

Trial and Appeal  
Practitioner Study Group

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# REPORT 2022

(Summary)

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Trial and Appeal Department  
Japan Patent Office

# Preface

The chief administrative judges and administrative judges of the Japan Patent Office (JPO) conduct proceedings concerning the appropriateness of examination results of patents, utility models, designs, and trademarks and the validity of rights, and make final decisions as an administrative agency. In order to properly conduct proceedings, it is important to review actual trial and appeal decisions and court decisions, and to feed the results back to future trial practices so as to objectify or clarify the criteria for determination. Moreover, by disseminating the results, it would allow us to share the understanding of trial practices with users of the trial and appeal system.

Based on this understanding, the Trial and Appeal Department of the JPO has held the “Trial and Appeal Practitioner Study Group” (initially called “Case Studies on Inventive Steps”) since 2006, in which corporate IP personnel, patent attorneys, attorneys, and the JPO’s chief administrative judges and administrative judges gather to conduct studies on trial and appeal decisions and court decisions. By this fiscal year, a total of 737 members have joined the studies of 195 cases and themes. Since 2016, judges of the Intellectual Property High Court and the Tokyo District Court have also participated in the Study Group as observers to add judicial perspectives, making the Study Group more comprehensive.

At this fiscal year’s Study Group, the members discussed general issues (support requirements for numerical limitation inventions; clarity requirements; intrinsic



**Trial court of the JPO**

properties in determining novelty; determination of inventive step when different features are matters related to a business method, or a game rule and arrangement; and determination of similarity of combined trademarks) and one particular case in each of five fields. Furthermore, by utilizing hybrid meetings, lively discussions were held in which participants were able to choose online or in-person participation.

Through in-depth discussions on specific cases and themes, the Study Group provides very valuable opportunities for participants to gain a deeper understanding of the perspectives from the different positions of corporate IP personnel, patent attorneys, attorneys, administrative judges, and judges, as well as the points of view of those with conflicting interests, such as a right holder and a demandant for invalidation trial. The results of the discussions are used not only by administrative judges but also by examiners and other officials at the JPO, as such results have been obtained through multifaceted considerations of issues and points of contention that are important in practice and also lead to objectification or clarification of the criteria for determination. Moreover, the results of the discussions are widely disseminated to users of the trial and appeal system in the form of report, which would be used as a reference by the users for in-depth knowledge of the perspectives from the different positions mentioned above and the points of view of those with conflicting interests. The results of the Study Group are also widely disseminated to the world by publishing English translation of the summary version of the report. It is expected that these efforts will help domestic and foreign users of the system understand the Japan's trial and appeal practice and will further enhance their confidence in the Japan's IP system.

Last but not least, we wish to express our gratitude to the members of the Japan Intellectual Property Association, the Japan Patent Attorneys Association, the Japan Federation of Bar Associations, the Intellectual Property High Court, and the Tokyo District Court for their cooperation in organizing the Trial and Appeal Practitioner Study Group, and to the study members and observers who participated in the Study Group.

March, 2023

**TAMURA Kiyoko**

Chairperson, Trial and Appeal Practitioner Study Group  
Executive Chief Administrative Judge,  
Trial and Appeal Department, Japan Patent Office

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**Demandant's and Demande'e's nameplates  
in the trial court of the JPO**

# Outline of Study

## I. Study Framework

Studies were conducted by each of the five groups (Patent – Machinery, Patent – Chemistry 1 (General Chemistry), Patent – Chemistry 2 (Pharmaceuticals and Biotechnology), Patent – Electricity, 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 1 theme and 1 case (the first study case and the second study case) for examination (the details are shown in the following pages).

The first cases were selected based on a general topic (support requirements in numerical limitation invention, clarity requirement, intrinsic properties in determining novelty, determination of inventive step in a case where different features are matters related to a business method, or a game rule and arrangement, and determination of similarity of combined trademark) 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 at that time. Among those, the second cases for the study were selected considering the importance of the trial and appeal practices.

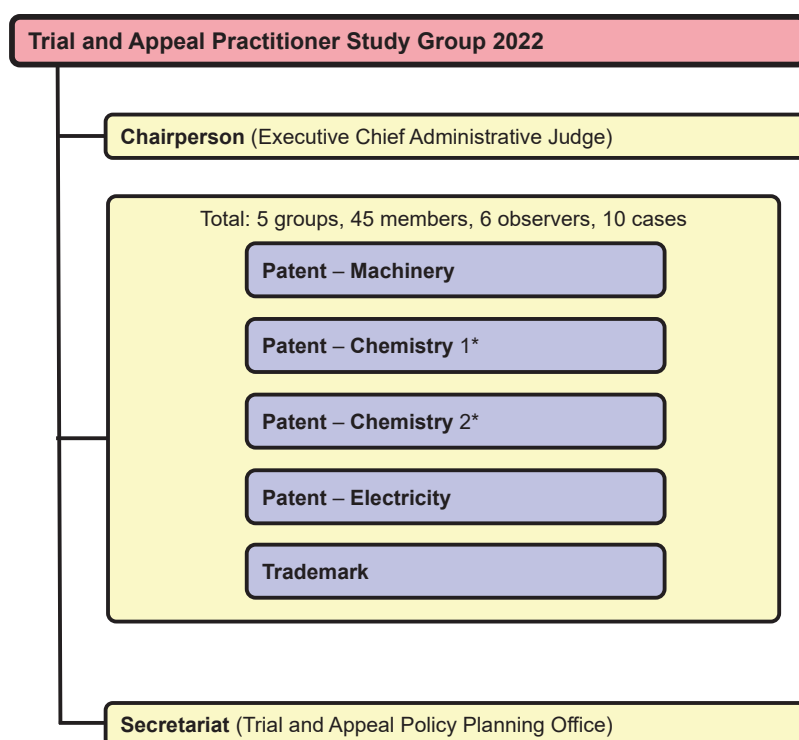
### III. Study Method

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.

All sessions for the study were conducted by a web conference, and by utilizing hybrid meetings for some sessions, lively discussions were held in which participants were able to choose online or in-person participation.



\* Patent – Chemistry 1: General Chemistry

Patent – Chemistry 2: Pharmaceuticals and Biotechnology

**Organization chart of the Trial and Appeal Practitioner Study Group 2022**



## Study Themes (the First Study Cases)

Field	No.	Topic	Point at Issue
Patent - Machinery	1	Support Requirements in Numerical Limitation Invention	<p>Issue 1: Method of determining support requirements of a numerical limitation invention</p> <p>Issue 2: To what extent should examples be enhanced in a specification</p>
Patent - Chemistry 1	2	Clarity Requirement	How the clarity requirement for a specific matter, which is not unambiguously clear only from the description of the claims, should be determined?
Patent - Chemistry 2	3	Intrinsic Properties in Determining Novelty	<p>Issue 1: In what cases is the matters (properties, etc.) specified in the invention not described in Cited Documents but considered to be inherent in Cited Invention?</p> <p>Issue 2: How should the applicant write the specification such that the invention are not rejected or invalidated on the grounds that the matters specifying the invention are inherent properties of the Cited Invention and do not constitute the different features? In addition, how should the patentee prepare the counterargument after the patent is granted?</p> <p>Issue 3: In what cases should consideration of ex-post materials, such as clarification of the inherent properties of Cited Invention by making additional experiments on Cited Invention, be allowed?</p>

Patent - Electricity	4	Determination of Inventive Step in a Case Where Different Features Are Matters Related to a Business Method, or a Game Rule and Arrangement	<p>Issue 1: In a case where different features are matters related to a business method, or a game rule and arrangement, should evidence be shown in order to deny inventive step? If there is a case where it is not necessary to show evidence, then what is that case?</p> <p>Issue 2: When inventive step is denied by using evidence in a case where the different features are matters related to a business method, or a game rule and arrangement, to what extent should descriptions be required as evidence? What kind of motivation is required?</p> <p>Issue 3: In order to affirm inventive step, what kind of matters the different features should be, based on the relationship with eligibility for invention?</p>
Trademark	5	Determination of Similarity of Combined Trademark	<p>Issue 1: When a well-known (prominent) trademark is included in a configuration of a combined trademark</p> <p>Issue 2: When components of the combined trademark differ in a level of distinctiveness</p> <p>Issue 3: When figures and characters are combined</p> <p>Issue 4: Consideration of actual trading conditions</p>

