Trial and Appeal Practitioner Study Group

$\underset{(Summary)}{REPORT} 2021$





Trial and Appeal Department (TAD) Japan Patent Office

Trial and Appeal Practitioner Study Group

REPORT 2021

(Summary)

Trial and Appeal Department Japan Patent Office

Preface

The chief administrative judges and administrative judges of the Japan Patent Office (JPO) review reasonableness of the examination results concerning patents, utility models, designs, and trademarks and also review validity of the 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 and appeal decisions and court decisions and improve future trial and 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 and appeal proceedings with users of the trial and 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 Steps"), in which corporate IP experts, patent attorneys, attorneys, and the JPO's chief administrative judges and administrative judges gather to discuss case studies on trial and appeal decisions and court decisions. By this fiscal year, a total of 691 members have reviewed 185 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.



Trial court of the JPO

In FY2021, as in the previous fiscal year, the Study Group members discussed general issues in six fields (e.g., for patents, new matter and description requirements, the remarkable effect in the course of determining inventive step, and patent eligibility; creativity in designs; and distinctiveness of a position trademark), and also picked up one particular case in each field and reviewed it. All meetings were held online and the members engaged in active discussions.

The discussion results of the Study Group are utilized by the JPO and have been made widely available to users of the trial and appeal system. These discussion results are also publicized to the world in the form of an English translation of a summary of this report. In the Judicial Symposium on Intellectual Property 2021 held in October 2021, one of the cases reviewed in "Trial and Appeal Practitioner Study Group 2020" was chosen as a topic for a panel discussion between administrative judges and other experts of Japan, Indonesia, Korea, Singapore, China, and the Philippines, with regard to determination of involving inventive step of a patented invention. Such discussion is expected to help IP experts of foreign countries understand the Japanese trial and 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 held online amid the coronavirus pandemic continuing from last year.

March, 2022

TAMURA Kiyoko

Executive Chief Administrative Judge Trial and Appeal Department Japan Patent Office

Contents

Outline of Study	5
Case 1: Patent – Machinery	11
Case 2: Patent – Chemistry 1	17
Case 3: Patent – Chemistry 2	21
Case 4: Patent – Electricity	25
Case 5: Design	29
Case 6: Trademark	33
Case 7: Patent – Machinery	37
Case 8: Patent – Chemistry 1	41
Case 9: Patent – Chemistry 2	45
Case 10: Patent - Electricity	49
Case 11: Design	55
Case 12: Trademark	59





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

Outline of Study

I. Study Framework

Studies were conducted by each of the six groups (Patent – Machinery, Patent – Chemistry 1 (General Chemistry), Patent – Chemistry 2 (Pharmaceuticals and Biotechnology), Patent – Electricity, Design, and Trademark)on determinations 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, attorneys 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 support requirement of patent, unpredictable remarkable effect in the course of determining inventive step, patent eligibility, creativity in design, and distinctiveness of a position 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 their 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 2: Pharmaceuticals and Biotechnology

Organization chart of the Trial and Appeal Practitioner Study Group 2021

Study Cases (the First Study Cases)

Field	No.	Topic	Point at Issue
Patent - Machinery	1	New matter	How should a determination be made of whether an amendment or correction introduces any new technical matter?
			Issue 1: In the case of an amendment or correction for further generalizing or abstracting the invention so as to encompass any constitution that is not explicitly stated in the description
			Issue 2: In the case of an amendment or correction for adding any matter specifying the invention that is not explicitly stated in the description
Patent - Chemistry 1	2	Support requirement for inventions with	Issue 1: How should a "problem to be solved by the invention" be identified in the course of determining the support requirement?
		numerical limitations	Issue 2: To what extent should working examples be disclosed in order to satisfy the support requirement?
			Issue 3: How should the support requirement be determined if a matter having the same meaning as a problem to be solved by the invention is specified in the claims of the invention?
Patent - Chemistry 2	3	Unpredictable remarkable effect in the course of	Issue 1: How should the unpredictable remarkable effect be determined in the course of determining inventive step?
		determining inventive step	Issue 2: How should parties allege and prove such unpredictable remarkable effect?
Patent - Electricity	4	Eligibility for patent	How should the presence of eligibility for patent be determined?

Design	5	Determination of design creativity	 (1) Identifying skills that a person skilled in the art has (ordinary skills concerning designs in the field to which the target design belongs) Issue 1: Choosing information that serves as the basis for determination from articles having dissimilar designs Issue 2: Cases in which "diversion" can be recognized Issue 3: Appropriate number of cited designs (motifs) (2) Impact of the scope of similarity in a design on the determination of creativity Issue 4: Determination of creativity in the field that is narrow in the scope of similarity in a design
Trademark	6	Position trademark	Distinctiveness of a position trademark

* Patent – Chemistry 1: General Chemistry

Patent – Chemistry 2: Pharmaceuticals and Biotechnology

Study Cases (the Second Study Cases)

Field No.	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	Access port and identification	Invalidation No. 2017- 800070	August 8, 2018	Trial decision to invalidate the patent	Patent Act, Article 36(6)(i) (support requirement) and Article 29(2) (inventive step)												
		thereof	2018 (Gyo- Ke) 10175	December 4, 2019	Dismissal of request													
Patent- Chemistry 1	Patent- 8 Chemistry 1	Run flat tire	Invalidation No. 2015- 800158	December 9, 2016	Trial decision to accept correction	Patent Act, Article 36(6) (ii) (clarity)												
																	Trial decision to partially invalidate the patent	
						Partial dismissal of request												
			2017 (Gyo- Ке) 10006	August 22, 2017	Dismissal of request													
			20. Ke			2017 (Gyo- Ke) 10015		Trial decision partially revoked										
				Invalidation No. 2015- 800158	December 26, 2017	Trial decision to accept correction												
						Partial dismissal of request												
					Trial decision to maintain the patent													

Patent- 9 Chemistry 2	9 Antiviral agent	Invalidation No. 2015- 800226	August 8, 2017	Trial decision to accept correction	Patent Act, Article 36(4)(i) (enablement	
					Trial decision to invalidate the patent	requirement) Patent Act, Article 36(6)(i) (support
			2017 (Gyo- Ke) 10172	September 4, 2018	Dismissal of request	requirement)
Patent- Electricity	Contact terminal	Invalidation No. 2015- 800030	August 16, 2016	Trial decision to accept correction	Violation of the requirement	
					Trial decision to invalidate the patent	for division of patent application
			2016 (Gyo- Ke) 10212	April 18, 2017	Dismissal of request	
Design	11	A plate-with through holes for extruding foodstuff	Appeal No. 2019-508	May 9, 2019	Decision to maintain the examiner's decision of refusal	Design Act, Article 3(2) (creative difficulty)
			2019 (Gyo- Ke) 10089	November 26, 2019	Dismissal of request	
Trademark	12	ありがとう (Arigato; thank you) (in standard characters)	Appeal No. 2017-9209	November 16, 2017	Appeal decision to maintain the examiner's decision of refusal	Trademark Act, Article 4(1)(xi) (Appropriateness of separate observation of a
			2018 (Gyo- Ке) 10002	June 21, 2018	Dismissal of request	composite trademark)

Case 1: Patent - Machinery

Topic	New matter (Patent Act, Article 17-2(3))
Issues	How should a determination be made of whether an amendment or correction introduces any new technical matter?
	Issue 1: In the case of an amendment or correction for further generalizing or abstracting the invention so as to encompass any constitution that is not explicitly stated in the description
	Issue 2: In the case of an amendment or correction for adding any matter specifying the invention that is not explicitly stated in the description
Major JPO/ Court Decisions for Reference	 Court decision of the IP High Court, December 11, 2019 (2019 (Gyo-Ke) 10026; Title of the invention "Fluid Pressure Cylinder and Clamp Device") (hereinafter "Court Decision for Reference 1") Court decision of the IP High Court, December 3, 2020 (2019 (Gyo-Ke) 10117; Title of the invention "Mechanical Parking Apparatus, Control Method of Mechanical Parking Apparatus, and Method of Providing Safety Check Function of Mechanical Parking Apparatus") (hereinafter "Court Decision for Reference 2") Court decision of the IP High Court, April 22, 2019 (2018 (Gyo-Ke) 10122; Title of the invention "Underwater Acoustic Positioning System") (hereinafter "Court Decision for Reference 3")

1. Points of discussion and discussion results

(1) Points of discussion

Since the determination standard was presented in the "Solder Resist" Grand Panel Case (court decision of the IP High Court, May 30, 2008; 2006 (Gyo-Ke) 10563), i.e., "matters stated in the description or drawings' refer to technical matters that a person skilled in the art can understand, taking into account all statements in the description or drawings. Where an amendment does not add any new technical matters to the technical matters that can be understood in this manner, the amendment can be deemed to be made within the 'scope of the matters stated in the description or drawings'," examinations, trials and appeals and courts have been making determinations on new matters under this frame of reference. Many members have appraised that this decision allows them to smoothly make determinations case by case, while some others expressed opinions that they cannot always say that the standard presents a clear standard which ensures predictability in determining a new matter.

Regarding this point, the members considered that the essence of determining a new matter lies in a task for fixing "a boundary within which the disclosure of the description is allowed to be generalized or abstracted" and this forces determinations to be made case by case. Accordingly, they found that further enhancing predictability is considered to require accumulation of appeal/trial and court judgment results and analyses thereof.

In light of the points above, the members focused on extracted examples of court precedents from those in the field of machinery in which courts determined whether the following amendments or corrections introduced any new matter: [i] an amendment or correction for further generalizing or abstracting the invention so as to encompass any constitution (embodiment) that is not explicitly stated in the description, and [ii] an amendment or correction for adding any matter specifying the invention that is not explicitly stated in the description, and proaches that should be taken to determining whether such amendment or correction introduces any new technical matter.

