

Trial and Appeal Practitioner Study Group

# REPORT

2020 (Summary)



Trial and Appeal  
Practitioner Study Group  
**REPORT 2020**

(Summary)

Trial and Appeal Department  
Japan Patent Office

# Preface

The chief administrative judges and administrative judges of the Japan Patent Office (JPO) review the reasonableness of the examination results concerning patents, utility models, designs, and trademarks and also review the validity of rights in order to make final decisions as an administrative agency. In order to strengthen this review process, it would be important to analyze the actual trial/appeal decisions and court decisions and improve future trial/appeal proceedings based on the analysis results. A wide distribution of the information about such analysis results would allow us to share the understanding about trial/appeal proceedings with the users of the trial/appeal system.

Based on this understanding, from 2006, the Trial and Appeal Department of the JPO started "Trial and Appeal Practitioner Study Group" (initially called "Case Studies on Inventive Step"), which invite trial/appeal experts to a meeting to discuss case studies on trial/appeal decisions and court decisions.



**Trial court of the JPO**

The discussion members of this Study Group consist of corporate IP experts, patent attorneys, attorneys, and JPO's chief administrative judges and administrative judges. A total of 631 members, including those participating in the Study Group in this fiscal year, have reviewed 173 cases. Since 2016, judges of the Intellectual Property High Court and the Tokyo District Court have also participated in the Study Group as observers. They added a legal perspective to discussions, making the Study Group more comprehensive. The discussion results of the Study Group are utilized by the JPO and have been made widely available to users of the trial/appeal system.

The Trial and Appeal Department of the JPO publicizes the discussion results of the Study Group to the world by making an English translation of a summary of this report available to the public. In the Judicial Symposium on Intellectual Property 2020 held in January 2021, we discussed one of the case studies reviewed in "Trial and Appeal Practitioner Study Group Report 2019" chosen as a topic for a panel discussion with administrative judges and other experts of Japan and those of the U.S. and Europe. Such discussion is expected to help IP experts of foreign countries understand the Japanese trial/appeal proceedings and find the Japanese IP system more reliable.

Lastly, we would like to express our gratitude to 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 for their kind cooperation for the commencement of this Trial and Appeal Practitioner Study Group. Also, we would like to convey our sincere appreciation to the discussion members and observers who participated in the Study Group and provided support for our unprecedented attempt to hold an online meeting amidst the coronavirus pandemic.

March, 2021

**HATTORI Satoshi**

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 and Food), Patent – Chemistry 2 (Pharmaceuticals and Biotechnology), Patent – Electricity, Design, and Trademark) on determinations made by the JPO and the Intellectual Property High Court focusing on specific cases as a reference or a subject.

Each group consists of corporate IP personnel, patent attorneys, lawyers as well as a chief administrative judge and administrative judges of the JPO. In addition, judges of the Intellectual Property High Court and the Tokyo District Court have 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

Each group have selected 2 cases (the first case and the second case) for examination (the details are shown in the following pages).

The first cases were selected based on a general topic (a new matter or description requirement of patent, determination of similarity of design, determination of distinctiveness of color per se trademark, etc.) considered important for the trial and appeal practices by reference to the point at issue in the recent trial/appeal decisions or court decisions.

The second cases were selected to meet the following criteria: (1) cases were selected from an appeal against examiner's decision of refusal, a trial for invalidation, a trial for rescission of registered trademark not in use, an opposition to grant of patent or an opposition to registration of trademark, where the trial/appeal decisions or court decisions were already concluded; and (2) rights in dispute do not exist in the end. Among those, the Japan Intellectual Property Association (JIPA), the Japan Patent Attorneys Association (JPAA) and the JPO recommended candidate cases and the JPO finally selected cases for the study considering important for the trial and appeal practices.



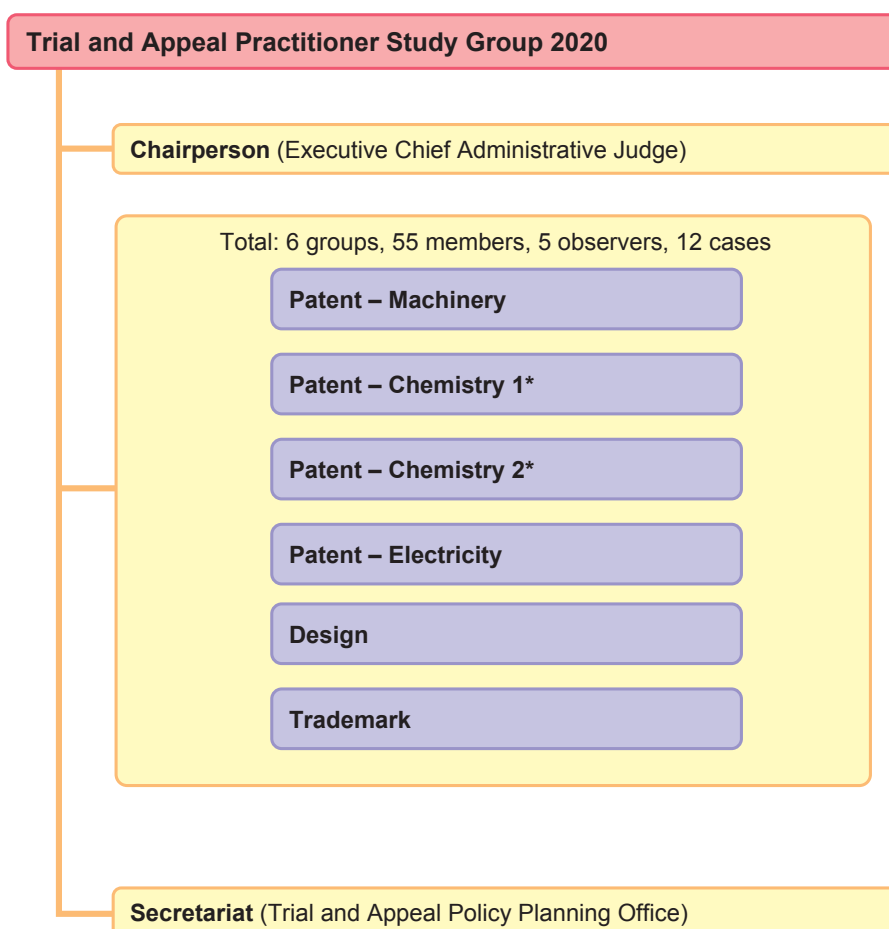
### III. Study Method

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

The members from the JPO have prepared the discussion points in advance, and at the first session, they explained outline, issues to be discussed etc. of the case. Following the first session, each member prepared an opinion on issues to be discussed, added new discussion points, and conducted further research and review as necessary.

At the second session, each member presented an opinion on issues to be discussed and the result of research, etc. The members discussed cases while giving consideration to such matters as background of the case, statements in a description, etc., evidence submitted, allegation made by the parties, previous court decisions, the members' own experience.

For preventing the spread of COVID-19 infection, all sessions for the study were conducted by a web conference.



\* Patent - Chemistry 1: General Chemistry, Food

Patent - Chemistry 2: Pharmaceuticals and Biotechnology

Organization chart of the Trial and Appeal Practitioner Study Group 2020

## Study Cases (The First Study Cases)

Field	No.	Topic	Point at Issue
Patent - Machinery	1	Clarity Requirement	<p>How should the clarity requirement be determined with regard to matters specifying the invention which are not unambiguously clear from the statement of the claim alone?</p> <p>&lt;Issue 1&gt;</p> <p>What is the "extent" when the court cases holding the clarity requirement mentioned "to the extent that the statement of the claim could cause an unexpected detriment to a third party"?</p> <p>&lt;Issue 2&gt;</p> <p>In the process of literal interpretation of the statement of the claim, how should the detailed explanation of the invention and the drawings be taken into consideration? In particular, when taking into consideration the problem to be solved by the invention, how should a distinction be made between "the claimed invention is clear" under the clarity requirement and "a problem to be solved by the invention would be actually solved" under the support requirement?</p>
Patent - Chemistry 1	2	New Matter	<p>&lt;Issue 1&gt;</p> <p>To what extent should an amendment or correction for adding any matters specifying the invention that are not explicitly stated in the initial description be accepted?</p> <p>&lt;Issue 2&gt;</p> <p>To what extent should consideration be given to ensuring that a third party who acted while taking as a premise the scope of the invention disclosed as of the filing would not sustain any unexpected detriment?</p>


Patent - Chemistry 2	3	Support Requirement	<p>How should the "problem to be solved by the invention" be found in the course of determining the support requirement?</p> <p>&lt;Issue 1&gt;</p> <p>Cases where a problem that is different from the one stated in the "Problem to be solved by the invention" of the description may be found</p> <p>&lt;Issue 2&gt;</p> <p>Changes in the claims and how to consider the statement of the problem to be solved by the invention along with such changes</p> <p>&lt; Issue 3&gt;</p> <p>How to state the problem to be solved by the invention when drafting the description</p>
Patent - Electricity	4	Clarity Requirement	<p>How to determine whether the clarity requirement is satisfied or not with regard to a matter specifying the invention which cannot be unambiguously considered to be clear based on the claims alone</p>
Design	5	<p>Determination of Design Similarity</p> <p>Expressions Used to Describe the Shape</p>	<p>Determination technique of design similarity</p> <p>&lt;Issue 1&gt;</p> <p>Border between the basic constitution and the specific form</p> <p>&lt;Issue 2&gt;</p> <p>Method to extract a group of prior designs</p> <p>Expressions used to describe the shape, etc.</p> <p>&lt;Issue 3&gt;</p> <p>Appropriateness of the expressions for finding the "impression" of the shape, etc.</p> <p>&lt;Issue 4&gt;</p> <p>Specifying the shape, etc. by using drawings and photographs</p>
Trademark	6	Color per se mark	<p>Distinctiveness acquired through use</p>

\*Patent – Chemistry 1: General Chemistry, Food

Patent – Chemistry 2: Pharmaceuticals and Biotechnology

## Study Cases (The Second Study Cases)

Field	No.	Title of Invention	JPO Docket No. (Trial/ Appeal Decision)	Date of Trial/Appeal Decision	Conclusion of Trial/ Appeal Decision	Major Issue
			Court Docket No. (Court Decision)	Date of Court Decision	Main Text of Court Decision	
Patent– Machinery	7	Metering and mixing device for multi-component substances	Appeal No. 2016-016153	September 20, 2017	Decision to maintain examiner's decision of refusal	Patent Act Article 29(2) (Inventive step)
			2018 (Gyo-Ke) 10016	November 26, 2018	Dismissal of a request	
Patent– Chemistry 1	8	Fermented beverage of soymilk and production method thereof	Invalidation No. 2017-800013	April 24, 2018	Trial decision to invalidate the patent	Patent Act Article 29(2) (Inventive step)
			2018 (Gyo-Ke) 10076	March 13, 2019	Dismissal of Request	
Patent– Chemistry 2	9	Pharmaceutical composition containing selected lanthanum carbonate hydrates	Invalidation No. 2016-800111	August 7, 2017	Trial decision to maintain the patent	Patent Act Article 29(2) (Inventive step)
			2017 (Gyo-Ke) 10171	September 19, 2018	JPO trial decision revoked	
			Invalidation No. 2016-800111	October 16, 2019	Trial decision to invalidate the patent	