\* Patent – Chemistry 1: General Chemistry  
Patent – Chemistry 2: Pharmaceuticals and Biotechnology

## Study Cases (the Second Study Cases)

Field	No.	Title of Invention	JPO Docket No. (Trial/ Appeal Decision)	Date of Trial/ Appeal Decision	Conclusion of Trial/Appeal Decision	Major Issue
			Court Docket No. (Court Decision)	Date of Court Decision	Main Text of Court Decision	
Patent-Machinery	1	Mounting Structure of Circuit Breaker	Invalidation No. 2018-800027	February 26, 2019	Trial decision to maintain the patent	Patent Act Article 44(1) (Divisional Requirement) Patent Act Article 29(2) (Inventive Step)
			2019 (Gyo-Ke) 10046	July 22, 2020	Dismissal of the request	
Patent-Chemistry 1	2	Solder Paste Composition and Reflow Soldering Method	Invalidation No. 2015-800058	January 30, 2017	Trial decision to accept correction	Patent Act Article 29(2) (Inventive Step)
					Trial decision to maintain the patent	
			2017 (Gyo-Ke) 10063	February 20, 2018	Revocation of JPO trial decision	
Patent-Chemistry 2	3	Dosage for Treatment with Anti-ErbB2 Antibody	Invalidation No. 2016-800071	July 5, 2017	Trial decision to maintain the patent	Patent Act Article 29(2) (Inventive Step)
			2017 (Gyo-Ke) 10165 2017 (Gyo-Ke) 10192	October 11, 2018	Revocation of JPO trial decision	
Patent-Electricity	4	Information Processing Device, Method, and Program	Appeal No. 2019-14077	March 11, 2021	Appeal decision to maintain an examiner's decision of refusal	Patent Act Article 29(1) (iii) (Novelty)
			2021 (Gyo-Ke) 10056	February 10, 2022	Dismissal of the request	

Trademark	5	六本木通り特許事務所 (Roppongi-dori Tokkyo Jimusho) (Standard Character)	Appeal No. 2019-11255	September 7, 2020	Appeal decision to maintain an examiner's decision of refusal	Trademark Act Article 3(1)(vi) (Trademark lacking distinctiveness)
			2020 (Gyo-Ke) No. 10125	April 27, 2021	Dismissal of the request	



# The First Study Cases (GENERAL TOPICS)

## Theme 1: Patent – Machinery

Topic	Support Requirements in Numerical Limitation Invention (Patent Act Article 36(6)(i))
Issue	Issue 1: Method of determining support requirements of a numerical limitation invention
	Issue 2: To what extent should examples be enhanced in a specification
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Reference Court Decision ①: Intellectual Property High Court, April 17, 2017 (2016 (Gyo-Ke) 10156, “Medical Guidewire” Case (Invalidation 2015-800133))</li> <li>• Reference Court Decision ②: Intellectual Property High Court, February 4, 2021 (2019 (Gyo-Ke) 10041, “Surface Sheet For Wound Dressing And Wound Dressing” Case (Invalidation 2017-800084))</li> <li>• Reference Court Decision ③: Intellectual Property High Court, August 29, 2019 (2018 (Gyo-Ke)) 10084, “Process For Packaging Wine In Aluminum Cans” Case (Invalidation 2016-800043))</li> <li>• Reference Court Decision ④: Intellectual Property High Court, February 19, 2020 (2019 (Gyo-Ke) 10025, “Gas Dissolving Device and Gas Dissolving Method” Case (Invalidation 2017-800116))</li> </ul>

### Issues and Study Results

- (1) Issue 1: Method of determining support requirements of a numerical limitation invention

In an invention in a mechanical field, it is always easy to grasp a causal relation between parameters and functions and effects, but inventions are not necessarily limited thereto. Even if the parameters are simple, such as length, weight, pressure, there are many cases in which it is difficult to understand the causal relation between the parameters and the functions and effects unless it is described in a specification. In a numerical limitation invention relating to parameters, how to determine support requirements is a matter of high interest for a practitioner in the mechanical field.

Therefore, Reference Court Decisions ① to ④ were studied based on the court decisions of Intellectual Property High Court, November 11, 2005 (2005 (Gyo-Ke), 10042, “Method For Producing Polarizing Film” Case (Grand Panel Court

Decision)) and Intellectual Property High Court, June 12, 2008 (2007 (Gyo-Ke), 10308, "Covered Hard Member" Case). As a result of the studies, regarding the support requirements for a numerical range directly linked to a solution of a problem in the mechanical field, opinions from the members were summarized as follows: "in the detailed description of the invention, if there is a description of a mechanism that can solve a problem by setting a numerical range within the numerical range in the claims, the description of the mechanism is an effective basis to meet the support requirements. On the other hand, even in a case in which such a description is insufficient, at least one example a numerical range of which is set within the numerical range in the claims that can solve the problem may be one factor working in a direction to meet the support requirements. An example that should be described to an extent that allows to grasp a tendency of the parameters while considering the common technical knowledge may be a more effective basis to meet the support requirements."

(2) Issue 2: To what extent should examples be enhanced in a specification

According to the discussion of Issue 1, it is organized the determination method that the numerical limitation invention in the mechanical field meets the support requirements. Next, regarding an opinion that "even in a case in which the description related to the mechanism is insufficient in the detailed description of the invention, an example that is described to an extent that allows a reader to grasp a tendency of the parameters while considering common technical knowledge may be a more effective basis to meet the support requirements," the members discussed with the case examples a viewpoint that to what extent should examples specifically be required. That is, in Issue 2, for a purpose of specifically discussing the above viewpoint, the members reviewed the tendency of parameters directly read from the examples in the case examples and common technical knowledge to be referred to when reading the tendency of parameters.

From the above viewpoint, the study results are summarized as follows.

It is considered that in a case in which the common technical knowledge to be referred to is described in the specification or the common technical knowledge to be referred to is clear even if not described and the tendency of the parameters can be estimated from the common technical knowledge, an example is not essential to grasp the tendency of the parameters.



In a case in which the common technical knowledge to be referred to is not described in the specification, a plurality of pieces of common technical knowledge that can be referred to are assumed, and the number of examples is small, it is uncertain whether the tendency of the parameters can be grasped depending on which common technical knowledge is referred to, and even if the tendency of the parameters can be grasped, a different tendency may be grasped depending on the common technical knowledge to be referred to. In order to prevent this from happening, it would be effective to grasp the tendency of the parameter by describing such as the followings in the specification: three or more sufficient examples for each parameter, the tendency of the parameters and the mechanism read from the example, correlation or independence of each parameter when there is a plurality of parameters. Even when the common technical knowledge is not described in the specification, it may be determined to meet the support requirements in consideration of statements, etc. after filing the application, but since there is a risk of being determined to violate the support requirements depending on the common technical knowledge to be referred to, it would be effective to describe the common technical knowledge in the specification if there is common technical knowledge to be referred to.

When the common technical knowledge is not described in the specification and it is difficult to assume the common technical knowledge to be referred to, only an example serves as a clue for grasping the tendency of the parameters, and thus sufficiency of an example is considered more important.

On the other hand, some members expressed their opinions from a practical viewpoint that the mechanism may not be known at the time of filing, and that it is difficult to select an example to be described in the specification because the application may be filed in a hurry. Since the mechanism can be easily estimated in the mechanical field in many cases, there was an opinion that it is ideal to describe the specification in a manner that the mechanism related to the numerical limitation can be grasped for the first time in the present invention from a viewpoint of satisfying both the support requirements and inventive step.



