Trial and Appeal Practitioner Study Group

REPORT 2025

(Summary)

JPO JAPAN PATENT OFFICE

Trial and Appeal Department (TAD)
Japan Patent Office

Trial and Appeal Practitioner Study Group

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Preface

The panel for trial and appeal of the Japan Patent Office (JPO) examines the soundness of examination results and the validity of rights for patents, utility models, designs and trademarks, and renders final determinations in the form of trial and appeal decisions as an administrative agency. In addition, the Intellectual Property High Court examines the propriety of trial and appeal decisions and renders court decisions. In order for the panel for trial and appeal of the JPO to conduct more appropriate trial and appeal examinations, it is important to discuss actual trial and appeal decisions and court decisions, aim to objectify or clarify the criteria for determination, and apply the results to future trial and appeal practices. Furthermore, it will be possible to enhance the predictability of trials and appeals by widely disseminating the results and by sharing an understanding of trial and appeal practices with users of the trial and appeal system.

Based on this understanding, since 2006, the Trial and Appeal Department of the JPO has been holding the "Trial and Appeal Practitioner Study Group" (originally named the "Case Studies on Inventive Step"), where corporate intellectual property representatives, patent attorneys, attorneys, as well as chief administrative judges and administrative judges of the JPO come together to study trial and appeal decisions and court decisions. Additionally, since 2016, this Study Group has been further enriched by the participation of judges from the Intellectual Property High Court and the Tokyo District Court as observers.

Trial court of the JPO

The participants of this year's Study Group discussed general issues in five fields: measurement methods and clarity requirement; determination of inventive step in light of common general knowledge, etc.; support requirement; interpretation and clarification of terms used in the claims; and subsequent grounds for invalidation under Trademark Act Article 4(1)(vii) (Trademark Act Article 46(1)(vi)), as well as one individual case in each field. In particular, when it comes to general issues in the patent field, we have focused on the "common general knowledge of a person skilled in the art".

This report summarizes the results of a lively discussion on the above issues (themes) and cases from the different viewpoints of corporate intellectual property representatives, patent attorneys, attorneys, administrative judges and judges, examining the important issues and points of contention in practice from a variety of perspectives. In addition, an English translation of the summary of this report is to be published, thereby facilitating the wider dissemination of the Study Group's results overseas. We sincerely hope that this report will be useful not only to the administrative judges, but also to the examiners of the JPO in making their determinations, and that it will further serve the users of the trial and appeal system both in Japan and overseas. Through these efforts, we hope to foster a deeper understanding of Japan's trial and appeal practices among system users both domestically and internationally, and to further enhance confidence in Japan's intellectual property system.

Finally, we would like to express our deepest 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 cooperation in organizing the Study Group, as well as to the members and observers who participated in and discussed the issues in the Study Group.

March 2026

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

Contents

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 five groups (Patent - Machinery 1, Patent - Machinery 2, Patent - Chemistry, 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 has selected one theme and one case for examination (the details are shown in the following pages).

Study 1 (one theme) was selected based on a general topic (measurement methods and clarity requirement; determination of inventive step in light of common general knowledge, etc.; support requirement; interpretation and clarification of terms used in the claims; and subsequent grounds for invalidation under Trademark Act Article 4(1)(vii) (Trademark Act Article 46(1)(vi)) considered important for the trial and appeal practices by reference to the point at issue in the recent trial/appeal decisions or court decisions.

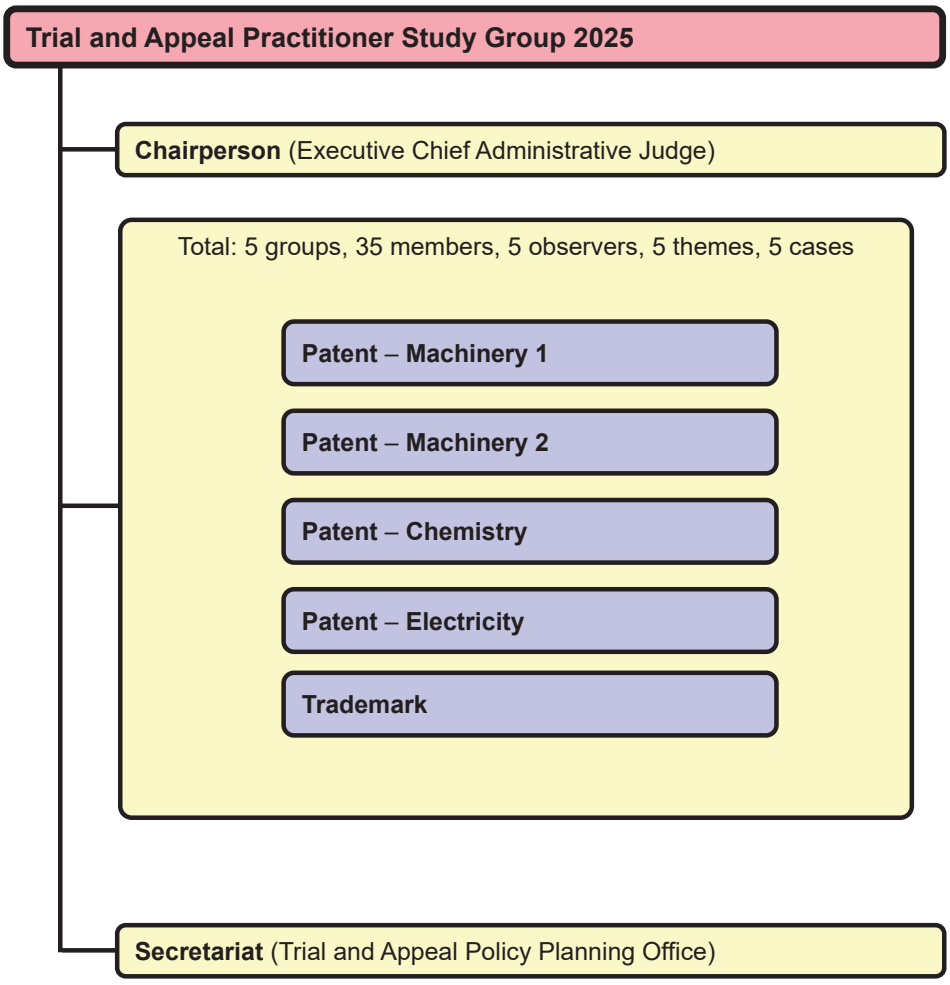
Study 2 (one case) was selected from cases considered important for trial and appeal practices among those that met the following two criteria: (1) cases for an appeal against examiner's decision of refusal, a trial for invalidation, a trial for rescission of registered trademark not in use, an opposition 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.

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, description of the specification, etc., evidence submitted, allegations made by the parties, previous court decisions, the members' own experience.



Organization chart of the Trial and Appeal Practitioner Study Group

Study 1 (general issue)

Field	No.	Topic	Point at Issue
Patent - Machinery 1	1	Measurement methods and the clarity requirement	Issue 1: What should be described in a specification to avoid a finding that a measurement method is unclear? Issue 2: What information, though not described in a specification, should be taken into consideration when understanding a measurement method? Issue 3: To what extent must a measurement method be clear for the clarity requirement to be satisfied?
Patent - Machinery 2	2	Determination of inventive step in light of common general knowledge, etc.	Issue 1: The meanings of "common general knowledge" and "well-known art" in the determination of inventive step, and the background for discussing common general knowledge, etc. Issue 2: How should common general knowledge, etc., be found? Issue 3: In light of common general knowledge, etc., how should the Different Feature be determined? Issue 4: Points to note when the trial panel finds common general knowledge, etc., ex officio.
Patent - Chemistry	3	Support requirement	Issue 1: When the specification does not contain sufficient examples covering the claim scope of the invention at issue, what matters are important to consider in determining whether the support requirement is satisfied? Issue 2: Where is the dividing line at which the support requirement is not satisfied even in light of common general knowledge, etc.?