Patent– Electricity	10	Information provision method, information provision program, and information provision system	Appeal No. 2017-011029	October 13, 2017	Decision to maintain examiner's decision of refusal	Patent Act Article 29(2) (Inventive step)
			2017 (Gyo-Ke) 10218	August 9, 2018	Dismissal of Request	
Design	11	Lighting device for inspection	Invalidation No. 2018-880005	November 27, 2018	Trial decision to invalidate the patent	Design Act Article 3(1) (iii) (Design similarity) and paragraph (2) of the same Article (Creative difficulty)
			2018 (Gyo-Ke) 10181	July 3, 2019	Dismissal of Request	
Trademark	12		Appeal No. 2017-16718	February 20, 2018	Decision to maintain examiner's decision of refusal	Trademark Act Article 4(1)(xi) (Similarity with other registered trademarks)
			2018 (Gyo-Ke) 10040	September 12, 2018	Dismissal of a request	

# Case 1: Patent – Machinery

Topic	Clarity requirement (the Patent Act, Article 36(6)(ii))
Issues	How should the clarity requirement be determined with regard to matters specifying the invention which are not unambiguously clear from the statement of the claim alone?
	Issue 1: What is the "extent" when the court cases holding the clarity requirement mentioned "to the extent that the statement of the claim could cause an unexpected detriment to a third party"?
	Issue 2: In the process of literal interpretation of the statement of the claim, how should the detailed explanation of the invention and the drawings be taken into consideration? In particular, when taking into consideration the problem to be solved by the invention, how should a distinction be made between "the claimed invention is clear" under the clarity requirement and "a problem to be solved by the invention would be actually solved" under the support requirement?
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• IP High Court, January 21, 2020 (2019 (Gyo-Ke) 10054, Massaging Machine) (hereinafter, Case A)</li> <li>• IP High Court, May 24, 2018 (2017 (Gyo-Ke) 10081, Modification Method for Sliding Door Device and Modified Sliding Door Device) (hereinafter, Case B)</li> </ul>

## 1. Issues discussed and discussion results

### (1) Basic points of determination of clarity

As provided in the Examination Guidelines, etc., whether the invention recited in the claim is clear is determined while taking into consideration not only the statement of the claim but also the statements of the description and drawings as well as the common general knowledge as of the filing.

Then, when taking the statements of the description and drawings into consideration in the course of determining the clarity requirement, the IP High Court holds to what extent the problem to be solved by the invention as stated in the description should be taken into consideration in 2009 (Gyo-Ke) 10434: "It is needless to say that whether or not the invention for which a patent is sought is clear should be determined from the perspective of whether or not the statement of the scope of claims is unclear to the extent that it could cause an unexpected detriment to a third party, as may be found by taking into consideration not only the statement of the scope of claims but also the statements in the description and drawings

attached to the application, as well as applying the technical knowledge shared among persons ordinarily skilled in the art at the time of the filing of the application as the basic standards."; "Seeing the objectives, etc. of the Patent Act in whole, in the process of construction of Article 36, paragraph (6), item (ii) of the Act, it is impermissible to demand that the statement of the scope of claims represent any technical meaning in relation to the function, characteristics, problem to be solved, or intended effect of the invention."

According to the above IP High Court's holding, it can be said that as a principle in the process of determining the clarity requirement, matters stated in the claim should not be interpreted as representing any technical meaning in relation to the function, characteristics, problem to be solved, or intended effect of the invention if they are not meant as such.

In addition, as the Examination Guidelines set forth the clarity requirement and the support requirement separately, these requirements should basically be determined separately.

## (2) Cases for Reference

(Case A) 2019 (Gyo-Ke) 10054, Massaging Machine

(Case B) 2017 (Gyo-Ke) 10081, Modification Method for Sliding Door Device and Modified Sliding Door Device

In both Cases (A) and (B), the IP High Court made a determination according to the determination principle under the clarity requirement, following the holding in the aforementioned precedent case, 2009 (Gyo-Ke) 10434.

In Case (B), the defendant (patentee) argued that the constituent feature of the invention described with the phrase "almost the same height as...." was added as an amendment to solve the reason for refusal and such circumstances as not stated in the claim should also be taken into consideration. However, the court rejected this argument, holding that such approach could make the scope of right unclear and "cause an unexpected detriment to a third party."

Thus, it is considered that taking into consideration the circumstances on the part of the defendant (patentee) that are not stated in the description, etc. could "cause an unexpected detriment to a third party."



### (3) Summary

#### A. Issue 1 (Regarding "to the extent that the statement of the claim could cause an unexpected detriment to a third party")

The majority of members agreed that although it is difficult to draw a clear conclusion unambiguously regarding the extent to which the statement of the claim could "cause an unexpected detriment to a third party" because it can vary depending on the extent to which the common general knowledge not stated in the description is taken into consideration, a matter that falls within the range of design errors based on the common general knowledge as of the filing would not cause an unexpected detriment.

Some members commented that a "third party" mentioned in the discussion seems to include a person skilled in the art, for example, and if a person skilled in the art who is an engineer, etc. of another company in the same industry can understand the invention stated in the claim, by making reference to the statements of the description and drawings and the common general knowledge as of the filing, the invention is clearly stated in the claim and the statement of the claim does not cause any unexpected detriment.

In this context, a third party would face difficulty when it cannot be easily judged whether the statement of the claim includes design errors, and if it does, to what extent.

With regard to the wording of the claim "almost" that was disputed in Case (B), the court held that the wording in this context falls within the range of design errors based on the common general knowledge as of the filing and therefore the claimed invention is clear, but some members commented that it could have been interpreted more broadly than meaning only design errors.

#### B. Issue 2 (Distinction between "the claimed invention is clear" under the clarity requirement and "a problem to be solved by the invention would be actually solved" under the support requirement)

In both Cases (A) and (B), the IP High Court made a determination according to the principle under the clarity requirement, following the holding in the aforementioned precedent case, 2009 (Gyo-Ke) 10434, and did not take into consideration the problem to be solved by the invention in making that determination. In future cases as well, the court will make decisions without taking

into consideration the problem to be solved by the invention in the course of determining the clarity requirement. However, as the clarity requirement has been determined more flexibly on a case-by-case basis in recent years, it is highly likely that the court will take into consideration the problem to be solved by the invention in more cases.

## Case 2: Patent – Chemistry 1

Topic	New Matter (the Patent Act, Article 17-2(3))
Issues	Issue 1: To what extent should an amendment or correction for adding any matters specifying the invention that are not explicitly stated in the initial description be accepted?
	Issue 2: To what extent should consideration be given to ensuring that a third party who acted while taking as a premise the scope of the invention disclosed as of the filing would not sustain any unexpected detriment?
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Court decision of the IP High Court, February 19, 2020 (2018 (Gyo-Ke) 10165, "Stable Bicarbonate Ion-Containing Drug Solution" Case) (hereinafter, Reference Court Decision (1))</li> <li>• Court decision of the IP High Court, August 22, 2018 (2017 (Gyo-Ke) 10216, Hair Dye, Method for Using the Same, and Hair Dye Article Case) (hereinafter, Reference Court Decision (2))</li> <li>• Court decision of the IP High Court, December 7, 2017 (2017 (Gyo-Ke) 10099, "Transparent Thin Film Field-Effect Transistor Using Homologous Thin Film as Active Layer" Case) (hereinafter, Reference Court Decision (3))</li> <li>• Court decision of the IP High Court, March 5, 2018 (2017 (Gyo-Ke) 10089 and 2017 (Gyo-Ke) 10090, "Medical Soft Container and Nutrient Supply System Using the Same" Case) (hereinafter, Reference Court Decision (4))</li> </ul>

### 1. Issue 1 (To what extent should an amendment or correction for adding any matters specifying the invention that are not explicitly stated in the description be accepted?)

(1) Determination standard of "an amendment does not introduce any new technical matter"

Before the discussion on this issue, the members were asked for their opinions about the fact that the determination standard indicated by "Solder resist" Grand Panel case i.e., "an amendment does not add any new technical matters to the technical matters that a person skilled in the art can understand, taking into account all statements in the description or drawings," is currently applied as a determination standard for adding a new matter. Some members stated that this kind of flexible standard may be necessary in order to allow an amendment for "adding matters that are obvious from the statement of the description," whereas other

members expressed opinions that the scope of amendment which may be accepted as one "that does not introduce any new technical matter" is not very clear, or that the determination that "an amendment does not introduce any new technical matter" seems to be made as hindsight analysis.

(2) Discussion by type

A. Amendment or correction for adding common general knowledge as of the filing in the technical field to which the claimed invention belongs

Most inventions in the chemical field are specified with a physical property value, but the valuation method or method for measuring or calculating the physical property value is not disclosed in the description in some patent applications. Accordingly, the members discussed whether an amendment for adding the valuation method regarding the physical property value stated in the initial description should be accepted if the amendment is made on the grounds that such method is common general knowledge as of the filing.

The majority of the members commented that an amendment for adding the common general knowledge that forms part of the claimed invention (the constituent element of the invention) should be accepted if the common general knowledge can be specified as such from the statements of the description or drawings, but they stated that a careful stance would be required toward accepting such an amendment adding the common general knowledge.

B. Amendment or correction based on the prior art or other various matters stated in the initial description

In Reference Court Decision (1), the correction for including the concentration of each substance, which was stated in the prior art, in the claims as part of the claimed invention, was accepted. In line with this court decision, the members discussed whether an amendment for including the part of prior art, which is explicitly stated in the initial description, in the claims as the constituent element of the claimed invention, should be accepted.

The members basically agreed that an amendment for including part of prior art in the claims as the constituent element of the claimed invention should be accepted only if that the part of prior art can be understood from the statements of the description or drawings.

C. Amendment or correction based on a product catalog of a device or materials used in a working example

The majority opinion was that an amendment based on a product catalog may be accepted only if it is possible to confirm, that matters to be newly added by the amendment from the product name or the product specification change history stated in the description are the matters stated in the initial description as in the case of Reference Court Decision (2). However, these matters should be limited to those related to the technical matters relevant to the nature of the invention as stated in the description or drawings.

