

国際知財司法シンポジウム2024
The Judicial Symposium on Intellectual Property /TOKYO2024
(JSIP2024)

模擬口頭審理 Mock Oral Proceedings

事例説明（英語版）
Case Explanation
(English version)

2024年10月25日
October 25, 2024



Case Summary

Case Summary

- **Pony Corp. (“Pony,” a patentee)** owns a patent right for an invention titled “Lid”(see attachment 3 for details). The patented invention relates to a lid used as a part of a storage container which can be heated in a microwave oven.
- **Rabbit Corp. (“Rabbit,” the demandant)** filed a request for **a trial for invalidation** alleging the following **reasons 1 and 2 for invalidation** of the patent.
- At **the oral proceedings**, Pony requested **the examination of a witness** who is the inventor of the invention described in Evidence A No. 4 (A-4 invention).

1. Reason for invalidation 1: lack of novelty due to the publicly worked invention

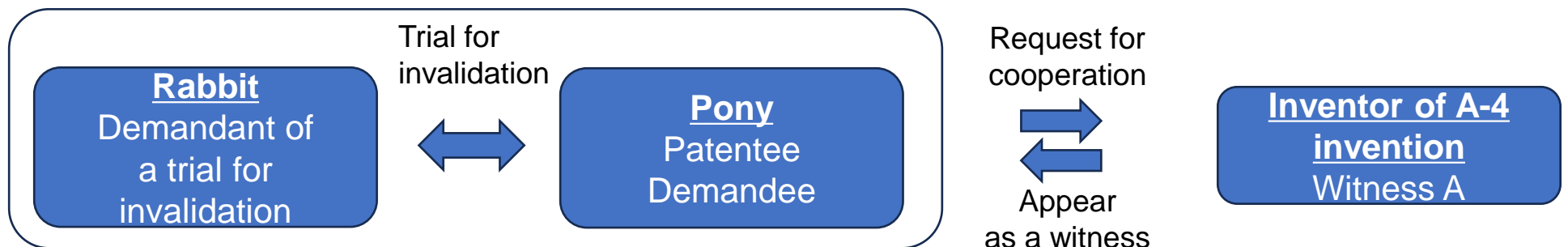
Evidence A No. 1 (“A-1”): Archive of mail-order site about Mouse Corp’s (“Mouse”) product “Storage Container M”

Evidence A No. 2 (“A-2”): Personal blog describing “Storage Container M”

Evidence A No. 3 (“A-3”): Review site for “Storage Container M”

2. Reason for invalidation 2: lack of inventive step due to the invention described in a document

Evidence A No. 4 (“A-4”): Public relations magazine of X City describing the results of the invention competition



Outline of the Invention (Technical field, Problem)

Technical Field

- A storage container in which stored food can be heated in a microwave oven ([0001])

Problem to be solved by the Invention

- When tilted to drain water through the through hole 911 as shown in Figure 8, the flap 93 was located below the through-hole 911, so the water drained from the through hole 911 hits the flap and splatters. ([0011], Fig.8)

Means for solving the Problem

- The flap is configured such that the protrusion is spaced apart from the through hole in a natural condition and the through hole is maintained in a closed state by the protrusion. The through hole is formed outside a base end portion of the flap in a plan view of the lid. ([0013], Fig.4)

Invention

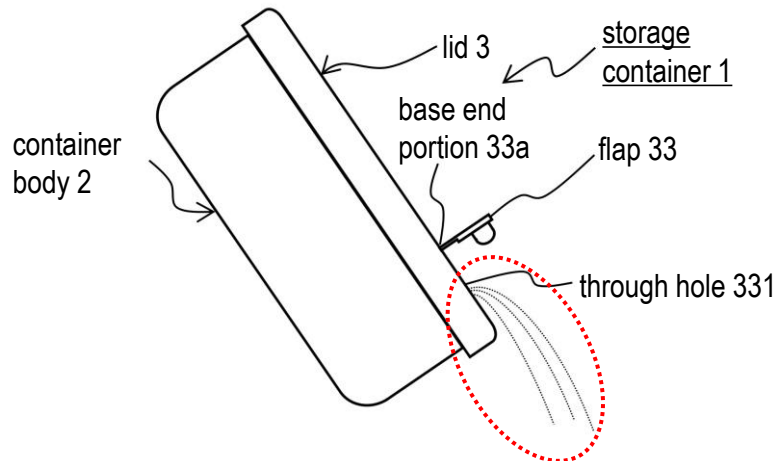


Fig.4 A diagram showing a state in which water is discharged from the through hole in the storage container of the embodiment

