that the patent should be invalidated (trial decision to partially invalidate the patent).

The plaintiff (demandant of the trial for invalidation) filed a revocation action against the trial decision in relation to the part of the trial decision partially maintaining the patent. The court determined, in relation to the aforementioned Different Feature 2, that an error in the finding of well-known art and an error in the

determination concerning non-obviousness as alleged by the plaintiff are well-grounded and revoked the trial decision that recognized involvement of an inventive step. The court held as follows after interpreting the significance of the aforementioned feature (a) as conducting a field test injection in advance of the construction by using the same grout (chemical liquid) to measure injection pressure (ground resistance pressure) with the decided flow rate in advance.

- (1) The aforementioned feature (a) concerning how to measure ground resistance pressure in a test injection and the remaining feature of Different Feature 2 concerning how to use the measured ground resistance pressure in the construction to conduct grout (chemical liquid) injection are respectively independent technical matters for which non-obviousness can be separately considered.
- (2) The aforementioned feature (a) is recognized as having been a well-known matter at the time of filing of the application for the patent. The remaining feature of Different Feature 2 is disclosed in the cited document (Evidence A No. 1).

2. Major issues discussed

- (1) Issue 1 (independence of the different features (technical matters))
 - A. First, the members were able to gain the following common understanding as a result of confirming the meaning of “independence”: Different features (or technical matters in a feature concerning one different feature) being independent of each other means that “non-obviousness can be separately considered,” as described in the court decision.
 - B. Next, the members were able to gain the following common understanding as a result of discussing what matters can affect whether the different features are independent of each other in light of judicial precedents.
 - (A) In general terms, independence between different features is discussed from the perspective of the problem to be solved by the invention and its solution in consideration of relevance between the features concerning the different features in terms of function and effect.
 - (B) Specifically, the following are possible examples of matters that can affect a determination of independence.
 - How abstractly or specifically is the problem to be solved by the

invention understood?

- To what extent do the statements or suggestions that shows relevance between the features concerning the different features in terms of function and effect exist in the scope of claims and description of the subject patent (or the subject application) or the cited documents?
- In a thought experiment in which the feature of the cited invention is altered in line with the feature of the invention to be discussed in relation to a different feature, is a determination concerning non-obviousness of another different feature affected?

C. Furthermore, the members discussed whether an effective allegation could be made regarding this case from the standpoint that the aforementioned feature (a) and the remaining feature of Different Feature 2 are not independent of each other, and agreed that it is difficult to make such allegation.

(2) Issue 2 (finding of well-known art)

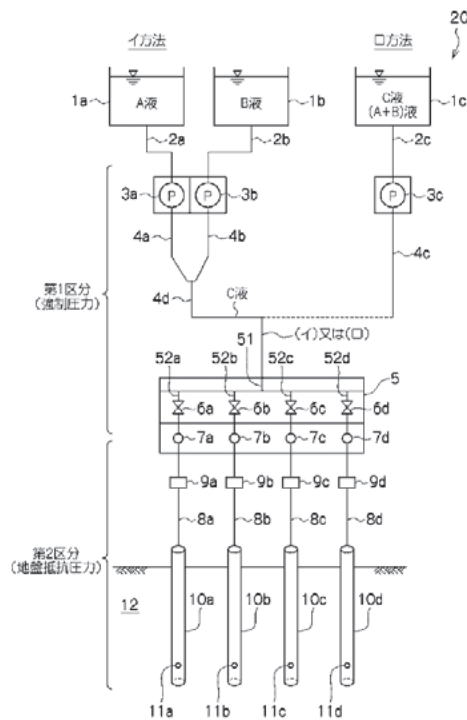
The court seems to have found the aforementioned feature (a) as one well-known art based on multiple well-known matters that are found from a group of well-known examples in the absence of evidence that explicitly shows the aforementioned feature (a) in block. Based on this viewpoint, the members discussed whether finding of well-known art in the court decision is characterized as such. In conclusion, the members agreed that the multiple well-known examples independently tend to lack explicitness or that it is appropriate to understand that those multiple well-known examples complement each other in relation to the parts that are only implicitly shown.

(3) Issue 3 (other issues discussed)

A. The members discussed whether the party who denies involvement of an inventive step in Invention 1 can make an auxiliary allegation from the standpoint that the invention is inferior to the cited invention in function and effect, that is, that the invention has the aspect of a “backward invention.” Some commented that such auxiliary allegation may be made as a counterargument against an allegation that cause or motivation for applying well-known art is not sufficient on the premise of establishment of reasoning

denying involvement of an inventive step.

- B. In addition, Claim 2 concerning the “grout injection device” (invention of a product), that is not subject to the action, contains a statement about a method that falls under the aforementioned feature (a). The members discussed whether the statement can be understood as a limitation on the invention of a product (the JPO’s answer was “no”). As a result, the members concluded that the statement could be understood as a limitation on the invention of a product depending on the statements in the description.
- C. Finally, the members discussed Invention 1 from the perspective of the support requirement.



Patented Invention [Fig. 1]

イ方法	Method A
ロ方法	Method B
A液	Liquid A
B液	Liquid B
C液(A+B)液	Liquid C (A+B)
第1区分(強制圧力)	Section 1 (compulsive pressure)
第2区分(地盤抵抗圧力)	Section 2 (ground resistance pressure)
(イ)又は(ロ)	(A) or (B)

Case 2: Patent – Machinery

JPO Docket Number	Trial for invalidation Invalidation No. 2010-800162 (Patent No. 3138613) (Apr. 14, 2011: trial decision to invalidate the patent; the case remanded) (Jan. 24, 2012: trial decision to maintain the patent; revoked) (May 29, 2015: trial decision to invalidate the patent; revoked)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, October 7, 2011 2011 (Gyo-Ke) 10168 (the case remanded) Court decision of the IP High Court, December 25, 2012 (the first court decision) 2012 (Gyo-Ke) 10082 (JPO trial decision revoked) Court decision of the IP High Court, March 23, 2016 (the second court decision) 2015 (Gyo-Ke) 10127 (JPO trial decision revoked)
Title of Invention	Laser machining apparatus
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Suitability of well-known example from the perspective of the technical field; so-called “easiness on easiness” (a case where multiple steps should be made in one point to arrive at the claimed invention)

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning “laser machining apparatus.”

In the first trial decision, the JPO approved the first request for correction and concluded that the patent was invalidated on the grounds of lack of an inventive step. A revocation action against the trial decision was filed, but a request for a trial for correction was filed after the filing of the revocation action. Therefore, the case was remanded to the JPO under the provisions of the Patent Act before the amendment. In the second trial decision, the JPO approved the second request for correction and determined that the matter newly added by the request for correction (Different Feature 3) could not have been easily arrived at by a person ordinarily skilled in the

art. Based on this determination, the JPO concluded that the patent is maintained. In the first court decision on this revocation action against the second trial decision, the court approved the reason for revocation alleging an error in the finding of the aforementioned Different Feature 3 and revoked the trial decision. After that, in the third trial decision, the JPO approved the third request for correction and determined that features pertaining to all the different features, including the different feature pertaining to a matter newly added by the request for correction (Different Feature 4), could have been easily arrived at by a person ordinarily skilled in the art based on the cited invention and well-known art. Based on this determination, the JPO concluded that the patent is invalidated.

In the second court decision (this court decision) on the revocation action against the third trial decision, the court determined as follows regarding the aforementioned Different Feature 4: The well-known example (Well-Known Example 11) that the JPO used as a ground for affirming non-obviousness in the third trial decision cannot be immediately considered to be one that shows art that is well-known to persons ordinarily skilled in the art pertaining to the cited invention because it clearly differs from the cited invention in terms of the technical field; in addition, it cannot be considered as disclosing or suggesting the feature of the invention pertaining to Different Feature 4. Based on this determination, the court revoked the third trial decision ruling that the invention lacks an inventive step.

2. Major issues discussed

(1) Issue 1 (suitability of the evidence cited as a well-known example from the perspective of the technical field)

A. First, the members discussed how specific field is generally understood as the “technical field” of a well-known example before considering commonality in the technical field.

Some members commented that this point may be affected by the degree to which the “problem” to be solved by the related technology is unique to the technical field, and the members came to share this understanding.

B. Next, the members discussed the issue of whether the technical field of the primary cited invention or that of the patented invention is compared with the technical field of a well-known example when considering whether well-known art can be found from the well-known example in light of the holding

in this court decision related to the aforementioned Well-Known Example 11.

First, some members pointed out that although the technical field of the invention and that of the primary cited invention are the same in many cases, if those technical fields differ, involvement of an inventive step is unlikely to be denied unless the problems to be solved by those inventions have a certain degree of commonality and a well-known example in the technical field corresponding to the problems that have such commonality is used. Secondly, some pointed out that how unique to the technical field the problem to be solved by the invention or the primary cited invention is can affect this issue, and the members came to share this understanding. Thirdly, the members agreed that what technical field the technical field of a well-known example is compared to may also be based on the statements and suggestions in the primary cited document.

(2) Issue 2 (so-called “easiness on easiness”)

The members discussed “easiness on easiness” in light of judicial precedents, focusing on the fact that the plaintiff (patentee) alleged that the defendant’s allegation falls under “easiness on easiness.”