D. Amendment or correction for narrowing the numerical limitation by adding an upper or lower limit not explicitly stated in the initial description

Opinions were divided among the members as to whether such amendment should be accepted. Those who agreed to accept such amendment commented that an amendment expanding the numerical limitation based on the disclosure in the working example would not affect the identicalness of the invention, whereas those who disagreed stated that it would be unfair to allow an applicant to change the numerical limitation freely within such the limitation by an amendment if a broad numerical limitation is stated in the initial description, because this could ruin the potential for selection inventions in subsequent applications.

E. Amendment or correction for converting the means for solving the problem, which is explicitly stated in the initial description, into a more generic concept, based on the operational function of the invention stated in the description

In Reference Court Decision (4), the amendment for converting the description of the open-close control parts provided at the opening of a medical soft container into a generic concept was accepted, by changing "the open-close control parts forming a pass-through into which a finger is to be inserted" into "the open-close control parts through which a finger of either hand is to be inserted from the right side or left side." The acceptance was made based on the operational function of the open-close control parts as stated in the initial description. The majority of the members agreed with this decision.

On the other hand, most members expressed an opinion that, in the chemical field where the prediction of the effect of an invention is difficult, it is practically difficult to make an amendment for converting a means for solving the problem, which is explicitly stated in the initial description, into a generic concept, on the

grounds that the direction in which the means is generalized is varied and thus uncertain, and that such amendment would imply that the invention as of the filing had not reached the level of the invention specified by the generic concept based on the operational function.

**2. Issue 2 (To what extent should consideration be given to ensuring that a third party who acted while taking as a premise the scope of the invention disclosed as of the filing would not sustain any unexpected detriment?)**

The members discussed to what extent consideration should be given to ensuring that a third party would not sustain any unexpected detriment due to an amendment.

The majority of the members commented that if the standard of "an amendment does not introduce any new technical matter" is determined appropriately by a person skilled in the art, it is not necessary to give additional consideration to whether a third party, who is a person skilled in the art, would sustain any unexpected detriment due to the amendment.

There was also an opinion that it may be possible to ensure to some extent that a third party would not sustain any unexpected detriment due to an amendment, by encouraging the applicant to give a detailed explanation or submit objective evidence regarding the legality of the amendment in addition to merely indicating the paragraph numbers of the amended parts of the description, so that a third party, who cannot take part in the examination or appeal procedures, can easily determine whether the amendment is appropriate.

## Case 3: Patent – Chemistry 2

Topic	Support requirement (the Patent Act, Article 36(6)(i))
Issues	How should the "problem to be solved by the invention" be found in the course of determining the support requirement?
	Issue 1: Cases where a problem that is different from the one stated in the "Problem to be solved by the invention" of the description may be found
	Issue 2: Changes in the claims and how to consider the statement of the problem to be solved by the invention along with such changes
	Issue 3: How to state the problem to be solved by the invention when drafting the description
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Court decision of IP High Court, April 13, 2018 (2016 (Gyo-Ke) 10182, 2016 (Gyo-Ke) 10184, "Pyrimidine Derivatives" Case) (hereinafter, Related Court Decision (1))</li> <li>• Court decision of IP High Court, May 24, 2018 (2017 (Gyo-Ke) 10129, "Food Product Containing Rice Saccharified Material and Rice Oil and/or Inositol" Case) (hereinafter, Related Court Decision (2))</li> <li>• Court decision of IP High Court, January 29, 2020 (2018 (Gyo-Ke) 10170, "Lithium Fluorosulfonate, Nonaqueous Electrolytic Solution, and Nonaqueous Electrolytic Solution Secondary Battery" Case) (hereinafter, Related Court Decision(3))</li> </ul>

### 1. Issues discussed and discussion results

(1) Issue 1 (Cases where a problem that is different from the one stated in the "Problem to be solved by the invention" of the description may be found)

As materials for discussion, three court decisions were picked up. In all of these cases, the problem to be solved by the invention can be clearly read from the "Problem to be solved by the invention" of the description. In the case of Related Court Decision (1), the plaintiff alleged that the problem stated in the "Problem to be solved by the invention" of the description is of a significantly low level and inappropriate based on the conditions such as a plurality of similar pharmaceutical products had already been placed on the market, and the claimed invention is not guaranteed to involve inventive step as a selection invention over the prior art that the applicant had been aware of. The court rejected this allegation, holding that: the determination of the inventive step should not be introduced into the framework of the determination of the support requirement; and it cannot be construed that



the determination of the support requirement varies depending on the applicant's subjective view as of the filing. Related Court Decision(2) pertains to the JPO decision on an opposition in which the JPO evaluated the advantageous effect of the example stated in the description in comparison with well-known art and found a problem that was higher in level than the one stated in the "Problem to be solved by the invention". However, the court revoked this decision on opposition on the grounds that the state of the art as of the filing is only a matter to be considered auxiliary in order to understand the description, and the comparison with the state of the art as of the filing should be made, if necessary, as an issue of inventive step. On the other hand, in Related Court Decision (3), the court pointed out that with regard to some items stated in the "Problem to be solved by the invention", the description does not indicate the prior art has a specific problem and the evaluation test is carried out and held that the problem to be solved by the claimed invention is not the hardship of enhancing or improving all the items stated in the "Problem to be solved by the invention", but the hardship of improving battery characteristics by enhancing or improving at least any one of these items.

The members reviewed Related Court Decisions (1) to (3) above, although in principle, the problem stated in the "Problem to be solved by the invention" column should be found as the problem as it is, there is room for finding a problem that is different from the one stated in that column. The members reached a consensus that if the statement in the "Problem to be solved by the invention" is inconsistent with the statement in other parts of the description, or if there are exceptional circumstances such as where the problem itself is not stated at all in any part of the description, as is frequently observed with foreign applications, it is permissible to find the problem based on the state of the art as of the filing.

However, opinions varied regarding specific cases where it is permissible to find a problem that is different from the one stated in the "Problem to be solved by the invention". Some members commented that this should be permitted only in limited, exceptional cases, whereas others commented that the problem could be stated not only in the "Problem to be solved by the invention" but also in any parts of the Detailed description of the invention.

With regard to the permissible level of difference between the problem thus found and the problem stated in the "Problem to be solved by the invention", the following opinions were expressed: as a basis of the description of "Problem to be

solved by the invention”, the content or level of the problem may be interpreted or supplemented, or a limitation to some of the problems stated in the "Problem to be solved by the invention" column or priority among these problems may be specified, by comprehensively understanding the statement of the Detailed description of the invention; after the comprehensive understanding, the technical value assessment or the common general knowledge may be taken into consideration if the problem can be found in diverse meanings; and even so, the common general knowledge is unlikely to be taken into consideration when finding a problem that is higher in level than the one stated in the "Problem to be solved by the invention" column.

- (2) Issue 2 (Changes in the claims and how to consider the statement of the problem to be solved by the invention along with such changes)

While claims may change by means of an amendment or divisional application, the statement in the "Problem to be solved by the invention" of the description is not amended and is kept as initially filed in most cases. Then, the members discussed how the statement in the "Problem to be solved by the invention" should be interpreted if it is kept as initially filed despite the changes in the claims.

Regarding the case of a divisional application, the members agreed that, assuming that two or more inventions were recited in the description of the original application, there is room for finding, after the division, a problem that is different from the problem stated in the original application.

Regarding the case of restriction of the claims by amendment, the majority of the members commented that there is no need to modify the statement of the problem that corresponded to the claims before the amendment, whereas some members commented that the optimal problem could vary as a result of the restriction of the claims putting emphasis on obviousness of the effect or the critical significance.

- (3) Issue 3 (How to state the problem to be solved by the invention when drafting the description)

In practices, drafters of descriptions may make various improvement when writing the problem to be solved by the invention, by considering the perspective of complying with the support requirement and also the perspective of involving inventive step over prior art. The members exchanged opinions on their practices as drafters or readers of descriptions. Knowing the actuality of practices of each other

would enable the practitioners to gain deeper insight into what is stated in each description.

## Case 4: Patent – Electricity

Topic	Clarity requirement (the Patent Act, Article 36(6)(ii))
Issues	How to determine whether the clarity requirement is satisfied or not with regard to a matter specifying the invention which cannot be unambiguously considered to be clear based on the claims alone
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Appeal against an examiner’s decision of refusal Appeal No. 2015-5914 (January 10, 2017: Appeal decision to maintain an examiner’s decision of refusal, Title of the invention "Audio encoder, audio decoder, encoded audio information, methods for encoding and decoding an audio signal and computer program")</li> <li>• Court decision of the IP High Court, September 20, 2018 (2017 (Gyo-Ke) 10116)</li> </ul>

### 1. JPO decision and court decision for reference

In this court decision for reference, the court examined an invention related to an audio encoder and found that the technical meaning of the statement that "the audio encoder is configured to use a dependency between a selection of a transition slope and a selection of a transform length or a correlation between window shapes of adjacent frames by use of the variable-length-codeword" (hereinafter "Element G") is unclear even if the description is taken into consideration. The court also held that "whether or not an invention for which a patent is sought is clear should be determined from the perspective that the scope of the claims is so unclear that they would damage the interests of third parties, where the information presented in the claims as well as in the description and drawings attached to the patent application are to be considered and the technical common sense at the time of filing the application is to be a basis of the decision.

### 2. Points of discussion

(1) Points of discussion about the JPO decision and court decision for reference

#### A. Clarity of Element G

The majority of the members agreed that the aforementioned reference court decision is appropriate. The members examined a case if the phrase "by use of the variable-length codes" was not included in Element G. The members concluded that the opinions would still be divided as to whether the clarity requirement is violated or not even if there is no such description in Element G,

and that the information presented in the description, etc. should be taken into consideration.

B. Consideration of the description, etc.

All of the members agreed that, if the patent claims are considered to be unclear, it would be reasonable to make a determination concerning the clarity based on the technical common sense as of the application filing date in consideration of the definitions of the terms used in the description, etc. and the explanation, etc. presented in the statements concerning the matters specifying the invention. Some members pointed out that, even in the case where the patent claims themselves are clear, if the description, etc. contains a definition of a term that is not in line with the technical common sense, it would be possible the patent claims to be unclear. Those members agreed that it would be necessary to consider the description, etc. Furthermore, some members pointed out that the statement "to the extent that would not unreasonably damage the interests of third parties" specifically means "to the extent that is predictable from the information presented in the claims." Those members commented that "to the extent that is predictable" means "as long as interpretation is possible based on general grammatical rules and general meanings of words." Moreover, some members pointed out that a determination should be made as to the balance among the meaning of the scope of claims, the information provided in the description, and literal interpretation based on the technical common sense from the viewpoint of whether a person skilled in the art who is a third party can understand the invention. Some of the members commented that it may be useful to examine this matter by classifying in patterns.

C. Sub-combination invention

Since this case is about a "sub-combination invention," the encoding process can be analogically interpreted from the decoding process to a certain extent. However, most members agreed that the case should be examined without special consideration.