Prior Art

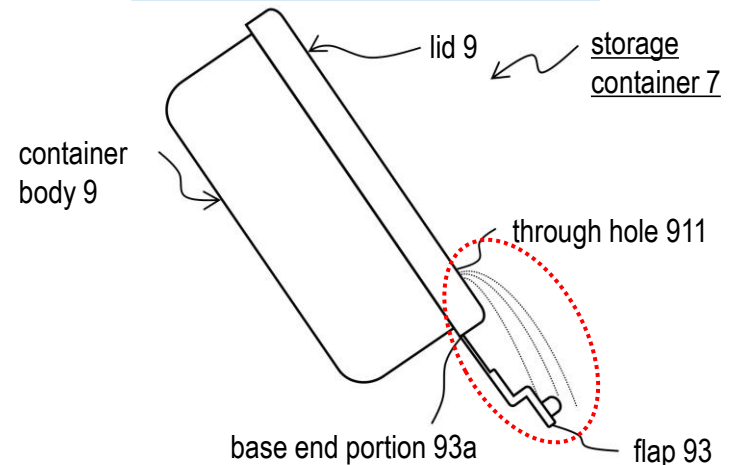


Fig.8 A diagram showing a state in which water is discharged from the through hole in a storage container of the prior art

Outline of the Invention (Scope of Claim)

Claim

- A **A lid** used as a part of a storage container in which stored food can be heated in a microwave oven, the lid comprising:
- B **a top plate portion** that covers an opening of a container body forming a storage space and has **a through hole** formed therein;
- C **an attachment portion** that is provided on an outer periphery of the top plate portion and is configured to be attachable to an upper edge that forms the opening of the container body; and
- D **a flap** that is provided to be elastically deformable to rotate with respect to the top plate portion, and has **a protrusion** that can close the through hole,
- E wherein the flap is configured such that the protrusion is spaced apart from the through hole in a natural condition and the through hole is maintained in a closed state by the protrusion, and
- F wherein the through hole is formed outside a base end portion of the flap in plan view of the lid.

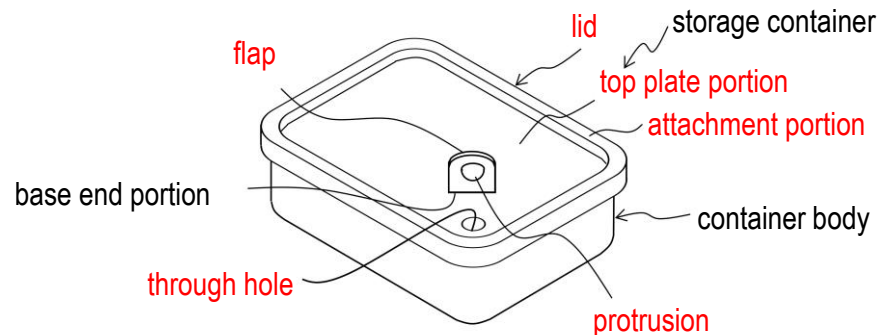


Fig.1 A perspective view of a storage container according to the embodiment

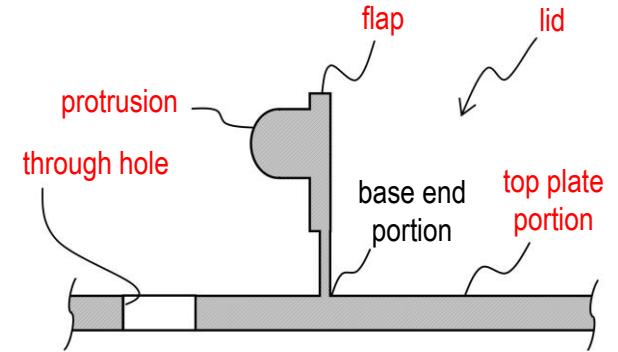


Fig.3A A partial cross-sectional view of the lid of the embodiment in a state where the through hole is open

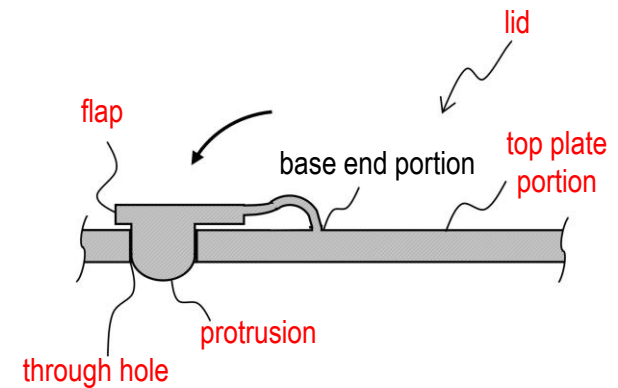


Fig.3B A partial cross-sectional view of the lid of the embodiment in a state where the through hole is closed