A. First, the members discussed whether the defendant’s allegation can be considered as “easiness on easiness.”

The members agreed as follows: The logic of the plaintiff’s allegation of “easiness on easiness” covers multiple different features, and therefore, this case differs from typical “easiness on easiness” wherein different secondary cited documents are applied to one different feature in two steps; however, if different features are related to each other, this case also can fit into the framework of “easiness on easiness.”

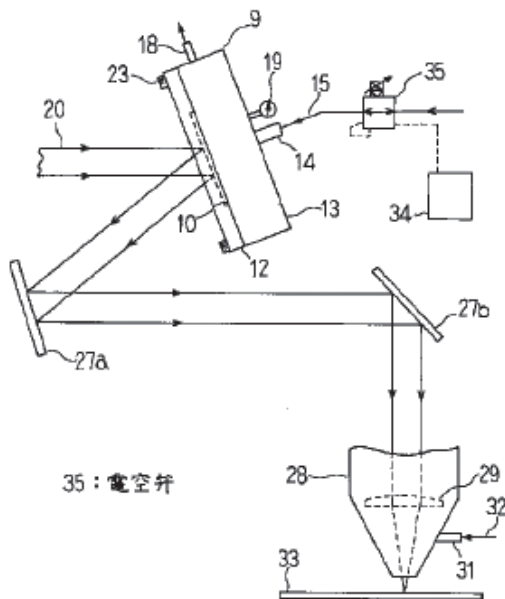
B. Next, the members discussed what arguments are possible from the perspective that this case does not fall under “easiness on easiness” and agreed that the following arguments are probably possible: (i) The aforementioned multiple different features are independent of each other, and non-obviousness can be separately considered with respect to each different feature (argument that is considered the most effective); (ii) Even if those different features are related to each other, the feature pertaining to one different feature could have been easily arrived at by a person ordinarily

skilled in the art, and the feature pertaining to the other different feature is a mere matter of workshop modification.

C. Furthermore, regarding “easiness on easiness,” the members discussed to what matters the parties must pay attention. The members agreed that a person who denies involvement of an inventive step should keep from falling into a pattern that is likely to fall under “easiness on easiness,” in which a change in the second step is made to solve a problem that arose from a change in the first step when reasoning non-obviousness.

(3) Issue 3 (possibility of an effective allegation)

The members discussed the possibility of an effective allegation, including whether there were other effective allegations that can be made by the party that affirms non-obviousness of the aforementioned Different Feature 4 (or denies involvement of an inventive step), and achieved a certain direction.



- 10: Curvature-variable reflecting mirror (laser beam reflecting member)
- 14: Air inlet
- 18: Air outlet
- 35: Electropneumatic valve

Patented Invention ([Fig. 2])

Case 3: Patent – Chemistry 1

JPO Docket Number	Trial for invalidation Invalidation No. 2014-800168 (Patent No. 4961115) (Jun. 28, 2016: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Aug. 30, 2017 2016 (Gyo-Ke) 10187 (dismissal of a request, JPO trial decision maintained)
Title of Invention	Reversibly thermochromic water-based ink composition for writing utensil and writing utensil containing the same
Major Issues	The Patent Act Article 36 (6) (ii) (clarity requirement)
Points	Significance of the average particle size, methods of measuring thereof and the clarity requirement

1. Outline of the case

This is a case relating to a trial for patent invalidation mainly focusing on the clarity requirement as its major issue.

In the trial decision, the JPO determined that the patented invention is unclear on the grounds that the particles of “microcapsule pigments” with the “average particle size between $0.5\ \mu\text{m}$ and $2.0\ \mu\text{m}$ ” cannot be specified. That is because; although it is not always correct that the difference in the values of the average particle sizes would never be brought about by the difference in the methods of measuring such values, the description attached to the application does not provide a method of measuring average particle sizes; such measuring method is not clearly stated even in light of common technical knowledge, etc.; and it is not possible to conclude that the “microcapsule pigments” are “roughly globular shape.”

In the court decision as well, the court stated that the patented invention could include non-spherical microcapsule pigments and, accordingly, it dismissed the request by the plaintiff against the JPO’s decision. The court found that the patented invention should be said to be unclear on the grounds that the significance of the “average particle size between $0.5\ \mu\text{m}$ and $2.0\ \mu\text{m}$ ” cannot be specified since the definition of the particle size concerning the “average particle size” of the patented invention is unclear even in light of the statement in the description, etc. and the

common technical knowledge.

2. Major issues discussed

(1) Issue 1 (Conditions that define the clarity of the average particle size)

The members reached a consensus that the “average particle size” can be said to be clear if: any specific definition or method of measuring the size is stated in the description attached to the application in a manner that the “average particle size” is defined unambiguously so as to make the definition become clear to a third party; or any specific definition or measuring method is clearly adopted for the method of measuring the “average particle size” as common technical knowledge in the given technical field.

(2) Issue 2 (Necessity for stating the definition of the average particle size and a measuring method thereof in the case where the microcapsule pigments are in the roughly globular shape)

It is a well-known fact that, even if “microcapsule pigments” are in the roughly globular shape, a particle size of the pigments may vary depending on the method of measuring the particle. Accordingly, the members reached a consensus that it is necessary to state the definition of the “average particle size” and a measuring method thereof in the description in order to be found that the significance of the “average particle size” is clear.

Meanwhile, the members basically reached a consensus that, even if a definition of the “average particle size” and a measuring method thereof are not stated in the description, such statement are unnecessary if it is an obvious practice to use a specific definition and measuring method in terms of such particle size as the common technical knowledge in the said field.

(3) Issue 3 (Possibility of maintaining the patent in the case where the shape of microcapsule pigments are corrected to the roughly globular shape)

Some members pointed out that the description merely states that “the said microcapsule pigments may have a circular cross-section ... ” and that the correction specifying the microcapsule pigments being “in the roughly globular shape” is not acceptable based on the above statement.

Meanwhile, others stated that the “microcapsule pigments” of the patented

invention include those that are “in the roughly globular shape” as the more specific concept and that the correction is acceptable.

Furthermore, many showed a view that if the correction is acceptable and if the “average particle size” is defined unambiguously, the patent could have been maintained, while others said that the patented invention is still unclear.

- (4) Issue 4 (Possibility of maintaining the patent in the case where the method of measuring the average particle size is stated)

The members basically reached a consensus that the important element for a third party is whether or not the patent is clearly stated, and the patent may satisfy the clarity requirement as long as a method of measuring the average particle size is defined unambiguously, the results of measurement by the method are reproducible and the numerical values of the average particle size are defined.

Meanwhile, multiple members pointed out that the invention may violate the support requirement if no specific statement is provided in the embodiment concerning the average particle size measured by the method.

- (5) Issue 5 (Interpretation of the terms and expressions of the patent by taking into consideration the statement shown in other gazettes filed by the same patent right holder)

In the court decision, the court determined on the shape of the “microcapsule pigments” by taking into consideration the statements of multiple publications of (unexamined) patent applications filed by the plaintiff. Concerning this, the members held discussions on whether or not the interpretation of the terms and expressions of the patent by taking into consideration the statements of other publications of patent applications filed by the plaintiff is appropriate.

As the patent and these other publications of (unexamined) patent applications are different applications, it is generally considered inappropriate to interpret the terms and expressions of the patent by taking into consideration other publications of (unexamined) patent applications. However, the members agreed that there would be no problem in taking into consideration such other applications as common technical knowledge (or objective facts).

(6) Issue 6 (Ex officio examination in trial decision)

In this trial for patent invalidation, in addition to the examination of the evidence filed by the defendant, the administrative judges in charge also examined the evidence ex officio in the same manner. Concerning this, the members held discussions on whether or not the administrative judges' ex officio examination was appropriate.

The members reached a consensus that, since the trial and appeal adopt the ex officio principle, it is appropriate for the administrative judges to examine the patent ex officio as a complementary effort based on the viewpoint of public benefits.

However, some members stated that the administrative judges should provide the plaintiff with an opportunity to state objections concerning the ex officio examination from the standpoint of securing the appropriate procedures for the plaintiff.

Case 4: Patent – Chemistry 1

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2013-4177 (Patent Application No. 2008-506508) (Jul. 25, 2014: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision; appeal decision revoked) (Jun. 13, 2016: 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, Jul. 30, 2015 2014 (Gyo-Ke) 10270 (JPO appeal decision revoked)
Title of Invention	Compositions comprising probiotic and sweetener components
Major Issues	The Patent Act, Article 29 (2) (inventive step)
Points	Findings of the cited invention, and finding of the identical and different features

1. Outline of the case

In the first appeal decision, the JPO found that in the amended invention, the bacteria “comprises strains isolated from resected and washed canine or feline gastrointestinal tract” whereas, in the cited invention disclosed in publication 1, the bacteria does not comprise those strains (different feature 1). However, the JPO found that these inventions have other features in common, and determined that a person ordinarily skilled in the art could have easily arrived at the idea of adopting the structure concerning said different feature 1 based on the cited invention, the matters stated in publication 2, and well-known matters. The JPO dismissed the amendment due to violation of the requirements for independent patentability and made a decision to maintain the examiner's decision of refusal by reason that the claimed invention before the amendment lacked an inventive step.

The court revoked the JPO appeal decision, holding that the JPO failed to find the amended invention and the cited invention to have different features A' and B, in addition to different feature 1, but erroneously found them to be identical features.