D. Summary

As a result of the examination of this court decision, it has been revealed that it is necessary to examine "the awareness by the practitioners with regard to clarity" and "the cases where clarity became an issue in the field of electricity."

(2) Points of discussion with regard to the clarity requirement

A. Awareness by the practitioners with regard to clarity

From the perspective of the interests of third parties, regarding how to handle the situation where they come across a patent whose clarity is doubtful, some members said they would consider employing a technique to have a discussion among multiple people from a multifactorial viewpoint in order to set an appropriate technical scope. Some members said that, when they conduct prior art search on an opposition procedure, invalidation trial procedure, or an infringement lawsuit, they would try to interpret the meanings of the terms used in the description only after collecting as many referential materials as possible in light of the technical common sense as of the application filing date and the description of a basic application. Moreover, as to when reading the claims and description for conducting the search, some members said that they read the claims first, while others said that they read the claims after understanding the problem to be solved by the invention and the advantageous effect of the invention to a certain extent. However, almost all of the members replied that they check the information about the problem to be solved by the invention and the advantageous effect of the invention. This reveals that such information tends to receive close attention. From the perspective of the interests of an applicant, the members discussed why unclear claims are sometimes included. They found that such claims tend to be included in the case where an applicant tries to widen the scope of a patent right as much as possible, the case where an unskilled person prepares an application, the case where an applicant of a divisional application tries to obtain a right that falls outside the originally planned scope, and the case where a foreign application is a basic application.

B. The case where clarity became an issue in the field of electricity

The members examined other cases besides this reference case where clarity became an issue in the court decisions handed down in the field of electricity over the past five years. Then, they exchanged opinions as to what trend can be observed in those court decisions. It is difficult to clearly classify those cases, but the members tried to classify those cases into the following three categories for the sake of the convenience of reporting: (1) the cases where the issue lies in whether interpretation is impossible or not in the first place, (2) the cases where the issue lies in which of the multiple interpretations should be adopted, and (3)

the cases where a clear clerical error is included.

Regarding Category (1), some members pointed out that all the wordings included in the claims must be interpreted without any omission in principle. However, it is possible to interpret the wordings in a claim in a limited way in determination of novelty and inventive step when the wordings included in a claim only specifies "another sub-combination" and does not specify any structure, function, etc. of the claimed sub-combination invention. Regarding Category (2), some members pointed out that, since any person who drafts and checks the claims, description, etc. by himself/herself could fail to notice such inconsistency involving possible multiple interpretations, it would be beneficial to have them checked by multiple persons. Regarding Category (3), some members pointed out that it is not necessarily easy for a third party to determine whether a "clear clerical error" is included or not from the perspective of a person skilled in the art and that, if a claim includes a wording that could raise a dispute as to whether it can be regarded as a "clear clerical error" or not, such claim should be interpreted in consideration of the predictability from the viewpoint of a third party.



## Case 5: Design

Topic	Determination of design similarity (the Design Act, Article 3(1)(iii)), Expressions used to describe the shape, etc.
Issues	(1) Determination technique of design similarity
	Issue 1: Border between the basic constitution and the specific form
	Issue 2: Method to extract a group of prior designs
	(2) Expressions used to describe the shape, etc.
	Issue 3: Appropriateness of the expressions for finding the "impression" of the shape, etc.
	Issue 4: Specifying the shape, etc. by using drawings and photographs
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Court decision of the IP High Court April 22, 2019 (2018 (Gyo-Ke) 10169, "Training Equipment" Case) (hereinafter "court decision for reference")</li> <li>• Invalidation No. 2017-880003 (October 3, 2017: Trial decision to maintain the design registration, the name of the article "Training equipment") (hereinafter "trial decision for reference")</li> </ul>

### 1. Issues discussed and discussion results

#### (1) Determination of design similarity

##### A. Issue 1 (Border between the basic constitution and the specific form)

In the court decision for reference, the court held that the plaintiff's allegation concerning the basic constitution can be considered to be describing the shape in an excessively abstract manner. Regarding this point, the members discussed how to specify the basic constitution and the specific form in such new product fields as training equipment and also try to determine the appropriate scope of similarity in a design for such new fields.

##### (A) Basic constitution and specific form

Regarding what elements should be put under the category of "basic constitution" or "specific form," the members shared the understanding that this categorization process would be affected by whether there is a larger number of prior designs in the product field that should be compared with the design claimed in the application and that such process would change on a case-by-case basis or depending on the standpoint. They also shared the understanding that, when an element is put under the category of either "basic constitution" or "specific form," a detailed examination should be made because such categorization must be made based on clear

justifications.

(B) Scope of similarity in a design belonging to a new field

Regarding the scope of similarity in a new field, most of the members agreed that a wide scope of similarity would be appropriate unless it is too wide. Their reasoning is that, since a determination specified in Article 3(1)(iii) of the Design Act requires a comparison between the claimed design and publicly known designs, the scope of similarity naturally becomes narrower in a mature field where the number of prior publicly known designs is high, whereas the scope of similarity becomes wider in a new field where only a small number of publicly known designs are available for comparison.

B. Issue 2 (Method to extract prior designs)

When the common features between the claimed design and the cited design are evaluated, if those features are found to commonly exist in other prior designs as well, there is a risk that, as a result of extracting a prior design that was registered after the cited design, the cited design could appear to be more characteristic. When the members examined such risk, slightly more than half of the members found that it would be reasonable to take into consideration such design that became publicly known after the registration of the cited design. Their reasoning is that, since a determination specified in Article 3(1)(iii) of the Design Act should be about whether the claimed design has novelty or not as of the application filing date of the claimed design and that, since all of the designs that existed before the filing of the claimed design should be examined, it would be reasonable to take the design changes into consideration and to determine the common features observed in the field to which the claimed design belongs.

(2) Expressions used to describe the shape, etc.

A. Issue 3 (Appropriateness of the expressions for finding the "impression" of the shape, etc.)

Regarding how the common features and the different features are evaluated in trial/appeal decisions, the members examined whether the expressions to describe the "impression" of the shape, etc. can correctly transfer the meaning to readers and what types of expressions are considered to be acceptable when describing the "impression," while such expressions could easily contain subjectivity. Most of the members agreed that the abstract expressions used in the trial decision for reference

are mostly acceptable and that such expressions would be reasonable as long as the expressions used to describe the impression are acceptable to readers. Their reasoning is that, since a determination of design similarity must be made based on the evaluation and interpretation of "aesthetic impression," it would be natural for such expressions to contain a subjective impression.

On the other hand, many members voiced their concern that an excessively subjective evaluation from the viewpoint of administrative judges would be inappropriate. All of the members agreed that, while the use of abstract expressions is not problematic, the examiner should make the best effort to avoid excessively subjective expressions and expressions that are difficult for consumers (including traders) to understand.

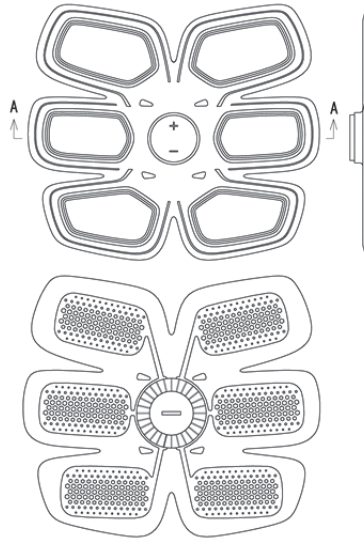
#### B. Issue 4 (Specifying the shape, etc. by using figures and photographs)

In practice, a notice of reasons for refusal and an examiner's decision of refusal specify the claimed design and the cited design by using words. However, since words are sometimes not enough to accurately describe those designs, the possibility of supplementary use of drawings and photographs and the possibility of the main use of drawings and photographs supported by the supplementary use of words came under discussion. Many members agreed that the supplementary use of drawings and photographs would be appropriate because it would increase the accuracy of an appeal decision, trial decision, etc. Their reasoning is that, while it sometimes takes time to understand expressions by words used in a trial/appeal decision or a notice of reasons for refusal, the supplementary use of drawings and photographs would make those documents more user-friendly.

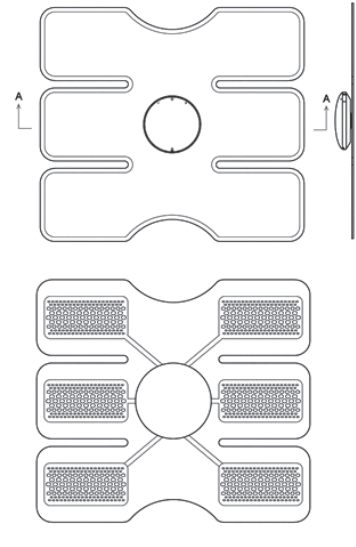
While further discussions are necessary to determine whether drawings should play a main role or supplementary role in describing designs, all of the members agreed that it would be generally acceptable to use drawings and photographs if necessary in order to specify the shape of the design in question.



[Court decision for reference]  
The registered design



[Court decision for reference]  
The design of Evidence A No.2  
[Trial decision for reference]  
The design of Evidence A No.1



[Trial decision for reference]  
The registered design

# Case 6: Trademark

Topic	Color per se mark
Issues	Distinctiveness acquired through use
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"><li>• Court decision of the IP High Court, June 23, 2020 (2019 (Gyo-Ke) 10147, "Hitachi Kenki" Case)</li><li>• Court decision of the IP High Court, March 11, 2020 (2019 (Gyo-Ke) 10119, "LIFULL" Case)</li></ul>

## 1. Issues discussed and discussion results

(1) Issue 1: The members discussed the court holding concerning the purport of Article 3(2) of the Trademark Act presented in the Court decision of 2019 (Gyo-Ke) 10147 ("Hitachi Kenki" Case) and examined its reasonableness. Many of the members agreed that the holding concerning the purport of Article 3(2) of the Trademark Act presented in this court decision is reasonable in general. While opinions were divided, the members shared the understanding that attention should be paid to the holding presented in this court decision that, in the trademark of "a single color without delineated contours," "public interest should be taken into consideration in order to prevent imposing unreasonable restriction of the free use of colors on the companies providing the designated goods."

(2) Issue 2: Analysis of the court decision presented in 2019 (Gyo-Ke) 10147 ("Hitachi Kenki" Case)

A. In the court decision, the court held that, in consideration of the fact that "the claimed trademark consists of a color that is commonly used on construction sites, etc.," the trademark cannot be considered to have acquired distinctiveness. Many of the members agreed that this holding is reasonable in general. Some members commented that they reached this conclusion because a strict examination of the claimed trademark before registration is necessary in the case of the registration of a trademark consisting of "a single color without delineated contours," which would greatly influence commercial transactions. Those members pointed out that such influence would be even stronger in the case of the registration of a trademark consisting of a color commonly used on construction sites, etc.