Patent - Electricity	4	Interpretation and clarification of terms used in the claims	Issue 1: The reasonable interpretation of claim terms in light of the specification Issue 2: Points to note that appear to affect the reasonable interpretation of claim terms in light of the specification Issue 3: Cases in which a claim term could have numerous possible interpretations
Trademark	5	Subsequent grounds for invalidation under Trademark Act Article 4(1)(vii) (Trademark Act Article 46(1)(vi))	Issue 1: Regarding the second category (cases where use of the trademark is likely to be contrary to the public interests, etc.) Issue 2: Regarding the fifth category (cases where the filing background of the application of the trademark registration lacks social appropriateness) Issue 3: Other categories in which a trademark registration subsequently comes to violate public order and morality

Study 2 (individual case)

Field	No.	Title of the Invention/ Trademark in the Application	Trial Number (Trial/ Appeal Decision)	Date of Trial/ Appeal Decision	Conclusion of Trial/Appeal Decision	Major Issue
			Case Number (Court Decision)	Date of Court Decision	Main Text of Court Decision	
Patent-Machinery 1	1	Electroformed tube manufacturing method and electroformed tube	Invalidation No. 2019-800099	Oct. 18, 2021	Trial decision to maintain the patent	Patent Act Article 36(6)(ii) (Clarity requirement)
			2021 (Gyo-Ke) 10140	Nov. 16, 2022	Partial revocation of the trial decision	
Patent-Machinery 2	2	Method for manufacturing magnetic pole housing, magnetic pole housing for electric motor, and electric motor	Appeal No. 2021-010198	Oct. 3, 2022	Appeal decision to maintain the examiner's decision of refusal	Patent Act Article 29(2) (Inventive step)
			2023 (Gyo-Ke) 10013	Dec.26, 2023	Dismissal of the request	
Patent-Chemistry	3	Moisture control device, moisture control method, program, storage medium, generated substance, product, device, and equipment	Appeal No. 2021-005843	Jan. 6, 2022	Appeal decision to maintain the examiner's decision of refusal	Patent Act Article 29(2) (Inventive step)
			2022 (Gyo-Ke) 10052	Feb. 16, 2023	Dismissal of the request	

Patent-Electricity	4	Optical information reader	Invalidation No. 2017-800019	Jan. 31, 2018	Trial decision to maintain the patent	Patent Act Article 36(6)(ii) (Clarity requirement)
			2018 (Gyo-Ke) 10080	Jan. 24, 2019	Dismissal of the demand	
Trademark	5	Heaven (standard characters)	Appeal No. 2021-15267	Jul. 14, 2022	Appeal decision to maintain the examiner's decision of refusal	Trademark Act Article 4 (1)(xi) (Determination of similarity of designated goods/ services)
			2022 (Gyo-Ke) 10090	Jan. 31, 2023	Dismissal of the request	

Study 1

Theme 1: Patent - Machinery 1

Topic	Measurement methods and clarity requirement
Issues	Issue 1 : What should be described in a specification to avoid a finding that a measurement method is unclear?
	Issue 2 : What information, though not described in a specification, should be taken into consideration when understanding a measurement method?
	Issue 3 : To what extent must a measurement method be clear for the clarity requirement to be satisfied?
Major JPO/ Court Decisions for Reference	• Court Decision (1): IP High Court Case No. 2022 (Gyo-Ke) 10029, Mar. 27, 2023 "Anti-glare film" Case (Opposition No. 2021-700030) • Court Decision (2): IP High Court Case No. 2022 (Gyo-Ke) 10109, Nov. 30, 2023 "Anti-glare film" Case (Opposition No. 2021-700209) • Court Decision (3): IP High Court Case No. 2011 (Gyo-Ke) 10418, Dec. 25, 2012 "Anti-glare film" Case (Invalidation No. 2010-800032) • Court Decision (4): IP High Court Case No. 2024 (Gyo-Ke) 10026, Dec. 25, 2024 "Laminate-type polyvinyl chloride-based tile with inorganic protective coating, and coating method therefor" Case (Invalidation No. 2022-800064) • Court Decision (5): IP High Court Case No. 2016 (Gyo-Ke) 10187, Aug. 30, 2017 "Reversibly thermochromic water-based ink composition for writing utensil and writing utensil containing the same" Case (Invalidation No. 2014-800168)

Issues and discussion results

(1) Issue 1 : What should be described in a specification to avoid a finding that a measurement method is unclear?

In determining the clarity requirement, not only the claim language at issue but also the corresponding description in the specification may be taken into consideration,[1] and this applies not only to measurement methods. Where matters specifying an invention defined in the claims are defined by numerical values, the members of the Study Group (hereinafter referred to as "Members") expressed the

1 IP High Court Case No. 2009 (Gyo-Ke) 10434, Aug. 31, 2010, etc.

view - without objection - that the specification should, to the extent possible, explicitly set forth a measurement method and measurement conditions for determining such numerical values to an extent understandable by a person skilled in the art, and define terms as necessary.

Some Members pointed out that, from the standpoint of the scope of rights,[2] it is preferable to describe a measurement method in as much detail as possible in the specification.

On the other hand, some Members pointed out that if the measurement method contains elements equivalent to know-how, providing detailed disclosure of the measurement method in the specification may pose disadvantages. Other Members pointed out the usefulness of describing, in the specification, the technical significance of measurement values obtained by a measurement method (i.e., the technical significance of the numerical limitations).

In addition, other issues were discussed such as problems arising when the measuring apparatus described in the specification is no longer manufactured or becomes obsolete after filing.

(2) Issue 2 : What information, though not described in a specification, should be taken into consideration when understanding a measurement method?

In assessing the clarity requirement, the assessment is based not only on the specification at issue but also on common general knowledge at the time of filing. Some Members expressed the view that the following should be considered when understanding the measurement method, even if these materials are not described in the specification: (a) general technical literature that can serve as evidence of the common general knowledge at the time of filing, (b) standard specifications related to measurement methods, and (c) matters ordinarily taken into consideration in the industry when determining generally used measurement methods and conditions.

The Members also discussed what allegations and evidence are necessary for

2 With respect to numerical values described in the claims, where the measurement method is not uniquely specified in the specification, etc., there are multiple court decisions ruling that "unless the numerical value described in the claims is satisfied when measured by any conventionally known method, there is no patent infringement" (Tokyo District Court Case No. 2002 (Wa) 4251, Jun. 17, 2003, among others). Accordingly, in patent infringement litigation, it may be inferred that the scope of rights is construed narrowly if the measurement method is not specified in detail.

information not described in a specification to be taken into consideration.

(3) Issue 3 : To what extent must a measurement method be clear for the clarity requirement to be satisfied?

For a numerical range specified in the claims to be regarded as clear, it is essential that measurement values remain stable when measured using a method based on the claim language, the description in the specification, and the common general knowledge at the time of filing. When the measurement method is fixed, the measurement value is fixed as well and the claim is clear. Where the measurement method is not fixed and multiple reasonable measurement methods can be presumed, it is considered necessary that, even if the measurement methods differ, the measurement values still fall within a certain range.

In addition, regarding variation in measured values, some Members pointed out that, depending on the chosen measurement method and conditions, the measured values may fluctuate, causing the measured object to fall within or outside the scope of rights, thereby rendering the outer bounds of the technical scope of the invention unclear. In response, given that variation in measured values is inherent, other Members pointed out that making an unduly strict finding under the clarity requirement on the basis of variation attributable to an unspecified measurement method or similar factors would be unfair to the applicant (patent holder). They also noted that there may be a value-judgment question as to whether it is appropriate to invalidate the patent in its entirety merely because some uncertainty exists at the outer bounds of the technical scope of the invention. Thus, while the Members expressed a range of views on what degree of variation should be tolerated, there was no disagreement that a finding of lack of clarity should be made where the measured values vary to an extreme degree.

Some Members also pointed out that variation in measurement results arising when multiple reasonable measurement methods can be assumed should be distinguished from unavoidable measurement error.

In addition, the relationship between the clarity requirement and the literal infringement analysis in infringement litigation was discussed.[3] On the one hand, some Members pointed out that, when the literal infringement analysis would

3 See note 2 above.

ultimately lead to a finding of non-infringement, there is no need to assess the clarity requirement strictly. On the other hand, some other Members opined that, when the measurement method or measurement conditions are unclear, this would needlessly increase the monitoring burden on third parties, and therefore compliance with the clarity requirement should be determined before conducting the literal infringement analysis.

Theme 2: Patent - Machinery 2

Topic	Determination of inventive step in light of common general knowledge, etc.
Issues	Issue 1: The meanings of "common general knowledge" and "well-known art" in the determination of inventive step, and the background for discussing common general knowledge, etc.
	Issue 2: How should common general knowledge, etc., be found?
	Issue 3: In light of common general knowledge, etc., how should the Different Feature be determined?
	Issue 4: Points to note when the trial panel finds common general knowledge, etc., ex officio.
Major JPO/ Court Decisions for Reference	• Case (1): IP High Court Case No. 2024 (Gyo-Ke) 10002, May 23, 2024 "Non-woven fabric for civil engineering work and its manufacturing method" Case (Invalidation No. 2022-800065) • Case (2): IP High Court Case No. 2023 (Gyo-Ke) 10061, Jun. 24, 2024 "Combustor and boiler" Case (Opposition No. 2021-700789) • Case (3): IP High Court Case No. 2024 (Gyo-Ke) 10049, Mar. 24, 2025 "Vehicle" Case (Appeal No. 2023-005963) • Case (4): IP High Court Case No. 2024 (Gyo-Ke) 10037, Feb. 20, 2025 "Wood composite material and flooring material" Case (Opposition No. 2022-701134) • Case (5): IP High Court Case No. 2023 (Gyo-Ke) 10103, Jul. 18, 2024 "Optical ferrules and optical ferrule molds" Case (Appeal No. 2021-013694) • Case (6): IP High Court Case No. 2022 (Gyo-Ke) 10110, Mar. 18, 2024 "Steel pipe sheet pile quay wall and its design method" Case (Invalidation No. 2021-800023)

Issues and discussion results

(1) Categorization of common general knowledge, etc., and usage contexts

Based on Cases (1) to (6), the manner in which common general knowledge is utilized in the process of determining inventive steps has been organized into the following four categories.