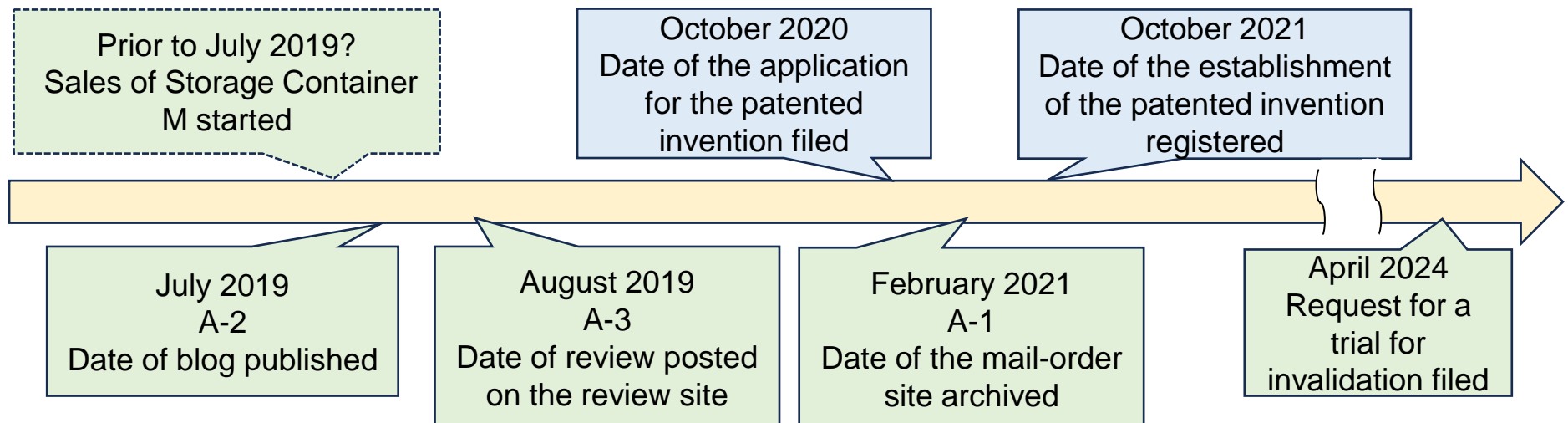
Summary of the Reason for Invalidation 1

Reason for Invalidation 1: Lack of Novelty due to the Publicly Worked Invention

Evidence submitted by the demandant:

A-1, A-2, A-3

- A-1 describes **detailed information on Mouse's product "Storage Container M,"** and the invention found from the description is **identical** to the patented invention. However, **the sales start date, etc. of the product is not stated, and the archived date is after the filing of the application for the patent.**
- Both A-2 and A-3 describe **dates prior to the filing of the application for the patent** and **the specific information on the product,** but they do not describe the information necessary to allege lack of novelty (cross-sectional view necessary to identify the shape of the flap).
- Mouse has already gone bankrupt, thus no information on the product is available from it.
- The demandant first alleged that the product was sold prior to the filing of the application for the patent based on A-2 and A-3. Then, it alleged that the product was an invention identified by the description in A-1 (A-1 invention) and that the patent was invalid for lack of novelty based on the A-1 invention.



Evidence for the Reason for Invalidation 1 (A-1) page 1/2

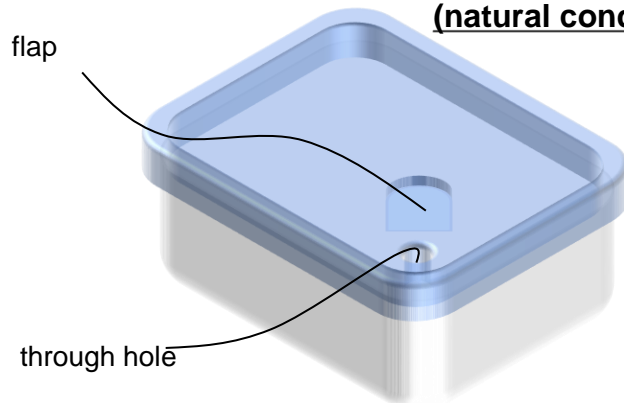
A-1 (Mouse's mail-order website, page 1/2)

Product Name: Storage Container M

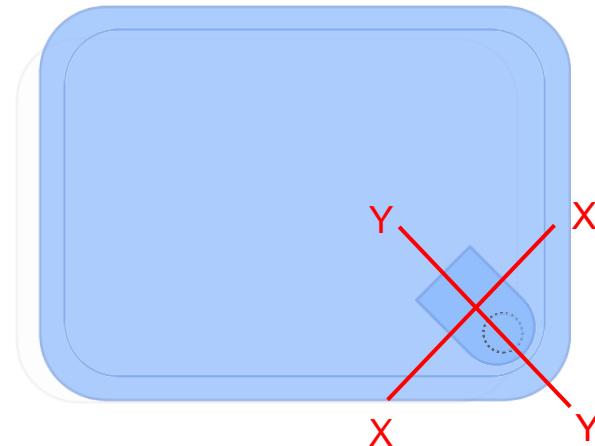
Product Information:

- Length 18cm x Width 12cm x Height 5cm
- Steam during heating is discharged through a through hole, so there is no need to worry about the lid coming off.
- When used in a microwave oven, the flap shall be left open.