- B. A majority of the members agreed that, regarding the use of characters in combination with the color of the claimed trademark on the product, it was reasonable for the court to hold, in the court decision, that "the claimed trademark should be considered to represent the plaintiff's product, i.e., a hydraulic shovel, when the color and those characters are used together." The members shared the understanding that, as far as this court case is concerned, the issue lies not in the use of characters, but in the lack of distinctiveness of the color trademark.
- C. Some members said that it was reasonable for the court to hold, in this court decision, that "while the color orange could be perceived as the plaintiff's corporate color and thereby recognized as the color of the claimed trademark to a certain extent, a relevance between the color and the plaintiff's goods is still weak." On the other hand, some members said that, in the case where the color in question has been used as a corporate color, if consumers associate the color with a trademark or the origin of the goods, the close link between the trademark and the goods would not have to be indicated in an advertisement itself.
- D. Many of the members agreed that it was reasonable for the court to hold in the court decision that "the results of this survey alone are not enough for the court to find that the color of the claimed trademark was recognized as an identification mark of the origin of the goods or services." Many of the members also agreed that, since the scope of coverage of this survey is too narrow, it is difficult to place importance on the survey results as evidential material.
- E. Regarding the holding presented in this court decision concerning the use of the claimed trademark by any person other than the plaintiff and the similarity between the color in question and the color used by another person, most of the members agreed that the points of examination in this court decision are generally reasonable in consideration of the fact that, since consumers who purchase hydraulic shovels can be considered to include various construction companies that use construction machines other than "hydraulic shovels," the color of construction machines other than "hydraulic shovels" can also be seen by the same consumers and suppliers.
- F. Many of the members agreed that the holding presented in this court decision is reasonable because the court focused on the characteristics, prices, etc. of the designated goods and services and evaluated the role played by the color

accordingly. The reason is explained as follows: when consumers distinguish certain goods from others, if the color of the goods is common and does not play an important role in the industry, a similar color used by another company would be recognized by the consumers as the same color; and the consumers' dependence on the trademark would decrease when choosing the goods or services whose prices are expensive or whose functions play indispensable roles. The members shared an understanding that, as just described, it is widely accepted in society that the importance of a color differs depending on the characteristics, prices, etc. of the designated goods or services.

G. Regarding the holding that unreasonable restriction of the free use of colors should be avoided in order to protect public interest, many of the members agreed that it is natural to avoid unreasonable restriction on the free use of colors, in other words, to prevent a certain individual (company) from monopolizing a certain color, in order to protect public interest and that, as a general theory concerning a trademark consisting of "a single color without delineated contours," it is especially important to avoid unreasonable restriction on the free use of color and, therefore, that the holding presented in the court decision is reasonable.

(3) The members made a comparison between 2019 (Gyo-Ke) 10147 ("Hitachi Kenki" Case) and 2019 (Gyo-Ke) 10119 ("LIFULL" Case) and had a discussion. Some members pointed out that, while the different legal provisions were applied to these two cases, it is common in both cases that the court did not mention in the court decision the application of the specific circumstances under which a criteria of "public interest should be taken into consideration." Some members pointed out that, in consideration of the way the trademark was used in the LIFULL Case, while it was difficult for the services to prove the allegation of the trademark use, such allegation might not be completely denied depending on the case.

#### (4) Conclusion

In light of the court decision concerning the "Hitachi Kenki" Case, it can be found that the court is trying to strictly examine and determine the registrability of a trademark consisting of "a single color without delineated contours " from the viewpoint of protecting public interest.



In practice, an applicant seeking for a registration of a trademark consisting of "a single color without delineated contours" should adopt a wide interpretation of the scope of consumers who would come across the trademark, and should grasp the way the color is used in the field of the designated goods or services that are identical or similar to those of the claimed trademark, and should thereby make an allegation by describing in detail how the color has acquired distinctiveness. In the case of an application for a trademark consisting of "a single color without delineated contours," more attention should be paid to the issue of public interest in comparison with the case of any other trademark application containing a different type of trademark.

[Appendix 1]

Court decision of the IP High Court,  
June 23, 2020 (2019 (Gyo-Ke) 10147,  
"Hitachi Kenki" Case)

The claimed trademark

[Color per se mark]



<Munsell value: 0.5YR5.6/11.2>

[Appendix 2]

Court decision of the IP High Court,  
March 11, 2020 (2019 (Gyo-Ke)  
10119, "LIFULL" Case)

The claimed trademark

[Color per se mark]



<Combination of RGB:  
R237, G97, B3>

## Case 7: Patent – Machinery

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2016-16153 (Patent Application No. 2013-545358) (September 20, 2017: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision→final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, November 26, 2018 2018 (Gyo-Ke) 10016 (dismissal of a request, JPO appeal decision maintained)
Title of Invention	Metering and mixing device for multi-component substances
Major issue	the Paten Act, Article 29(2) (inventive step)
Point	Finding of technical common sense and well-known art, Determination concerning violation of the procedures and the multiple different features

### 1. Outline of the Case

The Claimed Invention is an invention related to "Metering and mixing device for multi-component substances." Since any person ordinarily skilled in the art could easily conceive of said invention, an examiner's decision of refusal was made under Article 29(2) of the Patent Act. The plaintiff (patent applicant) made an amendment to the scope of claims when the plaintiff filed an appeal against the examiner's decision of refusal. However, the JPO dismissed the amendment and made a trial decision of refusal by holding that the amendment did not satisfy the independent requirement for patentability (inventive step). In response, the plaintiff filed a lawsuit to request for revocation of the appeal decision.

In the lawsuit, the main points of dispute were what can be found as technical common sense and well-known art, whether violation of the procedures occurred, and whether any person ordinarily skilled in the art could easily conceive of the different features. The court dismissed the plaintiff's request by holding that all of the grounds for revocation alleged by the plaintiff were groundless.

### 2. Outline of the major issues discussed

#### (1) Issue 1

Appropriateness of the manner of finding new technical common sense, well-known art and conventional art when a determination is made about the

involvement of inventive step.

(2) Issue 2

Whether the following statement can be considered to be technical common sense in the machinery field in general: "In the case of a drive mechanism to linearly move the parts, in comparison with the rack-and-pinion mechanism, the feed screw mechanism would make it possible to make small adjustments by producing only such amount of drive that is relatively small in consideration of the operation amount without increasing the size or complexity of the driving mechanism." This point was disputed in the lawsuit.

(3) Issue 3

Appropriateness of the determination as to whether any person ordinarily skilled in the art could easily conceive of Different Feature 2 (Please refer to the section 3.

(3) B of the Report 2020 (full text))

### **3. Issues discussed and discussion results**

(1) Issue 1

In the court decision, regarding the appeal decision concerning the involvement of inventive step, the court upheld the appeal decision by holding that, even if new technical common sense is found, it cannot be considered to be an additional reason for refusal. The members discussed what kind of technical common sense would not be an additional reason for refusal, namely would not be regarded as violation of the procedures.

Many of the members agreed that violation of the procedures would not occur even if new technical common sense is found as long as it does not affect the conclusion.

However, many of the members commented that an addition of any technical common sense that could affect the conclusion might cause violation of the procedures and that a completely different combination of a primary cited invention and a secondary cited invention could go beyond the scope of the technical common sense of the persons skilled in the art.

(2) Issue 2

Regarding the technical common sense concerning the rack-and-pinion mechanism and the feed screw mechanism, many of the members agreed that those mechanisms can be considered to be a part of the technical common sense in the machinery field in general. Some members commented that the question of whether the rack-and-pinion mechanism can be replaced with the feed screw mechanism just for the purpose of avoiding an increase in size and complexity of the patented invention cannot necessarily be answered based on the technical common sense in the machinery field in general. Other members commented that, since a drive mechanism that uses the rack-and-pinion mechanism or the feed screw mechanism is often controlled by an electric motor, it can be considered to be technical common sense that belongs not only to the machinery field but also to multiple fields, such as the control field and the electrical field.

(3) Issue 3

The appeal decision states that, when making a determination concerning Different Feature 2 in the process of determining the involvement of inventive step of the Claimed Invention, the JPO examined the following two points: the adoption of well-known art that "uses the feed screw mechanism instead of the gear mechanism" and the change in the "ratio in terms of quantity." The JPO concluded that any person skilled in the art could easily conceive of the idea of applying well-known art to something related to a mechanical component (the "drive mechanism"). Then, after applying the well-known art concerning the drive mechanism to the primary cited invention, the JPO found that something related to a functional component (the "quantity ratio") can be considered to be a design choice.

Regarding Different Feature 2, the plaintiff alleged that, since a change takes place in two steps (a change in the drive mechanism and then the quantity ratio), any person ordinarily skilled in the art could not easily conceive of Different Feature 2. However, in the court decision, the court found that, in each step, any person ordinarily skilled in the art could easily conceive of the idea of adopting well-known art and making a design choice to the primary cited invention. The court upheld the appeal decision by holding that the determination made in the aforementioned appeal decision with regard to conceivability cannot be considered

to be inappropriate.

In light of the past court cases, the members examined whether the method of making a determination with regard to conceivability in the court decision was appropriate or not. Many of the members commented that the determination made in the court decision with regard to conceivability was appropriate. Those members commented that, if the drive mechanism and the quantity ratio are related to each other, this case could be considered to be related to the theory of so-called “easiness on easiness (*Youi no youi*”, a theory about the conceivability of a combination of cited inventions), while the drive mechanism and the quantity ratio related to Different Feature 2 may be found to be unrelated, independent differences according to the court decision. Many members commented that, if the drive mechanism and the quantity ratio are not related to each other and can be considered to be independent different features, a different secondary cited invention could be cited for each of them and concluded that the conclusion (the determination presented in the court decision) would remain the same.

In contrast, some members commented that, if the rack-and-pinion mechanism is the most suitable for the Invention because it does not require a long rotation axis, the replacement of said mechanism with the feed screw mechanism could not be considered to be technical common sense in the machinery field. For this reason, those members commented that, in the case of the primary cited invention, which functions properly thanks to the rack-and-pinion mechanism, if said mechanism is replaced with the feed screw mechanism, said invention might lose the function that cannot be performed without the rack-and-pinion mechanism. Those members commented that, if the primary cited invention loses the function as described above, the aforementioned replacement could have an obstructive factor and could result in the conclusion that inventive step is involved.

## Case 8: Patent – Chemistry 1

JPO Docket Number	Trial for invalidation Invalidation No. 2017-800013 (Patent No. 5622879) (April 24, 2018: trial decision to invalidate the patent → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, March 13, 2019 2018 (Gyo-Ke) 10076 (the request dismissed, JPO trial decision maintained)
Title of Invention	Fermented beverage of soymilk and production method thereof
Major issue	the Patent Act, Article 29(2) (inventive step)
Point	Findings of fact by evidence that became available after filing an application, Findings of different features

### 1. Outline of the case

This is the case concerning a trial to seek invalidation of a patent for an invention titled "Fermented beverage of soymilk and production method thereof."