Table 1 (Classification Table): How common general knowledge, etc., is utilized at each stage in the inventive step determination process

Category	Context	Use in each case
1	Finding the present invention	Case (5): Interpretation of a technical term ("parting line burr") [Finding: Yes] [4]
2	Finding the cited invention	Case (1): Finding the configuration (needle-punched non-woven fabric) [Finding: Yes] Case (3): Finding the configuration (vehicle equipped with an accelerator pedal) [Finding: Yes] Case (5): Finding the configuration (presence and position of a burr-like line) [Finding: Yes]
3	Determination of the Different Features by applying the secondary citation	Case (2): Well-known inherent problem (reducing carbon dioxide emissions) [Finding: Yes]; well-known solution (use of ammonia as a heat source) [Finding: Yes] → Motivation to apply the secondary citation based on commonality of the problem and the solution [Inventive step: No] [5]
4	Determination of the Different Features without the secondary citation	Case (1): Adding in an amount corresponding to the effect [Finding: Yes]; various product concentration (mixing ratio) [Finding: Yes]; difficulty of specification change (obstructive factors (teaching away)) [Finding: No] → Falls within a matter of design choice [Inventive step: No] Case (3): Well-known art that hybrid vehicles include lean vehicles [Finding: Yes]; commonality of the problems between lean vehicles and the cited invention [Finding: No] → Not a matter of design choice [Inventive step: Yes]

4 [Finding: Yes]: Means that, in the court decision, the common general knowledge, etc. set forth on the left was found. [Finding: No]: Means that, in the court decision, the technical common knowledge, etc. set forth on the left was not found.

5 [Inventive step: Yes]: Means that, in the court decision, the inventive step was affirmed. [Inventive step: No]: Means that, in the court decision, the inventive step was denied.

		Case (4): Qualitative relationships between a wood-based board's homogeneity, strength, etc., related to Different Feature 2 (thickness, length, width) [Finding: Yes]; from multiple pieces of evidence, the thickness/length/width values fall within a certain range [Finding: Yes] → Falls within a matter of design choice [Inventive step: No] Case (6): Relationships among parameters in a known relational equation [Finding: Yes]; existence of a self-evident premise regarding the yield strength of steel (use JIS-standard steel) [Finding: Yes] → No motivation to use steel having yield strength not less than JIS-standard steel [Finding: No] → Deriving the formula representing rho (ρ) is not a matter of design choice [Inventive step: Yes]

(2) Relationship between common general knowledge, etc., and tacit knowledge

In cases where the technical content is explicitly documented, it is relatively easy to later prove common general knowledge. However, in the mechanical field, technical content often remains as tacit knowledge without being documented in patents, academic papers, etc., and it has been pointed out that proving such tacit knowledge is difficult.

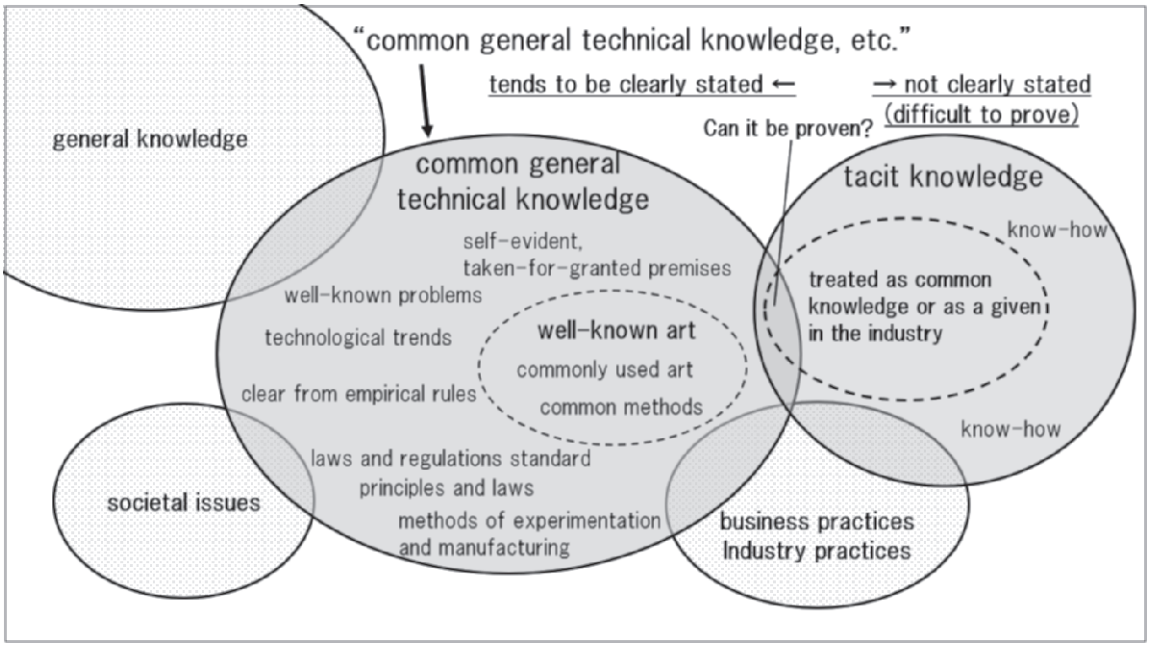


Fig. 1 Relationship between common general knowledge, etc., and tacit knowledge

(3) Outcomes of the present discussions

Through the present discussions, it became clear that common general knowledge, etc., not only serves as a basis for inferring motivation but also has diverse functions and is utilized in diverse ways. In light of this, the matters considered and organized are listed below. Note that Fig. 2 and Tables 2 to 4 are included in the main body of the report from this study group.

(1) Categorization of usage contexts for common general knowledge, etc., in the determination of inventive step (Categories 1 to 4 in Table 1)

(2) Examples of the positioning of common general knowledge, etc., in the determination of inventive step, based on case-based examples of proof using common general knowledge, etc. (Steps A to E in Fig. 2 and Table 3)

(3) Examples of laws and regulations, standards, and societal demands, which may be found as common general knowledge, etc., in each category (Tables 2 and 4)

(4) Meanings of common general knowledge and well-known art, and their relationship with tacit knowledge (Issue 1, Fig. 1)

(5) Examples of finding common general knowledge, etc., in each category (Issue 2)

(6) Points to note and proof in determining the Different Features in light of common general knowledge, etc. (Issue 3)

(7) Points to note when finding common general knowledge, etc., ex officio (Issue 4)

We hope that this report will contribute to a better understanding and organization of common general knowledge, etc.

Theme 3: Patent - Chemistry

Topic	Support requirement
Issues	Issue 1: When the specification does not contain sufficient examples covering the claim scope of the invention at issue, what matters are important to consider in determining whether the support requirement is satisfied?
	Issue 2: Where is the dividing line at which the support requirement is not satisfied even in light of common general knowledge, etc.?
Major JPO/ Court Decisions for Reference	• Court Decision (1): IP High Court Case No. 2022 (Gyo-Ke) 10059, Jun. 15, 2023 "Glass and glass material for press molding" Case (Invalidation No. 2020-800117) • Court Decision (2): IP High Court Case No. 2016 (Gyo-Ke) 10189, Oct. 25, 2017 "Optical glass" Case (Appeal No. 2015-008434) • Court Decision (3): IP High Court Case No. 2023 (Gyo-Ke) 10019, Aug. 7, 2024 "Method for treating atopic dermatitis" Case (Invalidation No. 2021-800003) • Court Decision (4): IP High Court Case No. 2015 (Gyo-Ke) 10099, Jul. 19, 2016 "White polyester film (JP) (Polyester composition and molded item produced therefrom (EN))" Case (Invalidation No. 2012-800177) • Court Decision (5): IP High Court Case No. 2016 (Gyo-Ke) 10064, Jun. 29, 2017 "Polyvinyl alcohol polymer film" Case (Invalidation No. 2015-800090) • Court Decision (6): IP High Court Case No. 2016 (Gyo-Ke) 10269, Aug. 8, 2017 "Sweetener composition containing highly purified monk fruit glycosides" Case (Invalidation No. 2015-800185) • Court Decision (7): IP High Court Case No. 2014 (Gyo-Ke) 10155, Oct. 19, 2016 "Reduced-sodium soy sauce" Case (Invalidation No. 2013-800113)

Issues and discussion results

(1) Issue 1: When the specification does not contain sufficient examples covering the claim scope of the invention at issue, what matters are important to consider in determining whether the support requirement is satisfied?