After the case was remanded, the JPO notified the appellant of the reasons for refusal of the request including the lack of an inventive step in the amended

invention (by finding a different cited invention from publication 1, which had previously been referred to, and finding the identical and different features between these inventions). Since the appellant did not respond to this notice, the JPO rendered another appeal decision to maintain (the second appeal decision), which later became final and binding.

2. Major issues discussed

- (1) Issue 1 (Factors that caused the JPO to make errors in finding the cited invention and the identical and different features when rendering the first appeal decision)

Some members commented that despite the amendment made at the time of filing the appeal which specifically restricted both probiotic and sweetener components, the JPO might have been somewhat influenced by the finding of the cited invention, which was made against the claimed invention before the amendment during the previous examination.

While the JPO found the cited invention using generic concepts, “probiotic” and “prebiotic,” the specific components of the claimed invention were enumerated as example in publication 1 as more specific concepts relevant to these generic concepts. Other members pointed out that this might have caused the JPO to make errors in finding the identical and different features between these inventions.

The members reached a consensus that multiple inventions may be disclosed in a single cited document and which one of them should be selected as a cited invention is a significant issue, and hence, it is important to find the cited invention by going back to the essential nature of the claimed invention as disclosed in the description as well as grasping the purpose, structure and effect of the claimed invention.

- (2) Issue 2 (Appropriateness of the findings of the cited invention and of the identical and different features when rendering the second appeal decision)

The members reached a consensus that even when they consider the scope of binding force of the court decision, they found no problem with the second appeal decision in which the JPO found another cited invention based on publication 1 and determined the identical and different features between this

new cited invention and the claimed invention.

The members also reached a consensus that it was appropriate for the JPO to have considered the technical meaning of the “sweetener component” in the claimed invention and then conducted a comparison between the “sweetener component” in the claimed invention and “sugar” in the new cited invention.

However, several members commented that although the cited invention was described in the claims in publication 1 as foodstuff containing “sugar,” it cannot be said even in light of other statements that the use of “sugar” in a “dairy treat” was clearly stated in publication 1, and therefore, the JPO should not have found this as an identical feature between the cited invention and the claimed invention, but should rather have found it as a different feature between them and considered the existence of an inventive step in the claimed invention.

The members reached a consensus that the JPO’s conclusion per se that denied the existence of an inventive step in the claimed invention based on the statement in publication 1 and well-known art is appropriate.

- (3) Issue 3 (Approach of finding a different cited invention from publication 1, which had previously been referred to, and finding other identical and different features between this new cited invention and the claimed invention)

A majority of the members commented that the replacement of the cited invention with a new one could not have been a surprise to the appellant, on the following grounds: (1) since the same publication was referred to as a cited invention through the examination phase and the appeal proceedings, the appellant could have fully anticipated that the administrative judge panel might find another cited invention by referring to the statements in the cited document that were different from those referred to by the examiner; and (2) in view of the prosecution history, the appellant must have had sufficient opportunities to argue by taking advantage of several opportunities to submit an amendment during the examination phase.

On the other hand, some members expressed an opinion that even though the document cited in the examination phase was also cited in the appeal proceedings, if the cited invention found by the panel is different from the one found by the examiner, finding identical and different features and the theoretical structure of denying the existence of an inventive step should also differ from

those employed by the examiner. Since the appellant would need to make a different counterargument accordingly, the appellant should be given an opportunity to make a counterargument against the new theoretical structure employed by the panel, they suggested. They further suggested that it should have been difficult for the appellant to concretely grasp the cited invention as found by the examiner just from the reasons for refusal given by the examiner in this case, and hence the panel should have notified the appellant of the reasons for refusal in order to clarify the cited invention subject to proceedings.

The members reached a consensus that, in order to evaluate whether or not the replacement of the cited invention could be a surprise to the appellant, it is important to objectively determine whether or not the appellant accurately grasp the point in question. Therefore, in view of the process of reaching an appeal decision, the panel should determine whether or not the appellant has made a counterargument while accurately understanding the intention of the reason of refusal rendered by the examiner or the panel, and whether or not the appropriate procedures have been secured for the appellant.

Case 5: Patent – Chemistry 2

JPO Docket Number	Trial for invalidation Invalidation No. 2013-800139 (Patent No. 2749247) (Apr. 15, 2015: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, November 16, 2016 2015 (Gyo-Ke) 10166 (JPO trial decision maintained)
Title of Invention	Pharmaceutical formulations containing benzothiophenes
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Determination of different features, remarkable effects of a pharmaceutical invention

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning “pharmaceutical formulations containing benzothiophenes.”

With regard to different features 1 and 2 between the corrected invention and the cited invention, the JPO determined that different feature 1 could have been easily achieved by a person ordinarily skilled in the art based on the cited invention and the common general technical knowledge available as of the priority date, while recognizing different feature 2 as a characteristic that can be found in the cited invention as well, and determined that the corrected invention 1 should be invalidated under the Patent Act Article 29 (2). The court dismissed the request of the plaintiff (demandee of the trial for invalidation), on the grounds that both different features 1 and 2 between the corrected invention 1 and the cited invention could have been easily achieved by a person ordinarily skilled in the art based on the cited invention and the common general technical knowledge available as of the priority date.

2. Major issues discussed

- (1) Difference of the methods of determining the matter specifying the invention “the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen” (different feature 2) between the trial decision and the court decision

The JPO determined that the fact “the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen” is a characteristic that pharmaceutical

formulations containing raloxifene as an active ingredient inherently possess, and the pharmaceutical formulations containing raloxifene as an active ingredient, which is contained in the cited invention, also has this characteristic. On the other hand, the court determined, based on evidence, that a person ordinarily skilled in the art could have easily arrived at the idea that if raloxifene, which is contained in the cited invention, is used in a pharmaceutical formulations for treating or preventing human osteoporosis, they would have a lower risk of uterine cancer than those containing tamoxifen. While the JPO regarded different feature 2 as not being a substantial difference, the court determined that it could have been easily arrived by a person ordinarily skilled in the art. The determination methods employed in the trial decision and the court decision on this feature thus differed. The members discussed this issue, focusing on the following points A to C.

A. Difference of determination methods between the trial decision and the court decision

In the discussion on the difference of determination methods between the trial decision and the court decision, some members commented that they found the JPO's determination to be more appropriate and more convincing. Other members pointed out that the court did not mean to deny the JPO's determination method, but might have tried to provide a more general reasoning because evidence showed that it was possible to predict that raloxifene would have a lower risk of uterine cancer than tamoxifen.

B. Matter specifying the invention: "the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen"

In the discussion on the meaning of the matter specifying the invention "the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen," some members commented that this matter merely describes the effect of corrected invention 1 as a pharmaceutical invention having fewer side effects and does not limit the use of corrected invention 1. Other members commented that irrespective of whether the matter specifying the invention "the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen," is described in the claim or not, the JPO should take the following effect into consideration as a factor in support of an inventive step of the invention if the effect of the claimed invention, having the lower risk,

could be recognized as remarkable. On the other hand, there was also a comment that even if the effect of having the lower risk is remarkable, a person ordinarily skilled in the art could have still easily arrived at an invention utilizing raloxifene as medicine for treating or preventing human osteoporosis.

- C. An alternative expression to the matter specifying the invention “the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen”

In response to the comment by multiple members that the matter specifying the invention “the pharmaceutical formulation has a lower risk of uterine cancer than tamoxifen” does not limit the use of corrected invention 1, the members discussed what would be an alternative expression to the matters. Some members commented that the usage, dosage and subject could be expressed. Other members pointed out that if the usage, dosage and subject are expressed as matters specifying the invention, the determination method in the trial decision would never be employed and it would be necessary to employ the determination method in the court decision.

(2) Remarkable effects of a pharmaceutical invention

A pharmaceutical invention is found to involve an inventive step if it has remarkable effects beyond the scope that is predictable based on the state of the art at the time of the filing. Therefore, the members discussed effects of a pharmaceutical invention that should be taken into consideration in support of an inventive step.

Major remarkable effects of a pharmaceutical invention are an “effect of different nature (from that of prior art)” and “synergistic effect.” Some members pointed out that there were cases in which the existence of an inventive step was denied on the grounds that, even if the effect of an invention could be deemed to be a “synergistic effect,” it was within the scope that the invention was expected to have. On this point, others commented that the existence of an inventive step would unavoidably be denied if the invention has a mere “additive effect,” whereas an inventive step should be found if the invention has effects including a “synergistic effect.” There was still a different opinion that in the case of a combination of two active ingredients, “additive

effect” itself can be considered unexpected from a technical perspective, which could contribute to an inventive step.

Case 6: Patent – Chemistry 2

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800093 (Patent No. 2664261) (Oct. 4, 2013: dismissal of a request, trial decision to maintain the patent; revocation of trial decision) (Jul. 7, 2017: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Feb. 19, 2015 2013 (Gyo-Ke) 10311 (revocation of JPO trial decision)
Title of Invention	Animal model for human disease
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Determination of different features

1. Outline of the case

This is a case relating to a trial for invalidation of a patent concerning “animal model for human disease.”