- (2) Discussion results
 - A. In the case of an amendment or correction for further generalizing or abstracting the invention so as to encompass any constitution that is not explicitly stated in the description
 - (A) Regarding the Court Decision for Reference 1 above, the court held that "the original description, etc. merely describe the art preliminarily using the hydraulic pressure by providing the hydraulic pressure introduction chamber 53 and the hydraulic pressure introduction passage 54 and supplementarily using the energizing force of the compression coil spring 53a, and this configuration cannot lead to a configuration in which the configuration involving the preliminary hydraulic pressure is intentionally removed and [the mechanism] is biased only by the compression coil spring which is a mere supplementary means." This determination is considered to be based on the background that the court discussed the

following points: there is no description or suggestion found in the original description, etc. which may lead the technical configuration that "advances the valve only by the elastic member"; the hydraulic pressure introduction passage 54 are indispensable constitutions for solving the problem to be solved by the invention; and the "configuration requiring the elastic member only" in the amendment is directly related to the problem to be solved by the invention (i.e., providing a fluid pressure cylinder and a clamp device capable of: [i] being secure of detecting the arrival of the output member to the predetermined position through a change in air pressure in the air passage in the cylinder body and being downsized, and [ii] enhancing the reliability and durability of detecting the predetermined position of the output member).

- (B) Regarding the Court Decision for Reference 2 above, the court held that "from the viewpoint of the object/meaning of the invention, the object/ meaning of the invention could be achieved if the safety check making position and the safety check end input means are at positions where the safety in the getting on/off room and the like can be checked, and there is no reason why the position should be limited to the inside or outside of the getting on/off room." The members understood that, as an exceptional case, based on the descriptions that the safety check making position and the safety check end input means can be located outside the getting on/off room as well as from the viewpoint of the object/meaning of the invention, the court made a determination that the "visual check configuration outside the getting on/off room" in the correction is a technical matter that a person skilled in the art can arrive by putting all statements in the description, etc. into consideration.
- (C) From the viewpoint of practical matters, the members held discussions on: approaches to describing a problem to be solved by the invention in the phase of developing the description so as to help applicants avoid a risk of receiving a determination that any amendment or correction is an addition of a new matter (e.g., whether any abstract statements may become advantageous); and to what extent the modifications should be stated (for example, if a single line "the valve may be biased only by the

coil spring" is stated in the description in case of the Court Decision for Reference 1 above or if an expression indicating that the safety check end input means may be provided outside the getting on/off room is not stated in the description in the case of the Court Decision for Reference 2 above, the determination may have been different or not, respectively).

Moreover, the members additionally held discussions on the effectiveness of: an amendment to the statements about a problem to be solved by the invention in the description in line with the amendment to the claims; and a deletion of a statement that causes a disadvantage in determining on a new matter from the description.

- B. In the case of an amendment or correction for adding any matter specifying the invention that is not explicitly stated in the description
 - (A) Regarding the amendment adding the words "simultaneously" and "immediately" in the case of the Court Decision for Reference 3 above, the court recognized that the embodiment of the claimed invention provides "a shipboard station receiver that simultaneously receives each reply signal returned from each submarine station transmitter/receiver" (simultaneous receiving constitution), while it did not recognize that the statement "a data processing device that can immediately calculate data for determining the position of the sea-bed station transmitter/receiver after it receives the data" (constitution for determining the timing of calculating a position) is described in the original description, etc.. In light of this, opinions were divided among the members concerning a determination on whether "the amendment introduces a new technical matter in terms of the relationship with the matters described in the original description." The members found that the court might consider the relationship between the constitutions by the amendment and the problem to be solved by the invention in the course of: [i] its interpretation which led to the understanding of the word "simultaneously," which appears in the background of the invention alone, meaning the "constitution for determining the timing of calculating a position" as well as the understanding that the invention provides the constitution; and [ii] its determination that the "constitution for determining the timing of calculating a position" "introduces a new

technical matter in terms of the relationship with the matters described in the original description of the claimed invention."

(B) A difference was seen between the JPO trial decision and the court judgment due to the interpretation of the word "immediately." In light of this, as for an amendment for adding any matter specifying the invention that is not explicitly stated in the description, the members considered it important to appropriately seek what technical meaning the added matter specifying the invention has.

Case 2: Patent – Chemistry 1

Topic	Support requirement for inventions with numerical limitations (Patent Act, Article 36(6)(i))
Issues	Issue 1: How should a "problem to be solved by the invention" be identified in the course of determining the support requirement?
	Issue 2: To what extent should working examples be disclosed in order to satisfy the support requirement?
	Issue 3: How should the support requirement be determined if a matter having the same meaning as a problem to be solved by the invention is specified in the claims of the invention?
Major JPO/ Court Decisions for Reference	 Court decision of the IP High Court, November 28, 2018 (2017 (Gyo-Ke) 10230, "Polyimide, and Polyimide Precursor" Case) (hereinafter "Related Court Decision (1)") Court decision of the IP High Court, October 26, 2017 (2016 (Gyo-Ke) 10215, "Mold Powder for Continuous Casting of Steel" Case) (hereinafter "Related Court Decision (2)") Court decision of the IP High Court, October 25, 2017 (2016 (Gyo-Ke) 10189, "Optical Glass" Case) (hereinafter "Related Court Decision (3)") Court decision of the IP High Court, August 22, 2017 (2017 (Gyo-Ke) 10006, 10015, "Run Flat Tire" Case) (hereinafter "Related Court Decision (4)")

1. Issues and discussion results

(1) Issue 1

In the case of the Related Court Decision (1), it was disputed that in identifying the problem to be solved by the invention, the defendant interpreted the excellent transparency in a limited manner while taking into consideration the statements of the prior arts and the working examples. Generally, in many inventions with numerical limitations, the operation and effect derived from the numerical limitations are quantitatively described in the detailed descriptions of the invention, and, as seen in the identification of the problem to be solved by the invention by the defendant in the case of the Related Court Decision (1), it could be interpreted in a limited manner depending on the approaches that applicants take when taking into consideration the statements in the prior arts or working examples in the detailed description of the invention.

Against this backdrop, concerning Issue 1, the members held discussions on approaches taken to identifying a problem to be solved by the invention in the course of determining the support requirement, and they generally agreed that such problem should be identified by comprehensively taking into consideration not only the statements in the "problems to be solved by the invention" column in the description but also those in the "detailed description of the invention" column in the description, technical common sense that persons skilled in the art have, etc.. Moreover, concerning the Related Court Decision (1) as well, the court identified another problem, which is different from those exactly stated in the "problem to be solved by the invention" column, by comprehensively taking into consideration the statements in the detailed description of the invention. Meanwhile, the court did not identify the transparency as the defendant did since it considered the statements in the prior arts and working examples in particular.

(2) Issue 2

A. Inventions with numerical limitations

Concerning the requirements that inventions with numerical limitations should satisfy the support requirement, the members generally agreed to the need for satisfying the following requirements, which are the same as those for other inventions in the field of chemistry: [i] a working example should explain that the numerical limitations throughout the range can solve the problem to be solved by the invention, or [ii] logic or a mechanism, which is described so as to fill the gap between the specific constitution in the working example and the constitution that indicates a more generic concept in the claims, is comprehensible by referring to the statements in the description or technical common sense. Furthermore, many members commented that the presence of working examples and comparative examples required to satisfy the support requirement may change depending on whether the given numerical range has any essential feature, and they also stated that if an invention is required to have any critical significance of the numerical limitations in particular, e.g., an essential feature in the numerical range, the invention is required to provide working examples and comparative examples for both boundary points of the range.

B. Model experiments

In the case of the Related Court Decision (2), the court held that it cannot be identified that the mold powder of the claimed invention could solve the problem to be solved by the invention based on the grounds that reproducibility of a model experiment is low and that it is not acceptable that the model experiment is appropriate for an experiment for evaluating the peeling-off of the mold powder from the surface of the cast piece immediately under the casting mold. In light of this, as, in some cases, embodiments of the inventions with numerical limitations are evaluated using model experiments and other tests, the members held discussions focusing on cases where model experiments and other tests are identified as working examples which are required to meet the support requirement.

As a result, they generally agreed that, even model experiments and other tests should be identified as working examples that satisfy the support requirement under certain conditions. Following this, they suggested several conditions under which model experiments and other tests should be identified as working examples that satisfy the support requirement.

(3) Issue 3

Concerning an invention in which a matter having the same meaning as the problem to be solved by the invention is specified in the claims of the invention, such specification of the matter might be a basis to determine that the invention described in the scope of claims falls under the range that a person skilled in the art would recognize that the problem would be solved by the invention. In particular, in some inventions with numerical limitations, such numerical limitations indicate the wording having the same meaning as the problem.

Against this backdrop, referring to the Related Court Decisions (1), (3) and (4) as cases where it was disputed whether the inventions in question, which were specified by the matter that can be understood as the matter having the same meaning as the problem to be solved by the invention, satisfy the support requirement, the members, focusing on Issue 3, held discussions on approaches taken to determining the support requirement of the inventions in which a matter having the same meaning as the problem to be problem to be solved by the inventions in which a matter having the same meaning as the problem to be solved is specified.

As a result, they generally agreed that it should not be determined that the inventions in question satisfy the support requirement only on the basis that a matter having the same meaning as the problem to be solved is specified in the claims.

Moreover, they generally agreed that the support requirement, even for the invention in which a matter having the same meaning as the problem to be solved by the invention is specified in the claims, should be determined in accordance with the "determination standards" held by the Special Division of the Intellectual Property High Court on November 11, 2005, with the case number of 2005 (Gyo-Ke) 10042, and also that the application of the "determination standards" depends on individual cases, therefore, a determination whether a specified matter in the claims has the same meaning as the problem to be solved by the invention or whether the specified matter may become a means to solve the problem of the invention should be made by taking into consideration the details of the target technology.