A. Organization of the Court Decisions

First, with respect to Court Decisions (1) to (7), the matters related to the determination of the support requirement addressed in the court decisions were classified and organized from viewpoints such as the relationship between the claims and the examples (whether the claim elements are a generic concept relative to the examples, or whether the elements define numerical ranges), and this organization was used as the premise for the discussion.

B. Points of focus in determining whether the support requirement is satisfied

Based on Court Decisions (1) to (7), we organized the matters that generally appear to be of focus in determining the support requirement and extracted the following three: (a) Logic that leads to recognizing a problem resolution. (In Court Decision (3), the court held that, in determining the support requirement, there are broadly two types of logic: "inferences deductively derived" from the specification and common general knowledge, and "cases inductively derived from a wide range of examples"), (b) the "mechanism" and the "technical relationship between the constituent elements of the invention and the problem/effect" (collectively, "technical relationship/mechanism"), and (c) the relationship between the claims and the examples (whether the claim elements are a generic concept relative to the examples, or whether the elements define numerical ranges). With respect to (c), there was broad agreement that, for determining satisfaction of the support requirement, there are cases where it suffices to understand the technical relationship/mechanism and cases where "clues" including indications as to the "degree/extent" are required, and they roughly correspond to whether the claim elements are a generic concept relative to the examples or define numerical ranges; and that where the relationship is one of "numerical ranges," indications as to the "degree/extent" are likely required. However, caution is required for this general categorization.

C. Differences in determining the support requirement by technical field

We also discussed whether differences in specific technical fields appear to lead to differences in determining the support requirement. The discussion indicated that: (a) as perspectives for the technical fields where differences determination seem

likely, (i) whether the technical relationship/mechanism is relatively physics-oriented or chemistry-oriented, and (ii) techniques for evaluating effects (quantitativeness, objectivity), were cited; and (b) regarding Court Decisions (1) and (2) (both inventions concerning glass compositions), an opinion was expressed that these are special, case-specific determinations and that generalization is difficult.

(2) Issue 2: Where is the dividing line at which the support requirement is not satisfied even in light of common general knowledge, etc.?

A. Approach to determining whether the support requirement is satisfied according to the logic by which recognition of problem resolution is derived

First, (a) in the case of deductive logic, if the recognition of problem resolution can be fully explained by deductive reasoning, there was broad agreement that support by examples may be minimal - for example, it may suffice to provide a single data point at the condition least favorable to exhibiting the effect. In addition, (b) where the mechanism of action of the claim elements is not clear and the recognition of problem resolution is derived inductively, there was broad agreement that, commensurate with the claim scope, examples are required that comprehensively cover the types and numerical values of constituent elements.

B. Required explanations

First, (a) regarding the technical relationship/mechanism, the prevailing view was that, as a general matter, it often suffices for determining satisfaction of the support requirement if the specification describes the purpose for setting the constituent elements and the effect on physical properties, etc. when adjusting the numerical values of the constituent elements. In addition, (b) regarding the number of examples, in cases of inductive logic, there was broad agreement that it is sufficient for the specification to include a variety and number of examples adequate to explain the correlation.

C. Supplementation by common general knowledge

We are generally of the same opinion that deductive explanations can be supplemented by common general knowledge (to satisfy the support requirement). Although supplementation may also be possible even where the logic is not deductive, it was also opined that, if the constituent elements are essential to problem resolution, it is difficult to prove them solely on the basis of common general knowledge. In addition, points to note were raised regarding the submission of evidence when

asserting common general knowledge.

(3) Finally

The approach presented in this report by focusing on whether the logic is deductive or inductive was recognized by the participants of this study group as being broadly applicable beyond the technical fields to which the inventions at issue in Court Decisions (1) to (7) belong. We hope that the discussions of this study group will help lead to highly objective and persuasive determinations, and statements of reasons, in line with the normative criteria of the support requirement.

Theme 4: Patent - Electricity

Topic	Interpretation and clarification of terms used in the claims
Issues	Issue 1: Reasonable interpretation of claim terms in light of the specification
	Issue 2: Points to note that appear to affect the reasonable interpretation of claim terms in light of the specification
	Issue 3: Cases in which a claim term could have innumerable possible interpretations
Major JPO/ Court Decisions for Reference	• Court Decision (1): IP High Court Case No. 2021 (Gyo-Ke) 10070, Jun. 28, 2022 "System and method for providing massage-related services" Case (Invalidation No. 2020-800056) • Court Decision (2): IP High Court Case No. 2024 (Gyo-Ke) 10023, Nov. 13, 2024 "Information processing terminal" Case (Appeal No. 2023-11666) • Court Decision (3): IP High Court Case No. 2017 (Gyo-Ke) 10133, Oct. 24, 2018 "Tape drive and recording medium" Case (Invalidation No. 2016-800069) • Court Decision (4): IP High Court Case No. 2006 (Gyo-Ke) 10420, May 10, 2007 "Self-optimizing detergent controller" Case (Appeal No. 2003-19708)

Issues and discussion results

(1) Issue 1: Reasonable interpretation of claim terms in light of the speci-fication

Court Decisions (1) and (2) are both cases in which the interpretation of claim terms was contested under the clarity requirement and can be regarded as cases where doubts could arise regarding the interpretation of the terms.

However, in both Court Decisions, the members of the Study Group (hereinafter referred to as "Members") reached consensus that the terms at issue could be interpreted in accordance with the claim language and were not terms for which interpretive doubts could arise. Accordingly, they discussed the background that led to the consensus.

What is common to Court Decisions (1) and (2) in interpreting claim terms is that, rather than extracting a claim term in isolation and considering its meaning, the interpretation of the claim terms is carried out by examining - consciously or unconsciously in light of the specification - whether the interpretation is acceptable as one made in light of the specification. In other words, as one example of practitioners' approach to term interpretation, the interpretation of a potentially disputed term is

carried out by examining whether it falls within the scope of a reasonable interpretation of the claim term in light of the specification.

(2) Issue 2: Points to note that appear to affect the reasonable interpretation of claim terms in light of the specification as described in (1) above

In discussing points to note that appear to affect the reasonable interpretation of claim terms, the following were derived from Court Decisions (1) to (3): (a) consideration of matters that have no reference in the specification; (b) consideration of the descriptions of the examples in the specification; (c) consistent and differentiated usage in the specification of the terms used in the claims; and (d) treatment of terms in the specification that are conjoined with "and" or "or" in the claims.

Beyond the Court Decisions, based on practitioners' experience, the Members discussed practical points to heed from the standpoint of factors thought to affect the reasonable interpretation of claim terms, and organized them from the following viewpoints: (a) choices in devising the wording of claim terms themselves; (b) definitions of terms; (c) description of the problem to be solved and the effects; (d) correspondence between the claim language and the examples; (e) prosecution history; (f) ordinary meaning and common general knowledge; and (g) the premises assumed when interpreting the claim terms.

(3) Issue 3: Cases in which a claim term could have innumerable possible interpretations

To obtain points to note for clarifying terms, the Members discussed Court Decision (4), in which clarity was at issue for a generally used term whose meaning in the claim was not defined.

With respect to Court Decision (4), they reached consensus that the holding on the clarity requirement regarding the interpretation of the claim term at issue, "system parameter," was reasonable. They further reached consensus that it might be difficult for the Court to affirmatively conclude that the term is clear based on reasoning derived from the specification and related materials. Although they did not actively endorse the holding, they did not oppose it because the claim term at issue—despite being a generally used term—was not so unclear as to impose an unexpected disadvantage on third parties. However, including the fact that the claim term was

not defined, they reached consensus that, particularly from the standpoint of third parties, the description in the specification could not be said to be sufficient.

Accordingly, they examined cases in which a claim term, as a generally used term, could have innumerable interpretations but cannot be assessed as unclear from the standpoint of the clarity requirement, and organized the opinions raised regarding points to note from the perspective of third parties.

(4) Summary of Discussion

When the interpretation of terms becomes a point of dispute from the standpoint of identifying the gist of the invention or under the clarity requirement, determinations tend to be tailored to the individual case. In addition, issues over term interpretation often arise, in the course of examination, trial/appeal, and court proceedings, from comparisons with publicly known technology that could not have been anticipated at the time of filing, or become apparent when, from the standpoint of a third party, attempting to grasp the outer bounds of another party's scope of rights. Furthermore, when drafting a specification intended for filing in foreign jurisdictions, an applicant should not prepare a specification that focuses solely on clarifying claim terms examined in Japan since it should be ready for translation into foreign languages. Accordingly, it is difficult to obtain a generally applicable answer for clarifying the interpretation of claim terms.