## Theme 2: Patent – Chemistry 1

Topic	Clarity Requirement (Patent Act Article 36(6)(ii))
Issue	How the clarity requirement for a specific matter, which is not unambiguously clear only from the description of the claims, should be determined.
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Reference Court Decision ①: Intellectual Property High Court, January 18, 2017 (2016 (Gyo-Ke) 10005, “Refresing Compositon for Ophthalmology” Case (Invalidation 2015-800023))</li> <li>• Reference Court Decision ②: Intellectual Property High Court, September 6, 2018 (2017 (Gyo-Ke) 10210, “Refresing Compositon for Ophthalmology” Case (Invalidation 2015-800023))</li> <li>• Reference Court Decision ③: Intellectual Property High Court, March 12, 2020 (2019 (Gyo-Ke) 10095, “Polycrystalline Silicon Fragments and Process for Comminuting Polycrystalline Silicon Rods” Case (Opposition 2017-701223))</li> <li>• Reference Court Decision ④: Intellectual Property High Court, September 3, 2020 (2019 (Gyo-Ke) 10173, “Double-Sided Adhesive Tape, Double-Sided Adhesive Tape for Fixing In-Vehicle Component, and Double-Sided Adhesive Tape for Fixing In-Vehicle Head-Up Display Cover” Case (Opposition 2018-700983))</li> <li>• Reference Court Decision ⑤: Intellectual Property High Court, August 3, 2017 (2016 (Gyo-Ke) 10152, “Charge Control Agent and Electrostatic Charge Image Developing Toner Using the Same” Case (Invalidation 2015-800130))</li> </ul>

### Issues and Study Results

(1) Issue 1: In a case where a specific matter is not defined in the specification, how the clarity requirement is determined in consideration of the description of the specification and common general technical knowledge at the time of filing.

A. Comparison between Reference Court Decision ① (determined to be unclear) and Reference Court Decision ② (determined to be clear)

Reference Court Decisions ① and ② are decisions on a trial for invalidation for the same patent: ① is the first court decision in the suit rescinding the first trial decision, and ② is the second court decision in the suit rescinding the second trial decision.

Since the average molecular weight of sodium chondroitin sulfate sold by Maruha Corporation is described as “viscosity-average molecular weight” in the present specification, Reference Court Decision ① determines that it is unclear whether the average molecular weight in the claims refers to either the “weight average molecular weight” or “viscosity average molecular weight,” whereas since the above description is deleted by the correction, Reference Court Decision ② determines that the average molecular weight in the claims means the “weight average molecular weight.”

From the above, the majority of members commented that the invention may be determined to be unclear if a matter specifying the invention can be interpreted in multiple ways in consideration of the descriptions in the specification, etc. and the common general technical knowledge at the time of filing, and it is not unambiguously determined which of a plurality of meanings the matter specifying the invention mean.

It can be said that the clarity requirement is not determined only by whether the meaning of a matter specifying the invention is unambiguously determined, but is finally determined by whether the description of the matter specifying the invention is unclear enough to cause an unexpected disadvantage to a third party in light of the “judgment criteria” held by the Intellectual Property High Court on October 30, 2008 (2008 (Gyo-Ke) 10107).

B. Comparison between Reference Court Decision ③ (determined to be unclear) and Reference Court Decisions ④ and ⑤ (determined to be clear)

In Reference Court Decision ③, it is obvious that the matter specifying the invention cannot be unambiguously interpreted, whereas in Reference Court Decisions ④ and ⑤, based on the description of the specification, etc. and the common general technical knowledge at the time of filing, there is prima facie grounds for unambiguous interpretation of the matter specifying the invention, and there are no specific grounds to perform other interpretation.

Various opinions are shown, and it is considered that these opinions have something in common in that the invention can be determined to be unclear if an explanation leading to an understanding of the matter specifying the invention is not described in the specification and also there is no common general technical knowledge at the time of filing leading to an understanding of the matter specifying the invention.

(2) Issue 2: What points should be noted when the specification, etc. is prepared in line with the determination of the clarity requirement of the above (1), and what points should be noted for dealing with a case where a violation of the clarity requirement is alleged in a trial for invalidation, etc.

A. Points to be noted in preparing a specification, etc.

(A) Description of specification (other than examples) and recitation of claims

After understanding the common general technical knowledge at the time of filing as a person skilled in the art, sufficiently review the breadth of the meaning of the matters specifying the invention, and in principle, aim to use in the claims the matters specifying the invention unambiguously clear and if necessary define them in the specification, etc.

A definition, measurement method, measurement conditions, etc. of the matters specifying the invention are specifically and clearly described in the specification or claims.

Numerical values quoted in the descriptions supporting the matters specifying the invention in the specification are described in accordance with the definition.

(B) Examples

In Examples, an experimental method, experimental conditions, and apparatus actually used are described in detail to the extent that a test can be additionally performed.

At least by describing the above matters in Examples, the matters specifying the invention can be interpreted based on the above descriptions, and thus it is less likely to be determined as being unclear.

B. Points to be noted for dealing with a case where the violation of the clarity requirement is alleged in a trial for invalidation

Various opinions are shown by the members. It is considered that these opinions have something in common in claiming that the meaning of the matters specifying the invention are unambiguously determined and not so unclear as to cause an unexpected disadvantage to a third party if the description of the specification, etc. and the common general technical knowledge at the time of filing are taken into account after ensuring evidence for supporting the common general technical knowledge at the time of filing

and correcting the descriptions of the specification and the claims as necessary.

In addition, regarding Reference Court Decision ②, the member commented that the reasons for invalidation are resolved by making correction to delete a description inconsistent with the common general technical knowledge of a person skilled in the art, which is a reference for an example of a countermeasure, but it should also be noted in Reference Court Decision ② that the description is not the basis for the enablement requirement, the support requirement, etc.

## Theme 3: Patent – Chemistry 2

Topic	Intrinsic Properties in Determining Novelty (Patent Act Article 29(1) )
Issue	Issue 1: In what cases is the matters (properties, etc.) specified in the invention not described in Cited Documents but considered to be inherent in Cited Invention?
	Issue 2: How should the applicant write the specification such that the invention is not rejected or invalidated on the grounds that the matters specifying the invention are inherent properties of the Cited Invention and do not constitute the different features? In addition, how should the patentee prepare the counterargument after the patent is granted?
	Issue 3: In what cases should consideration of ex-post materials, such as clarification of the inherent properties of Cited Invention by making additional experiments on Cited Invention, be allowed?
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Reference Court Decision ①: Intellectual Property High Court, December 25, 2019 (2019 (Gyo-Ke) 10006, 10058, “Use of Mometasone Furoate for Treating of Airway Passage and Lung Disease” Case (Invalidation 2015-800166))</li> <li>• Reference Court Decision ②: Intellectual Property High Court, January 31, 2011 (2010 (Gyo-Ke) 10122, “Pharmaceutically Stable Formulation of Oxaliplatinum” Case (Invalidation 2009-800029))</li> <li>• Reference Court Decision ③: Intellectual Property High Court, March 19, 2019 (2018 (Gyo-Ke) 10036, “Inhibition of IL-17 Production” Case (Invalidation 2017-800007))</li> <li>• Reference Court Decision ④: Intellectual Property High Court, January 18, 2011 (2010 (Gyo-Ke) 10055, “Vascular Aging Inhibitor and Anti-Aging Agent” Case (Appeal 2009-006947))</li> <li>• Reference Court Decision ⑤: Intellectual Property High Court, September 10, 2014 (2013 (Gyo-Ke) 10209, “Agent for Preventing Arteriosclerosis, Agent for Suppressing Vascular Intimal Thickening and Agent for Improving Vascular Endothelial Function” Case (Appeal 2011-000151))</li> <li>• Reference Court Decision ⑥: Intellectual Property High Court, October 11, 2011 (2011 (Gyo-Ke) 10050, “Composition with Anti-Osteoporosis Activity” Case (Appeal 2007-023664))</li> <li>• Reference Court Decision ⑦: Intellectual Property High Court, December 14, 2020 (2019 (Gyo-Ke) 10076, “Compositions and Methods for Treatment of Inflammatory Diseases and Autoimmune Diseases” Case (Invalidation 2017-800154))</li> </ul>

## Issues and Study Results

- (1) Issue 1: In what cases is the matters (properties, etc.) specified in the invention not described in Cited Documents but considered to be inherent in Cited Invention?