Case 3: Patent – Chemistry 2

Topic	Unpredictable remarkable effect in the course of determining inventive step (Patent Act, Article 29(2))
Issues	Issue 1: How should the unpredictable remarkable effect be determined in the course of determining inventive step?
	Issue 2: How should parties allege and prove such unpredictable remarkable effect?
Major JPO/ Court Decisions for Reference	 Court decision of the Supreme Court, August 27, 2019 (2018 (Gyo-Hi) 69, "Topical Ophthalmic Formulations Containing Doxepin Derivatives for Treating Allergic Eye Diseases" Case) (hereinafter "Related Court Decision (1)") Court decision of the IP High Court, February 25, 2020 (2019 (Gyo-Ke) 10011, "CRISPR-Cas Systems and Methods for Altering Expression of Gene Products" Case) (hereinafter "Related Court Decision (2)") Court decision of the IP High Court, January 15, 2020 (2019 (Gyo-Ke) 10067, "Preventive Composition and Preventive Nutritive Composition for Age-related Diseases and Low Functional Capacity" Case) (hereinafter "Related Court Decision (3)") Court decision of the IP High Court, August 29, 2017 (2016 (Gyo-Ke) 10162, "Ophthalmic Composition" Case) (hereinafter "Related Court Decision (4)") Court decision of the IP High Court, December 25, 2019 (2019 (Gyo-Ke) 10006, "Use of Mometasone Furoate for Treating Airway Passage and Lung Diseases" Case) (hereinafter "Related Court Decision (5)")

1. Issues and discussion results

- (1) Issue 1: How should the unpredictable remarkable effect be determined in the course of determining the inventive step?
 - A. A target of comparison in the course of determining the unpredictable remarkable effect

Supporting the judgment of the Related Court Decision (1) above, the members agreed that the unpredictable remarkable effect of the subject invention should be determined by comparing with the effect that, a person skilled in the art can predict from the constitution of the subject invention as of the relevant date for determining inventive step (theory for comparison in the subject invention). Meanwhile, some members pointed out that in many cases, difficulties are actually seen in predicting such effects which may be derived from the constitution of the claimed invention, and the majority of members commented that, looking at the past determinations, the unpredictable remarkable effect has been determined by comparing the effects of the cited inventions or the effects derived from combining the cited inventions and technical common sense.

Following this, some members expressed opinions that in the following two conditions, it can be said that an approach to determining an unpredictable remarkable effect based on the comparison with the cited invention would not be different from the approach presented in the court decision of the Supreme Court above: if the effect predictable from the claimed invention is basically and nearly equal to the effect of the cited invention which is a comparative reference; or if the results of consideration of both the effect achieved by the cited invention and the effect supposed to be achieved by well-known arts or technical common sense (Related Court Decisions (2) and (4)) are set as the final targets of comparison.

B. Relation between the constitution that can be easily arrived at and the unpredictable remarkable effect

There is no provision stipulated for the "effects" of inventions in Articles of the Patent Act on the inventive step, and experts adopt two theories in determining the position of such effects in the course of determining inventive step: the independence requirement theory and the secondary consideration theory. Against this backdrop, the members held discussions on the position of the effects of inventions in related court decisions and practical duties. As a result, concerning the related court decisions, the members agreed that no court has presented a clear determination concerning the position of such effects. In addition, the majority of members commented that many cases have separated the step for discussing the constitution that can be easily arrived at and the step for discussing how remarkable the effect is (Related Court Decisions (3) to (5)), but in some cases, determination on the remarkableness of the effect seems to affect the determination on the constitution that can be easily arrived at (Related Court Decision (2)). Moreover, many members expressed opinions that regardless of either theory, such effect is finally determined as a result of comprehensive consideration of some viewpoints, such as motivations, a factor teaching away and remarkable effect, etc., and accordingly, few courts explicitly express their opinion which theory they adopted, and that, after all, the relation between the constitution that can be easily arrived at and the unpredictable remarkable effect is not considered rigidly, and thus courts may flexibly and appropriately consider such effects case-by-case in the course of determining inventive step.

C. Impact of a technical idea involving a motivation to the determination of the effect

Some cases arrive at the constitution of the claimed invention in order to solve another problem different from the problem to be solved by the claimed invention, or in other words, they arrive at it as being motivated by the constitution of a cited invention that is built on a technical idea different from the claimed invention. Concerning such cases, the members held discussions on the impact of technical ideas involving such motivations to the determination of the effects of inventions. As a result, they found that the effect which is expected to be brought about by the target cited inventionwhich solves another problem which is a direct trigger of the motivation in question-is usually different from the effect of the claimed invention, and thus, the claimed invention is considered to bring an effect dissimilar to the effect of the cited invention, and, based on this, they agreed that unpredictable remarkableness of the claimed invention is likely to be accepted in these cases. Meanwhile, some members expressed opinions that if expected effects are different between the claimed invention and the target cited invention and if the effect of the claimed invention could be understood by a person skilled in the art as a similar effect of the cited invention based on the technical common sense, an unpredictable remarkable effect would not be recognized in the claimed invention.

(2) Issue 2: How should parties allege and prove such unpredictable remarkable effect?

In light of the discussion results about Issue 1 above, the members held

discussions on approaches taken by parties to alleging and proving the unpredictable remarkable effect so as to receive support or denial from courts. They focused on two viewpoints that should be taken into consideration in the course of determining an unpredictable remarkable effect: "whether the effect in question is unpredictable by a person skilled in the art as being achieved by the constitutions of the each claimed invention" and "whether the effect in question is remarkable beyond the scope of effects that a person skilled in the art could have predicted as being achieved by the constitutions of the claimed invention" (see the Related Court Decision (1)), and based on this, they agreed that such parties, in light of these two viewpoints, should allege and prove the effect in question in qualitative and quantitative aspects. Moreover, they referred to the court's statement to the plaintiff's allegation, which was made based on the experimental results, etc. submitted after the priority date of the claimed invention, explaining that there is no statement concerning this point in the description of the claimed invention and this does not make any impact on the determination of the inventive step of the claimed invention (see the Related Court Decision (5)). Following this, they also agreed that as seen in this explanation, the effect of the claimed invention requires certain evidence relied on the description of the claimed invention.

Furthermore, the members expressed opinions on: approaches to understanding the scope of the effect stated in the description, approaches to presenting evidence and data that should be prepared at filing, practical approaches to alleging and proving the effect in question in inter partes trials, etc., and practical approaches to offering rebuttal evidence against the opposing party's argument.

Case 4: Patent – Electricity

Торіс	Eligibility for patent (Patent Act, Article 29(1) main paragraph)
Issue	How should the presence of eligibility for patent be determined?
Major JPO/ Court Decisions for Reference	 Court decision of the IP High Court, February 24, 2016 (2015 (Gyo-Ke) 10130; Title of invention "Energy Saving Action Sheet") Court decision of the IP High Court, October 17, 2018 (2017 (Gyo-Ke) 10232; Title of invention "Steak Providing Method") Court decision of the IP High Court, June 18, 2020 (2019 (Gyo-Ke) 10110; Title of invention "Method for Settling Electronically Recorded Monetary Claims and Monetary Claims Management Server")

1. Issue

How should the presence of eligibility for patent be determined?

2. Discussion results

- (1) Frame of reference for eligibility for patent
 - A. Approach to determining eligibility for patent on the basis of the keyword "as a whole"

In all cases of the related court decisions above, it was disputed whether the invention in question as a whole falls under the "creation of technical ideas utilizing the laws of nature" in light of the technical significance of the invention. On a practical level, the approach to determining whether the invention in question "as a whole" utilizes the laws of nature is important in determining eligibility for a patent.

Against this backdrop, the members exchanged views on the appropriateness of the approach to determining eligibility for a patent by focusing on the point that the invention "as a whole" utilizes the laws of nature, and the majority of members agreed to its appropriateness. Meanwhile, some members pointed out that concerning the approach to determination, courts' determinations on whether the invention in question as a whole utilizes the laws of nature vary among cases and that it might be disputed to how much degree the invention in question should include a constitution in which the laws of nature are utilized so as to fall under the scope of eligibility for a patent.

B. Elements to be considered in identifying technical significance

As all related court decisions above identified the "technical significance" of the inventions in question in the course of determining eligibility for a patent, the approach to identifying this "technical significance" is considered to place weight on three important elements: "a predetermined technical problem, a constitution of the technical means for solving the problem, and an effect drawn from the constitution."

Based on this, the members exchanged views on the appropriateness of identifying the technical significance of inventions by focusing on the three elements: "a predetermined technical problem, a constitution of the technical means for solving the problem, and an effect drawn from the constitution," and the majority of members commented that this approach is appropriate. Meanwhile, some members pointed out that under the frame of reference for identifying technical significance by focusing on a problem, constitution and effect, differences may be caused in determinations depending on the criteria on which the term "technical" is defined.

- (2) Practical problems, etc. involving eligibility for a patent
 - A. Discussions on two related court decisions in which eligibility for a patent was denied

Among the related court decisions above, two decisions denied eligibility for a patent. Concerning these cases, the members held discussions on factors based on which eligibility for a patent was denied.

(A) "Energy Saving Action Sheet" Case (2015 (Gyo-Ke) 10130)

The majority of members commented that the factor for the denial of eligibility for a patent would lie in a point that the claimed invention provides an energy saving action sheet per se. In response to the call for opinions on possible approaches to overcoming the factor, some members stated that [i] another patent application should be filed as an invention, such as of a device, different from the invention of the sheet per se, or [ii] an approach to specifying the invention in the claims in which the "sheet" is paper and the "axis" or "area" is printed thereon in ink. (B) "Method for Settling Electronically Recorded Monetary Claims and Monetary Claims Management Server" Case (2019 (Gyo-Ke) 10110)

Some members pointed out that the factors on which eligibility for a patent was denied would lie in such points as that there is room for interpretation that the entity to conduct the claimed method for settlement may include people and that the scheme as a human-made arrangement and the feature of the invention are integrated. Meanwhile, others pointed out that since the constitution "transmission/reception of signals" utilizes the laws of nature, the court could have acknowledged eligibility for a patent in this case.