**Perspective view
(natural condition)**



**Plan view
(closed state)**

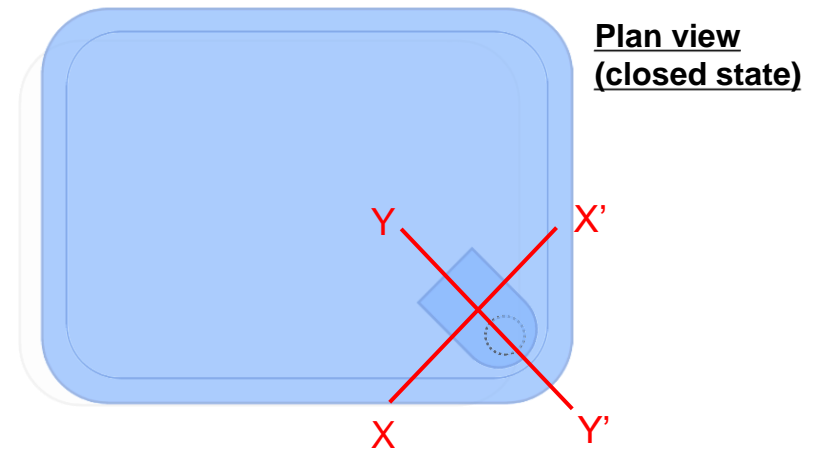
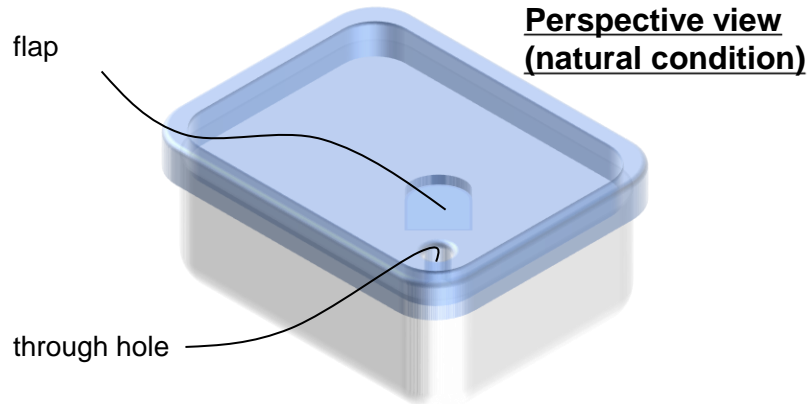


Key points of A-1:

- The invention that can be found from A-1 is **identical** to the patented invention.
- The archive was obtained **after the filing of the application for the patent.**
- **No mention of the date of sales started.**

Evidence for the Reason for Invalidation 1 (A-1) page 2/2

A-1 (Mouse's mail-order website, page 2/2)



| | <u>[X-X' cross-section]</u> | <u>[Y-Y' cross-section]</u> |
|-----------------------------|-----------------------------|-----------------------------|
| [Closed state] | | |
| [Intermediate state] | | |
| [Natural condition] | | |

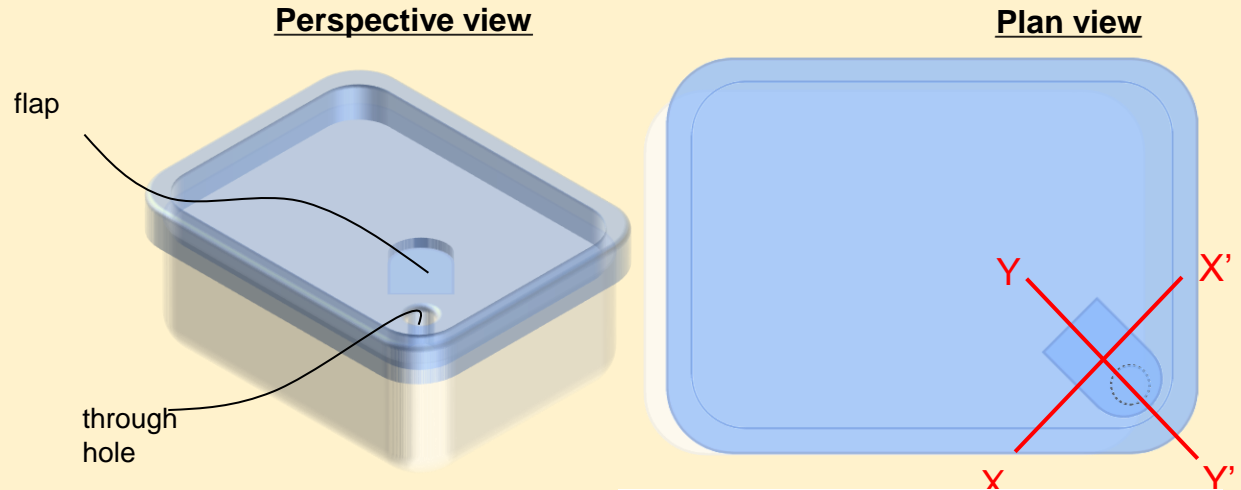
Evidence for the Reason for Invalidation 1 (A-2)

A-2 (personal blog)

Product Name: Storage Container M

Product Information:

- Length 18cm x Width 12cm x Height 5cm
- Steam during heating is discharged through a through hole, so there is no need to worry about the lid coming off.
- When used in a microwave oven, the flap shall be left open.



Source: Mouse's mail-order site

July 6, 2019

I would like to introduce you to a storage container by Mouse today.

I have been recently looking for quality storage containers as I have been making more and more food to put in the fridge, and I came across this product!

I have used various similar products in the past, but this product works well with the through hole that discharges steam well when using it in the microwave oven.