When the invention is specified by the physical properties and structures inherent in the product describe in Cited Documents, such as a melting point, particle size, or viscosity, which are possible to measure and recognize according to the state of the art at the time of filing, the members agreed that even if the matters (such as properties) specified in the invention are not explicitly described in Cited Documents, it is recognized that they are inherent in Cited Invention, and do not constitute the different features.

Opinions are divided about a product specified by properties that cannot be recognized or measured according to the state of the art at the time of filing, such as a function or effect exerted when the product described in Cited Documents acts on an object not described in Cited Documents.

Based on the decision structure of Intellectual Property High Court, June 30, 2008 (2007 (Gyo-ke) 10378), the “Crystalline Azithromycin Dihydrate” case, even where the invention is the product specified by the properties that cannot be recognized or measured according to the state of the art at the time of filing, if it is possible to manufacture and replicate a product that can be said to be completely the same from the description of the manufacturing method of the product based on the specification, or the technical common sense of a person skilled in the art or the state of the art at the time of filing, it can be said that the product itself, including functions and effects thereof, is described, and thus the majority of the members have the opinions that novelty can be denied.

Regarding a product specified for use based on properties of functions, effects, etc. that are not described in Cited Documents, the members agreed that it should not be concluded no difference is present as intrinsic properties if the properties provide a new use and the use is cited in the claims to distinguish the invention from Cited Invention in terms of the use.

- (2) Issue 2: How should the applicant write the specification such that the invention is not rejected or invalidated on the grounds that the matters specifying the invention are inherent properties of the Cited Invention and do not constitute



the different features? In addition, how should the patentee prepare the counterargument after the patent is granted?

Various opinions are raised from the members, such as describing differences from the known properties and mechanisms of action, differences from the known use, limitations on target patients, etc. in the specification, searching and understanding the prior art in advance that can be regarded as inherent properties, describing use of the claimed invention in an expression that can be distinguished from the existing use in line with the mechanism of action newly discovered in the invention, and describing the newly discovered properties, etc. as use to clarify the difference from the prior art.

- (3) Issue 3: In what cases should consideration of ex-post materials, such as clarification of the inherent properties of Cited Invention by making additional experiments on Cited Invention, be allowed?

The members agreed that consideration of ex-post materials should be allowed when it is possible to measure and recognize the physical properties and structure inherent in the product described in Cited Documents, such as a melting point, particle size, or viscosity, according to the state of the art at the time of filing.

Similar to the discussion in Issue 1, if it is recognized that the manufacturing method in Cited Documents is described sufficiently detailed and specific to enable manufacturing exactly the same product, and the product has properties that cannot be recognized or measured according to the state of the art at the time of filing based on objective data such as the current results of additional tests, then, it can be said, even if the properties are unknown, that the description in Cited Documents specifies the product itself having such properties by the manufacturing method. In conclusion, the majority of members agreed that even ex-post materials should be allowed for consideration.



## Theme 4: Patent – Electricity

Topic	Determination of inventive step in a case where different features are matters related to a business method, or a game rule and arrangement (Patent Act Article 29(2))
Issue	Issue 1: In a case where different features are matters related to a business method, or a game rule and arrangement, should evidence be shown in order to deny inventive step? If there is a case where it is not necessary to show evidence, then what is that case?
	Issue 2: When inventive step is denied by using evidence in a case where the different features are matters related to a business method, or a game rule and arrangement, to what extent should descriptions be required as evidence? What kind of motivation is required?
	Issue 3: In order to affirm inventive step, what kind of matters the different features should be, based on the relationship with eligibility for invention?
Major JPO/ Court Decisions for Reference	<ul style="list-style-type: none"> <li>• Reference Court Decision ①: Intellectual Property High Court, March 29, 2018 (2017 (Gyo-Ke) 10097, “System Operation Method” Case (Invalidation 2015-800110))</li> <li>• Reference Court Decision ②: Intellectual Property High Court, June 20, 2019 (2018 (Gyo-Ke) 10166, “Program and Server” Case (Appeal 2017-013961))</li> <li>• Reference Court Decision ③: Intellectual Property High Court, March 17, 2020 (2019 (Gyo-Ke) 10072, “Host Club Visit Invitation Method and Host Club Visit Invitation Device” Case (Appeal 2018-003578))</li> <li>• Reference Court Decision ④: Intellectual Property High Court, June 4, 2020 (2019 (Gyo-Ke) 10085, “Server Device, Control Method, Program, and Game System Thereof” Case (Appeal 2019-002409))</li> <li>• Reference Court Decision ⑤: Intellectual Property High Court, September 24, 2020 (2019 (Gyo-Ke) 10114, “Video Distribution System, Video Distribution Method, and Video Distribution Program for Distributing Video Including Animation of Character Object Generated Based on Motion Of Actor” Case (Appeal 2019-000892))</li> </ul>

## Issues and Study Results

- (1) Issue 1: In a case where different features are matters related to a business method, or a game rule and arrangement, should evidence be shown in order to deny inventive step? If there is a case where it is not necessary to show the evidence, then what is that case?

According to the reference court decision ③ and the reference court decision ④, it was determined that even if the different features were matters related to a business method, or a game rule and arrangement, it was necessary to show evidence that there were other publicly known techniques and well-known techniques, and to show reasoning using the evidence.

Therefore, the members discussed whether evidence should be shown. As indicated in the reference court decision ③ and the reference court decision ④, the majority of members agreed that the evidence should be shown in principle regardless of whether the different features were related to the rule or arrangement. On the other hand, some members expressed their opinions that since an invention protected by the Patent Act is an invention constitutes a “creation of technical ideas utilizing a law of nature” in the first place, inventive step should not be recognized by matters related to a rule or arrangement that does not contribute to a technique utilizing a law of nature, and it does not mean evidence should be shown.

In addition, the members mentioned some examples of the case where it is not necessary to show evidence, including a case where the different features are design matters, a case where there is no particular significance in the different features, and a case where functions and effects cannot be achieved, similar to a case of normal determination of inventive step. On the other hand, there was an opinion that since the determination is different for each case, it is not possible to generalize that evidence is not necessary to be shown if the different features are design matters.

- (2) Issue 2: When inventive step is denied by using evidence in a case where the different features are matters related to a business method, or a game rule and arrangement, to what extent should descriptions be required as evidence? What kind of motivation is required?

As examined in the above (1), in a case where evidence should be shown, there

was an opinion that inventive step was more likely to be denied even if the matters themselves related to the different features were not disclosed as evidence when functions and effects obtained from the different features were not technical. However, it is considered that since the extent of descriptions required for denying the progress is different for each case, a disclosure content, a technical idea, etc. of the evidence need to be examined well.

In addition, regarding the motivation, the majority of members agreed that it was necessary to determine the motivation in the same manner as in normal determination of inventive step, as indicated in the reference court decision ① and the reference court decision ②. On the other hand, the majority of members also agreed that the relevance of the technical fields regarded as one of the motivations can be understood more flexibly than in the normal determination, and the scope that can be recognized as technical fields related to cited inventions tended to be wider than in the normal determination.

- (3) Issue 3: In order to affirm inventive step, what kind of matters the different features should be, based on the relationship with eligibility for invention?

There were some opinions that if a claimed invention is applicable to a “creation of a technical idea utilizing a law of nature” as a whole, the invention is satisfied with eligibility for patent, whereas a part of the invention may not be a technical matter using a law of nature (may be matters related to a business method, or a game rule and arrangement). There was another opinion if matters related to the different features is a business method, or a game rule and arrangement “itself” and is not a technical matter utilizing a law of nature, affirmation of inventive step based on such different features is contrary to an idea of the Patent Act that protects a “creation of a technical idea utilizing a law of nature” in the first place. Therefore, as determination of eligibility for invention and inventive step are related, the different features affirming inventive step need to be a “technical matter utilizing a law of nature” related to a business method, or a game rule and arrangement, that is eligible for invention determined by matters related to the different features alone. The opinions of the members are divided as to whether the determination of eligibility for invention and the determination of inventive step should be considered separately, and whether the matters related to the different features need to

satisfy eligibility for invention independently.