Nevertheless, the Court Decisions cited herein garnered consensus among practitioners that the Court's holdings on the interpretation of the terms were appropriate, and the cases serve as useful references for practitioners when interpreting terms.

The insights obtained herein are considered beneficial for those engaged in examination, trial/appeal, and litigation practice, as such findings provide practitioners' perspectives when interpreting and clarifying the terms used in claims.

Theme 5: Trademark

Topic	Subsequent grounds for invalidation under Trademark Act Article 4(1)(vii)
Issues	Issue 1: Regarding the second category (cases where use of the trademark is likely to be contrary to the public interests, etc.)
	Issue 2: Regarding the fifth category (cases where the filing background of the application of the trademark registration lacks social appropriateness)
	Issue 3: Other categories in which a trademark registration subsequently comes to violate public order and morality
Major JPO/ Court Decisions for Reference	• Court Decision (1): IP High Court Case No. 2005 (Gyo-Ke) 10349, Sep. 20, 2006 "Anne of Green Gables" Case (Invalidation No. 2003-35094) • Court Decision (2): IP High Court Case No. 2007 (Gyo-Ke) 10391, Jun. 26, 2008 "CONMER" Case • Court Decision (3): IP High Court Case No. 2012 (Gyo-Ke) 10273, Feb. 6, 2013 "Suken" Case (Invalidation No. 2011-890088) • Court Decision (4): IP High Court Case No. 2012 (Gyo-Ke) 10064, Nov. 15, 2012 "The Japan Kanji Aptitude Testing Foundation" Case (Invalidation No. 2010-890022) • Court Decision (5): IP High Court Case Nos. 2023 (Gyo-Ke) 10128–10130, etc., Aug. 8, 2024 "Mark Gonzales" Case (Invalidation No. 2022-890042, etc.) • Court Decision (6): IP High Court Case No. 2024 (Gyo-Ke) 10079, Feb. 5, 2025 "LEADER" Case (Invalidation No. 2022-890061) • Court Decision (7): IP High Court Case No. 2015 (Gyo-Ke) 10022, Aug. 3, 2015 "Noraya" Case (Invalidation No. 2014-890015) • Court Decision (8): IP High Court Case No. 2023 (Gyo-Ke) 10112, Mar. 14, 2024 "haqihana" Case • Trial Decision (9): Invalidation No. 2022-890065 (Trial decision to invalidate the patent, July 12, 2023) "Yukkuri Chabangeki" Case

Issues and discussion results

(1) On applicability of the second and fifth categories under Trademark Act Article 4(1)(vii)

Court precedents (the "Anne of Green Gables" Case), the Examination Guidelines for Trademarks (prepared by JPO), etc., identify five categories of trademarks that fall under Trademark Act Article 4(1)(vii). Among these, with respect to the applicability of subsequent grounds for invalidation (Article 46(1)(vi)) concerning the second category (cases where use of the trademark is likely to contrary to the public interest, etc.) and the fifth category (cases where the filing background of the application of the trademark registration lacks social appropriateness), a small but growing body of relevant court decisions, etc., has begun to accumulate in recent years. Accordingly, for the purpose of serving as a reference for future examination and trial/appeal practice and enhancing predictability for users, we examined the applicability of Article 4(1)(vii) for these two categories (particularly the applicability of subsequent grounds for invalidation).

In this examination, first, for both the second and fifth categories, the prevailing view was that the application of these categories should be conducted with caution on the premise of the approach set forth in the holding in the "CONMER" Case - namely, that expanding the scope of that item (vii) into the private sphere to exclude trademark applications would significantly impair predictability and legal stability regarding eligibility for trademark registration, and therefore is not permissible except in exceptional cases with special circumstances.

Building on that, it was recognized that the scope within which one can address trademark applications exhibiting some egregiousness or malicious nature (the "special circumstances" per the holding in the "CONMER" Case cited above) and subsequent grounds for invalidation is limited. Within that limited scope, multiple concrete cases (examples) were presented and examined as to, in what specific situations (or upon satisfaction of what requirements), Article 4(1)(vii) would apply under the second category or the fifth category.

Specifically, the following factors were identified: whether the matter has a broad social impact beyond the parties involved; whether the dispute is of a nature that should be left to civil litigation; whether the general elements of the dispute, without considering the particular facts of the dispute, would be contrary to the public interest or general moral values; and whether the right holder is issuing

infringement warnings (including harassment), seeking injunctions, or making monetary claims. In addition, another factor was identified: where the manner of use effectively falls under the first category (for example, where a mark consisting of multiple constituent elements, as a whole, would fall under the first category, yet separate trademark registrations are obtained for each constituent element and, at the stage of use, these are combined and used it as one).

(2) On the applicability of subsequent grounds for invalidation under the second and fifth categories

The applicability of the two categories in (1) above and the applicability of subsequent grounds for invalidation overlap in substance, making it difficult to examine these aspects separately. As in (1) above, however, the prevailing view was that application should, in principle, be undertaken cautiously on the premise of the approach set forth in the holding in the "CONMER" Case cited above. The concrete cases in (1) above were taken as benchmarks indicating, for example, that although, in principle, it is difficult to acknowledge subsequent grounds for invalidation under either category, the invalidation grounds should be recognized in such cases. Specifically, in addition to the purpose that the Trademark Act individuates the grounds for unregistrability in each item of Article 4(1), and in view of the gravity that invalidation of a trademark registration also has effects on third parties, even if one takes an affirmative stance toward recognizing subsequent applicability, simply expanding and relaxing the individualized grounds for unregistrability through interpretation of item (vii) should be denied. Rather, a majority held that it is necessary to find some additional egregiousness that is difficult to capture under the individual items (the "special circumstances" per the holding in the "CONMER" Case cited above).

On the other hand, as issues concerning subsequent grounds for invalidation, it was noted that there is little court decision and that identifying and proving such grounds is difficult. A range of opinions was expressed, including the view that, with respect to subsequent grounds for invalidation, for example, the facts of use and the filing background lie on a continuum, making it difficult to distinguish them as matters falling under the second category (use) versus the fifth category (filing background).

Moreover, since subsequent circumstances - including renewal registrations and

transfer registrations - are not the "background to the filing," subsequent applicability to the fifth category cannot be presumed. In view of this as well, the majority opinion was that, in principle, subsequent grounds for invalidation relating to the fifth category are not presumed.

(3) Other categories in which a trademark registration subsequently comes to violate public order and morality

A number of participants expressed the view that, where changes in societal or consumer perceptions subsequently render the trademark itself, or the characters/figures consisting of the mark, contrary to international comity or insulting in expression, or where its use comes to be prohibited by law, while balancing of the freedom to select trademarks and freedom of expression becomes an issue, the case could well constitute subsequent grounds for invalidation. Various other opinions were also examined.

(Reference) Five categories of trademarks that fall under the Trademark Act Article 4(1)(vii), based on the "Anne of Green Gables" Case and other precedent court cases that contributed to the establishment of judicial norms, as well as the Examination Guidelines for Trademarks.

(First category)	Trademarks which are, in composition per se, characters or figures, signs, three-dimensional shapes or colors or any combination thereof, or sounds that are unethical, obscene, discriminative, outrageous, or unpleasant to people.
(Second category)	Trademarks which do not have the composition per se as prescribed in the first category above but are liable to conflict with the public interests of the society or contravene the generally-accepted sense of morality if used for the designated goods or designated services.
(Third category)	Trademarks with their use prohibited by other laws.
(Fourth category)	Trademarks liable to dishonor a specific country or its people or trademarks generally considered contrary to the international faith.
(Fifth category)	Trademarks whose registration is contrary to the order predetermined under the Trademark Act and is utterly unacceptable for lack of social reasonableness in the background to the filing of an application for trademark registration.

Study 2

Case 1: Patent - Machinery 1

Product-by-Process Claims

Trial No.	Invalidation No. 2019-800099 (Patent No. 3889689) (Unsuccessful demand) (Oct. 18, 2021: Trial decision allowing correction and dismissing the demand (first trial decision); partial revocation of the trial decision) (Dec. 18, 2023: Trial decision allowing correction and dismissing the demand (second trial decision); decision on the trial becomes final and binding)
Court Case No. Date of Court Decision	IP High Court Case No. 2021 (Gyo-Ke) 10140 Nov. 16, 2022 (Partial revocation of the trial decision)
Title of the Invention	Electroformed tube manufacturing method and electroformed tube
Main Issue	Patent Act Article 36(6)(ii) (Clarity Requirement)

1. Outline of the case

In this case, the Court reviewed the clarity requirement of the product-by-process claims at issue while applying the "unequivocally clear" standard[6] set forth in prior court decisions.[7] The Court ultimately held that the claims at issue do not meet the clarity requirement because they cannot be regarded as "unequivocally clear" and therefore the Court partially revoked the trial decision.