- B. Discussions on the related court decision in which eligibility for a patent was involved ("Steak Providing Method" Case (2017 (Gyo-Ke) 10232))
 - (A) Factors based on which eligibility for a patent was acknowledged The majority of members commented that the important factor is that the terms "label", "measuring apparatus" and "seal" are associated with each other.
 - (B) Appropriateness of the court's determination of acknowledgment of eligibility for a patent

The majority of members agreed that the court's determination is appropriate. Meanwhile, some expressed views that as the claimed invention generally describes a mere human-made arrangement, the court's determination is not appropriate.

- (C) Concerning the constituent element A (a constituent according to implementation of the present steak providing method), the members discussed the appropriateness of the determination that the constituent cannot be considered to provide substantial technical means as the "steak providing system" (page 32 of the court decision), and the majority of members commented that the determination is appropriate.
- (D) Key points of the claimed invention that should be understood as a technical idea "utilizing the laws of nature"

The majority of members stated that the point that the claimed invention utilizes a "measuring apparatus" and "seal" could be assessed as utilization of the laws of nature. Meanwhile, some members presented a question that if utilization of a measuring apparatus or seal becomes a ground for utilization of the laws of nature, the scope of the invention subject to protection might become too broad.

(E) Other opinions

Some members pointed out that, on a practical level, it is necessary to discuss approaches to identifying a technical problem based on the statements in the description of the claimed invention for reviewing eligibility for a patent.

C. Considerations in filing an application

The members exchanged views on well-designed approaches to filing an application, where a court may point out eligibility for a patent, such as applications for computer software-related inventions and business-related inventions, etc.

(3) Scope within which eligibility for a patent is recognized in terms of computer software-related inventions

The members exchanged views on the scope within which computer softwarerelated inventions are subject to protection, and the majority of members stated that the scope stipulated in the current Examination Guidelines is appropriate. Meanwhile, some members pointed out that in many cases, the requirement of the cooperation of hardware resources (for realizing the information processing by a software) is focused on more than necessary, and, based on this, that the current scope of inventions subject to protection may be slightly narrow.

Case 5: Design

Торіс	Determination of design creativity (Design Act, Article 3(2))	
Issues	 Identifying skills that a person skilled in the art has (ordinary skills concerning designs in the field to which the target design belongs) 	
	Issue 1: Choosing information that serves as the basis for determination from articles having dissimilar designs	
	Issue 2: Cases in which "diversion" can be recognized	
	Issue 3: Appropriate number of cited designs (motifs)	
	(2) Impact of the scope of similarity in a design on the determination of creativity	
	Issue 4: Determination of creativity in the field that is narrow in the scope of similarity in a design	
Major JPO/ Court Decisions for Reference	 Court decision of the IP High Court, April 18, 2019 (2018 (Gyd Ke) 10147, "Tabletop Mat" Case) (hereinafter "Court Decision for Reference (1)") Court decision of the IP High Court, April 18, 2019 (2018 (Gyd Ke) 10148, "Tabletop Mat" Case) (hereinafter "Court Decision for Reference (2)") Court decision of the IP High Court, June 16, 2021 (2020 (Gyd Ke) 10136, "Dental Block with Holder" Case) (hereinafter "Court Decision for Reference (3)") 	

1. Issues and discussion results

- Identifying skills that a person skilled in the art has (ordinary skills concerning designs in the field to which the target design belongs)
 - A. Issue 1: Choosing information that serves as the basis for determination from articles having dissimilar designs (Court Decisions for Reference (1) and (2))
 - (A) Is a person skilled in the art belonging to the field of articles(group) in which "tabletop mats" is classified able to easily arrive at the diversion of the configurations of Design 1 and Design 2 classified in the group of congratulatory and condolatory goods to "tabletop mats"?

All participating members reached a consensus that a persons killed in the art would be able to easily arrive at such diversion since such a person is considered to have sufficient opportunities to access any configuration of congratulatory and condolatory goods at trade exhibitions and other occasions.

(B) Determination that the group in which the claimed design is classified and that in which the cited design is classified are different

a. If the usage and function of the claimed design and the cited design are the same, a "tabletop mat," that does not specify the field of goods, and a "rush mat for 'Bon'," which is congratulatory and condolatory goods, are considered to be a relation of inclusion. However, are these two articles considered similar?

The majority of members made a comment that since the usage and functions of the former and the latter are the same, these articles are considered similar.

b. Concerning the Court Decisions for Reference, is the determination of applying creativity rather than novelty appropriate?

Many members stated that it is not appropriate based on a ground that if the articles in question are identical or similar, it should be discussed whether novelty is involved in the first place.

Meanwhile, some members pointed out that in this court case, novelty was not disputed.

- B. Issue 2: Cases in which "diversion" can be recognized (Court Decisions for Reference (1) and (2))
 - (A) Requirements for "diversion"
 - a. Is it required to prove that a person skilled in the art has sufficient opportunities to access any configurations that are classified in other groups of articles?

The majority of members commented that it is required to prove it since, without such proof, it cannot be said that such a person could easily create the design in question based on any configurations of articles classified in other groups.

b. What are specific details subject to such proving considered?

The members suggested information on appearance of the design in question to various types of the press, information on prize-winning history of such design, information on participation of such design in exhibitions, experience in "accessing" the fields to which such design belongs, etc.

c. Is there any difference found between the "diversion" in the Court Decisions for Reference and the "diversion" in terms of business practices stipulated under the Examination Guidelines for Design?

The majority of members stated that they are different since the Court Decisions for Reference presented the diversion between similar articles while the Examination Guidelines provide the diversion between dissimilar articles.

(B) Is it appropriate to cite a "motif provided in information for which it is clear that no persons skilled in the art would retrieve it in ordinary duties"?

The majority of members presented a view that citing such a motif is not appropriate since the claimed design should provide new ideas or creativity from the viewpoint of a person skilled in the art.

Meanwhile, some others stated that as far as such information is published and distributed, it may be difficult to remove a possibility when such a provided motif becomes a tip to creativity.

- (C) Configurations of motifs whose "diversion" is accepted
 - a. Level of similarity between the configuration of the claimed design and that of the cited design

All participating members agreed that the creativity of the claimed design is allowed to be denied only when the modification in question is within the range of modifications which have ordinarily been made.

b. Is it appropriate that no examples are provided since the motif in question is based on a well-known shape?

The majority of members commented that it is appropriate since if the motif is based on a well-known shape, the applicant is unlikely to raise a doubt about the details of the reasons for refusal.

Meanwhile, some mentioned that at least certain information such as sources on such a motif should explicitly be shown.

C. Issue 3: Appropriate number of cited designs (motifs) (no Court Decisions for Reference discussed)

Many members stated that two or three designs are appropriate. Some

members stated that they cannot specify an appropriate number of cited designs.

- (2) Impact of the scope of similarity in a design to the determination of creativity
 - A. Issue 4: Determination of creativity in the field that is narrow in the scope of similarity in a design (Court Decision for Reference (3))
 - (A) Are there any cases when the scope of similarity in a design is narrow, it becomes an obstructive factor for new creation?
 - (B) Are there any cases in which an applicant cannot obtain any design right because of a lack of creativity as a result that he/she have conducted an "action seeking non-imitation configurations"?

The majority of members commented that as for (A), it does not become an obstructive factor since "novelty" and "creativity" are determined based on different frames of reference, and some members stated that as for (B), cases where an applicant cannot obtain any design right may occur in theory due to the same reason as above.

(C) Points that the members agree with regarding the plaintiff's allegations and other opinions

The majority of members commented that although they understand the mindset of the agent, they cannot agree with the allegations.



Court Decision for Reference (1)] Claimed Design



[Court Decision for Reference (1)] Design 1



[Court Decision for Reference (1)] Design 2

Case 6: Trademark

Topic	Position trademark
Issue	Distinctiveness of a position trademark
Major JPO/ Court Decisions for Reference	 Court decision of the IP High Court, February 12, 2020 (2019 (Gyo-Ke) 10125, "Convection-Type Oil Stove" Case); Appeal against examiner's decision of refusal; Appeal No. 2018-7479 (August 20, 2019: Decision to maintain examiner's decision of refusal in appeal against examiner's decision → final and binding) Court decision of the IP High Court, December 15, 2020 (2020 (Gyo-Ke) 10076, "Container for Sauce for Barbecued Meat" Case); Appeal against examiner's decision of refusal; Appeal No. 2017-10633 (March 30, 2020: Decision to maintain examiner's decision → final and binding)

1. Points of discussion and discussion results

- (1) Point of discussion 1: Trademark Act, Article 3(1)(iii) (Distinctiveness by nature of the claimed trademark)
 - A. Concerning the frame of reference to determine the applicability of Article 3(1)(iii) of the Trademark Act, which was presented in the court decisions of both the "Convection-Type Oil Stove" Case and the "Container for Sauce for Barbecued Meat" Case, some consider that these decisions are in line with the frame of reference for the applicability of Article 3(1)(iii) of the Act which was shown in the court decisions of other cases involving three-dimensional trademarks. In light of this, the members held discussions on the relationship between the determination on the applicability of the said Article 3(1)(iii) of the Act concerning the cases involving position marks consisting of three-dimensional shapes and the determinations on the applicability of the said Article 3(1)(iii) concerning the cases involving three-dimensional trademarks. As a result, the majority of members stated that these cases should be determined within the same frame of reference, while others commented that they should be determined within different frames of reference.
 - B. Concerning the approaches to recognizing the claimed trademark and appropriateness thereof, the court decision in the "Convection-Type Oil Stove"

Case recognized the "three substantially ring-shaped flames appearing by reflection" as a "three-dimensional shape." The majority of members agreed with this recognition.