The plaintiff alleged that the four different features found in the trial decision should be considered to be a single different feature. Regarding this point, the court decision states that, according to the information presented in the Description, it cannot be found that the adoption of the idea of combining the constituent components that embody the four different features and finding such combination as one integrated feature would bring about advantageous effects. The court held that there is no error in the trial decision with regard to the finding of different features.

In the court decision, based on a comprehensive evaluation of the circumstances related to one of the different features, i.e., the range of viscosity, the court found that, since beverages that have such a range of viscosity were sold to general consumers two to three years after the filing of the Patent Application, said range of viscosity can be considered to fall within an ordinary range that is readily acceptable to consumers. The court rejected the plaintiff's allegation by holding that it cannot be found that the condition of viscosity changed to a significant extent within two to three years after the filing of the Patent Application.

## 2. Major issues discussed

### (1) Issue 1

(Regarding the court decision in which the court examined the viscosity of the fermented soymilk of the invention based on the results of measurement of the viscosity of beverages manufactured two to three years after the filing of the application and found that the viscosity can be considered to fall within an "ordinary range" that is readily acceptable to consumers as of the filing date, and resulting in rejection of inventive step)

#### A. Finding of the viscosity readily acceptable to consumers (preference)

In the Invention, based on the results of the viscosity measurement of soymilk and fermented soymilk manufactured (purchased) after the filing date, the court found that a beverage "with a viscosity at 7 °C of 5.4 to 9.0 mPa·s " can be considered to fall within an ordinary range readily acceptable to consumers. Most of the members agreed that these facts, more specifically, the fact that the viscosity of the aforementioned soymilk, etc. was accepted by consumers and the fact that the viscosity matched the preference of consumers, can be inferred from the fact that the aforementioned soymilk, etc. are sold to general consumers. The members discussed "what are specific circumstances suspecting the credibility" of the results of measurement submitted by the parties concerned. In the Invention, both the defendant (the demandant of a trial for invalidation) and the plaintiff (the patentee) submitted different results of measurement to support the allegation of each party. The members also discussed what should be taken into consideration when making a determination in such situation.

#### B. Finding of the fact that the viscosity readily acceptable to consumers (preference) had not changed within two to three years after the filing date

Regarding the requirements that must be met in order to infer the fact that the viscosity readily acceptable to consumers (preference) has not changed within two to three years, many of the members agreed that, in view of the fact that the aforementioned soymilk has been sold under the same brand (the same product name and the same package) regardless of before or after the filing date and the fact that it is not a common business practice to keep selling products under the same brand name even after such degree of change in the product characteristics that can be perceived by consumers, it can be presumed that the product characteristics had not changed in a manner that can be perceived by consumers.

Many of the members pointed out that, in order to prove that the product after the filing date is the same as the products before the filing date, it is necessary not only to sell the product under the same brand, but also to show that no change has been made to the constituent or the manufacturing method of the product.

#### C. Influence on future practices

Some members commented that, since the court decision did not lower the required level of evidence or deny the involvement of inventive step based on a fact that became publicly known after the filing date, this court decision would not change future practices and would not greatly change the cost or labor necessary to provide evidence. Also, some members commented that it is an orthodox method to make an allegation based on publicly known art through publications and that the company should keep purchasing and storing products of other companies in order to prove what was already in public use.

On the other hand, some members pointed out that this court decision proves one more example of a case where the court did not find that, no product manufactured after the filing date can be prevented from being considered as evidence that denies inventive step just because it was manufactured after the filing date. Also, some members commented that this court decision gave them a little relief because the court decision made it possible to use a product manufactured after the filing date as evidence.

Having paid attention to the fact that the Patented Invention is a parameter invention, some members commented that, if technical significance cannot be found in terms of numerical range, it might be reasonable to make the patentee bear the burden of proof.

#### (2) Issue 2

(Regarding the court decision that did not accept the allegation of the plaintiff (patentee) that Different Features 1-1 to 1-4 should be found as a single different feature, and the court decision found Different Features 1-1 to 1-4 based on the understanding that the matters specifying the invention necessary to produce an effect of the invention should be deemed as one integrated feature)

The court decision found that, based on the working examples and comparison examples, it cannot be said that Invention 1 can produce an excellent effect only if multiple constituent elements are employed as one integrated feature. All of



the members agreed that this finding is reasonable. Some members pointed out that a determination as to different features should be made by deeming multiple matters specifying the invention as one integrated matter only when those matters specifying the invention produce synergistic effects.

Many of the members pointed out that, even if the technical significance of each of the matters specifying the invention is not supported by a working example or comparison example, it would suffice if the description states that each of the matters specifying the invention is related to each other and contributes to the resolution of the problems.

On the other hand, some members commented that there are many cases where working examples and comparison examples are indispensable to grasp the integrated constituent elements and that such cases are especially noticeable in the field of chemistry. Also, some members pointed out that the allegation that multiple different features should be integrated into one feature would lead to the recognition that all of the matters specifying the invention related to the aforementioned different features are indispensable and would therefore increase the risk of narrowing the scope of claims in the course of patent prosecution.

## Case 9: Patent – Chemistry 2

JPO Docket Number	Trial for invalidation Invalidation No. 2016-800111 (Patent No. 3224544) (August 7, 2017: trial decision to maintain the patent (first trial decision) →revoked) (October 16, 2019: trial decision to invalidate the patent (second trial decision) → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, September 19, 2018 2017 (Gyo-Ke) 10171 (JPO trial decision revoked)
Title of Invention	Pharmaceutical composition containing selected lanthanum carbonate hydrates
Major issue	the Patent Act, Article 29(2) (inventive step) (whether a person ordinarily skilled in the art could have easily arrived at the different feature; whether the Invention has a remarkable technical effect)
Point	Motivation for adopting the configuration involving the different feature; determination on whether the effect of the Invention is remarkable

### 1. Outline of the case

This is a case of a trial for invalidation of a patent titled "Pharmaceutical composition containing selected lanthanum carbonate hydrates."

The major issue is whether the Invention involves inventive step. The Invention and the cited invention differ in that the number of hydration water molecules of the lanthanum carbonate hydrates is in the range of "3 to 6" in the Invention, whereas that number is "1" in the cited invention.

In the first trial decision, the JPO recognizes inventive step in the Invention, stating that: common general technical knowledge regarding polymorphisms argued by the demandant of the invalidation trial cannot be taken into consideration; the different feature between the Invention and the cited invention could not have easily been arrived at by a person ordinarily skilled in the art; and thus the Invention has a remarkable effect.

Whereas, the court denied the existence of inventive step in the Invention and revoked the first trial decision, on the grounds that: in light of common general technical knowledge or well-known art regarding the number of hydration water molecules as of

the priority date, as argued by the plaintiff (the demandant), a person ordinarily skilled in the art who accessed the cited document would have been motivated, with regard to the cited invention, to attempt to prepare lanthanum carbonate hydrates with a different number of hydration water molecules, and could have easily arrived at lanthanum carbonate hydrates with 3 to 6 hydration water molecules; and that the effect of the Invention cannot be regarded as being remarkable.

## **2. Major issues discussed**

- (1) Issue 1 (Basis for determining the presence of a motivation in the case where the primary prior art does not state any motivation for adopting the configuration involving the different feature)

The members discussed how the presence or absence of a motivation should be determined in the field of chemistry if the primary prior art does not state or suggest any motivation, and in such case, what factors can be used as the basis for determining the presence of a motivation.

The members reached a consensus that whether common general technical knowledge or well-known art as of the filing date (priority date) could have been applied to the primary prior art should be determined by considering the relevance of technical fields, the similarity of problems, operation, function, etc, the problems generally known, and the solution that a person ordinarily skilled in the art would have normally tried, and also by comprehensively taking into consideration whether there is a factor obstructing the application to primary prior art, and whether the application produces an unpredictable, remarkable effect. As examples of common general technical knowledge that may be used as the basis for a motivation in the fields of chemistry and medicine, the members mentioned alteration and optimization of a dosage form, crystal polymorphism, hydrate, salt, pH, etc. In the field of biotechnology, an established method such as the acquisition of antibodies or aptamers was mentioned as such example.

- (2) Issue 2 (Changes in the allegations of the plaintiff (the demandant) regarding the ease in arriving at the different feature)

In this case, the plaintiff (the demandant) changed its allegations regarding common general technical knowledge in the litigation stage from those in the JPO trial stage. The members discussed whether such changes in the allegations are

acceptable.

The members agreed that in this case, the plaintiff's allegations and proof in the JPO trial stage and those in the litigation stage are basically the same in that both discussed common general technical knowledge to be applied to the primary prior art, and therefore it is appropriate for the court to have accepted the plaintiff's allegations and proof in the litigation stage.

- (3) Issue 3 (Subject of comparison for determining whether the Invention exerts a remarkable effect)

The court held that in the process of determining whether the Invention exerts a remarkable effect, comparison should be the "effect that could be predicted from the state of the art as of the priority date of the Application on the assumption that the cited invention had applied to the configuration of the Invention relating the different feature." The members reached a consensus that this is appropriate as it is in line with the holding by the Supreme Court (Topical Ophthalmic Formulations Case, 2018 (Gyo-Hi) 69, Court decision of August 27, 2019). At the same time, some members pointed out that it would be difficult to predict the effect when an invention to be compared is applied to the Invention, because the effects of inventions in the fields of chemistry and biotechnology are not very predictable.

- (4) Issue 4 (Comparison between the effect of the Invention and the effect of the cited invention)

In connection with the comparison between the effect of the Invention and the effect of the cited invention, the members discussed what the defendant (the patentee) could have alleged in order to have the court support the existence of an inventive step in the invention. One of the members commented that if the defendant had indicated common general technical knowledge to the effect that the number of hydration water molecules could have a different influence between in the experiment condition of pH3, which was adopted in the Description, and in the experiment condition of pH 7, which was adopted in the primary prior art, and then the defendant could have alleged that the Invention with the abovementioned number of hydration water molecules in pH3 had an unexpected effect on the grounds that it was quite useful since a great effect could be obtained at pH3, where the environment is similar to the stomach. In addition, some members commented

that although the description of the Application indicated the relationship between the number of hydration water molecules and the effect of the Invention using data (a convex graph), the plaintiff (the demandant) may not have fully explained that it successfully predicted the number of hydration water molecules that could bring about the maximum effect. Other members commented that even by referring to that data, it would have been difficult for the defendant to argue that the number of hydration water molecules has critical significance. There was also the following opinion: the defendant could have argued that, since the primary prior art suggests that the type of cations to absorb phosphoric acid has an influence on the effect, it is normal to think that the effect will remain the same even if the number of hydration water molecules is changed, and therefore it is difficult to predict the effect of improving the phosphate ion removal rate by choosing a particular number of hydration water molecules; thus, the defendant could have argued the remarkable effect of the Invention while lowering the level of the "effect that can be predicted from the cited invention." The discussion was highly suggestive, with the members considering possible approaches for alleging and proving the effect of the Invention from various perspectives.