Key points of A-2:

- The “product name,” “product information,” “perspective view,” and “plan view” are exactly the same as those in A-1 (the source is also clearly indicated).
- “Cross-sectional view” is not shown.

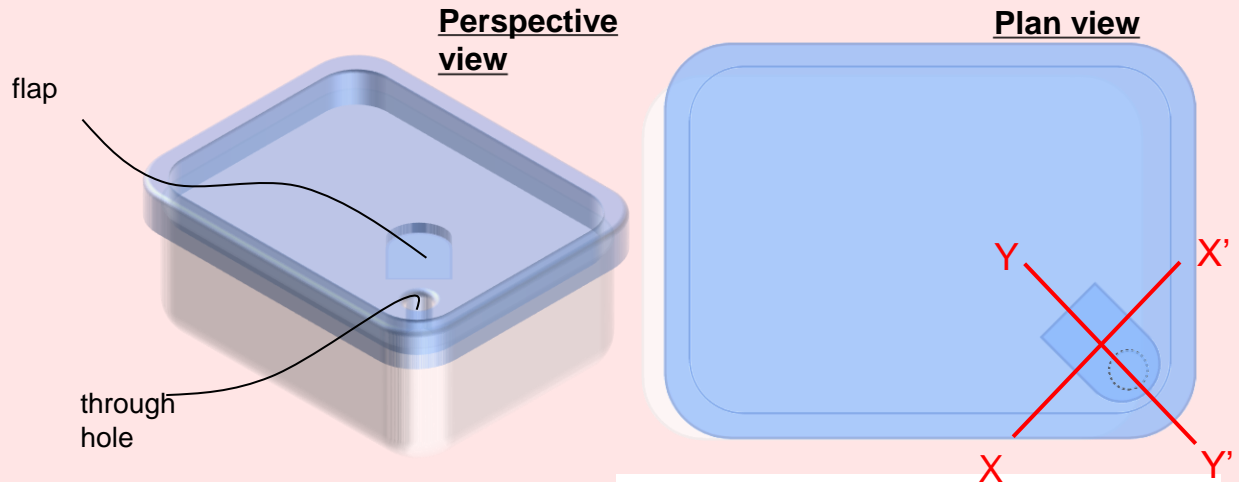
Evidence for the Reason for Invalidation 1 (A-3)

A-3 (review site)

Product Name: Storage Container
M

Product Information:

- Length 18cm x Width 12cm x Height 5cm
- Steam during heating is discharged through a through hole, so there is no need to worry about the lid coming off.
- When used in a microwave oven, the flap shall be left open.



Source: Mouse's mail-order site

● August 6, 2019 (by XX)

[Overall Rating] ☆ ☆ ☆

[Price] ☆ ☆ ☆ ☆

[Review]

The price is reasonable when compared to similar products.

● August 18, 2019 (by YY)

[Overall Rating] ☆ ☆ ☆ ☆ ☆

[Price] ☆ ☆ ☆ ☆ ☆

[Review]

The best storage container I've ever used.

Key points of A-3:

- The “product name,” “product information,” “perspective view,” and “plan view” are exactly the same as those in A-1 (the source is also clearly indicated).
- “Cross-sectional view” is not shown.

Arguments of Both Parties:

the date on which the invention was publicly known to be worked

Demandant side

Written request

Since dates are given on the personal blog (A-2) and the review site (A-3), the products reviewed on these web pages (Storage Container M) were sold on August 18, 2019 at the latest.

Demandee side (patentee)

Written reply

Because **the content of a blog or review site post can be easily edited at any time**, the blog (A-2) and the review site (A-3) **cannot be evidence that** the reviewed products **were sold** prior to August 18, 2019.

Oral proceedings

Allegation by the demandant

The blog (A-2) was created by an individual and the review site (A-3) was created by a business enterprise, and the two are created by different entities. Even if the date on one of the pages is incorrect, **it is highly unlikely that both dates described are incorrect**, so the reviewed products were sold on or prior to August 18, 2019 at the latest.

In addition, the reviewed products are identical to the A-1 invention, as **both contain identical product information and drawings that referred to A-1**.

Allegation by the demandee

Blogs and review sites in general can be easily edited even after the date of posting. In addition, because the identities of the author of the blog (A-2) and the poster of the review site (A-3) are not certain, the credibility of the content described is low. Therefore, A-2 and A-3 do not deserve to be adopted as evidence that the products were sold prior to August 2019.