- C. This decision also recognized that the claimed trademark is employed for the purpose of "contribution to functions or an aesthetic impression" rather than identifying its origin. Regarding the approaches to and appropriateness of the recognition, the majority of members disagreed with the court's final determination that the claimed trademark falls under Article 3(1)(iii) of the Act since they considered that in the "Container for Sauce for Barbecued Meat" Case, the court held that it is easily predictable that a label would be placed on the section that does not constitute an element of the claimed trademark.
- D. Concerning approaches to and the scope of "special circumstances, such as a circumstance where the shape in question is beyond the extent of the prediction that the shape is adopted for reasons of its function or its aesthetic impression of the product, etc.," the members expressed a variety of opinions on possible types of shapes that might fall under the "shape being beyond the extent of the prediction" above and other issues. For example, concerning the "Convection-Type Oil Stove" Case, some members stated that considering the close relationship between the shape of a product and the design thereof, they receive a severe impression from the court's determination that the shape of a product, etc. has no distinctiveness unless there are any special circumstances, such as a circumstance where the shape in question is beyond the extent of the prediction if the shape is adopted for reasons of its aesthetic impression. Moreover, concerning the "Container for Sauce for Barbecued Meat" Case, some members commented that if the case is related to the position mark for a part of the container in a shape like the perfume container which was registered as a three-dimensional trademark (Court decision of the IP High Court, 2010 (Gyo-Ke) 10366), the container for sauce for barbecued meat, which might lack distinctiveness as a perfume container, should be recognized as a container "in a shape beyond the extent of the prediction that..." as mentioned above.
- E. The members focused on the relationship between the protection under the trademark right and that under other intellectual property rights, and some

members commented that since protection under the Patent Act and that under the Design Act fall under the circumstances where a three-dimensional shape is predicted to be adopted for reasons of its function or its aesthetic impression respectively, a circumstance where the shape of the product in question is protected under the Patent Act, etc. for reasons of its function may cause a negative impact on the determination of whether the shape is eligible for receiving protection under the Trademark Act.

- (2) Point of discussion 2: Trademark Act, Article 3(2) (Distinctiveness acquired through use of the claimed trademark)
 - A. Concerning the approaches to the market share and the appropriateness thereof (in the "Convection-Type Oil Stove" Case), some members expressed an opinion that in setting a target market, it is important to consider to what extent the scope of target customers should be broadened.
 - B. Concerning the ideal approaches to advertisement contributing to proving a fact that the position mark consisting of the three-dimensional shape in question has acquired distinctiveness, some members pointed out that as for the "Convection-Type Oil Stove" Case and the "Container for Sauce for Barbecued Meat" Case, there is a challenge, in both cases, that the details of the advertisement do not always make impressive the characteristics of the three-dimensional shape that constitutes the mark of the claimed trademark.
 - C. Concerning the use of a trademark that contributes to proving a fact that the position mark consisting of the three-dimensional shape in question has acquired distinctiveness, some members commented that it is important, for example, to thoroughly keep the same shape among the same type of products so as to receive a more positive evaluation.
 - D. Concerning the appropriateness of the approaches to determining whether the label on the designated goods should be taken into consideration (in the "Container for Sauce for Barbecued Meat" Case), the members focused on whether certain elements, such as the appearance of the label attached to the products and the degree of being well known for (letters in) the label, might draw a different conclusion, and some members stated that a different conclusion might be drawn since if the appearance of the label and the letters are not distinctive and a portion of the letters is not well known, the court

might be more likely to recognize that the part of the three-dimensional shape in question functions as a mark for identifying the origin of the products, etc.

- E. Concerning points that should be more organized in conducting the survey by questionnaire (in the "Container for Sauce for Barbecued Meat" Case), some members pointed out the importance of: choosing populations, the adequacy of questions and similarity between targets for comparison and the claimed trademark (i.e., selecting choices), while others commented that in light of the risk where such questionnaire may contain arbitrary elements, striking a balance between the questionnaire and objective circumstances (e.g., market shares and advertisement performance) cannot be ignored.
- (3) Comparison between the "Convection-Type Oil Stove" Case and the "Container for Sauce for Barbecued Meat" Case and points to note in aiming at successful trademark registration of a position mark

The members pointed out a common point of these cases that in the course of determining the applicability of Article 3(1)(iii) of the Act, the courts, in both cases, found that the given three-dimensional shape "contributes to functions or an aesthetic impression" rather than identifying the origin.

Meanwhile, the members also pointed out that these cases are different in such points as whether: the three-dimensional shape consisting of the trademark in question is protected under other intellectual property rights, the trademark on the product in question can be visually recognized by customers when buying the product, and the durable life of the product is relatively longer.

Based on this, the members commented that in filing an application for a position trademark consisting of the three-dimensional shape, applicants are recommended to presuppose a future need of proving the distinctiveness acquired through use of a trademark, and based on this, develop a trademark while placing eyes on a future application even during the phase of commercialization of target products if possible.

Case 7: Patent – Machinery

Topic	Determination concerning the support requirement; finding of a cited invention
JPO Docket Number	Trial for invalidation Invalidation No. 2017-800070 (Patent No. 6018822) (August 8, 2018: trial decision to invalidate the patent → final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, December 4, 2019 2018 (Gyo-Ke) 10175 (dismissal of request, JPO trial decision maintained)
Title of Invention	Access port and identification method thereof
Major issue	Patent Act, Article 36(6)(i) (support requirement) and Article 29(2) (inventive step)

1. Outline of the case

This case was over the fulfillment of the support requirement and involvement of inventive step in relation to an invention titled "Access port and identification method thereof."

The JPO made a trial decision to invalidate the patent on the grounds that the Invention does not fulfill the support requirement and also lacks inventive step. In response, the plaintiff (patentee) alleged that the trial decision contains an error in the determinations concerning the support requirement and involvement of inventive step and should thus be revoked, and filed a lawsuit to request revocation of the trial decision.

In the court decision, the court decides that the Invention is within the scope that a person skilled in the art can recognize as being able to solve the problem to be solved by the Invention based on the statement of the detailed description of the invention in the Description and is not in violation of the support requirement. However, the court determined that the Invention lacks inventive step because it is an invention that would have easily been able to be made by applying the matters described in Cited Document 2 and well-known art to a cited invention. Consequently, the court dismissed the plaintiff's request.

Incidentally, in the court decision, the court found a primary cited invention that differs from the cited invention that was found from multiple documents in the trial decision and made a determination concerning the involvement of inventive step.

2. Issues discussed and discussion results

(1) Issue 1 (Regarding determinations concerning the support requirement)

The members discussed why the determinations in the trial decision and the court decision in this case differed though both of the determinations were made based on the framework for determination for the support requirement indicated in the court decision of the Grand Panel Case of the Intellectual Property High Court (court decision of the IP High Court, November 11, 2005; 2005 (Gyo-Ke) 10042 ("Manufacturing Methods of Polarizing Film")).

The majority opinion was as follows. The trial decision and the court decision are the same in having found the "problem to be solved by the invention" in light of the fact that Invention 1 is for an "access port capable of automatic injection" and in consideration of the statements in columns other than the "Problem to be solved by the invention" column in the Description. However, "correlation," which is one of the means for solving the problem specified in the claim, is included in the "problem to be solved by the invention" in the trial decision while it is not included therein in the court decision. Thus, the trial decision and the court decision differ in the "problem to be solved by the invention" that was found from the statement of the detailed description of the invention. Therefore, the trial decision and the court decision differed in the conclusion of the determination concerning the support requirement.

Regarding the difference between the "problem to be solved by the invention" found in the trial decision and that in the court decision, the members had the opinion that finding of the "problem to be solved by the invention" based on the statements in the "Problem to be solved by the invention" column in the Description can ensure objectivity and is convincing as the point of an argument, and also the opinion that the content of the parties' allegations in the support requirement as well as in other reasons for invalidation, such as those relating to clarity or inventive step, may affect the conviction of the trial panel and the court in relation to a determination concerning the support requirement.

In finding the "problem to be solved by the invention" for determining the support requirement, in principle, it should be based on statements in the "Problem to be solved by the invention" column in the Description. It is considered necessary to take notice of whether the problem found is not excessive even in the case of taking into account the structure of the Invention in finding the problem, and to pay attention to whether the problem found is not different from the problem found based on the statements in the Da and common general technical knowledge that supplements them.

(2) Issue 2 (Regarding finding of the cited invention)

The members discussed in what cases it is permitted to find one cited invention from multiple documents with regard to the fact that the court held in this court decision that "Evidence A No. 9 Invention cannot be found from the statements in Cited Document 1, a paper describing the results of experiment on pressure-resistant performance using Toray's Port,¹ and Cited Document 2 is an attached document describing the specifications and use conditions of Toray's Port that was prepared by a person different from the person who prepared Cited Document 1 on a date different from the date of preparation of Cited Document 1."

The members agreed with the following opinion: the case where another document is a document proving common general technical knowledge can be cited as an example case where it is permitted to find one cited invention from multiple documents; however, even in such case, it is only permitted to find a cited invention from a publication in consideration of common general technical knowledge described in said another document, and it is not permitted to find a cited invention by adding common general technical knowledge to the matters described in a publication. In this regard, it is sometimes difficult to determine whether common general technical knowledge is taken into account or added, and it is considered preferable to deal with this point as the issue of involvement of inventive step from the perspective of careful determination.