In the first JPO trial decision (hereinafter the “JPO trial decision”), the JPO accepted corrections, and determined that the request for a trial shall be dismissed on the grounds that the invention cannot be considered to be incomplete, that it cannot be considered to fail to meet the enablement requirement, the support requirement, and the description requirement, and that it cannot be considered to lack novelty or an inventive step. A revocation action against the trial decision was filed. In the court decision, the court revoked the JPO trial decision by holding that, regarding reason for revocation 5 (lack of novelty or an inventive step based on Evidence A No. 1 invention) among the reasons for revocation 1 to 8, a person ordinarily skilled in the art could have easily arrived at the idea of applying Evidence A No. 3 invention and Evidence A No. 4 invention to the nude mouse in Evidence A No. 1 invention and creating a non-human animal model for human neoplasm metastasis.

2. Major issues discussed

- (1) Difference of determination between the JPO trial decision and the court decision in the matters used to specify the invention, “a non-human animal model for the

metastasis of human neoplastic disease” (different features)

Regarding the different features between invention 1 and Evidence A No. 1 invention (non-human model animal for human neoplasm metastasis), the JPO did not find it easily-conceivable, while the court did. Regarding this point, the members had a discussion from the following perspectives A to C.

A. Finding of common general technical knowledge

There is a difference between the JPO trial decision and the court decision in finding of the common general technical knowledge as of the priority date of the application, which makes a basis for their determination. In summary, the JPO trial decision states that there is no common general technical knowledge that infiltration necessarily results in metastasis while the court decision states that there is common general technical knowledge concerning the cancer advancement process that infiltration would increase the risk of metastasis. The members held a discussion about the common general technical knowledge found in the JPO trial decision and the court decision. Some members pointed out that evidence which made a basis in finding common general technical knowledge must have been different between the JPO trial decision process and the court decision process, probably because the plaintiff (the demandant of the trial for invalidation) submitted new evidence related to common general technical knowledge to the court. On the other hand, it was also noted that the common general technical knowledge found by the JPO, which is a technical government agency, should be respected to the extent possible when making a court decision.

In the court decision, the court found it is easily arrived on the grounds that there was common general technical knowledge that “the risk for metastasis is also high.” Some members questioned the reasonableness of the court decision which relied on such common general technical knowledge which held uncertainty. In this regard, other members argued that it is not necessary to expect 100% certainty in the field of biotechnology for a person ordinarily skilled in the art to get motivated and that a certain degree of certainty would be enough. Some other members pointed out that, since this is a case concerning a phenomenon that occurs inside the body, the technical closeness between the primary cited invention and the secondary cited invention is important when determining whether a person ordinarily skilled

in the art could be motivated or not.

B. Determination of the different features

The court determined that a person ordinarily skilled in the art could have easily arrived at the idea of creating a “non-human animal model for human neoplasm metastasis” from Evidence A No. 1 invention on the grounds that it was easily predicted that further advancement of infiltration over time would cause metastasis with high possibility. The members discussed whether that determination was appropriate. Some members argued that, even if it was possible to “predict that further advancement of infiltration over time would increase the risk of metastasis,” it does not necessarily mean that they would have applied the animal model in Evidence A No. 1 invention to human neoplasm metastasis. Other members argued that, since the description at issue does not provide any specific evidence to prove the occurrence of metastasis, the “non-human animal model for metastasis” of the patented invention should be considered to be nothing more than an animal model that “might have risk of metastasis after infiltration occurred over time.” They argued that, if the patented invention stays at such level, it is reasonable for the court to determine that the invention does not involve an inventive step.

C. Embodiment presented in the description

The members had a discussion concerning the fact that the description at issue does not present any embodiment where metastasis was actually confirmed. Although the description only confirms the occurrence of infiltration, the JPO determined in the trial decision that reason for invalidation 1 (violation of the main paragraph of the Patent Act Article 29 (1)) and reason for invalidation 3 (violation of the support requirement) are groundless. Therefore, the JPO trial decision can be presumed to have determined those reasons for invalidation by complementing “common general technical knowledge” that the embodiment of “infiltration” can be associated with the occurrence of “metastasis,” in other words, by complementing “common general technical knowledge” that metastasis will occur after infiltration. Some members pointed out that, if so, the JPO trial decision could have adopted the “common general technical knowledge” when examining Evidence A No. 1 invention, which proves the occurrence of infiltration, and could have determined that metastasis will occur after

infiltration.

Some members commented as follows: if it can be considered that metastasis can occur in the case of the invention but not in the case of Evidence A No. 1 invention, there must be some cause for this difference. However, it doesn't seem to be the case, because the description at issue is silent about such cause.

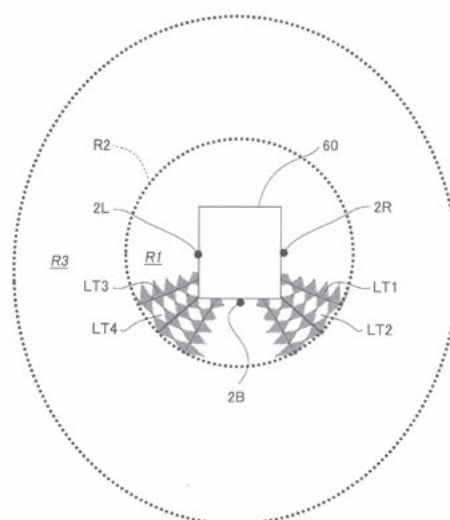
Case 7: Patent – Electricity

JPO Docket Number	Appeal against an examiner’s decision of refusal Appeal No. 2015-22933 (Patent Application No. 2014-6965) (Oct. 17, 2016: board decision maintaining 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, Sep. 25, 2017 2016 (Gyo-Ke) 10264 (JPO appeal decision maintained)
Title of Invention	Excavator
Major Issues	The Patent Act Article 29 (2) (inventive step: finding of the cited invention, cause or motivation, etc.)
Points	Finding of the content of the document illustrated as publicly known art in the cited document

I. Outline of the case

This is a revocation action against an appeal decision of the JPO that dismissed an appeal against an examiner’s decision of refusal. The title of the claimed invention is “excavator.” The major issue of this case is whether the content of the publicly known document illustrated only by the document number in the primary publication can be taken into consideration in the same manner as “common general technical knowledge” in the course of finding the cited invention.

The JPO found that the invention described in Claim 1 of the application in question (hereinafter “the claimed invention”) and the cited invention (based on Evidence A No. 3, hereinafter “A3”) differ in terms of the Different features 1 and 2, and determined that since a person ordinarily skilled in the art could have easily arrived at the structure involving the Different features 1 and 2 based on the cited invention and well-known art (Evidence A No. 6 and 7), the claimed



Claimed invention [Fig. 14]

invention may not be patented under the Patent Act Article 29 (2) (appeal decision maintaining an examiner's decision of refusal in appeal against the examiner's decision).

The appellant (the plaintiff) filed a revocation action against the JPO appeal decision, alleging lack of cause or motivation, lack of applicability of the well-known art. The court found the cited invention based on A3 by referring to the statement in Evidence A No. 5 (hereinafter "A5"), which was cited in A3 in order to indicate publicly known art. The statement of A5 which was referred by the court involved description which was inconsistent with the purpose of citing A5 in A3. Based on this finding, the court determined that the claimed invention and the cited invention differed in terms of Different Features 1 and 2 as found by the JPO, and that there was cause or motivation for applying the well-known art to the structure involving Different Features 1 and 2. In conclusion, the court determined that all reasons for revocation alleged by the plaintiff were groundless (court decision to dismiss the plaintiff's request).

2. Major issues discussed

- (1) Issue 1 (Finding of the document illustrated as publicly known art in the cited document)

The discussion was focused on whether or not the above mentioned court's determination was appropriate, i.e. whether it is possible to consider the statements in the document illustrated as publicly known art in the primary cited document in the course of finding the cited invention. Opinions were divided among the members.

The members who agreed with the court's determination provided the following reasons for their opinion: (i) the court merely referred to the technology of integrating multiple bird's eye image data, which is the technology related to the creation of bird's eye images and indicated as common general technical knowledge in A5; (ii) the fact that A5 is cited in A3 proves the existence of the cause or motivation for combining them, and furthermore, A5 is specifically mentioned as publicly known art. However, all the members agreed that if there is any factor that clearly hinders the combination of the primary cited document and the publicly known documents cited in the primary cited document, it would be difficult to find the cited invention by referring to the

matters cited in the primary cited document.

If this kind of consideration is allowable, the presentation of multiple publicly known documents could result in expanding the scope of the cited invention. The members further discussed if that would be allowable. Some members supported such expansion because this would encourage the applicant to disclose prior art documents, but the majority, while giving consideration to maintaining the balance with the rule that violation of the enablement requirement and amendment requirement (addition of new matters) for the claimed invention cannot be avoided by presenting publicly known documents, expressed the opinion that publicly known documents should be considered only within a limited scope. For example, it should be decided based on the relevance between the art found in the primary cited document and the publicly known art indicated in the publicly known document, or the existence or non-existence of the cause or motivation for referring to the publicly known document.

The members who disagreed with the court's determination provided the following reasons for their opinion: it is not appropriate to regard various matters stated in a single publicly known document as a well-known art; it is unlikely for a person ordinarily skilled in the art who has accessed A3 to assume matters that are not mentioned in the cited part of A3 and are inconsistent with the purpose of the citation. There was also an opinion that there was no cause or motivation but an obstructive factor regarding the combination of A3 and A5 since the cited invention found by the court, which was acknowledged by combining A3 with A5, adopted the order of process steps changed back into the order adopted by the prior art indicated in A3.