Based on these facts, in order to obtain the affirmative determination of inventive step, when filing an application, it is important to clarify a technical matter utilizing a law of nature and describe the significance, function, and effect of the technical matter in the detailed description of the invention also on matters related to a business method, or a game rule and arrangement of the invention.

## Theme 5: Trademark

Topic	Determination of Similarity of Combined Trademark
Issue	Issue 1: When a well-known (prominent) trademark is included in a configuration of a combined trademark
	Issue 2: When components of the combined trademark differ in a level of distinctiveness
	Issue 3: When figures and characters are combined
	Issue 4: Consideration of actual trading conditions
Major JPO/ Court Decisions for Reference	<p>(Issue 1)</p> <ul style="list-style-type: none"> <li>• Reference Court Decision ①: Intellectual Property High Court, August 29, 2018 (2018 (Gyo-Ke) 10026, “VANSNEAKER” Case (Opposition 2017-900135))</li> <li>• Reference Court Decision ②: Intellectual Property High Court, January 20, 2016 (2015 (Gyo-Ke) 10158, “REEBOK ROYAL FLAG” Case (Appeal 2014-025615))</li> </ul> <p>(Issue 2)</p> <ul style="list-style-type: none"> <li>• Reference Court Decision ③: Intellectual Property High Court, January 24, 2017 (2016 (Gyo-Ke) 10164, “ゲンコツメンチ (Genkotsu Menchi; food)” Case (Invalidation 2015-890083))</li> <li>• Reference Court Decision ④: Intellectual Property High Court, March 7, 2018 (2017 (Gyo-Ke) 10169, “ゲンコツコロッケ (Genkotsu Korokke; food)” Case (Invalidation 2015-890082))</li> </ul> <p>(Issue 3)</p> <ul style="list-style-type: none"> <li>• Reference Court Decision ⑤: Intellectual Property High Court, March 11, 2021 (2020 (Gyo-Ke) 10118, “SMS” Case (Invalidation 2019-890048))</li> </ul>

### Issues and Study Results

(1) Issue 1: When a well-known (prominent) trademark is included in a configuration of a combined trademark

A. After various elements were considered in determining the integrity of a trademark including a well-known trademark in the configuration thereof, and the members discussed what consideration of those elements should be.

First, some members expressed that the importance or the priority of the consideration elements should not be determined only by specific consideration elements, but determined comprehensively. On the other hand,

there was an opinion that, subsequent to an appearance (such as a position, a size), the well-known or the distinctiveness of each component of the trademark in the trade fields of the designated goods and services seemed to be emphasized.

Some members commented that when a user of a combined trademark including the well-known trademark is different from a user of the well-known trademark, the combined trademark is required to be more integrated in appearance or concept.

- B. In relation to the “REEBOK ROYAL FLAG” case (the reference court decision ②), the members also discussed on the determination of similarity when assuming that an earlier application and a later application relationship between a trademark including a well-known trademark in the configuration thereof and another trademark has been switched.

(2) Issue 2: When components of the combined trademark differ in a level of distinctiveness

- A. Elements for determining a level of distinctiveness of the components of the combined trademark have become a subject to discussion. In this regard, first, some members have an opinion that a lower limit of the level of distinctiveness of each component was absolutely evaluated, and then the level of distinctiveness of each component was relatively evaluated.
- B. There was an opinion referring to the comparison between the “ゲンコツメンチ (Genkotsu Menchi; food)” case (the reference court decision ③) which is not similar to “ゲンコツ (Genkotsu; food)” and the “ゲンコツコロッケ (Genkotsu Korokke; food)” case (the reference court decision ④) which is similar to “ゲンコツ (Genkotu; food)”. They are specific examples in which the evaluation of distinctiveness may affect the determination of integrity of the combined trademark.

(3) Issue 3: When figures and characters are combined

The members discussed on a case of a combined trademark including figures and characters. When determining similarity of a character portion extracted as a main part, whether it is necessary to ask a higher similarity than that in a case of an un-combined trademark. The majority of the members agreed that



there was no need for asking a higher similarity.

(4) Issue 4: Consideration of actual trading conditions

A. Regarding actual trading conditions, according to the judicial precedents and Examination Guidelines, when determination of similarity of a trademark, actual trading conditions that are general and constant are taken into consideration, but actual trading conditions that are special and limited are not taken into consideration. Based on this standard, the members discussed how the actual trading conditions were considered in the recent JPO/Court decisions when observing combined trademarks in contrast.

First, the members stated some opinions relating to the practical use of this standard. Regarding the determination of similarity of the trademark, when a claim related to actual conditions such as the use of trademarks is made, it is noticeable that the above standard is used as a reluctant reason for not adopting this claim.

B. As specific contents of the “general and constant actual conditions of the designated goods in general” referred to in the judicial precedents, etc., first, some members cited “a trading system, a distribution route, a demand bracket, usage status of a trademark, etc.” which can be found in court cases. On the other hand, some members expressed their opinions that the trading system, the usage status, etc. of a trademark referred to herein may be varied and fluid, thus a scope applicable to the “general and constant actual conditions of trade” was not clear enough to be understood.

Regarding this point, some members pointed out that, in addition to a point of view that the publicity was considered incorporated into the general and constant actual conditions in many cases in practice and another point of view that differences in properties of products or services were implicitly considered as a kind of the actual trading conditions, it appeared that the specific actual trading conditions were substantially considered as general and constant conditions.

# The Second Study Cases

## Case 1: Patent – Machinery

*Regarding superordinate conceptualization of a configuration in a divisional application and a comparison in which a combination of a plurality of members corresponds to one member*

JPO Docket Number	Trial for invalidation Invalidation No. 2018-800027 (Patent No. 5688625) (Request dismissed) (February 26, 2019: trial decision to maintain the patent → final and binding)
Court Decision Date Docket Number	Intellectual Property High Court, July 22, 2020 2019 (Gyo-Ke) 10046 (Dismissal of the request, JPO trial decision maintained)
Title of Invention	Mounting Structure of Circuit Breaker
Major issue	Patent Act Article 44(1) (Divisional Requirement) Patent Act Article 29(2) (Inventive Step)

### 1. Overview of the case

In the present case, inventive step and divisional requirements were disputed over the invention titled “mounting structure of circuit breaker.” The trial decision determined that the invention had inventive step and satisfied the divisional requirements (trial decision to maintain the patent). A suit against the trial decision was filed, and the court held that the inventive step was acknowledged, and the divisional requirements were satisfied. The conclusion of the trial decision and the court decision is consistent (dismissal of the request), however, the court found there was an error in a part of determination of difference in features in the trial decision.

### 2. Major issues discussed

- (1) Issue 1: Regarding a comparison in which a combination of a plurality of members of Exhibit A-1 corresponds to one member of the present invention

The trial decision determined that it cannot be said that the “mounting member 5 on which the branch switch 4 is mounted” in Exhibit A-1 corresponds to the “circuit breaker” in the present invention. In response to this, the court determined that a circuit breaker including a separate mounting member was

included in the “circuit breaker” of the present invention. The members discussed, although the finding of Exhibit A-1 was the same in the trial decision and the court decision, the comparison between the “mounting member 5 on which the branch switch 4 is mounted” of Exhibit A-1 and the circuit breaker” of the present invention, which have been concluded to be different from each other.

In the discussion, the members agreed that the court decision was valid based on the facts that there was no description in Claim 1 of the present invention that the mounting mechanism of the circuit breaker was limited to one created in advance uniformly and integrally with a device itself having a circuit breaker function, and that there was a description in Exhibit A-1 that “the branch switch 4 is mounted.....together with the mounting member 5 in a state in which the branch switch 4 is mounted on the mounting member 5.”