In addition, the identity of the author, the date of publication, and whether cross-reference is assumed are also cited as important factors for permitting finding of a cited invention from multiple documents. However, the majority opinion was that even if two cited documents in this case were prepared by the same person on the same date, it is not permitted to find one cited invention

¹ P-UCELSITE PORT made by Toray

from those cited documents as long as Cited Document 1 and Cited Document 2 are separate and independent documents that have different natures. Specifically, Cited Document 1 is a paper on pressure-resistance performance while Cited Document 2 is a manual.

Moreover, in the trial decision, the invention is found as an invention described in publications (Article 29, (1)(iii) of the Patent Act) from Cited Document 1 and Cited Document 2. However, in this case, there is no problem in finding the cited invention as a publicly worked invention (Article 29, (1)(ii) of the Patent Act) from multiple documents as a cited invention since it is possible to prove that the existence and configuration of the product, Toray's Port, are publicly known, by the paper, Cited Document 1, and the product information attached to Toray's Port, Cited Document 2. Regarding difference depending on which invention is found, in the case of finding an invention described in a publication, a document (Cited Document 2) other than a publication finding a cited invention (Cited Document 1) needs to be a document for indicating common general technical knowledge while in the case of finding a publicly worked invention, the issue is credibility concerning whether Cited Document 2 has the configuration of the product that is identical to the product of Cited Document 1.

Case 8: Patent - Chemistry 1

Topic	Determination concerning the clarity requirement in consideration of the statements in the description and drawings attached to the written application as well as common general technical knowledge of persons skilled in the art at the time of the filing of the patent application
JPO Docket Number	Trial for invalidation Invalidation No. 2015-800158 (Patent No. 4886810) (trial decision to maintain the patent) (December 9, 2016: trial decision to partially invalidate the patent (first trial decision) \rightarrow the part of the trial decision partially invalidating the patent revoked) (December 26, 2017: trial decision to maintain the patent (second trial decision) \rightarrow final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, August 22, 2017 2017 (Gyo-Ke) 10006, 10015 (the part of the trial decision partially invalidating the patent revoked)
Title of Invention	Run flat tire
Major issue	Patent Act, Article 36(6)(ii) (clarity)

1. Outline of the case

This is a case of a trial for invalidation of a patent for an invention titled "Run flat tire."

In the trial decision of the case, the JPO determined that the statement of the claims of the Patent does not satisfy the clarity requirement because the statements in Claim 1, "an extrapolation line A of a portion in which … shows an approximately linear change" and "an extrapolation line B of the sharp drop portion," are not clear, respectively.

In response, the court determined that the meaning and content of "extrapolation line A of a portion in which ... shows an approximately linear change" can be understood based on common general technical knowledge in ASTM standards and JIS standards and also determined that it is clear that "extrapolation line B of the sharp drop portion" means the portion which shows the steepest slope going down from the left to the right in a figure illustrating changes in dynamic storage elastic modulus by temperature. Based on these determinations, the court held that the statement of the claims of the Patent cannot be considered to be unclear to the extent that the interests of third parties are unreasonably damaged.

2. Major issues discussed

- (1) Issue 1 (Regarding the court's interpretation that the "sharp drop" portion is the "portion which shows the steepest slope going down from the left to the right")
 - A. The members agreed that the meaning of the occurrence of a "sharp drop" and that of the "steepest slope going down from the left to the right" differ in a literal sense. However, the opinions of the members were divided about the reasonableness of having interpreted the "sharp drop" portion as the "portion which shows the steepest slope going down from the left to the right" in the court decision.
 - B. First, as the opinion that the aforementioned interpretation is reasonable, the members said that the "sharp drop" portion can be interpreted as the "portion which shows the steepest slope going down from the left to the right" in consideration of the statements in the description, etc.

Such opinion is based on the following reason: from the statements in the description, etc., the "sharp drop" portion is considered to refer to a portion in which the slope is largely constant in a downward-sloping zone, and said portion corresponds to the "portion which shows the steepest slope going down from the left to the right"; therefore, the conclusion of the court decision contains no problem.

- C. Alternatively, as the opinion that the aforementioned interpretation is not reasonable, the members cited such points as that the "sharp drop" portion cannot be interpreted in a limited way as the "portion which shows the steepest slope going down from the left to the right" because the description does not state the definition of the term "sharp."
- (2) Issue 2 (Regarding the point that the court understood the "portion in which … shows an approximately linear change" based on common general technical knowledge concerning the measurement of glass transition temperature and determined that it is possible to draw an extrapolation line of said portion) A. The majority of the members considered it reasonable that the court

understood the "portion in which … shows an approximately linear change" based on common general technical knowledge concerning the measurement of glass transition temperature and determined in the court decision that it is possible to draw an extrapolation line of said portion.

Such opinion is specifically based on the following reason.

It is possible to specify the "portion in which … shows an approximately linear change" by referring to the drawings. However, the way of drawing an extrapolation line tangent to said portion is not specifically stated in the description. Therefore, it is considered possible for a person skilled in the art to draw an extrapolation line based on common general technical knowledge in the field to which the patent pertained even without receiving detailed instruction on the way of drawing an extrapolation line by taking into account, for example, the way of getting an "extrapolated onset temperature for glass transition" under JIS standards as common general technical knowledge in the field of polymers, in which rubber is included.

- B. On the other hand, some members also commented as follows: a linear approximation can be created from a continuous curve by minimizing the amount of change; therefore, drawing an extrapolation line in the "portion in which … shows an approximately linear change" means that it is possible to draw an extrapolation line at any portion; consequently, an extrapolation line drawn in the "portion in which … shows an approximately linear change" is probably not unambiguously determined after all.
- (3) Issue 3 (Regarding the court's determination that the statement of the claims of the Patent is not unclear to the extent that the interests of third parties are unreasonably damaged because the temperature at an intersecting point differs only by 1°C depending on the way of drawing lines)
 - A. The majority of the members commented that it is reasonable that the court determined in the court decision that the statement of the claims of the Patent is not unclear to the extent that the interests of third parties are unreasonably damaged because the temperature at an intersecting point differs only by 1°C depending on the way of drawing lines.

Such opinion is based on the following idea: it has already been found that temperature at an intersecting point differs only by 1°C depending on the

way of drawing lines; considering the issue on the premise of establishment of that finding, first, in general terms, a person skilled in the art does not consider the difference by 1°C as particularly inappropriate in terms of temperature for which digits up to 1°C are considered as significant digits; in addition, even considering the issue on a case-by-case basis in relation to this case, as of the priority date of the original application for the Patent, the range of temperature of a rubber composition for reinforcing the side portion of a run flat tire attracted attention only in terms of the range of temperature below 150 °C; therefore, there is no circumstance that requires an accuracy of less than 1°C in the specification of temperature at an intersecting point.

B. On the other hand, some members also commented as follows: in the Patent, the critical value in the phrase "the temperature at the intersecting point is 170°C or higher," that is, "170°C," is considered to be a very sensitive value because the "temperature at the intersecting point" in Comparative Example 1 in the Description is "169°C"; therefore, there may be some cases in which whether the patent right is infringed is affected by said difference by 1°C and the interests of third parties are unreasonably damaged.

Case 9: Patent – Chemistry 2

Topic	To what extent common general technical knowledge and pharmacological data submitted after the filing of an application can be taken into consideration	
JPO Docket Number	Trial for invalidation Invalidation No. 2015-800226 (Patent No. 5207392) (August 8, 2017: trial decision to accept correction and invalidate the patent → final and binding)	
Date of Court Decision Court Docket Number	Court decision of the IP High Court, September 4, 2018 2017 (Gyo-Ke) 10172 (dismissal of request, JPO trial decision maintained)	
Title of Invention	Antiviral agent	
Major Issues	Patent Act, Article 36(4)(i) (enablement requirement) Patent Act, Article 36(6)(i) (support requirement)	

1. Outline of the case

This is a case of a trial for invalidation of a patent for an invention titled "Antiviral agent." In the trial decision, the JPO determined that the patent does not comply with the enablement requirement on the following grounds: the compounds whose pharmacological data was shown in the detailed explanation of the invention differ from each compound of the Patented Invention (hereinafter the "Compound") and an integrase inhibitory action of the Compound including wide-ranging and varied compounds has not been made clear; even if the structures of those compounds shown in the data are similar to the compounds of the Compound at first glance, the Compound cannot be immediately understood as an integrase inhibitor; and furthermore, it is not permitted to satisfy the enablement requirement by using pharmacological data submitted after the filing of an application in light of the purport of the patent system to adopt the first-to-file system.

On the other hand, in the court decision, the court did not make a determination concerning the enablement requirement, but reviewed on the support requirement for the following points. The court first found the problem to be solved by the Patented Invention and common general technical knowledge concerning an integrase inhibitor and then considered whether a person skilled in the art can recognize that the aforementioned problem can be solved and whether a person skilled in the art can understand an integrase inhibitory action by a chelate ligand, as well as consideration of additional test results, and similarity between chemical compounds stated in the Description and prior art documents and effects on an integrase inhibitory action, etc., respectively. As a result, the court determined that the statement of the claims does not comply with the support requirement.