2. Issues discussed

(1) Issue 1: Clarity requirement for product-by-process claims

First, the members of the Study Group (hereinafter referred to as "Members") discussed the Court's determination that the claims were not "unequivocally clear." Several Members opined that this was appropriate in light of the specification and

6 "If, at the time of filing, it is unequivocally clear from the claims, specification, drawings, and common general knowledge what structure or characteristics are exhibited by the product manufactured by the relevant manufacturing method, the interests of third parties are not unjustly harmed. Therefore, even in the absence of 'impossible or impractical circumstances,' there is no violation of the clarity requirement."

7 IP High Court Case No. 2015 (Gyo-Ke) 10242, Sep. 20, 2016 "Double eyelid forming tape" Case, among others.

prosecution history. On the other hand, some other Members expressed concerns that the Court's decision did not make clear the degree of clarity required under the "unequivocally clear" standard. Specifically, they raised concerns that, if the standard is applied strictly and there are no "impossible or impractical circumstances,"[8] most product-by-process claims would fail to meet the clarity requirement.

Accordingly, the Members discussed the level at which the structure or characteristics can be deemed "unequivocally clear." Some Members opined that the structure or characteristics should be as apparent as in cases where a product is directly defined by its structure or characteristics. Some of the other Members opined that it must be possible to determine that the structure or characteristics differ from those obtained via other manufacturing methods. Conversely, still other Members opined that, considering whether the interests of third parties are unjustly prejudiced, it may suffice that the invention is specified to the extent necessary to address the problem to be solved.

In addition, with respect to the patentee's assertions in this case, some Members expressed the view that, if the patentee did not discuss the "inner surface accuracy" of the electroformed tube in depth, the Court might find no violation of the clarity requirement.

Next, the Members also discussed the "impossible or impractical circumstances," which were acknowledged in the trial decision, but were not specifically addressed in the Court's decision because the patentee admitted that there were no such circumstances at the litigation stage.

In the case of the present invention, some Members opined that there was little basis for asserting the existence of "impossible or impractical circumstances." Moreover, as a general matter, in mechanical inventions, cases in which it is impossible or impractical to directly specify the structure or characteristics of a product are extremely rare, and many Members took the view that such an argument can scarcely be made in practice. On the other hand, some of the other Members took the view that, if the patentee asserted "impossible or impractical

8 The circumstances under which product-by-process claims satisfy the clarity requirement are those indicated in Supreme Court Cases No. 2012 (Ju) 1204 and 2685, both decided on June 5, 2015. Specifically, the term "impossible or impractical circumstances" means any circumstances in which it is impossible or utterly impractical to define the product directly based on its structure or characteristics at the time of the filing of the application.

circumstances," the Court might accept the assertion.

In addition, some Members pointed out the following reasons why the patentee did not assert the existence of "impossible or impractical circumstances." First, in several prior court decisions[9], the Court held that the product-by-process claims in those cases satisfied the clarity requirement under the "unequivocally clear" standard. Second, in this case, the patentee had also obtained a patent for the manufacturing-method invention and had a reasonable prospect of proving that the relevant claim limitations were satisfied in a parallel patent infringement action seeking an injunction and related remedies[10] (hereinafter referred to as the "Related Infringement Litigation").

Furthermore, the Members discussed differences between the prior court decisions in the mechanical field and the present court decision. Some Members opined that the present invention had a peculiarity: the substantive problem to be solved was, among other things, to facilitate manufacturing; the means for solving that problem were embodied in the manufacturing method itself; and it was unclear whether those means were reflected in the finished product.

(2) Issue 2: Other grounds for revocation

Regarding the grounds for revocation other than the clarity requirement, the determinations in the trial decision were upheld, but these grounds were also reviewed for completeness.

Regarding the inventive step, although the distinction from the prior art was only a limitation to a numerical range, many Members agreed with the Court's decision affirming inventive step not only because there was a substantive gap between the numerical ranges, but also because the intended use differed. On the other hand, some Members opined that the present specification does not sufficiently explain the critical significance of the recited numerical range and pointed out that reducing the wall thickness of an electroformed tube is a well-recognized objective.

(3) Issue 3: Related infringement litigation

In view of the fact that the Related Infringement Litigation concerning the same

9 See note 7 above.
10 Tokyo District Court Case No. 2019 (Wa) 17622, Nov. 16, 2022.

patent right was pending in parallel with the present case, the Members organized the chronological relationship between the present case and the Related Infringement Litigation and discussed how infringement litigation before the courts and invalidation trials before the JPO should be handled.

Some Members observed that, in recent years, it has not been uncommon to refrain from filing an invalidation trial unless unavoidable and instead raise only an invalidity defense in patent infringement litigation. The reasons for this practice include potential drawbacks of pursuing invalidation trials, such as (a) in an invalidation trial, it may be difficult to introduce new arguments or evidence because they may be treated as impermissible amendments (e.g., amendments that alter the gist of the case); and (b) multiple opportunities to seek correction of claims (generally, effectively twice), which may allow a request for correction to be filed at an advanced stage of the proceedings, thereby requiring the determination to be revisited and having a non-negligible impact on the litigation.

Case 2 : Patent - Machinery 2

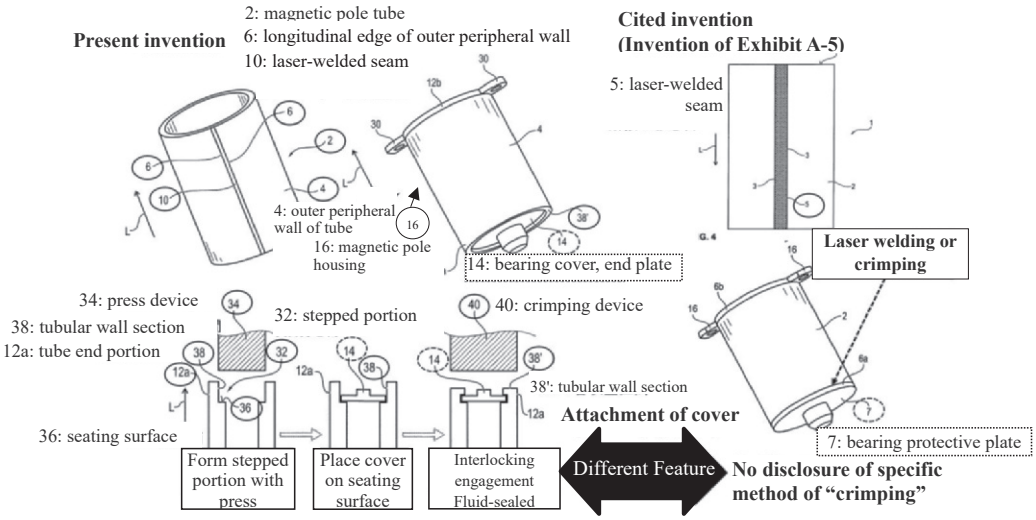
Application of Multiple Well-known Art to the Cited Invention in the Determination of Inventive Step

Trial No.	Appeal No. 2021-010198 (October 3, 2022: Appeal decision to maintain an examiner's decision of refusal; decision on the appeal becomes final and binding)
Case No. Date of Court Decision	IP High Court Case No. 2023 (Gyo-Ke) 10013 Dec. 26, 2023 (Dismissal of the request)
Title of the Invention	Method for manufacturing magnetic pole housing, magnetic pole housing for electric motor, and electric motor
Main Issue	Patent Act Article 29(2) (inventive step)

1. Outline of the case

The appeal decision in the appeal against the decision of refusal for the present application (an international application) found that, by applying two well-known arts (well-known matter 1 and well-known matter 2) to the cited invention (Invention of Exhibit A-5), the claimed invention could have been easily conceived by a person skilled in the art, and the court decision upheld that determination.

The invention of the present application relates to a method for manufacturing the housing (magnetic pole housing) of an electric motor, and the cited invention is the same.



The appeal decision found well-known matter 1 and well-known matter 2 as two well-known arts relating to the Different Feature, and the court decision upheld this. As evidentiary support for well-known matter 2, in addition to Exhibit A-9, Exhibits B-1 and B-2 were added at the litigation stage.