(2) Issue 2: Regarding superordinate conceptualization of a configuration in a divisional application

The present application is a divisional application, and the description of “the claw portion and the recess portion” in the original application was abstracted to the description of “the fitting portion and the fitted portion”, which was not described in the specification of the original application, etc., thereby realizing a superordinate concept. Regarding the above superordinately conceptualized content, the trial decision and the court decision of the present invention do not clearly show a determination as to whether the content is explicitly described in the specification of the original application, etc. or is obvious from the description, and determine that “the superordinate conceptualization is not directly related to a solution of a problem, and thus a new technical matter is not introduced.”

Prior to the study of whether the superordinate conceptualization corresponds to an addition of a new matter, when making a superordinate concept, there has been organized into two types: a “configuration deletion type” in which a part of matters specifying the invention described in series is deleted, and a “wording extension type” in which an original wording is changed to a wording expressing its comprehensive concept as in the present invention. The determination method specialized for the latter type is not shown in court cases including a decision by Intellectual Property High Court, May 30, 2008 (2006 (Gyo-Ke), 10563,

“Solder Resist” Case) (Grand Panel Court Decision) or in Examination Guidelines for Patent and Utility Model in Japan. Therefore, when the validity of the trial decision and the court decision of the present invention was studied, the following three major opinions were expressed by the members.

- A. It is desirable to study in more detail on specific technical matters belonging to the scope extended by the superordinate conceptualization.

Although some members did not agree with the conclusion that the divisional requirement was satisfied in the trial decision and the court decision of the present invention, a majority of members agreed with the conclusion. Regarding the study of the divisional requirement, as a result of the discussion, the members who agreed with the conclusion, as well as the members who did not agree with the conclusion, expressed an opinion that it is desirable to study specific technical matters belonging to the scope extended by the superordinate conceptualization in more detail, and this opinion relatively obtained the large number of members’ consent. That is, in the case of the “wording extension type,” since the scope extended by the wording of the comprehensive concept is not explicitly described, there is a possibility that a new technical matter is introduced. Regarding the specific technical matters belonging to the extended scope, it is mentioned a specific fitting form other than a form in which the mountain members of the claw portion and the recess portion are reversed in their locations, and it is more desirable to carefully study whether this corresponds to “introduction of new technical matters.”

- B. Extension is possible if the configuration is directly related to the solution of the problem.

Some members commented that an amendment when making the superordinate concept has two types however, regardless of whether the amendment belongs to the “configuration deletion type” or the “wording extension type,” the determination as to whether the amendment corresponds to an addition of a new matter is basically the same, and whether the configuration is “directly related to the solution of the problem” may be used as a determination criterion.

C. It is necessary to study whether the claw portion and the recess portion are directly related to the solution of the problem.

There was also an opinion that the claw portion and the recess portion, which indicates a specific fitting form, are “directly related to the solution of the problem.”

(3) Additional Issue: Regarding an influence of a difference in size of an object described in the primary cited invention and the secondary cited invention on motivation)

The members additionally discussed on motivation when there was a difference in size of objects between the primary cited invention and the secondary cited invention. As a result, the members reached a consensus that the size of an object has a certain frame for each technical field and when the technical field becomes different due to an excessive difference in size, and when a difference in size of an object affects the problem, it may be said that there is no motivation for applying the secondary cited invention to the primary cited invention, but it cannot be said that there is no motivation for applying the secondary cited invention to the primary cited invention only due to a difference in size.

## Case 2: Patent – Chemistry 1

### *Regarding Consideration of Remarkable Effects in Determination of Inventive Step*

JPO Docket Number	Trial for invalidation
	Invalidation No. 2015-800058 (Patent No. 4447798) (Request dismissed)
	(January 30, 2017: Trial decision to maintain the patent (First trial decision) → Revocation of the trial decision)
	(November 16, 2018: Trial decision to maintain the patent (Second trial decision) → Withdrawal of the request)
Court Decision Date Docket Number	Intellectual Property High Court, February 20, 2018 2017 (Gyo-Ke) 10063 (Revocation of JPO trial decision)
Title of Invention	Solder Paste Composition and Reflow Soldering Method
Major issue	Patent Act Article 29(2) (Inventive Step)

#### 1. Overview of the case

Present Invention 1 relates to a solder paste composition, and in the trial for invalidation, the reasons for invalidation such as violation of inventive step, were asserted.

The different feature between Present Invention 1 and Exhibit A-1 is only whether the solder powder is “lead-free”. In the trial decision, it was determined that a person skilled in the art could have easily conceived of a matter specifying Present Invention 1 related to the difference in Exhibit A-1, but according to the description of the present specification and the certificate of experimental results submitted by the patentee, Present Invention 1 exerts a remarkable effect which cannot be predicted by a person skilled in the art, and thus Present Invention 1 could not have been easily arrived at by a person skilled in the art based on Exhibit A-1.

In contrast, in the court decision, it is pointed out that the problem to be solved by Present Invention 1 is common technical knowledge at the time of application of the present patent and also it is difficult to say that the result of the certificate of experimental results (defendant’s experiment) is based on clear criteria for

determination, and the court judged that the effect of Present Invention 1 is not a remarkable effect that cannot be predicted by a person skilled in the art, and thus the trial decision should be revoked.

## **2. Major issues discussed**

- (1) Issue 1: In Present Invention 1, the court held that “it is possible to prevent the re-oxidation of the solder powder and improve properties of solder as long as a molecule contains antioxidants containing a phenol skeleton with a tert butyl group, which could have been predicted by a person skilled in the art based on Exhibit A-1 and common technical knowledge”

A. In Present Invention 1, there are many opinions that the effect of using an antioxidant composed of a hindered phenol-based compound is supported by the description of the present specification, particularly by comparison between an example containing the antioxidant and a comparative example not containing an antioxidant.

Regarding the contents of the examples (condition setting and evaluation method), many members agreed that the contents of the examples are appropriate and there are no points that make experimental results invalid or inappropriate, however, some members pointed out that the contents of the examples are insufficient in that the contents are qualitative and subjective, and that there are not enough comparative examples.

B. There are many opinions that the effect in A. of Present Invention 1 could have been predicted by a person skilled in the art based on Exhibit A-1 and common technical knowledge. The reasons for this include that Exhibit A-1 describes that the re-oxidation can be prevented by using an antioxidant, and that the problem to be solved by Present Invention 1 is common technical knowledge at the time of application of the present patent.

- (2) Issue 2: The court held that “the effect of Present Invention 1 obtained by limiting ‘a molecular weight of the antioxidant to at least 500’ is not recognized to be a particularly remarkable effect that cannot be predicted by a person skilled in the art based on Exhibit A-1 and common technical knowledge”

A. The members agreed that it cannot be said that the critical significance of the molecular weight of the antioxidant is supported by the description of the



present specification, and that the contents of examples (condition setting and evaluation method) are not appropriate. The reasons for this are that, in the present specification, there is no data in which the effects are compared by focusing on the molecular weight of the antioxidant, that there is no description associating the molecular weight of the antioxidant with the effect of Present Invention 1, and the like.

- B. Opinions are divided as to whether the defendant's experiment supports the critical significance of the molecular weight of the antioxidant. It is considered that the difference in perception affects as to whether the experimental results actually shown by the defendant's experiment are within the range of the matters described in the present specification, whether the contents (condition setting and evaluation method) of the defendant's experiment conform to the description in the present specification, and whether the contents are appropriate.
- C. In Present Invention 1, there are many opinions that the effect of using an antioxidant having a molecular weight of at least 500 is not a particularly remarkable effect that cannot be predicted by a person skilled in the art based on Exhibit A-1 and common technical knowledge at the time of application of the present patent. The reasons for this are that it is difficult to say that the critical significance of the molecular weight of the antioxidant is sufficiently supported by the description of the present specification and the defendant's experiment, that it is well-known that the larger the molecular weight of the antioxidant, the more excellent the antioxidant effect, and the like.
- D. Opinions of the members were divided on the validity of the last-out defendant's experiment. It is considered that there is the difference in perception as to whether the experimental results actually shown by the defendant's experiment is within the range of the matters described in the present specification, and the differences between the members regarding the patent system also have an effect.

- (3) Issue 3: Regarding considerations when creating a specification, etc. and when alleging that the present invention exerts a remarkable effect in a trial for invalidation, etc.