(2) Issue 2 (Finding of the cited invention by the JPO)

The members discussed whether or not the JPO's finding of the cited invention was appropriate, focusing on its determination that based on A3, an image to be composited contains an overlapping area.

A majority of the members expressed the opinion that whether or not an overlapping area exists is yet to be identified, since it can be assumed based on Fig. 2 in A3 that a combined image shown in Fig. 16 also contains an overlapping area and it is too much to say that the existence of an overlapping area is rejected on the basis of the description in Fig. 16. Other members commented

that it should be considered that the existence of an overlapping area is rejected, on the grounds that A3 can be read as not recognizing the existence of an overlapping area as a problem, and that an image to be displayed would be rather unnatural if A3 is understood as showing that an overlapping area exists and processes including blending are performed.

(3) Issue 3 (Finding and application of well-known art)

The referenced parts of Evidence A No. 6 and 7, which are indicated as well-known art in the JPO's decision, express the technology of blending and its problems. The members discussed whether it was appropriate for the JPO to have found the well-known art based on such descriptions and applied it to A3.

While the majority found the JPO's approach to be appropriate, some members were of the opinion that those documents were not appropriate in this case since the problems described in those documents cannot be ignored when applying to A3.

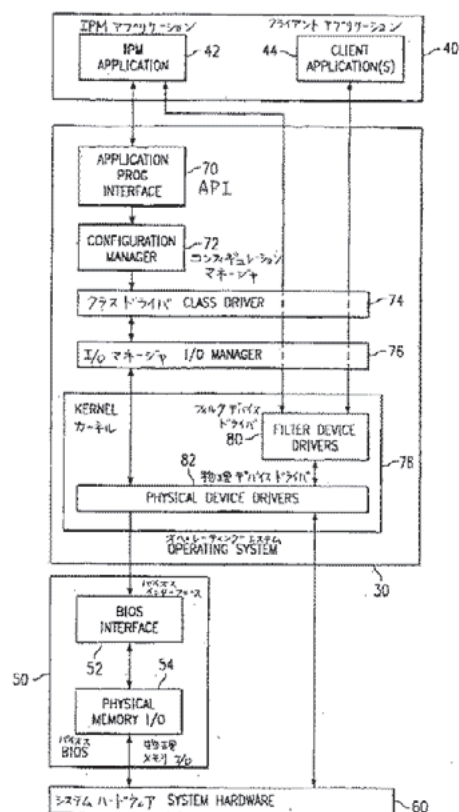
Case 8: Patent – Electricity

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2014-22371 (Patent Application No. 2013-17748) (Sep. 7, 2015: board decision maintaining an examiner's decision of refusal in appeal against the examiner's decision; appeal decision revoked) (Aug. 7, 2017: board decision maintaining an examiner's decision of refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Dec. 26, 2016 2016 (Gyo-Ke) 10023 (JPO appeal decision revoked)
Title of Invention	Method and apparatus for providing intelligent power management
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	The existence or non-existence of irregularity in procedure, determination of an inventive step

I. Outline of the case

This is a revocation action against an appeal decision of the JPO that dismissed an appeal against an examiner's decision of refusal. The title of the claimed invention is "method and apparatus for providing intelligent power management." The major issue of this case is whether the JPO erred in finding the cited invention and overlooked the difference between the claimed invention and the cited invention.

In the first appeal decision, the JPO determined that the invention described in Claim 8 of the application in question could have been easily made by a person ordinarily skilled in the art based on the cited invention described in Evidence A



Claimed invention [Fig. 3]

No. 1 and the well-known art (Evidence A No. 2) and it therefore may not be patented under the Patent Act Article 29 (2) (board decision maintaining an examiner's decision of refusal).

The appellant (the plaintiff) filed a revocation action against the JPO appeal decision, alleging errors in the finding of the cited invention mentioned above. The court revoked the JPO decision on the grounds that there had been an error in the JPO's finding of the cited invention and that, due to this erroneous finding, the JPO overlooked the difference between the claimed invention and the cited invention, which affected its conclusion and therefore is illegal (court decision of revocation of the JPO appeal decision).

As a result of the proceedings after the case was remanded, the JPO rendered an appeal decision (the second appeal decision) to the effect that the claimed invention described in Claim 1 of the application in question could have been easily made by a person ordinarily skilled in the art based on the cited invention described in Evidence B No. 2, and it therefore may not be patented under the Patent Act Article 29 (2). This decision became final and binding.

2. Major issues discussed

(1) Issue 1 (Finding of the cited invention and the difference)

The members first discussed whether or not it was appropriate for the court to have determined that the JPO had erred in finding the cited invention and overlooked the difference. A majority of the members found the court's determination to be appropriate.

The major reason for their support of the court's determination was that Evidence A No. 1 does not describe a comparison between application programs, and hence the claimed invention, which activates a circuit simply depending on the type of application program, and the cited invention, which activates a circuit by monitoring each processing load, differ in terms of the technical (design) concept. Another reason was that, since Evidence A No. 1 indicates the control system on the assumption of using only a single application program, it is difficult to understand the technical concept of assuming multiple programs and dividing them into several types from Evidence A No. 1.

Some members also commented that, because the definition of the term "type of application program" used to describe the claimed invention cannot be clearly

understood even by taking into consideration the statements in the detailed explanation of the invention, it may be possible to reach the determination presented in the JPO's first appeal decision by interpreting the term as covering a broad scope that includes a calculation request.

(2) Issue 2 (Determination of the difference)

Along with the discussion on Issue 1, the members also discussed whether or not the existence of an inventive step can be denied based on the cited invention if the difference between the claimed invention and the cited invention is found as held by the court.

A majority of the members commented that since Evidence A No. 1 indicates the technology for activating a circuit based on a processing load, the existence of an inventive step can be denied by combining the cited invention with well-known art, such as the technology for controlling a circuit based on an application program that has a corresponding processing load. Other members commented that because the claimed invention was supposed to use a "multitask OS," it may be necessary to indicate some well-known art in this respect as well. The members agreed that even if the existence of an inventive step can be denied, careful explanation and determination would be necessary with regard to the presentation of well-known art and the grounds or, cause or motivation for combining it with the cited invention.

Meanwhile, more than a few members expressed the opinion that if Evidence A No. 1 is adopted as the starting point, it may be difficult to deny the existence of an inventive step because the claimed invention would constitute an alternation of the core technical idea of Evidence A No. 1 or a worsening of the cited invention.

(3) Issue 3 (Suitability of the support requirement and clarity requirement)

The members discussed whether the term "type of application program" used to describe the claimed invention satisfies the clarity requirement and support requirement. While the number of the members who found no particular problem with this term was slightly larger, some members commented that it is difficult to understand this term as an upper level concept of "type" due to lack of a sufficient explanation of "type" in the "detailed explanation of the invention"

section.

(4) Issue 4 (the presence or absence of irregularity in procedure)

The members discussed another issue of whether there had been any irregularity in procedure. Nearly half of the members commented that the examiner's decision of refusal in which the examiner indicated Evidence B No. 3 as a document showing well-known art was appropriate, and that the presentation of Evidence A No. 2 by the JPO in the first appeal decision was nothing more than the replacement or supplementation of that document showing well-known art and allowable.

There was also an opinion expressed by nearly half of the members that the examiner's determination expressed in the decision of refusal was inappropriate in light of the statements in the decision of refusal and the content of Evidence B No. 3. A majority of these members commented that in this case, the JPO's first appeal decision contains an irregularity in procedure because it altered the content of the determination made by the examiner. Other members commented that since the applicant was provided with sufficient opportunities to refute the examiner's determination during the examination and appeal trial proceedings, the JPO cannot be deemed to have committed an irregularity in procedure for presenting Evidence A No. 2 as well-known art in the first appeal decision.

Case 9: Design

JPO Docket Number	Trial for invalidation Invalidation No. 2014-880005 (Design Registration No. 1423705) (Jan. 22, 2016: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Nov. 7, 2016 2016 (Gyo-Ke) 10054 (the request dismissed, JPO trial decision maintained)
Article to the Design	Handrail
Major Issues	The Design Act Article 3 (2) (whether a person ordinarily skilled in the art of the design would have been able to easily create the design based on shape, patterns or colors, or any combination thereof that were publicly known in Japan or a foreign country)
Points	Finding of the registered design and finding of the added evidence

1. Outline of the case

This is a case related to a trial for invalidation of a partial design in which an article to the design is a “handrail.”

In the JPO trial decision, the JPO found gradation patterns on glass face plates as shown in one of the drawings attached to the application that is titled “reference view explaining transmittance” as a form of the registered design. The JPO also stated that the design could have been easily created by a person ordinarily skilled in the art of the design based on Evidence A No. 2 Design to No. 11 Design and that the registration should be invalidated (JPO trial decision to invalidate the patent).

In the court decision, the court dismissed the request of the plaintiff (the demandee of the trial) (the court decision to dismiss the request).

2. Major issues discussed

(1) Issue 1 (Finding of the registered design)

Many members commented that, when finding the registered design, the administrative judge panel should have found whether or not “the gradation

patterns are arranged only at the center part in the thickness direction of the laminated glass.” Those members explained that their view is supported by the facts that this point could have affected the common features and different features of the two designs, that the demandee added this point to the demandee’s allegation as another point of dispute, and that this is finding concerning the description of the application and drawings, the finding of the design is an important point of dispute.