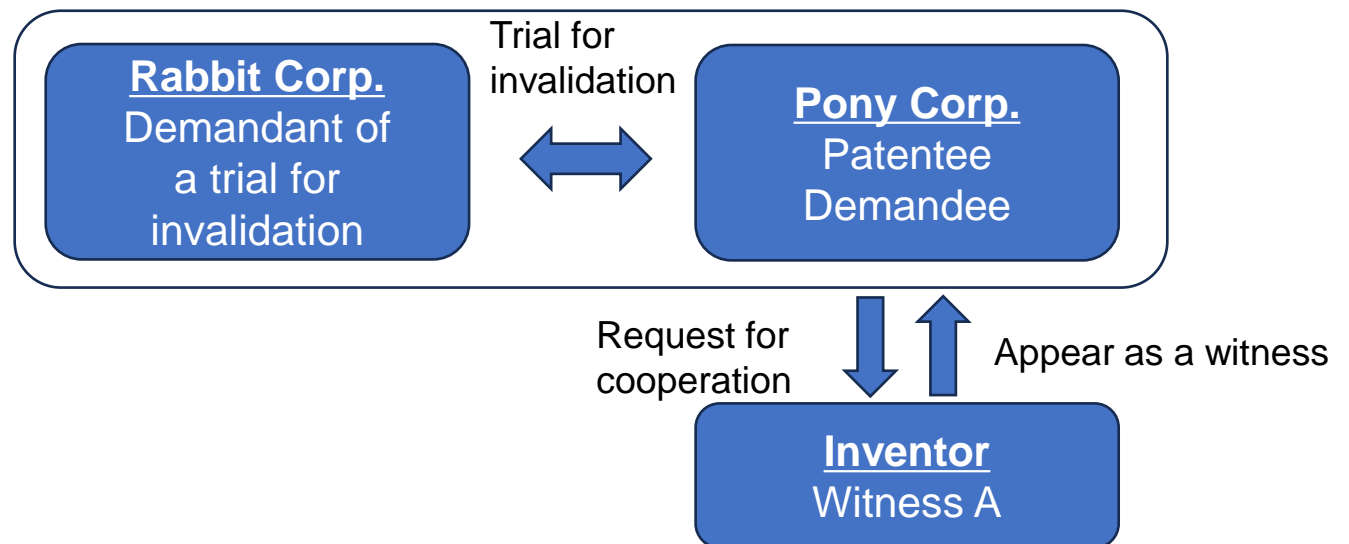
Summary of the Reason for Invalidation 2

Reason for Invalidation 2: Lack of Inventive Step

Evidence submitted by the demandant:

A-4: Public relations magazine of X City describing the results of the invention competition

- A-4 described information about an invention competition held in X City, including **detailed information** about the winning entry, “Storage Container S,” and **the judge’s comments** on it. The public relations magazine was published **prior to the filing of the application for the patent**.
- In this invention competition, local business enterprises manufactured prototypes of the prize-winning candidate products that passed the document screening, and a judge (a professor) conducted trials of the prototypes before deciding on the winners.
- **The demandant** alleged that the invention described in A-4 (A-4 invention) has an obvious problem, and that the patented invention is invalid because the patented invention could have been easily conceived by applying a well-known art to solve the problem.
- In response, **the patentee** requested **the examination of the inventor A as a witness** to prove that the inventor of the “Storage Container S” did not recognize the problem.



Evidence for the Reason for Invalidation 2 (A-4) page 1/2

A-4 (X City public relations magazine, page 1/2)

Name of prize-winning invention: Storage Container S

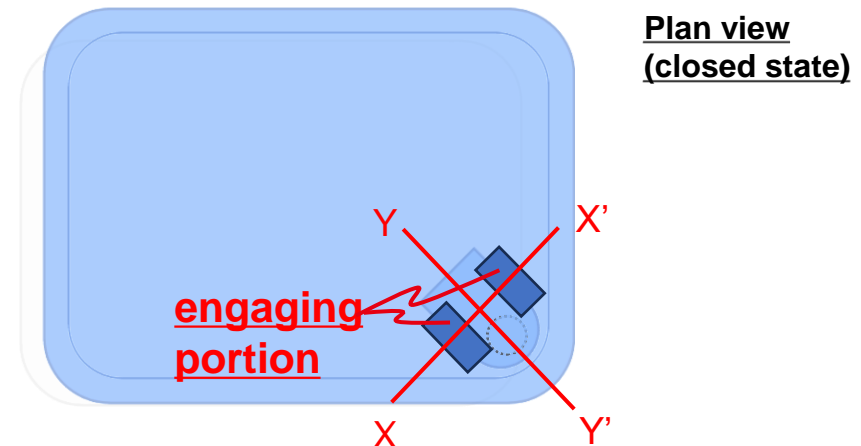
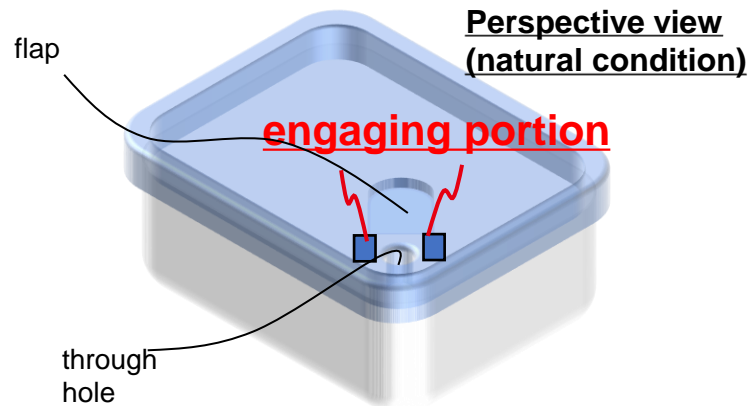
Inventor: A (resident of X City)

Outline of invention:

- A food storage container made of heat-resistant plastic.
- When used in a microwave oven, the flap can be left open to allow steam to escape through the through hole during heating, eliminating the risk of the lid coming off.