Various remarks were raised by the members that the evaluation criteria in the examples and the certificate of experimental results should be objective and quantitative, and unclear criteria and arbitrary evaluation should be avoided, and that the reasons such as why the element that can be a matter specifying the invention is desirable and how the element contributes to the effect should be described in the specification.

## Case 3: Patent – Chemistry 2

### *Regarding Consideration of Common Technical Knowledge or Ex Post Facto Materials in Determination of Inventive Step*

JPO Docket Number	Trial for invalidation Invalidation No. 2016-800071 (Patent No. 5818545) (Request dismissed) (July 5, 2017: Trial decision to maintain the patent → Revocation of the trial decision) (June 4, 2019: Registration of withdrawn of the request → final and binding)
Court Decision Date Docket Number	Intellectual Property High Court, October 11, 2018 2017 (Gyo-Ke) 10165 (Revocation of the trial decision) 2017 (Gyo-Ke) 10192 (Revocation of the trial decision)
Title of Invention	Dosage for Treatment with Anti-ErbB2 Antibody
Major Issue	Patent Act Article 29(2) (Inventive Step)

#### **I. Overview of the case**

Regarding the issue, the different feature between the present invention and the cited invention in terms of inventive step is that, in the former, the “intravenous administration” of the “anti-ErbB2 antibody” is performed at an initial dose of 8 mg/kg and a plurality of subsequent doses of 6 mg/kg at intervals of three weeks (8/6/3 dosage regimen), whereas in the latter, the “intravenous administration” of the “anti-ErbB2 antibody” is performed at an initial dose of 4 mg/kg and a plurality of subsequent doses of 2 mg/kg at intervals of one week (4/2/1 dosage regimen).

In the trial decision, it was determined that a person skilled in the art could not have been motivated to perform administration using the dosage regimen of 8/6/3 instead of the dosage regimen of 4/2/1, and inventive step was affirmed.

In the court decision, it was recognized that it is common technical knowledge for a person skilled in the art to adjust the dosage and dosing interval during development of pharmaceuticals, and it was judged that the dosage regimen of 8/6/3 could have been easily arrived at.

In addition, regarding the attached document distributed after 15 years or more from the priority date, there is no basis for considering the description of the attached

document when conspicuity of the effects of the present invention is determined.

## **2. Major issues discussed**

- (1) Issue 1: Regarding consideration of common technical knowledge in determination of inventive step

The members discussed on the evidence presented as the ground for considering the dosage regimen as common technical knowledge.

There were opinions that it is understandable the determination of the trial decision in that it is difficult to apply knowledge relating to small molecular drugs, etc. to the antibody of the present invention, and that the evidence submitted at the court has a large impact on the court decision. On the other hand, there were other opinions that the finding of the common technical knowledge in the court decision is appropriate and is close to common sense on the premise that problems of reducing the burden of hospital visits and pain during administration were common in chemotherapy, and the pharmaceuticals having features in dosage regimen have well-known problems such as increase in potency, side effects, and drug compliance.

- (2) Issue 2: Regarding judgment on differences in determination of inventive step

It was determined in the trial decision that a specific dosage regimen of 8/6/3 according to the present invention cannot be specifically conceived, whereas it was determined in the court decision that it is easy to administer once a week at a dose of up to about 8 mg/kg, and that it is easy to arrive the dosage regimen of 8/6/3 from the three-weekly administration method.

Studies have been made to separately consider technical matters in the constituents of the invention according to such different points.

As a result, while an opinion was given that the dosage regimen should be integrally determined because the dosage regimen cannot be set independently of the technical matters, an opinion was given that the dosage regimen may be determined independently because there was no critical significance peculiar to 8/6/3, and another opinion was also given that the part that recognizes common technical knowledge is important but whether each element of the initial dose, the continuous dose, and the dosing interval is determined independently or integrally has little effect on the conclusion of inventive step.

- (3) Issue 3: Regarding judgment on presence or absence of motivation (obstructive factor) in determination of inventive step

In the court decision, in response to the defendant's (patentee's) allegation that "setting the dosing interval to 3 weeks, which greatly exceeds the half-life, as in the dosage regimen of 8/6/3 cannot be said to be an optimization of technology," the court held that the considerations on the assumption that the dosing interval is longer than the half-life are known and could have been easily conceived; the appropriateness of this holding has been discussed.

As a result, the members reached a consensus that the finding in the court decision was appropriate, stating that the effect of common technical knowledge is large and there are no obstructive factors enough to negate the motivation.

- (4) Issue 4: Regarding determination of effects exerted by the present invention

In the trial decision, the remarkable effects were found as compared with the range of 10  $\mu\text{g/ml}$  to 20  $\mu\text{g/ml}$  of the target trough serum concentration in the past clinical trials related to the present antibody, but in the court decision, the remarkable effects were denied as compared with the trough serum concentration of about 79  $\mu\text{g/ml}$  in the case of administration at the dosage regimen of 4/2/1 described in the prior art. The members discussed differences in the determinations of the trial decision and court decision and reached a consensus that it would be appropriate to compare with the dosage regimen of 4/2/1 of the primary cited reference.

- (5) Issue 5: Regarding consideration of ex post facto materials in determination of inventive step

The court decision denied that the materials presented after the fact by the patentee is used as a basis for consideration of effects, and the members discussed as to whether the ex post facto materials could be taken into account in the court decision if what conditions were satisfied.

The members commented although it can be understood that it is difficult to prepare clinical data at the time of filing the application, even in the simulation, the trough serum concentration in the attached document can be obtained, a preferable best score is obtained, a comparison with 4/2/1 should be made, etc.

(6) Issue 6: Regarding allegation and proof of the concerned party

Although the members studied as to what kind of different additional allegations should have been made by the patentee for inventive step to be acknowledge, all members agreed that it would be difficult in this situation.

## Case 4: Patent – Electricity

### *Handling of Matters Related to “Other Device” in Sub-Combination Inventions*

JPO Docket Number	Appeal against an examiner’s decision of refusal Appeal No. 2019-14077 (Patent Application No. 2016-67886) (Request dismissed) (March 11, 2021: Appeal decision to maintain an examiner’s decision of refusal → final and binding)
Court Decision Date Docket Number	Intellectual Property High Court, February 10, 2022 2021 (Gyo-Ke) 10056 (Dismissal of the request, JPO appeal decision maintained)
Title of Invention	Information Processing Device, Method, and Program
Major issue	Patent Act Article 29(1)(iii) (Novelty)

#### **1. Overview of the case**

This case relates to a case of an appeal against an examiner’s decision of refusal of the patent application and a case to a request for revocation of the trial decision with the title of the invention as “Information Processing Device, Method, and Program.”

In the appeal decision, it was found that the claimed invention 1 after amendment (hereinafter, referred to as “the amended invention”) where such the written amendment was filed on October 23, 2019 (hereinafter, referred to as “the amendment”), was not directly specified a part of constituent features of the invention, and determined that the invention lacks inventive step, and due to this finding, the amendment was dismissed on the grounds of violation of independent requirements for patentability, and thereby it is determined that the invention according to Claim 1 before the amendment lacks novelty (Appeal decision to maintain an examiner’s decision of refusal).

In response to this, a suit against the appeal decision was filed, and the court determines that it is appropriate to find the gist of the invention by excluding matters that have no meaning in specifying the invention according to the claim, and that there is no error in the appeal decision in finding the amended invention, and the court decision supports the appeal decision (Dismissal of the request).

## 2. Major issues discussed

- (1) Issue 1: Regarding how the invention is found and determined when there is a matter related to “other device” in the sub-combination invention)

When the recitation of claims includes matters related to “other device” (other sub-combination), and the matters related to the “other device” do not specify any structure, function, etc. of the sub-combination invention, the opinions of the members are divided into the followings: an opinion that for the reason that there is little risk of erroneous finding of the gist or oversight of the different features as in the Examination Guidelines (see “4.1” and “4.2.2” of Section 4 in Chapter 2 of Part III), the invention should be found as described and determined that there is no substantial differences even if there are differences in expression in determining inventive step; and an opinion that for the easy-to-understand reason, as in the present court decision, matters related to “other device” are excluded in finding the invention and the determination of inventive step should be made as usual. On the other hand, the members reached a consensus that no difference is present in the conclusion regardless of which findings or determination method is adopted.