(2) Issue 2 (Finding of the added evidence)

Many members commented that, regarding Evidence A No. 14-2 submitted in the middle of proceedings to supplement the description in Evidence A No. 11, the panel should have clarified the purport and significance of the submission of the evidence in advance, more specifically, the evidence to prove that the design is a “publicly known design” or the “evidence to prove that the design was created by using a common technique.” Some members commented that it was not clear whether the demandant’s allegation should be interpreted to be saying that the design is a “publicly known design” or that the design was created by using “a common technique.” Those members commented that the panel should have explored the intention of the allegation of the demandant by presiding over the proceedings.

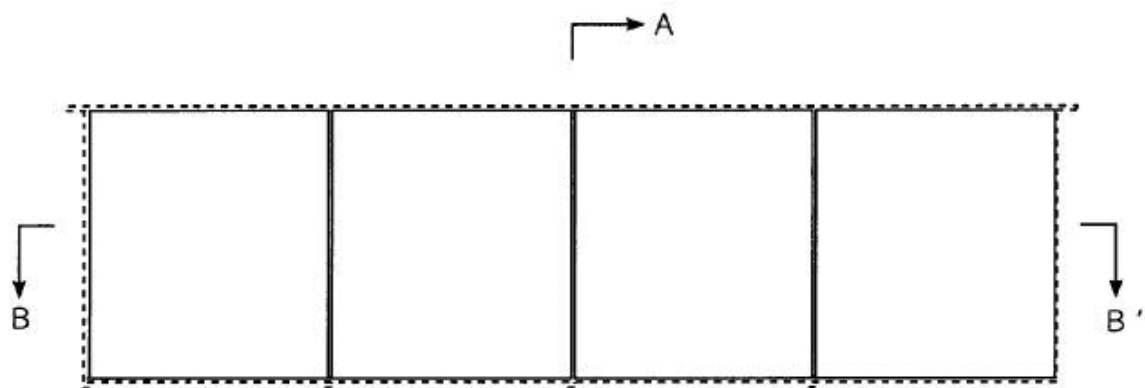
(3) Issue 3 (Construction of logic of the determination that a person ordinarily skilled in the art of the design would have been able to easily create the design)

Some members commented that, while it was determined that the addition of B to A or the replacement of A with B was not creative because any person ordinarily skilled in the art of the design would have been able to easily create the design, the JPO trial decision should have explained the logic of such determination by arguing, for example, that, since it is easy to add a pattern on a panel that has a similar composition ratio and also easy to adjust the height of the gradation patterns, it would be easy to combine the idea of creating a pattern by putting different patterns together and the idea of changing the composition ratio.

Registered design

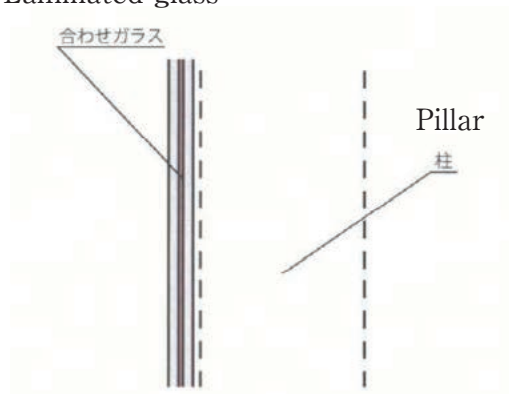


[Reference view explaining transmittance]

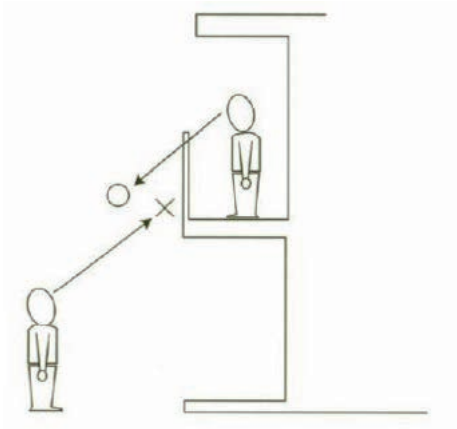


[Front view]

Laminated glass



[C-C' detailed cross-section view]



[Drawing to explain the characteristics of the design]

* The statements presented in the application and the rest of the drawings are omitted.

Case 10: Trademark

JPO Docket Number	Trial for invalidation Invalidation No. 2014-890032 (Trademark Registration No. 5643664) (Mar. 27, 2015: trial decision to invalidate the trademark; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Oct. 29, 2015 2015 (Gyo-Ke) 10073 (dismissal of a request)
Trademark	養命茶 (<i>yomeicha</i>) (standard characters)
Major Issues	Trademark Act, Article 4 (1) (xv) (Confusion about the source of goods)
Points	Risk of causing confusion about the source of the two trademarks due to the fact that the trademark includes a part of the prominent trademark

I. Outline of the case

With regard to the trademark at issue, which consists of standard characters “養命茶” (*yomeicha*) and was registered for the designated goods including “Tea-based beverages,” a trial for invalidation was requested by citing another trademark “養命酒” (*yomeishu*) and alleging that the registered trademark falls under the Trademark Act Article 4 (1) (xi), (xv) and (xix). The JPO found the cited trademark to be well-known and prominent, and determined that the cited trademark and the registered trademark share the term “養命” (*yomei*) as their core part and that the goods for which the cited trademark is used and the designated goods of the registered trademark have common usage, purpose, consumers, and shops and thus they have close relation with each other. Based on this determination, the JPO concluded that the registered trademark falls under the Trademark Act Article 4 (1) (xv) and invalidated the trademark registration (JPO trial decision to invalidate the registration of the trademark). The court maintained the JPO’s determination for the same reasons and dismissed the request of the plaintiff (the demandee of the invalidation trial).

2. Major issues discussed

(1) Issue 1 (Method of determining whether the trademark falls under the Trademark Act Article 4(1) (xv))

A. In the course of determining the degree of similarity of the registered trademark and the cited trademark, both the JPO and the court focused on the part of the structure of these trademarks, “養命,” as their core part. The members expressed no objection to this observation method.

The members discussed whether the JPO and the court could have drawn a conclusion by comparing the trademarks “養命茶” and “養命酒” in their entirety and determining the degree of their similarity. Some members commented as follows: the difference between these trademarks in terms of goods, i.e. “tea” and “liquor,” makes a difference in the level of their capability to distinguish, and these trademarks cannot easily be described as being “similar to each other” when compared through the overall observation in terms of the external appearance, pronunciation and concept; however, the use of the concept of “core part” made it easier to explain their similarity, and this led to finding a high degree of similarity.

Since the definition of the term “core part” which was used in this case was not clear, the members compared this term with the conventional term “features” used in the determination of similarity under the Trademark Act Article 4 (1) (xi). A majority of the members expressed a view that the JPO and the court used different terms because the applied articles were different ((xi) and (xv)), but the term “core part” and the term “features” are substantially almost identical. The members agreed that the definition of the term “core part” should be clarified by the JPO or the court if the term were to be used in the future.

B. The JPO and the court determined that the designated goods of the registered trademark, “tea-based beverages, plant-and-cereal-based tea mix,” and the goods in connection with the cited trademark, “medicated liquor,” have close relation with each other. With regard to this determination, some members questioned whether tea and medicated liquor, which may be purchased at the same place but for different motivation or purposes, can be deemed to have relation with each other in terms of the usage or purpose of the goods. However, in conclusion, the members agreed that this

determination is appropriate.

- (2) Issue 2 (Determination to be made if multiple reasons for invalidation are alleged)

While the demandant alleged that the registered trademark falls under the Trademark Act Article 4 (1) (xi), (xv) and (xix), the JPO determined in the trial decision whether the registered trademark falls under (xv) alone and did not determine regarding (xi) and (xix). Some members commented that, considering the infringement litigation, the demandant must have wished the JPO to also determine that the registered trademark constitutes a “trademark similar (to another person’s registered trademark)” set forth in the Trademark Act Article 4 (1) (xi). Other members expressed an opinion that (xv) is applicable to invalidate the registration comprehensively over a broad range of designated goods or services whereas (xi) is applicable to invalidate the registration only for goods and services similar to those of another person’s registered trademark, and therefore, the JPO’s determination could be divided into two parts, one explaining invalidity under (xi) for the specific goods among the designated goods, and the other part explaining invalidity under (xv) for the rest of the goods, which would be somewhat odd.

- (3) Issue 3 (Standard set in the L’AIR DU TEMPS Case)


The members also discussed the standard set by the Supreme Court in the L’AIR DU TEMPS Case regarding the applicability of the Trademark Act Article 4 (1) (xv). Among the other court decisions in which “actual state of transaction” in this standard is determined, the IP High Court in the GUZZILLA Case determined that traders and consumers of the designated goods, “hydraulic jacks” and “toys and miscellaneous goods,” include the same traders and consumers for the goods using the cited trademark, focusing on common features of these goods which were very partial. Some members commented that it may be allowable to focus on any available facts that can be regarded as representing actual state of transaction, regardless of whether they are general or specific.