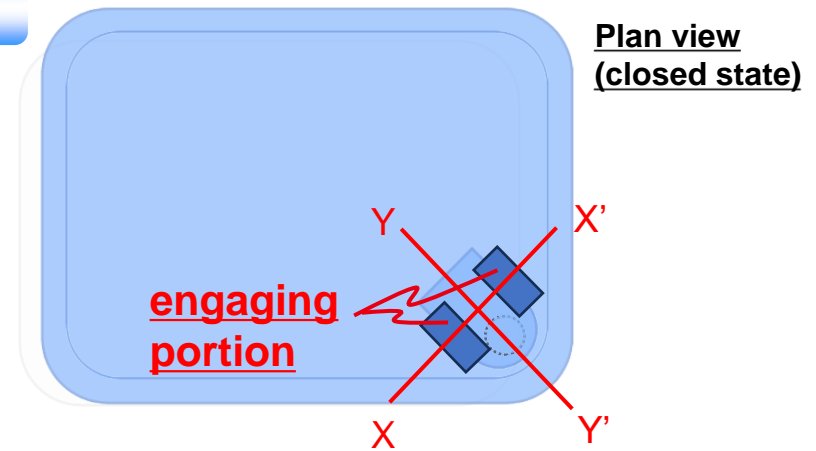
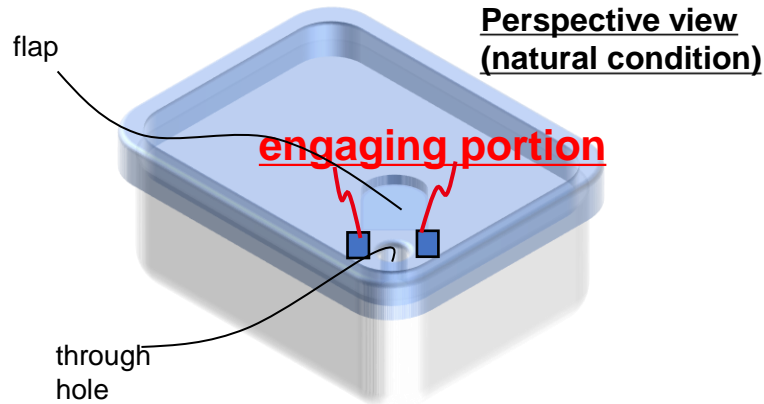
Comment by the judge (Professor P):

The through hole and the flap made it easy to be heated in a microwave oven, which was a good idea. However, **even with the flap closed, liquid sometimes leaked from the through hole when the container was tilted**, so it would have been better if this point had been improved.



Evidence for the Reason for Invalidation 2 (A-4) page 2/2

A-4 (X City public relations magazine, page 2/2)



| | <u>[X-X' cross-section]</u> | <u>[Y-Y' cross-section]</u> |
|-----------------------------|-------------------------------------|-----------------------------|
| [Closed state] | <p>X engaging portion X'</p> | <p>Y flap Y'</p> |
| [Intermediate state] | <p>X X'</p> | <p>Y Y'</p> |
| [Natural condition] | <p>X engaging portion X'</p> | <p>Y Y'</p> |

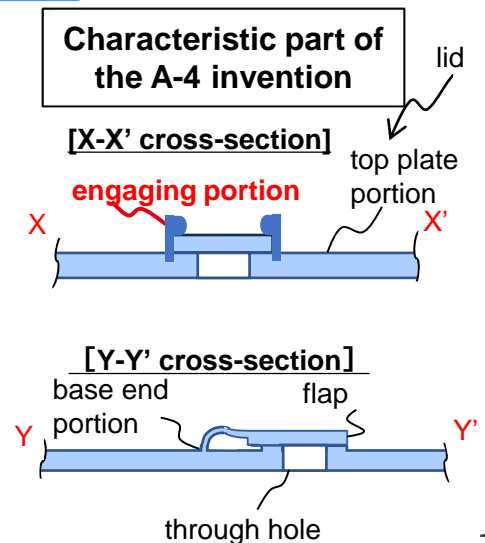
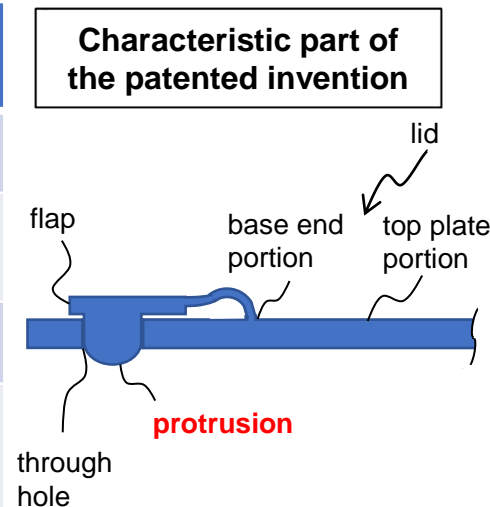
A-4 Invention and Its Differences with the Patented Invention