- (2) Issues 2 and 3: Regarding “constituent element (B),” “constituent elements (C) and (C1) to (C7)” are found and determined by excluding as matters related to “other device”

In the publication notifying unit provided in the information processing device of “constituent element (B),” a point that the server which is “other device” is notified of the information in the publication as the “first information including the information that serves as the basis for extracting the second and third information by the server”, and another point that “in the server ... when the seventh information is transmitted to the information processing device,” which is the “constituent elements (C) and (C1) to (C7),” do not contribute to specifying the function, structure, etc. of the “information processing device” that is the sub-combination invention. Thus, the members agreed that the court decision determined by excluding the matters are appropriate.

In order to specify the information processing device as contributing to specification, it is considered to specify the first information and the seventh information themselves: by containing special information used for processing on



the server, as a means of processing or encrypting the information into a format that can only be processed by the server recited in the claim, as information processed or encrypted in the above format, etc. However, no such statement is described in the detailed description of the invention, and thus it is considered difficult to specify as above in this case.

- (3) Issue 4: Regarding the “information” (seventh information) of “constituent element (D),” the finding that “the information in the publication related to the intellectual property right was generated by the information processing device as a result of notifying the server of the information in the publication” is found as a matter related to the “information processing device”

In the receiving unit provided in the information processing device of “constituent element (D),” the description that the “information” (seventh information) is “generated as a result of notifying the server of the information in the publication related to said intellectual property right by the information processing device” is a matter to specify a server that is “other device,” but it is also considered to specify the case where the receiving unit provided in the information processing device receives the “information,” and in that case it can be said to contribute to specifying the function, structure, etc. of the “information processing device.” Thus, the majority of the members agreed that there is no problem in findings.

- (4) Issue 5: In what kind of relationship a sub-combination invention with respect to “other device” is considered “exclusive”

In the court decision of the Intellectual Property High Court 2010 (Gyo-ke) 10056 case which is incorporated in this court decision, it is determined that if the liquid ink storage container, which is the sub-combination invention, is “exclusive” to the recording device which is the “other device,” it is a mistake to consider by excluding the presence of the recording device.

Then, the members examined in what kind of relationship the sub-combination invention with respect to “other device” is considered “exclusive.” The members expressed the opinions when the sub-combination invention is in a relationship in which the effect of the invention is obtained only when used in combination with “other device,” and when the sub-combination invention is to solve the technical

problem by combining with the matters related to “other device”, and there is the relationship where the technical problem is solved only after the features of the sub-combination invention itself and the matters related to “other device” were combined.

## Case 5: Trademark

### *Regarding Distinctive Character of Trademark Comprising of Common Name of Road and Location of Providing Services*

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2019-11255 (Trademark Application No. 2018-30044) (Request dismissed) (September 7, 2020: Appeal decision to maintain an examiner's decision of refusal → final and binding)
Court Decision Date Docket Number	Intellectual Property High Court, April 27, 2021 2020 (Gyo-Ke) No. 10125 (Dismissal of a request, JPO appeal decision maintained)
Trademark	六本木通り特許事務所 (Roppongi-dori Tokkyo Jimusho) (Standard Character)
Designated Services	Class 45 Agencies for procedures relating to patents for start-ups
Major issue	Trademark Act Article 3(1)(vi) (Trademark lacking distinctiveness)

#### 1. Overview of the case

The case relates to a trademark in the application consisting of the standard characters of “六本木通り特許事務所 (Roppongi-dori Tokkyo Jimusho (Roppongi-dori Patent Firm))”. For this case, a suit against the appeal decision was filed with respect to the appeal decision of dismissal of the request in the appeal against an examiner's decision of refusal, and the case was final and binding by dismissal of the request.

#### 2. Major issues discussed

(1) Issue 1: Regarding the element “Roppongi-dori” (written in characters) are found to be the common name of the road and that it is the place where the designated services of the trademark in the application are provided

A. The members pointed out that the matter that the road name “Roppongi-dori” is officially established is not important in itself, but a matter of whether consumers recognize the “Roppongi-dori” as a place to provide services is an issue.

Meanwhile, the members also pointed out that the fact that the name is

officially established can contribute as a criterion for making the judge easier to recognize the Applicability of Article 3(1).

- B. If a plurality of road with the same name is present nationwide, there are many opinions that the presence of the plurality of road with the same name does not immediately act in the direction of affirming the distinctiveness of the trademark.
  - C. If a road name is to cover a wide area, opinions of the members are divided into the views that the distinctiveness is generated and is not generated.
- (2) Issue 2: Regarding the claim of the plaintiff that the trademark in the application can be recognized as a compound noun with a specific meaning other than simple combination of the dictionary meanings of each component
- A. For example, there are many registered trademarks consisting of a “geographical name + place providing services” for the designated services related to certain businesses, such as hotels. The members showed an understanding that this is probably because such a combination is recognized as a trade name and identification of origin.
  - B. On the other hand, the members expressed an opinion when one of the reasons why applications for trademarks including the word “Law Firm” are often rejected, it should be focused on the matter that the name of “Law Firm” is legally required to be attached to the name of the firm related to the practice of law.
- (3) Issue 3: In the appeal decision, the applicability of Article 3(1) is affirmed based on the matter that there are many examples of use of firm names with the same composition as the trademark in the application, but the court found that the presence of the examples of use does not become a necessary fact made on the premise for judging whether there is a function to identify the origin of the services provided by the applicant and other services. Regarding this point, the members discussed the appeal decision and the court decision from the viewpoint of comparison.
- A. Regarding the positioning of the above examples of use in determination of applicability of Article 3(1) of the Trademark Act, the position of the court decision is basically upheld.

- B. Regarding the presentation of an example of use that does not have the same composition as the trademark in the application at the stage of an examination or a trial/appeal, the members are of the opinion that this matter is questionable, while others affirmed this matter.
- (4) Issue 4: According to the Examination Guidelines, the trademark “Patent Professional Corporation Roppongi Patent Firm” does not fall under Article 3(1)(iv) unless there is another identical trademark. The members discussed as to how this point should be considered in comparison with the conclusion of the appeal decision and court decision
- A. Even if the trademark does not fall under Article 3(1)(iv) of the Trademark Act, the applicability of Article 3(1)(vi) will continue to be an issue, but the members recognized that the addition of the name of the company type implies an identification of the business entity, and this would be a major factor in determining the distinctiveness.
- B. If the trademark falls under Article 3(1)(iv) of the Trademark Act, there is possibility for obtaining the distinctiveness according to Article 3(2), but whether the trademark satisfies exclusive adaptability will be an issue. There is also an opinion that this would make a significant difference from the case of the judgment on the (iv).
- (5) Issue 5: Appeal and court decisions in the past concerning the trademarks having a composition similar to the trademark in the application are examined, and the following opinions are given.
- A. There are cases that Article 3(1)(iv) and (vi) are confused when determination.
- B. It seems that there are cases where it is determined that trademarks have no exclusive applicability even if they are actually adopted and used as an identification of origin.
- C. The exclusive adaptability does not require actual demand, and it is considered sufficient if there is a possibility of future demand.
- D. There are appeal decisions applying Article 3(1)(iii) and applying Article 3(1)(vi), but it seems that there is no practical inconvenience whichever is applied.
- E. The exclusive applicability should be determined by considering changes in future situations, not by whether there is a fact of use at the time of the

appeal decision.

- F. From the viewpoint of the court, it is often considered from the perspective of what kind of inconvenience may be suffered by infringement when the holder of trademark right files an infringement suit. In that case, there is a view that the scope of rights may vary depending on the designated goods and services, whereas a view that variation of the scope of rights should not be considered, and these opinions are inconsistent also in court decisions.

# **Trial and Appeal Practitioner Study Group REPORT 2022 (Summary)**

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