# Case 10: Patent – Electricity

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-11029 (the examiner's decision maintained) (October 13, 2017: decision to maintain an examiner's decision of refusal in appeal against the examiner's decision → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, August 9, 2018 2017 (Gyo-Ke) 10218 (dismissal of a request, JPO appeal decision maintained)
Title of Invention	Information provision method, information provision program, and information provision system
Major issue	the Patent Act, Article 29(2) (inventive step) (Finding of the cited inventions, Existence of motivation)
Point	To what extent is it possible to take into consideration a well-known technical problem that is not explicitly stated in the cited documents?

## 1. Outline of the Case

This is a case about an appeal against the examiner's decision of refusal concerning a patent application for an invention titled "Information provision method, information provision program, and information provision system."

The appeal decision states that the presentation of a "virtual operator," which is not described in the Cited Invention 1, was made merely as a result of the exercise of ordinary creativity and also states that, in connection with the problems to be solved by the Cited Inventions 1 and 2, the JPO found a well-known problem that is not explicitly described in the Cited Inventions 1 and 2. As a conclusion, the JPO determines a person skilled in the art can easily conceive of the Invention based on the Cited Inventions 1 and 2 and well-known matters.

In the court decision, the court dismissed the plaintiff's request by holding that, in consideration of the well-known matters, it would be natural to consider that an "agent" of Cited Invention 2 includes "a person who imitates an actual operator of a company (virtual operator)." The court also stated that the JPO found the well-known problem without developing a generic concept.

## 2. Major issues discussed

(1) Issue 1 (Motivation to combine a well-known problem with cited documents)

A. Finding of the well-known problem "Facilitation of media communication,"

which is not explicitly stated in the Cited Inventions 1 and 2

First, the members examined the appropriateness of the court decision that found the aforementioned well-known problem and shared the understanding that the court decision was appropriate. As the grounds for such understanding, many of the members pointed out that, even though there are concrete problems that are different from each other, the well-known problem can be found based on other documents. In view of the fact that the Cited Inventions 1 and 2 belong to the technical field of voice automatic response system, some members commented that the problem was self-evident and that the cited documents do not contain information about such problem simply because it is well known.

B. Extent to which a well-known problem can be taken into consideration if the problem is not explicitly stated

Many of the members mentioned that a determination as to whether a well-known problem can be taken into consideration should be made based on whether the technical field is the same or not. Many of the members pointed out that, even if the same wording is used, it could mean different things in different technical fields.

Many of the members commented that, if certain problems are stated in many of the prior art documents, it should be acceptable to develop them a generic concept and find them as a well-known technical problem. Some members pointed out that it would be possible to find a problem based only on one cited document by setting some criteria, such as "whether the problem in question is self-evident" and "whether the problem is easy to discover."

C. Whether it is possible to deny the involvement of inventive step in the Invention if the well-known problem "Facilitation of media communication" cannot be found

Many of the members who support the idea of denying the involvement of inventive step pointed out that, if careful consideration is given to the relatedness between the technical fields, the problems that any person skilled in the art could easily conceive of, and other common problems, it would be possible to present the grounds for finding the existence of a motivation to combine the Cited Inventions 1 and 2. Some of the members who support the idea of finding the involvement of inventive step pointed out that, the involvement of inventive step cannot be denied without finding the reasonable grounds for selecting the

Cited Inventions 1 and 2 or finding a motivation to combine them. Regardless of which idea the members support, they agreed that a determination concerning the involvement of inventive step would be greatly affected by whether it is possible to present the grounds for finding the existence of a motivation to combine different prior art references.

- D. What should be taken into consideration in the case where the problem to be solved by the Invention is different from the problem to be solved by cited inventions

Many of the members commented that cited documents must be selected based on reasonable grounds and that, even if the technical field is identical with that of the Invention, it would be necessary to carefully examine whether the cited invention, particularly the primary cited invention, is appropriate or not. Some members pointed out that the problems to be solved by the Cited Inventions 1 and 2 should not be taken lightly even if emphasis is placed on the problem to be solved by the Invention.

(2) Issue 2 (Concept included in an "agent" of the Cited Invention 2)

First, the members discussed the similarity between such concepts as an "agent," a "virtual operator," and a "character." Some members commented that it is impossible to find any significant difference in terms of the role and effect of each of those concepts, while other members commented that there are small differences among them depending on how each of those concepts is described in the descriptions. As far as compared with the Invention, the members agreed that there is no difference in terms of role and effect.

Next, the members discussed the finding presented in the court decision that an "agent" of Cited Invention 2 naturally includes a "virtual operator." The members agreed that, in consideration of the well-known art, the finding presented in the court decision is appropriate. Many of the members commented that it is necessary to examine the problem and effect of the cited invention and the technical common sense as of the application filing date. Some members pointed out the importance of the statement "characters including fictitious persons and anthropomorphic animals" and the importance what to suggest by the figures indicating the characters (Figure 6) presented in the Cited Document 2.



(3) Issue 3 (Difference in the effects of an "agent" and a "person who imitates an actual operator of a company (virtual operator)")

Some members commented that an outstanding effect can be recognized, in addition to the effect described in the initial description, if an "agent" and a "virtual operator" are displayed separately and used to conduct an experiment in which the differences between the two can be shown in terms of users' reaction speed and the number of accesses. Furthermore, regarding the relationship between the effect and the determination of involvement of inventive step, some members commented that, in the case of an invention in the field of AI for example, even in the case of the same machine learning model, the recognition accuracy could improve, depending on input data. Those members agreed that, in such case, it will be important to determine whether the effect can be considered to be outstanding. When the members discussed the details of the effect, those members commented that, if an advantageous effect exists, it could imply that, despite the existence of an advantageous effect, such effect is insufficient to complete an invention as of the application filing date, however, it could be enough to imply an obstructive factor that could prevent an attempt at combination. Some members commented that, if an outstanding effect exists, the involvement of inventive step may be affirmed as long as any person skilled in the art cannot predict such effect.

# Case 11: Design

JPO Docket Number	Trial for invalidation Invalidation No. 2018-880005 (Design Registration No. 1224615) (November 27, 2018: trial decision to maintain the design registration →final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, July 3, 2019 2018 (Gyo-Ke) 10181 (dismissal of a request, JPO trial decision maintained)
Title of Invention	Lighting device for inspection
Major issue	the Design Act, Article 3(1)(iii) (Design similarity) and paragraph (2) of the same Article (Creative difficulty)
Point	Finding of the partial design, Determination concerning novelty and creative difficulty

## 1. Outline of the Case

This is a case where a trial for invalidation was requested in connection with the design registration (partial design) for an article "Lighting device for inspection."

In the trial decision, the JPO found that the Registered Design is similar to neither the Cited Design 1 (Evidence A No. 1) nor the Cited Design 3 (Evidence A No. 3). The JPO also found that it would be difficult to create the Registered Design based on the Cited Design 1 or the Cited Design 3, or a combination thereof (Trial decision to maintain the registration of the Registered Design).

In the court decision, the court also denied similarity and difficulty in creation and dismissed the request of the plaintiff (Demandant of the trial) (Court decision to dismiss the request).

## 2. Major issues discussed and discussion results

(1) Issue 1 (Appropriateness of the finding of the basic constitution and specific constitution)

The members examine the appropriateness of the finding of the configurations of the Registered Design and the cited designs presented in the trial decision and the court decision. Regarding this point, many of the members agreed that, despite the difference in the expressions used in the trial decision and the court decision, they mean the same thing in substance and that the findings presented in the trial

decision and the court decision are appropriate.

- (2) Issue 2 (Appropriateness of the finding that the position for drawing the power cable out is the most important point for consumers)

In the court decision, the court held that, in the case of the Registered Design, the position of the power cable is the most important point for consumers. Regarding this point, many of the members agreed that the finding presented in the court decision is appropriate because the position of the power cable greatly affects the user-friendliness of lighting device for inspection.

- (3) Issue 3 (Reasonableness of comparing the two designs from the perspective of whether "position" means a vertical position or horizontal position)

In light of the situation where the Registered Design is a partial design whereas the cited design is a design for a whole article, the members examined the reasonableness of comparing the two designs from the perspective of whether "position" means a vertical position or horizontal position. Regarding this point, many of the members questioned the finding presented in the court decision because it seems to be unreasonable to believe that a heat-releasing function of the heat sink cannot be performed unless it is positioned in a vertical manner.

- (4) Issue 4 (Method to convince the applicant and the demandant when a reference design is presented in the trial decision (or the examiner's decision of refusal) for the first time in response to the allegation from the applicant or the demandant)

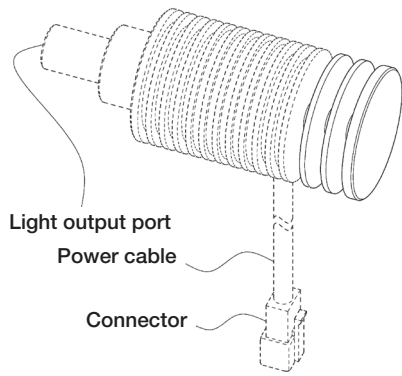
The members examined a case where a reference design is presented in the trial decision (or the examiner's decision of refusal) for the first time in response to the allegation from the applicant or the demandant. The members discussed what measures can be taken to make sure that the applicant and the demandant are convinced about such reference design. Regarding this point, some members commented that the demandant would be convinced without problem. On the other hand, some members commented that the JPO should give the demandant an opportunity to present a counterargument.

- (5) Issue 5 (Reasonableness of making a determination based on the same cited design under Article 3(1)(iii) of the Design Act and paragraph (2) of the same Article)

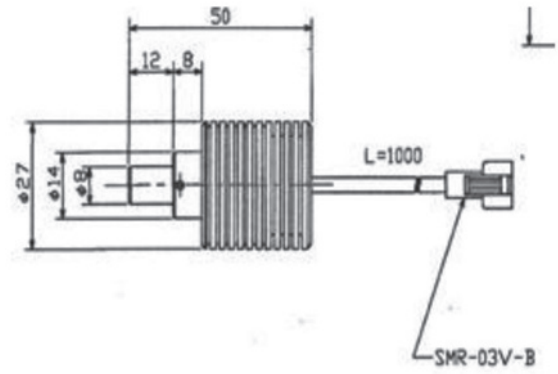
The members examined the reasonableness of making a determination based on the same cited design under Article 3(1)(iii) of the Design Act and paragraph (2) of the same Article (whether both provisions, i.e., Article 3(1)(iii) of the Design Act and paragraph (2) of the same Article are applicable to the same cited design). Regarding this point, some members commented that the same cited design could be used as a reference as is the case with a cited invention that is taken into consideration when making a determination concerning novelty and inventive step under the Patent Act.