Well-known matter 1	Evidentiary basis: Exhibits A-6, A-7, A-8	When attaching a cover as an end plate to the housing of an electric motor, form, over the entire circumference on the inner wall of the housing, a seating surface for supporting the cover and an annular thin-walled portion extending in the axial direction; place the cover on the **seating surface; deform** the annular thin-walled portion **radially inward** over the entire circumference of the housing; and **crimp** the cover to fix it.
Well-known matter 2	Evidentiary basis: Exhibits A-9, B-1, B-2	When forming a stepped portion at the tube end of a tubular member, use a **press device**.

2. Issues discussed and discussion results

Using this case as a vehicle, we also considered the so-called "extremely easily conceivable," and mainly examined the logic of determining the Different Features by using multiple well-known arts.

There was a consensus that the conclusions of the appeal decision and the court decision—that the present application lacks inventive step—were appropriate. On that basis, we mainly examined the following (1) to (4).

(1) On the finding of well-known matters 1 and 2 in this case and the Different Features determination

With respect to finding well-known matters 1 and 2, many viewed both as common-sense matters, and there was agreement that their finding was appropriate.

As to the Different Features determination, many expressed positive views that the court decision, by showing motivation for applying well-known matters 1 and 2 step by step, provided clearer and more understandable reasoning than the appeal decision, which presented the simultaneous application of well-known matters 1 and 2.

Conversely, some participants noted concern that, in the court decision, well-known matter 2 was applied in light of a problem arising from the application of well-

known matter 1 to the cited invention; even if there is motivation to apply well-known matters 1 and 2, it could appear to fall under "extremely easily conceivable," in which case inventive step would be affirmed, raising concerns about the logic and drafting.

(2) Need for motivation when applying well-known art

As a general matter beyond this case, we examined whether motivation is required for applying well-known art to the cited invention. Opinions were divided among participants. It was confirmed that, in current examination and trial/appeal practice, even for the application of well-known art, motivation is required, as with the application of a secondary cited invention.

(3) Examination of the Different Features determination under the design-choice framework

The appeal decision and the court decision are considered to have adopted the logic of determining the Different Features[1] by applying a secondary cited invention (or well-known matter) that requires motivation, when applying well-known matters 1 and 2.

We also examined whether lack of inventive step for the present application could be shown under a logic different from that adopted in the appeal decision and the court decision. Participants agreed that, at least for the application of well-known matter 2, it is possible to determine the Different Features[2] under the design-choice framework.

(4) Stepwise determination of ease of arriving at the invention(obviousness) and the "extremely easily conceivable"

Using this case, we examined the propriety of conducting a stepwise determination of the ease of arriving at the invention when applying multiple well-known arts to a cited invention. Further, as a general matter beyond this case, we also examined the so-called "extremely easily conceivable," and organized, from the perspective of design choice, that even where something appears to be "extremely

1 Category 3 in Table 1 and Figure 2 of Study 1 (main body) [Patent Machinery 2].
2 Category 4 in Table 1 and Figure 2 of Study 1 (main body) [Patent Machinery 2].

easily conceivable," there are cases in which inventive step is denied.

Through Studies 1 and 2 [Patent Machinery 2], we were able to reconfirm the importance of determining inventive step in light of common general knowledge.

Case 3: Patent - Chemistry

Determination of Novelty and Inventive Step for Claimed Effects

Appeal No.	Appeal No. 2021-005843 (Japanese Patent Application No. 2019-536612) (Unsuccessful request) (Jan. 6, 2022: Appeal decision to maintain an examiner's decision of refusal; decision on the appeal becomes final and binding)
Case No. Date of Court Decision	IP High Court Case No. 2022 (Gyo-Ke) 10052 Feb. 16, 2023 (Dismissal of the request)
Title of the Invention	Moisture control device, moisture control method, program, storage medium, generated substance, product, device, and equipment
Main Issue	Patent Act Article 29(2) (inventive step)

1. Outline of the case

In this case, the inventive step of the invention relating to a moisture control device was disputed with respect to the Different Feature placed on the physico-chemical effects of the device. The appeal decision determined the Different Feature to be easily conceivable under either "Perspective A" or "Perspective B." Both perspectives reasoned obviousness (the ease of arriving at the invention) by focusing on an example in Exhibit A-1, based on the cited invention identified from the claims of Exhibit A-1, but the perspectives differed in the content of the focused example and in the common general knowledge taken into account. The court decision held that the appeal decision under Perspective A contained no error; therefore, without needing to examine the correctness of Perspective B, it found that the plaintiff's grounds for revocation lacked merit.

2. Issues discussed

In this study, we focused on claimed physico-chemical effects in an apparatus invention in the chemical field. Because both the appeal decision and the court decision determined that, taking common general knowledge into account, the cited invention or its example produces the effects at issue, we considered that, depending on how the cited invention is identified, a finding of lack of novelty could also be

possible. Accordingly, in addition to evaluating Perspectives A and B, we examined the matter from the standpoint of lack of novelty.

(1) Issue 1: Logic of lack of inventive step in the court decision (Perspective A)

Regarding the court decision's finding that, for the example in Exhibit A-1, water droplets became finer due to a "decrease in interfacial tension," which is not directly described in Exhibit A-1, we considered the possibility that the court focused on the following Viewpoints A and B, and agreed that the court had taken into account the fact that both were concurrently present. Some opined that Viewpoint A carried greater weight, and further, that Viewpoint A alone could be decisive.

Viewpoint A: The result of applying "electromagnetic waves" in the example of Exhibit A-1 and the result of the "decrease in the interfacial tension of water" recognized as common general knowledge are both "finer water droplets," i.e., identity of result. [identity of result]

Viewpoint B: In specifying common general knowledge, the cause that brings about "finer water droplets" is uniquely identified.

(2) Issue 2: Logic of lack of inventive step in the appeal decision (Perspective B)

Regarding the appeal decision's finding that, in the example of Exhibit A-1, "electromagnetic waves" are recognized to "decrease interfacial tension," we considered the possibility that the decision focused on the following Viewpoints C and D, and many were of the opinion that the fact that both were presented was taken into account.

Viewpoint C: The "heating" of water by "electromagnetic waves" in the cited invention and the operation of "raising the temperature of water" as the cause of "decrease in interfacial tension" recognized as common general knowledge are both "raising the temperature of water," i.e., identity of cause that leads to the "decrease in interfacial tension." [identity of cause]

Viewpoint D: In specifying common general knowledge, the causal relationship is identified in that "raising the temperature of water" necessarily brings about a "decrease in interfacial tension."

(3) Issue 3: From the perspective of lack of novelty

A. Novelty based on the example in Exhibit A-1

We examined whether it is possible to identify, as the cited invention, a device

using “edible oil containing a long-chain fatty acid salt” based on the description of the example in Exhibit A-1, and whether such a cited invention could be said to destroy the novelty of the invention on the ground that a person skilled in the art would understand it to have the effect of bringing the water into a state of “reduced interfacial tension.” As a result, there was consensus that it can be identified as the cited invention, but views diverged on novelty: some found lack of novelty, while others did not necessarily do so.

B. On inherency of the effect

We examined whether “finer water droplets” produced by applying electromagnetic waves can be considered to inherently include the effect of “decrease in interfacial tension,” and found differing opinions: some said it is “inherent,” while others said it is “inherent only under certain conditions.” On the other hand, there was agreement that there is no difference between the approach to inherency in apparatus inventions and the approach to inherent properties in inventions of compounds or pharmaceuticals.

3. Finally

Focusing on claimed physico-chemical effects in apparatus inventions in the chemical field, we found a variety of views on the conditions under which, taking common general knowledge into account, the device described in the cited document can be said to produce the prescribed effect, as well as on inherency and novelty. This indicates the need, case by case, to determine appropriately which points in the evidence to focus on and what line of reasoning to use to reach a conclusion, and it also suggests the importance of drafting appeal decisions, etc., so that the reasoning process is apparent.

Case 4: Patent - Electricity

Practical Points to Note regarding Determinations under Clarity Requirement

Trial No.	Invalidation No. 2017-800019 (Patent No. 3823487) (Unsuccessful demand) (Jan. 31, 2018: Trial decision dismissing the demand; decision on the trial becomes final and binding)
Case No. Date of Court Decision	IP High Court Case No. 2018 (Gyo-Ke) 10080 Jan. 24, 2019 (Dismissal of the request)
Title of the Invention	Optical information reader
Main Issue	Patent Act Article 36(6)(ii) (Clarity Requirement)

1. Outline of the case

The present invention relates to an optical reading apparatus that irradiates a reading target such as a two-dimensional code with light and reads an image of the target from reflected light.

The trial decision determined that the present invention does not violate the clarity requirement and the enablement requirement. The plaintiff sought revocation of the decision on the grounds of error in the determinations, but the plaintiff's assertions were not accepted.

2. Issues discussed

The members of the Study Group (hereinafter referred to as "Members") mainly discussed the following issues and summarized their opinions.