A-4 invention (Invention found based on A-4)

- A A lid used as a part of a storage container in which stored food can be heated in a microwave oven, the lid comprising:
- B a top plate portion that covers an opening of a container body forming a storage space and has a through hole formed therein;
- C an attachment portion that is provided on an outer periphery of the top plate portion and is configured to be attachable to an upper edge that forms the opening of the container body; and
- D' **a flap** that is provided to be elastically deformable to rotate with respect to the top plate portion, and that can close the through hole, and
an engaging portion formed on the top plate portion,
- E' wherein the flap is configured such that **the flap** is spaced apart from the through hole in a natural condition and the through hole is maintained in a closed state by **the engaging portion,** and
- F wherein the through hole is formed outside a base end portion of the flap in plan view of the lid.

Differences between the patented invention and A-4 invention

| | The patented invention | A-4 invention |
|--------------------------------|------------------------------|------------------------------------|
| Protrusion | Yes | No |
| Closure of through hole | Protrusion | Flap |
| Engaging portion | No | Yes |
| Through hole in a closed state | Maintained by the protrusion | Maintained by the engaging portion |



Well-Known Art

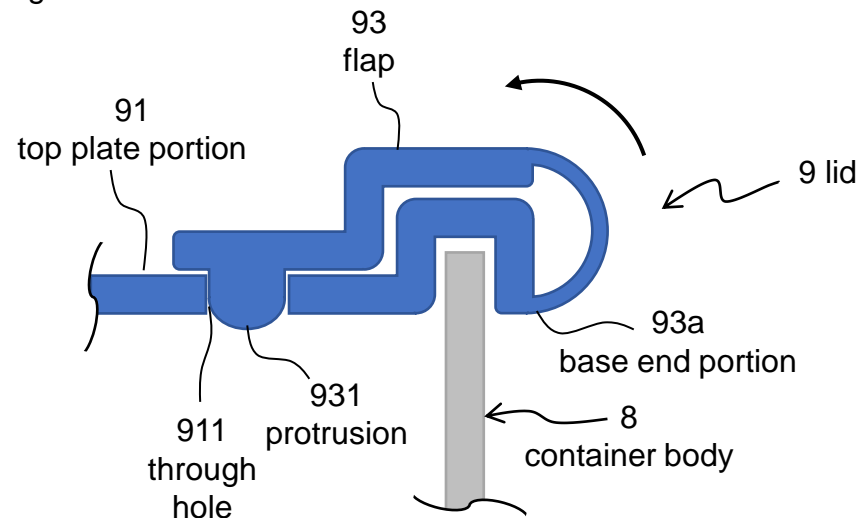
Well-known art

While, in the description of this patent invention (paragraph [0009] and fig.7B), it is described as [background art] that, in a storage container, a protrusion 931 of a flap 93 is fitted into a through hole 911 formed in a lid to make it closed,

“in order to solve the problem of liquid leakage from the through hole, the flap shall be provided such that the protrusion is spaced apart from the through hole in a natural condition and the through hole is maintained in a closed state by the protrusion” was a well-known art prior to the filing of the application for this patent.

Note: It is assumed that this matter is well known art.

Fig. 7B a partial cross-sectional view of the conventional lid in a state where the through hole is closed.



Arguments of Both Parties and Examination of witnesses: Problem of liquid leakage

Demandant side

Written request

As **the problem of liquid leakage is pointed out in the comment of A-4**, prevention of liquid leakage in storage containers is **an obvious problem that a person ordinarily skilled in the art would have naturally recognized**, since it is a problem that even a non-expert noticed. In order to solve this problem, a person ordinarily skilled in the art would have easily applied the well-known art to the A-4 invention.

Demandee side (patentee)

Written reply

Since the A-4 invention has an engaging portion and is fully equipped with a function to engage the flap in the closed state of the through hole, there is no motivation to change this function. In addition, **the liquid leakage pointed out in the comment in A-4 was not expected by the inventor, so the comment cannot constitute evidence that a person ordinarily skilled in the art recognized the problem of liquid leakage in the A-4 invention.**

Oral proceedings: Examination of the inventor A as a witness (recognition of the problem)

Examination by the demandant

(Q3) Did you (the inventor A) recognize the prevention of liquid leakage as a common problem in storage containers?
(A3) "Storage Container S" is an invention to solve the problem of steam being discharged through the through hole when heated in a microwave oven. **I did not recognize that liquid leakage from the through hole would be a problem in "Storage Container S."**

Examination by the demandee

(Q1) Did you (the inventor A) recognize the problem of liquid leakage at the time of the invention of the "Storage Container S"?
(A1) **I did not recognize the problem**, as it was not expected that the container would be used in such a way that liquid would leak through the through hole.
(Q2) In the comment in A-4, the problem of liquid leakage was pointed out. What did you think when you read that point of view?
(A2) Liquid leakage is a result of unexpected usage. **Since the comment by the judge, who is not an expert, was off the mark, I did not agree with it.**