2. Major issues discussed

- (1) Issue 1 (Regarding consideration of common general technical knowledge)
 - A. The members agreed that the determination that a person skilled in the art cannot understand that the Compound has an integrase inhibitory action based on common general technical knowledge is reasonable. The members cited the following points as reasons therefor: (1) the invention in this case is a medical use invention, but no pharmacological data on the Compound is stated; (2) the demandee (plaintiff) alleges that a person skilled in the art can reasonably recognize that the Compound has an integrase inhibitory action based on the statements in the Description and common general technical knowledge, but the Description gives no explanation about any mechanism of action and structure activity correlation and the demandee also could not sufficiently prove common general technical knowledge supporting the aforementioned allegation; (3) the demandant submitted multiple pieces of evidence supporting "common general technical knowledge that a large difference might be produced in an integrase inhibitory action due to a slight change in modification to the structure of an integrase inhibitor"; however, on the other hand, the demandee's counterargument was insufficient.
 - B. The members also agreed that <u>the determination that based on common general technical knowledge</u>, a person skilled in the art cannot recognize, from the compound whose pharmacological data was stated in the <u>Description</u>, that the Composition acts as an integrase inhibitor is reasonable. The members cited the following points as reasons therefor, in addition to the perspectives mentioned in (1) to (3) in A. above: (4) it was found the existence of common general technical knowledge that a molecule having a structure that could be a chelate ligand does not necessarily have an integrase inhibitory action was found; (5) it was not proven the existence of common general technical knowledge that it can have a person skilled in the art

recognize that any other compounds of the Compound has an integrase inhibitory action. In addition, regarding the allegation that bioisosteres are expected to show the equivalent pharmacological activity, the members pointed out that the allegation was not sufficiently proven by the statements in the Description and common general technical knowledge.

C. <u>Regarding the issue of under what conditions (content disclosed in the</u> <u>description and presentation of common general technical knowledge) the</u> <u>satisfaction of the support requirement and the enablement requirements is</u> <u>found in the cases where all the pharmacological test results were deleted in</u> <u>the course of filing a divisional application, like in this case, the majority</u> <u>opinion was that if it is not that the Description does not state</u> <u>pharmacological test data at all, the support requirement and the enablement</u> <u>requirement can be satisfied if it is possible to explain and prove that the</u> <u>claimed invention also satisfies the description requirements based on data</u> <u>stated in working examples.</u>

In addition, some members commented that even if the existence of common general technical knowledge that denies that pharmacological test results of another compound stated in the Description can be generalized and expanded to the Invention as a whole is alleged and proven, the satisfaction of the support requirement and the enablement requirement can be found if it is possible to indicate from common general technical knowledge and the statements in the Description of the application that pharmacological activity is not significantly changed by a change in modification.

(2) Issue 2 (Regarding consideration of subsequently submitted data)

A. The members also agreed that <u>the determination that subsequently</u> <u>submitted data is not taken into consideration in this case</u> is reasonable. In this case, there is common general technical knowledge that a slight change in modification causes a large difference in a pharmacological action, and in consideration of this common general technical knowledge, whether the compounds of the Invention actually show pharmacological action is unclear from the statements in the Description. On that basis, the members agreed that as the description requirements, specifically, the support requirement and the enablement requirement, are not satisfied in this case without

support by subsequently submitted data in question, it is not permitted to take subsequently submitted data into consideration for such purpose.

B. Regarding the issue of <u>under what conditions subsequently submitted</u> additional test results should be taken into consideration, the majority opinion was that in the case where, regarding the relationship between the structure and integrase inhibitory activity of a compound, explanation about the (possible) mechanism of action was disclosed and logically supported to a certain extent by the description and common general technical knowledge, etc. then it is determined that a person skilled in the art can reasonably understand the explanation, subsequently submitted additional test results can be taken into consideration to the extent of supporting and confirming the explanation. Multiple members said that in this case, subsequently submitted additional test results could be taken into consideration if it can be understand from the statements in the Description that each compound pertaining to the Invention shows an integrase inhibitory activity by having a binuclear bridged tridentate ligand structure.

Case 10: Patent – Electricity

Topic	To what extent may a structure be generalized in an invention claimed in a divisional application?	
JPO Docket Number	Trial for invalidation Invalidation No. 2015-800030 (Patent No. 5449597) (August 16, 2016: trial decision to accept correction and invalidate the patent → final and binding)	
Date of Court Decision Court Docket Number	Court decision of the IP High Court, April 18, 2017 2016 (Gyo-Ke) 10212 (dismissal of request, JPO trial decision maintained)	
Title of Invention	Contact terminal	
Major issue	Violation of the requirement for division of patent application	

1. Outline of the case

This is a case concerning a trial for invalidation of a patent for an invention titled "Contact terminal" and a request for revocation of a trial decision.

In the trial decision, the JPO determined that all the inventions pertaining to the Patent lack novelty based on the publication of an unexamined patent application of the original application pertaining to the Patent because the patent application pertaining to the Patent does not satisfy the requirement provided in Article 44 (1) of the Patent Act and the filing date of the patent application thus becomes the actual filing date (trial decision to invalidate the patent).

In response to this, a lawsuit to request revocation of the trial decision was filed, and in the court decision, the court determined that all of the grounds for revocation alleged by the plaintiff were groundless (dismissal of request).



Contact terminal 10	Body case 11
Inclined surface 15	Coil spring 31
Spring receiving hole 14	Insulation ball 30
Elongated hole 13	Large diameter portion 22
Side peripheral portion 25	Plunger pin 20
Concave hole 23	Small diameter portion 21
Opening end portion 16	Protrusion end portion 21a
Pin portion 12	

2. Discussion results

[Fig. 2]

(1) Issue 1: Regarding the reasonableness of the determination that a "contact terminal without an insulation ball is also included" in Invention 1

The members agreed that there is no statement about the insulation ball in Claim 1 and that the court decision is reasonable in the determination that a "contact terminal without insulating ball is also included" in Invention 1 based on a literal interpretation.

(2) Issue 2: Regarding the reasonableness of having found the problem to be solved by the invention by including the point "without flowing current through the coil spring"

First, the members agreed that the problem to be solved by the invention stated in the description, etc. of a divisional application is not bound by the problem to be solved by the invention stated in the description, etc. of the original application and can differ therefrom.

On the other hand, regarding finding of the problem to be solved by the invention, the members were divided with the following opinions: (1) in consideration of [Mode for carrying out the invention] in addition to [Background of the invention] and [Problem to be solved by the invention], it is clear that the "burning out of the coil spring" is the problem to be solved by the invention; therefore, it is reasonable that the court found the problem to be solved by Invention 1 by including the point "without flowing current through the coil spring"; (2) a divisional application is filed by making part of a patent application that includes two or more inventions into a new patent application, and a problem to be solved by the invention can naturally differ from each other between the invention claimed in a divisional application to and the invention stated in the original application; therefore, it is not necessarily reasonable to find the problem to be solved by the invention in relation to all the inventions stated in the description, etc. of the original application.

(3) Issue 3: Hypothetical cases: Regarding Claim 1 at the time of filing the Divisional Application

The members considered whether each of the following cases is considered to violate the requirement for division of patent application: (1) where the statement "having a central axis offset from the central axis of the plunger pin" is deleted; (2) where the "inclined concave portion having a substantially conical surface shape" is replaced by the "concave portion"; and (3) where the "spherical portion formed by the spherical surface of a ball" is changed to the "pressing member having an insulation surface."

Case (1): The members were divided with the following opinions: the deletion satisfies the requirement for division because it is clear from the statements in [0033] in [Mode for carrying out the invention], etc. that "having a central axis offset from the central axis of the plunger pin" is an additional element; a change that makes it impossible to specify the "offset central axis," which is a means for solving the problem that corresponds to the statement that "current can reliably flow from the plunger pin to the body case," does not satisfy the requirement for division of patent application.

Case (2): The members agreed that the change satisfies the requirement for division of patent application.

Case (3): The members were divided with the following opinions: the change satisfies the requirement for division of patent application because the point that the pressing member is not spherical does not directly affect the solution of the problem to be solved by the Invention; changing the "spherical portion formed by the spherical surface of a ball" to the pressing member having a shape other than a spherical shape does not satisfy the requirement for division of patent application because an invention that requires an insulation ball is stated in the description of the original application.

(4) Issue 4: Regarding points to which the members pay attention in practice when filing a divisional application in light of this court decision, points to consider when filing an original application, and points to consider when filing a divisional application

When filing an original application: The members expressed opinions such as that it is preferable to clearly state the essential structure and the problem solved by the essential structure as well as additional structures and effects achieved by the additional structures.

When filing a divisional application: The members expressed opinions as follows: they avoid changing the statements of the description of the original application in the description of a divisional application; it is preferable to file a backup divisional application (sibling divisional application) in advance because the risk of violation of the requirement for division of patent application is inevitable in the case of deleting a structure of a working example when filing a divisional application.

(5) Issue 5: Regarding points to which the members pay attention when making an amendment or filing a request for correction in the case where violation of the requirement for division of patent application became an issue

The members expressed opinions as follows: it is desirable to prepare multiple claims in stages as it is difficult to prepare a new claim on the occasion of amendment or correction; it is necessary to pay attention to the risk that if the applicant tries to argue that the disputed structure "is not a new matter" (not violate the requirement for division of patent application) and states confidently that it can be any constitution which is not related to the solution of the problem, this could result in an inventive step being less likely to be found.

Case 11: Design

Topic	Appropriateness of the determination concerning the choice of cited designs and the evaluation of creative difficulty and aesthetic impression of the design in the application	
JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2019-508 (Design Application No. 2017-26691) (May 9, 2019: Appeal decision to maintain the examiner's decision of refusal → final and binding)	
Date of Court Decision Court Docket Number	Court decision of the IP High Court, November 26, 2019 2019 (Gyo-Ke) 10089 (dismissal of request, JPO appeal decision maintained)	
Article to the design	A plate-with through holes for extruding foodstuff	
Major issue	Design Act, Article 3(2) (creative difficulty)	

1. Outline of the case

This is a lawsuit to request revocation of the appeal decision to refuse the design registration that was rendered in response to an appeal against the examiner's decision of refusal.

The appeal decision determined that the design in the application was not granted for a design registration pursuant to Article 3(2) of the Design Act, as a person skilled in the art of the design could have easily created it based on the publicly known shapes of Design 1 through Design 3 (appeal decision of refusal).