- (6) Issue 6 (Relationships between an unknown configuration, novelty and originality of the newly conceived design, and motivation)

In the court decision, the court held that, if a part of the configuration of the Registered Design has an unknown configuration, it can be found that the creation of such configuration proves novelty and originality of the newly conceived design. The court also held that, as far as the unknown configuration is concerned, a motivation to create such configuration cannot be found in principle unless there is any other evidence. The members examined the reasonableness of such determination of the court. Regarding this point, many of the members commented that the finding presented in the court decision is reasonable because the word "motivation" can make sense, although this word seems to be frequently used in relation to a determination concerning patentability.



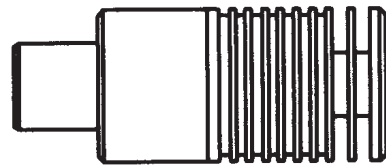
**Registered Design**  
[Referential perspective view]



**Cited Design 2**  
(Reference material 1)




**Cited Design 1**



**Cited Design 3 [Front view]**

## Case 12: Trademark

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-16718 (February 20, 2018: decision to maintain an examiner's decision of refusal)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, September 12, 2018 2018 (Gyo-Ke) 10040, Case to request for revocation of the appeal decision (dismissal of a request, JPO appeal decision maintained)
Trademark	 [Designated goods]:   Class 21 "Fences for pets; combs for pets; toilets for pets; feeding vessels for pets; brushes for pets," etc.
Major issue	the Trademark Act, Article 4(1)(xi)(Similarity with other registered trademarks)
Point	Determination of similarity between trademarks containing characters shaped as designs

### 1. Outline of the case

This case is about a trademark consisting of a figure (the "Figure Part") having a black semi-elliptical shape containing a white picture that appears to be a dog standing with his nose pointing toward the right and the "OGGY" part placed to the right of the Figure Part. A trademark application was filed for this Claimed Trademark covering "Fences for pets," etc. as its designated goods. However, the applicant received an examiner's decision of refusal and filed an appeal against the examiner's decision of refusal. The JPO made an appeal decision that this appeal is unacceptable because this trademark falls under Article 4(1)(xi) of the Trademark Act. In this case, the applicant requested revocation of the appeal decision.

In the court decision, the court further examined the applicability of Article 4(1)(xi) of the Trademark Act and dismissed the plaintiff's request. The court dismissed the request of the applicant under Article 4(1)(xi) of the Trademark Act by holding that the Claimed Trademark and the cited trademark are identical in terms of pronunciation and concept in consideration of the extent to which the character "D" is shaped as a design although the two trademarks are different in terms of appearance, more specifically in terms of the existence or absence of the character "D" shaped as a design and also by holding that, since the two trademarks have a configuration that can be recognized as

the alphabetic characters "DOGGY," such appearances of those trademarks are likely to cause confusion about the source of goods.

## **2. Major issues discussed**

(1) Issue 1 (Regarding the finding of the Figure Part (the process of finding the Figure Part to be the character "D" shaped as a design))

- A. The members pointed out the following three points to determine what should be taken into consideration as the most important element when finding that the Figure Part consists of the character "D" shaped as a design. In order for consumers and traders who come across the Claimed Trademark to recognize that the Figure Part consists of the character "D" shaped as a design, it is important for them to understand that said part has the same shape as "D." Thus, the members pointed out that (1) it is important to have the same shape as "D" with serifs. The members also pointed out that (2) it is important that the Figure Part does not have a distinctive design, recognizing that, if the Figure Part has a distinctive design and gives a special impression, the design could have a distinctive function of source as a figure since the distinctiveness of "DOGGY" is insufficient. Some members further pointed out (3) since the dog's silhouette can be associated with "DOGGY" which creates the concept of a "dog" from the Claimed Trademark, it is important that the white part inside the Figure Part has the shape of a dog.
- B. The court decision and the appeal decision found that the white picture inside the Figure Part has the shape of a dog. The members agreed that, if the white part did not have the shape of entire dog (for example, a picture of a part of a dog, footprints of an animal, a bone, which dogs like, and so on), it would not affect the conclusion because any of such picture can be associated with dogs to a certain extent. On the other hand, the opinions of the members were divided about a case where the white part inside the Figure Part has the shape of something unrelated to dogs (for example, a car or an airplane).
- C. Many of the members concluded that, regarding the difference between the court decision and the appeal decision in terms of how and what the court or the JPO found about the white picture inside the Figure Part, the court decision is the same as the appeal decision in substance. The members came to the conclusion that, in a lawsuit, in response to the plaintiff's allegation that "It cannot be said

with certainty that (the picture part) can be recognized as a dog," the court explained the reason why the picture can be easily perceived as a dog and that the court merely gave a more detailed explanation than the JPO, which gave an explanation about the reason in the appeal decision.

D. Opinions are divided among the members as to whether the actual trade condition of the designated goods, i.e., pet-related products, influences a determination as to whether the Figure Part can be found as the character "D" shaped as a design. Some members found that such influence does not exist because, without taking into consideration the actual trade condition, the Figure Part can be considered to be the character "D" shaped as a design. Other members found that such influence exists because, if the designated goods were something unrelated to dogs, it would be rather forcible to combine the character "D" with "OGGY" and recognize them as the word "DOGGY," which can be associated with the concept of dogs.

(2) Issue 2 (Regarding the finding of the pronunciation and concept associated with the Claimed Trademark)

A. Regarding how the court decision and the appeal decision found the pronunciation and concept associated with the Claimed Trademark, the opinions were divided among the members as follows: (1) since the court decision and the appeal decision basically found them in the same way, the method of finding is agreeable in both cases; (2) the court decision, which adopted a more careful method, is more appropriate; and (3) the finding presented in the court decision is rather overstated.

B. The members examined how much importance should be attached to the relationship with the Designated Goods when it comes to the finding of the pronunciation and concept associated with the Claimed Trademark. Some members commented that (1) no importance needs to be attached, while other members commented that (2) importance should be attached to a certain extent. They explained the reason for the former comment by saying that the designated goods of the Claimed Trademark include a wide range of products such as cosmetics, while the reason for the latter comment is that the relationship with the designated goods of the Claimed Trademark is important because the "OGGY" part alone cannot be easily recognized as a word (or an idiom) that has



a certain meaning.

(3) Issue 3 (Regarding the distinctiveness of the word "DOGGY" in relation to the designated goods)

A. Many of the members commented that the distinctiveness of the word "DOGGY" must be considered to be weak in relation to the designated goods because "DOGGY" can be found as a simple word meaning "related to dogs."

B. Regarding the prior art effect of the cited trademark to exclude later applications, some members mentioned that: (1) although the distinctiveness of the cited trademark is weak, it is inevitable to find a trademark as a similar trademark as long as it has the same appearance and pronunciation; and (2) ultimately, a determination must be made based on whether there is the likelihood of confusion about the source of goods or services.

## **Trial and Appeal Practitioner Study Group REPORT 2020 (Summary)**

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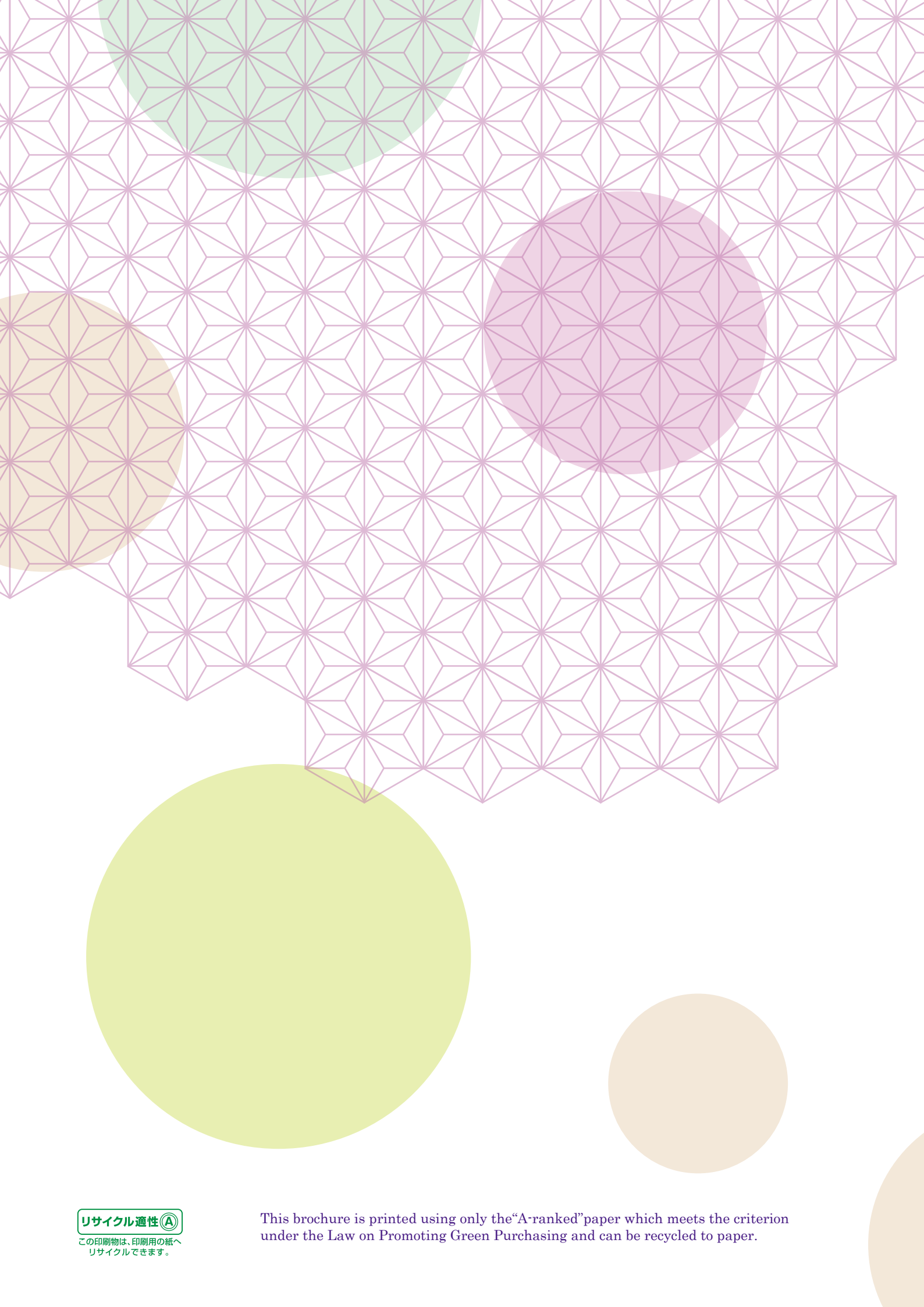
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