- (4) Issue 4 (Comparison with other cases)

The members compared the present case with other cases in which the


trademark registration was invalidated, i.e., “養命青汁” (yomei aojiru) Case (court decision of the IP High Court on October 29, 2015 [2015 (Gyo-Ke) 10074]), and “宮古養命草” (*miyako yomeisou*) Case (court decision of the IP High Court on February 9, 2016 [2015 (Gyo-Ke) 10180]). With regard to the “宮古養命草” Case, some members commented that this trademark may be less similar to the cited trademark, “養命酒.”

The members also discussed the recent court decisions in which the registered trademark was found to fall under the Trademark Act Article 4 (1) (xv) :

“” (court decision of the IP High Court on September 13, 2017 [2016 (Gyo-Ke) 10262]);

“豊岡柳” (court decision of the IP High Court on October 24, 2017 [2017 (Gyo-Ke) 10094]);


“MEN'S CLUB” (court decision of the IP High Court on November 14, 2017 [2017 (Gyo-Ke) 10109]);

“” (court decision of the IP High Court on December 25, 2017 [2017 (Gyo-Ke) 10080]); and

“**GUZZILLA**” (court decision of the IP High Court on June 12, 2018 [2017 (Gyo-Ke) 10214]).

Some members commented that the JPO should infer and find the party's intent (e.g. free-ride and bad faith trademark filings) from a broader range of facts. Other members expressed an opinion that the court has expanded the scope of protection under the Trademark Act Article 4 (1) (xv) somewhat too broadly. In cases where trademarks are not similar (a lower degree of similarity) but the goods for which they are used are similar, it may be possible to preclude the likelihood of confusion as long as the trademarks are not similar. In this respect, the members discussed the scope of protection under the Trademark Act Article 4 (1) (xv).

Case 11: Trademark

JPO Docket Number	Trial for rescission Rescission No. 2014-300026 (Trademark Registration No. 5169730) (Mar. 31, 2017: trial decision to rescind the registration; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jan. 15, 2018 2017 (Gyo-Ke) 10108 (dismissal of a request, JPO trial decision maintained)
Trademark	 The trademark consists of the Japanese characters 緑健青汁 (Ryokuken Aojiru) in a stylized font, with the English characters RYOKUKEN AOJIRU below it. There are also smaller Japanese characters above the main text: りょくけん青汁 and リョクケン青汁.
Major Issues	The Trademark Act Article 50 (1) (finding of whether a registered trademark in question has been used or not)
Points	Allegation and evidence submitted in a trial for rescission of registered trademark not in use

1. Outline of the case

This is a trial to seek rescission of the above-mentioned registered trademark due to non-use. In the JPO trial decision, the JPO rescinded the trademark registration by holding that the evidence submitted by the demandee cannot prove that the product catalogs and magazines were distributed within the period required to prove trademark use (the JPO trial decision to accept the request). In the court decision, the court took the same approach as the JPO trial decision and found that the product catalogs and magazines cannot be found to have been distributed within the period required to prove trademark use, and furthermore, found that the trademark is not deemed identical from common sense perspective with the used trademark and thereby dismissed the request by the plaintiff (the demandee of the JPO trial) .

2. Major issues discussed

(1) Issue 1 (Whether the trademark has been used or not)

A. In the JPO trial decision and the court decision, the JPO and the court did not find that the magazines containing an advertisement using the trademark “緑

健青汁 (RYOKUKEN AOJIRU)” (Evidence B No. 3 = Evidence A No. 3 mentioned in the court decision; hereinafter “Evidence B No. 3 magazine”) were distributed within the period required to prove trademark use. Many members agreed that it is unnatural that the advertisement using the trademark “緑健青汁” posted in Evidence B No. 3 magazine included a notice that materials would be distributed at the place of academic conference to be held on the day before or on that day of the release date of Evidence B No. 3 magazine. When the demandant pointed out that said magazine stored in the National Diet Library does not contain the advertisement using the trademark “緑健青汁,” the demandee alleged that Evidence B No. 3 magazine is the second edition of said magazine. The members reached the consensus that it is unnatural for the demandee to make such allegation after the demandant pointed out the difference between Evidence B No. 3 magazine and the one stored in the library. The publisher of Evidence B No. 3 magazine and the demandee have the same representative and the same place of business. Regarding this point, some members argued that the fact that both parties have the same representative would make it easy to create evidence and therefore it would have an impact on a determination on its credibility.

- B. In the JPO trial decision and the court decision, they also did not find that the product catalog containing the trademark “緑健青汁” (Evidence B No. 2= Evidence A No. 2 mentioned in the court decision, hereinafter “Evidence B No. 2 catalog”) was distributed within the period required to prove trademark use. Regarding the bill presented as Evidence B No. 14 (Evidence A No. 27 mentioned in the court decision), some members argued that, while the demandee, which attended an inquiry session held by the administrative judge panel and was told that the printed matters related to the bill cannot be identified as the catalog, newly submitted a modified bill as evidence, what should have been submitted as evidence were the documents recording the communications with regard to the drafting, etc. of the catalog between the person who placed an order for catalog printing, and the printing company, because such communications must have taken place. Some members argued that, regarding the evidence submitted by the demandee to prove the printing and shipping costs for Evidence B No. 2 catalog, it would be unreasonable to strictly require the consistency between the number of

printed matters and the number of shipped matters.

- C. In conclusion, the members agreed that, while the credibility of evidence should be determined by considering various factors such as the reasonableness of the content of the evidence, the status of the person who prepared the evidence, and the consistency among the different pieces of evidence, besides the content of each evidence, the fact that the trademark was used cannot be found in this case because the allegation was changed without any legitimate reasons and that the evidence was submitted at an unnatural timing in an unnatural manner.

(2) Issue 2 (Trial for rescission of registered trademark not in use)

- A. The members discussed what precautions a holder of trademark right can take in preparation for a trial for rescission of registered trademark not in use. Some members explained that, in many cases, a company has not determined the final logo (design) to be actually used in business at the time of the filing and files an application for a trademark consisting of standard characters, and subsequently uses a logo that has a design significantly different from the one claimed in the application. Also, some members explained that, in some cases, in order to ensure that the trademark used in an advertisement is identical with the registered trademark, the company takes measures such as bringing to employees attention and requiring a confirmation by a person in charge of the trademark before using a trademark. They also explained that some companies recognize the fact that bills, receipts, etc. often do not contain information necessary to identify a trademark and therefore, in the course of exchanging communications electronically (e-mail, etc.) or in writing (order sheet, etc.) with the aim of preparing a bill, etc., they intentionally store documents that can link the bill, etc. with a certain trademark. These members also pointed out that, in the case of a company that conducts transactions of goods and services on the Internet, webpages are often stored in an archive, which makes it relatively easy to prove the fact that a trademark is used and that it would be a good management strategy for a company to periodically save evidence of trademark use in the form of images.
- B. One of the members presented what can be done by the holder of trademark

right when a trial for rescission of registered trademark not in use is filed while evidence to prove the use of a trademark is not sufficiently available. It was explained that the holder of trademark right can submit evidence to prove the use of the trademark by conducting an Internet search and gathering evidence for the use of the trademark. Some members pointed out that, if a company submits a statement or a copy of an e-mail to prove the use of a trademark, it would be desirable to submit statements written by both parties involved in the transaction. Other members argued that there is a risk of falsification in the case of using email as evidence and that its credibility should be carefully determined while supplementary evidence should be required.

C. Many members supported the current system under which a panel conducts an inquiry, etc. to encourage the demandee to show proof of allegation. These members found such system to be effective in solving a case in a proper manner. However, some members agreed that improvement would be necessary in a case where an inquiry, etc. result in the extension of the period of proceedings.

(3) Issue 3 (Whether the trademark is identical from common sense perspective with the used trademark)

Some members argued that the trademark may be deemed identical from common sense perspective with the used trademark in view of the facts that the strong, dominant part of the trademark consists of four Chinese characters “綠健青汁” and that any other parts of the trademark may be considered to be supplementary to the Chinese characters.

Many members argued that, while some companies may create a trademark consisting of characters written in two horizontal lines to indicate how the Chinese characters or foreign words should be read, companies should refrain from filing an application for a trademark consisting of characters written in multiple lines unless such configuration is necessary to indicate how the trademark should be read because such trademark configuration would create a problem of identicalness from common sense perspective in a trial for rescission of the registered trademark not in use.

Case 12: Trademark

JPO Docket Number	Opposition to registration of trademark Opposition No. 2013-900069 (Trademark Registration No. 5544516) (Nov. 22, 2013: decision to revoke; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, May 14, 2014 2013 (Gyo-Ke) 10341 (dismissal of a request)
Trademark	オタク婚活 (<i>otaku konkatsu</i> : <i>otaku</i> marriage hunting) (standard characters)
Major Issues	The Trademark Act Article 3 (1) (iii) (function for distinguishing relevant services from others)
Points	The criteria for making the determination on whether the trademark registration falls under the Trademark Act Article 3 (1) (iii)

I. Outline of the case

This is a case where a request for an opposition to registration of trademark was filed by the opponent alleging that the trademark fell under the Trademark Act Article 3 (1) (iii). The trademark consists of standard characters “オタク婚活” (*otaku konkatsu*) and is registered for the designated service of Class No. 45 “Marriage partner introduction or dating services; dating services and the provision of information on the same using websites on the Internet; the provision of information necessary for marriage by using the Internet.” In the decision on opposition, the JPO found that the traders and consumers would recognize the trademark as meaning “*otaku’s* marriage hunting or *konkatsu* (activity of *otaku* to get married)” and that the trademark fell under the Trademark Act Article 3 (1) (iii) because it consisted solely of a mark simply indicating the quality (content) and usage in a common manner (rescission of trademark registration). In the court decision, the court as well found that traders and consumers would recognize the trademark as meaning activity to get married (marriage hunting) for people who were referred to as “*otaku*” and found that the trademark fell under the Trademark Act Article 3 (1) (iii) (dismissal of a request).