The court dismissed the plaintiff's request for revocation of this appeal decision, holding that the appeal decision is free from any illegal points that would give rise to revocation.

2. Issues discussed and discussion results

 Issue 1 (whether the designs cited in the court decision (Designs 1 through 3 and reference material) were appropriate)

All members agreed that the choice of cited designs was appropriate.

Some members commented that citing Design 2 was not absolutely necessary but it had no negative impact from the standpoint of providing more detailed explanation about the publicly known shapes.

- (2) Issue 2 (whether the appeal decision and court decision denying the creative difficulty and aesthetic impression as to the shape of the margin area (elements not present in Design 1 and Design 3) was appropriate)
 - A. Whether the determinations as to the creative difficulty of the shape of the margin area in the court's finding and the defendant's allegation were appropriate)

The majority of members agreed that they were appropriate as it is obvious that a margin area in the shape of fish cake is created by punching 60-degree staggered holes on a circular plate.

Some other members pointed out that the size and shape of the margin area are not necessarily determined by perforating a plate in such a manner.

- B. Difference between the allegations of the plaintiff and defendant as to the relationship between the creative difficulty and aesthetic impression
 - (A) Defendant's allegation that "Article 3(2) of the Design Act does not relate to the issue of whether a design involves an aesthetic impression"

Various opinions were raised, such as that Article 3(2) relates to whether an aesthetic impression created by a design represents novelty or creative originality of design ideas from the viewpoint of a person skilled in the art, not whether the aesthetic impression itself is present.

(B) Absence of reference to the relationship between the creative difficulty and aesthetic impression in the court decision

Some members raised an opinion that whether the design in the application involves an aesthetic impression does not serve as the basis for determining its creative difficulty, and it is not absolutely necessary to address the issue of the relationship between the creative difficulty and aesthetic impression.

(C) Plaintiff's allegation that "The design in the application creates a specific aesthetic impression which gives its observers an impression that they have never seen before; therefore, the creation of the design in the application represents a novel idea or creative originality from the viewpoint of a person skilled in the art."

Members presented various opinions, such as that the plaintiff should have elaborated on the reason why "a person skilled in the art could not easily create" the design "having a specific aesthetic impression that gives its observers an impression that they have never seen before" based on the cited designs.

- (3) Issue 3 (difference in balance of arrangement (arrangement of perforated holes as well as the proportions and dimensions of margin areas))
 - A. Whether the defendant's allegation and the court's decision both denying the creative difficulty were appropriate

Many members agreed that they were appropriate, for such reasons as that the balance of arrangement present in the design in the application does not represent novelty or originality of design ideas from the viewpoint of a person skilled in the art.

In addition, some members commented that, although this finding was not appropriate as it only considered the margin area as a matter of dimensions, it could be justified if the margin area is not considered as part of an aesthetic impression.

B. Whether the ground relied upon by the defendant to deny the creative difficulty was sufficient

A slight majority of members were of opinion that, although the defendant submitted Evidence B No. 8 and No. 9 (an extruding plate for a confectionery maker), and the court determined that adopting such balance of arrangement for the design in the application was obvious as a person skilled in the art could have easily conceived of such balance, the defendant's ground was not sufficient to rebut the plaintiff's allegation.



Design in the application



Design 2



Design 1





Design 3

Case 12: Trademark

Topic	Determination of similarity of a composite trademark (whether the finding related to separate observation is appropriate)		
JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2017-9209 (Trademark Application No. 2016- 75858) (November 16, 2017: Appeal decision to maintain the examiner's decision of refusal → final and binding)		
Date of Court Decision Court Docket Number	Court decision of the IP High Court, June 21, 2018 2018 (Gyo-Ke) 10002, Case to request revocation of the appeal decision (dismissal of request, JPO appeal decision maintained)		
Trademark	ありがとう (Arigato; thank you) (in standard characters)		
Cited Trademarks	Cited Trademark A	By profiles b! South	
Major issue	Trademark Act, Article 4(1)(xi) (Appropriateness of separate observation of a composite trademark)		

1. Outline of the case

In this case, the applicant filed an application for registration of a trademark " $\mathfrak{B}\mathfrak{H}$ $\mathfrak{H}^{\mathfrak{S}} \succeq \mathfrak{I}$ (Arigato; thank you)" comprising standard characters with the designated services of Class 35 ("Preparation of financial statements", etc.), but received a decision of refusal. The applicant filed an appeal against the examiner's decision of refusal but the JPO rendered a decision to dismiss the request for appeal pursuant to Article 4(1) (xi) of the Trademark Act. In response to this, the applicant filed an action to seek revocation of the appeal decision.

In the appeal decision, the JPO determined the trademark in the application and

the Cited Trademarks A and B (hereinafter, these may be collectively referred to as the "Cited Trademarks") to be similar trademarks that may cause confusion with each other, as the main elements of the Cited Trademarks give a similar impression in appearance, and sound and concept of the Cited Trademarks are also identical to those of the trademark in the application. The court decision also supported the appeal decision and dismissed the plaintiff's request.

2. Major issues discussed

- (1) With respect to the appropriateness of the finding as to the appearance of the Cited Trademarks, the majority of members agreed that the court's finding as to Cited Trademark A was appropriate. However, some members found it inappropriate, as the character part " $\mathfrak{H}\mathfrak{H}\mathfrak{H}\mathfrak{L}\mathfrak{I}$ " (Arigato; thank you)" appears in a fan-shaped figure depicted in a way so that the fan is held by a welcoming cat with its left forefoot and is not completely separate from the figure of the welcoming cat. With respect to Cited Trademark B, all members agreed that the court's finding was appropriate, as the character part " $\mathfrak{H}\mathfrak{H}\mathfrak{H}\mathfrak{L}\mathfrak{I}$ " (Arigato; thank you)" are written completely separate from the elliptic background parts with some space, in the size equivalent to the width of the trademark and at a conspicuous location in the upper part of the trademark.
- (2) With respect to the appropriateness of the finding of the court decision that the character part "ありかとう (Arigato; thank you)" or "ありかとう! (Arigato; thank you!)" that are elements of the Cited Trademarks give a strong impression to attract observers, the majority of members considered this finding to be inappropriate for both Cited Trademarks A and B. As the reasons for this, members presented opinions such as that supposing the character part "ありか" とう! (Arigato; thank you)" or "ありか"とう! (Arigato; thank you)" or "ありか"とう! (Arigato; thank you)" were words that are "extremely simple," "easy to sound" and "casual and familiar," they would not rather give a strong impression to their observers.
- (3) With respect to the appropriateness of the finding as to the concept associated with the Cited Trademarks, opinions of members differed. For Cited Trademark A, some members considered the court's finding to be appropriate as the concept would not be immediately associated with the figure part of the welcoming cat

and the word " $\mathfrak{B}\mathfrak{H}\mathfrak{B}\mathfrak{L}\mathfrak{I}$ (Arigato; thank you)." Other members were against the court's finding as the entire configuration of the trademark naturally associates the concept of "a welcoming cat saying $\mathfrak{B}\mathfrak{H}\mathfrak{I}\mathfrak{L}\mathfrak{I}$ (Arigato; thank you)." With respect to Cited Trademark B, some members considered the court's finding to be appropriate as the court decision used different wording from that used for Cited Trademark A; whereas other members commented that the court's finding to be inappropriate as, based on observation of Cited Trademark B in its entirety, the figure and word parts are strongly connected in terms of the concept.

- (4) With respect to the hypothetical configuration of the Cited Trademarks which would make the findings referred to in (1) through (3) above different, for Cited Trademark A, members suggested cases of adopting different styles for the characters or a different configuration or arrangement for the surrounding part of the characters, for example, representing the characters "ありがとう (Arigato; thank you)" in red color or reducing the size of the characters "ありがとう (Arigato; thank you)" and the fan figure including the characters "ありがとう (Arigato; thank you)". With respect to Cited Trademark B, members suggested a configuration depicting the characters "ありがとう ! (Arigato; thank you)" inside the elliptic background part or in a way partially overlapping the background part, and a configuration using the same font for the entire mark or depicting the characters "ありがとう (Arigato; thank you)" or "ありがとう! (Arigato; thank you)" in combination with other words with no source-identifying function.
- (5) With respect to the court's finding as to the source-identifying function of elements of the Cited Trademarks, the majority of members expressed some sense of disagreement. For example, some commented that the source-identifying function represented by the character part of "ありがとう (Arigato; thank you)" or "ありがとう! (Arigato; thank you!)" contained in the elements of Cited Trademark A and Cited Trademark B may be relatively insignificant when compared with the entire configuration of these trademarks.
- (6) With respect to the appropriateness of the conclusion that the trademark in the

application is similar to each of the Cited Trademarks, there were divergent opinions including those affirming it and those casting doubt on it. For example, a member submitted a comment that in reality, for commercial transactions, it is not likely to cause confusion in connection with goods and services between the trademark in the application and Cited Trademarks A and B, as these marks are clearly different in appearances and the word " $50 b^{3} \geq 5$ (Arigato; thank you)" is comparatively weak in terms of the source-identifying function. In this connection, members also discussed the consistency with existing Supreme Court decisions regarding the determination of similarity of a composite trademark (Supreme Court 2007 (Gyo-hi) 223, Tsutsumi no ohinakkoya case, and Supreme Court 1962 (O) 953, Rira takarazuka case), and commented that in practice these decisions are taken into consideration in a flexible way on a case-by-case basis.

Trial and Appeal Practitioner Study Group REPORT 2021 (Summary)

Contact details for inquiries:

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

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

Trial and Appeal Practitioner Study Group

 $\underset{(Summary)}{R E P O R T} 2021$



This brochure is printed using only the "A-ranked" paper which meets the criterion under the Law on Promoting Green Purchasing and can be recycled to paper.