(1) Issue 1: Assuming that no common general knowledge was presented through the Exhibits for "predetermined frequency component ratio" in Element D, could it be said that, based solely on the specification, the term was so unclear as to cause an unexpected disadvantage to third parties?

With respect to the claim language concerning "predetermined frequency component ratio" in Element D of the present invention, the plaintiff argued that the term "frequency component ratio" was not a term of ordinary usage and was not explained in the specification. The defendant referred to evidence of common general knowledge as shown by Exhibits A-5 and A-18, and the court held that the term was

clear. The Members therefore first considered whether it was necessary to cite literature as evidence of common general knowledge when assessing the clarity of the claim term. Specifically, in Study 1 (Theme 4: Patent - Electricity), the Members discussed the viewpoint that a potentially disputed term should be interpreted by examining whether it falls within a reasonable interpretation of the claim term in light of the specification. Applying this approach to the present invention, the Members considered whether the claim term at issue, when interpreted in light of the specification, could be regarded as sufficiently clear, without citing technical literature, so as not to cause an unexpected disadvantage to third parties.

(2) Issue 2: What are the advantages and disadvantages of interpreting a term that is not explained in the specification?

In discussing Issue 1 with respect to the claim language concerning "predetermined frequency component ratio" in Element D, the Members confirmed that the term "frequency component ratio" was not a term of ordinary usage and was not explained in the specification. Accordingly, the Members reached a consensus that the Court appropriately addressed the clarity requirement by taking into account the common general knowledge as shown by Exhibits A-5 and A-18. The Members therefore further examined, from the perspectives of the right holder and third parties, advantages and disadvantages of interpreting a term that is not explained in the specification in light of common general knowledge.

(3) Issue 3: In order to be found clear based on the description in the specification alone, what matters should be included in the original specification in relation to common general knowledge?

The Members acknowledged that, as discussed in Issue 2, if common general knowledge is taken into account, there is a risk that matters not described in the specification may be incorporated in identifying the invention, thereby generally resulting in significant disadvantages. Ideally, it is desirable that the clarity requirement be satisfied by providing a detailed description in the specification. On the other hand, if the technical meaning of every term must be described in the specification, the specification will become unduly long, and in many cases, this would be impractical from the standpoint of the burden on the right holder (applicant) in preparing the specification (workload and fees/translation costs). For third parties as

well, reading an excessively long specification with many sections that do not substantively require detailed description would impose a heavy burden. Thus, there is a trade-off between the level of detail in the specification and the burdens on the right holder and third parties. Accordingly, the Members examined what matters, at a minimum, need to be included in the original specification in view of common general knowledge so that clarity can be found based on the specification alone.

(4) Issue 4: On the holdings regarding the clarity requirement for "set to be relatively long" in Element F and "predetermined value" in Element G

The court held that the specific expressions "set to be relatively long" in Element F and "predetermined value" in Element G are clear in view of the claim language (Claim 1) and the description in the specification. The Members discussed the appropriateness of these holdings and, beyond the present case, also examined considerations to be borne in mind when expressions such as "predetermined value" or "relative" are used in claims, including the potential for unexpected disadvantages to third parties.

(5) Issue 5: Practical points to heed when common general knowledge is implicated in arguments on clarity and inventive step

In the related litigation concerning the same patent, "2019 (Gyo-Ke) 10022," the clarity requirement for the term "frequency component ratio" in Element D was not disputed. Based on the interpretation of the term grounded in common general knowledge, as determined in the present case, the court appears to have treated the identified distinction from the prior art accordingly and assessed inventive step. Given that such cases may arise in which consideration of common general knowledge in a clarity determination affects inventive step, the Members examined practical points to heed when common general knowledge is implicated in arguments on clarity and inventive step.

Case 5: Trademark

Appeal No.	Appeal No. 2021-15267 (Unsuccessful request)
Case No. Date of court decision	IP High Court Case No. 2022 (Gyo-Ke) 10090 Jan. 31, 2023 (Dismissal of the request)
Trademark in the Application	Heaven (standard characters) Designated services: Class 43 "Providing foods and beverages at host clubs; providing advice, consultation, or information relating thereto," etc.
Cited Trademark	 Designated services: Class 43 "providing Indian curry and Indian cuisine"
Main Issue	Determination of similarity of designated goods/services

1. Outline of the case

In this case, applicability of Trademark Act Article 4(1)(xi) to the trademark in the Application was disputed, and similarity between the designated services of the trademark in the Application and those of the cited trademark was recognized.

2. Issues discussed

(1) Issue 1: On the factors for determining similarity of goods/services

The Supreme Court judgment in the "ARIKA" case (2009 (Gyo-Hi) 217), cited in the present court case, sets out four criteria for determining similarity of goods/services: (i) the names assigned to the classes in the Appended Table of the Trademark Act Enforcement Order; (ii) the contents and nature of the goods or services designated as belonging to those classes in the Appended Table of the Trademark Act Enforcement Regulations; (iii) the explanations of goods or services in the notes to the classification table composing the International Classification; and (iv) the similarity groups in the Examination Guidelines for Similar Goods and Services.

Among these, for the factors in judgment exemplified in the Examination Guidelines for Trademarks, discussion was had on whether there is relative weight among them; if so, what factors give rise to such weighting; and whether there is room to consider other factors.

A. A majority took the view that there is relative weight among the factors, and the majority view was to base this on the holdings in the Supreme Court's leading case on similarity of goods/services, "橘正宗 (Tachibana Masamune)" case 1958 (O) 1104).

There was also the view that which factor is emphasized depends on the case.

B. As factors affecting the relative weight among the factors in judgment, based on consideration of the purport for which each factor is set forth, opinions noted the importance of whether there is a practice of manufacturing and selling by the same business operator, and the range of consumers.

On the other hand, as analyses tailored to the goods/services being compared, there were views proposing a three-way breakdown - goods vs. goods, services vs. services, and between goods and services - and views that characteristics of distribution channels for goods have an impact.

C. As factors in judgment other than those exemplified in the Examination Guidelines for Trademarks, in addition to matters commonly asserted as circumstantial facts indicating a likelihood of confusion in acts of unfair competition under the Unfair Competition Prevention Act, there were opinions pointing to whether parts are exclusive or general-purpose, and to qualifications or approvals required for sales/provision.

(2) Issue 2: On priority relationships among the laws and regulations prescribing the factors in judgment

Next, with respect to the hierarchical and priority relationships among items (i) to (iv) above, the normative hierarchy was confirmed to follow legal theory.

From the standpoint of practical application, some opined that, in view of the relationship in which special law prevails over general law, item (iv) would be examined first.

There was also an opinion asking to what extent item (iv) is taken into account in trials/appeals, with the view expressed that items (iv) and (iii) are used only as references.

(3) Issue 3: On the significance of goods/services in similarity determinations across different classes

Even in similarity determinations across different classes, the prevailing view was that the basic approach should follow the purport of the "橘正宗 (Tachibana Masamune)" judgment, and there are no special additional elements merely because the determination crosses class boundaries.

Opinions were also expressed that, although the factors in judgment exemplified in the Examination Guidelines for Trademarks in part reflect the purposes underlying classification of individual goods/services into their classes, and classes do not define the scope of similarity (Trademark Act Article 6(3)), it should not be precluded to treat them as one of the factors to be referenced as a premise in similarity determinations.

(4) Issue 4: On consideration of actual conditions of trading

In the present judgment, the "actual conditions of trading" served as the basis for determining similarity of services. Discussions were held as to whether, as with the Supreme Court's holding on similarity of trademarks in the "Hodogaya Chemical Corporate Logo" Case (1972 (Gyo-Tsu) 33), consideration should be limited to "general and constant" conditions.

A. On this point, the majority view was that, in similarity determinations for goods/services as well, as in similarity determinations for trademarks, at the examination stage, priority should be given to the actual conditions of general and constant trading, whereas at the trial/appeal stage, there is room to consider the actual conditions of specific, concrete trading.

There were also opinions that a similar distinction should be made between the rights-formation stage (appeal against a decision of refusal, etc.) and the post-registration stage (trial for invalidation, infringement litigation). However, it was also noted that infringement litigation as a whole addresses specific, concrete facts, making it difficult to construct general rules from those holdings.

It was further noted that assertions by the demandant/party that appear to concern the actual conditions of specific, concrete trading may, in some cases, be intended as circumstantial facts from which to infer the actual conditions of general and constant trading, and this should be kept in mind.

B. In addition, although not itself the actual conditions of trading, there were views

that the degree of similarity between trademarks can function as an adjustment valve in the similarity determination for goods/services, and that each factor in judgment exemplified in the Examination Guidelines for Trademarks itself has the character of exemplifying "the actual conditions of general and constant trading."

Trial and Appeal Practitioner Study Group REPORT 2025 (Summary)

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