2. Major issues discussed

(1) Issue 1 (Regarding the JPO decision on opposition and the court decision)

- A. Regarding the criteria, which was presented by the court, for making the determination on whether the trademark registration falls under the Trademark Act Article 3 (1) (iii), some members expressed a negative view on the part of the criteria that stated “where the trademark is used for the designated service by the traders and consumers of the designated service of the trademark, it is sufficient if they would generally recognize that the trademark indicates the aforementioned characteristics of the service, and would also recognize as such in the future.” Their point was that the future situation should not be taken into account, because predictability would decrease due to the risk of making an arbitrary determination: a determination on how a trademark would be recognized by traders and consumers can be greatly influenced by the subjectivity of a person. On the other hand, some members expressed a positive view on such part of the criteria because it would allow a flexible determination in consideration of not only the current level of such recognition but also the future possibility of such recognition. The members pointed out that it is necessary to protect words that have strong public characteristics (the names of ingredients, places of origin, etc.), and that there are cases where foreign words that were once not well known in Japan subsequently became widely known. In view of these facts, they concluded that the aforementioned criteria that included the future situation were reasonable.
- B. The members supported how the words “オタク” (*otaku*: people who love anime (cartoon films), manga (comics), games, idols, etc.) and “婚活” (*konkatsu*: marriage hunting) were found in the JPO decision and the court decision. Regarding the grounds for such findings, some members argued that, while the words in *Kojien* or any other major dictionaries published in Japan can be considered to be widely known, the words in “*Gendai yōgo no kiso-chishiki*” (*Basic Knowledge of Modern Japanese Words*), which contains trendy words as well, cannot be considered to be widely known. Some members commented that, when it comes to online information, the information on the website of a company or a local government is more suitable to cite as evidence than the information on an individual person’s

blog, that the information on Wikipedia or any other online dictionaries would be insufficient as evidence, and that newspaper articles would provide stronger evidence than online information. On the other hand, other members argued that, in this modern age, online information is also important data to consider when determining the level of recognition among consumers.

The court stated in the court decision that “in order to state that the trademark falls under the Trademark Act Article 3, paragraph (1), item (iii) of the Trademark Act ... it is not necessary to prove the fact that the trademark is generally used.” Regarding the fact that the court did not find that the word “オタク婚活” (*otaku konkatsu*) was generally used, the members understood that, to make a determination according to the court’s standard, the court did not need to find that the word was actually used.

The members further examined, if the court were not able to find the fact that the word “オタク婚活” (*otaku konkatsu*) was generally used, whether that would be a factor to deny the trademark falls under the aforementioned Article. Some members argued that the finding that the word has never been used would serve as one of the factors that would support the denial. However, all the members agreed that such finding would not become a deciding factor to deny that the trademark falls under the Trademark Act Article 3 (1) (iii).

In the court decision, the court found that the word “オタク婚活” (*otaku konkatsu*) was generally recognized as meaning of activity to get married (marriage hunting) for people who are referred to as otaku by holding that there are examples where similar words “アラサー婚活” (the activity to get married for people around thirty years old), “シニア婚活” (the activity to get married for elderly people), and “熟年婚活” (the activity to get married for mature aged people) were used. Some members pointed out that the court should have given an example of a word consisting of “an attribute associated with hobbies, etc. and the word ‘婚活.’” Other members argued that, since the word “オタク” (*otaku*) has a broad meaning, the meaning of the word “オタク婚活” (*otaku konkatsu*) is ambiguous.

(2) Issue 2 (comparison with other cases)

By comparing the case with “しょうゆそると (standard characters)” (literal

meaning: “soy sause salt”) (Appeal No. 2017-8837, not falling under the Trademark Act Article 3 (1) (iii)), “東京家族葬 (standard characters)” (literal meaning: “Tokyo family funeral”) (Appeal No. 2016-16164, not falling under the Trademark Act Article 3 (1) (iii)), “洗えるスーツケース (standard characters)” (literal meaning: “washable suitcase”) (Appeal No. 2016-15226, falling under the Trademark Act Article 3 (1) (iii)), and “肉ソムリエ (standard characters)” (literal meaning: “meat sommelier”) (Appeal No. 2014-19333, 2015 (Gyo-Ke) 10152, falling under the Trademark Act Article 3 (1) (iii)), the members examined the capability to distinguish of a mark consisting of words that have weaker capability to distinguish.

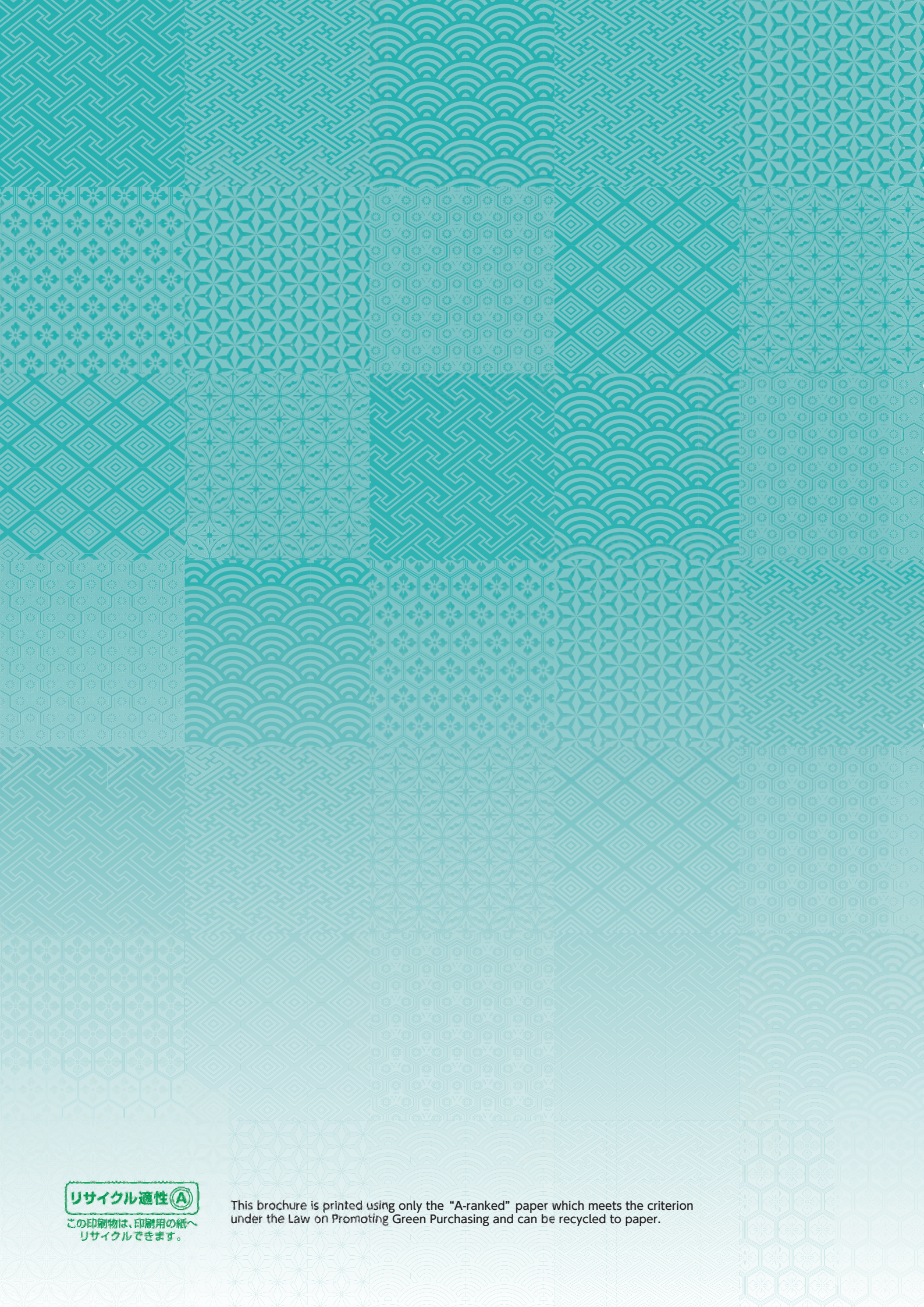
Some members argued that “しょうゆそると” and “東京家族葬,” which were determined in the JPO decision as marks that do not fall under the Trademark Act Article 3 (1) (iii), should be considered to fall under the said Article. However, the majority of members supported the JPO decision as a whole. Some members pointed out that, in the case of “肉ソムリエ” (meat sommelier), which was determined in the JPO decision and the court decision as a mark that falls under the Trademark Act Article 3 (1) (iii), both decisions seemed to have been greatly influenced by various previous cases where a word of the name of a product, foodstuff, etc. is combined with the word “ソムリエ” (sommelier), such as “野菜ソムリエ” (literal meaning: vegetable sommelier).

Trial and Appeal Practitioner Study Group REPORT 2018 (Summary)

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