

TRIAL AND APPEAL PRACTITIONER STUDY GROUP REPORT 2017 (SUMMARY)

***Trial and Appeal Department
Japan Patent Office***



Trial and Appeal
Practitioner Study Group

REPORT 2017

(Summary)

Trial and Appeal Department
Japan Patent Office

Preface

The chief administrative judges and administrative judges of the Japan Patent Office (JPO) conduct proceedings for trials and appeals and make final determination as an administrative regarding the appropriateness of the examination results on applications for patents, utility models, designs, trademarks, as well as the validity of the rights granted.

In order to conduct proceedings more properly, it is important to analyze the actual trial and appeal decisions and court decisions and to utilize the outcome for the sake of improvement of trial and appeal practice. Moreover, by widely disseminating the analysis results, it enables administrative judges to share the understanding of the trial and appeal practice with the users of the trial and appeal systems.

With this notion in view, the Trial and Appeal Department of the JPO has held the "Trial and Appeal Practitioner Study Group" (originally named the "Case Study on Inventive Step") since FY2006, in which patent practitioners from various sectors gather in one place to review and discuss the trial and appeal and court decisions.



Trial court of the JPO

Members of the Study Group consists of corporate IP personnel, patent attorneys, lawyers, and JPO administrative judges including chief administrative judges. To date, a total of 446 members have studied 138 cases overall. The Trial and Appeal Department has made use of the study outcomes and widely disseminate them among the users of trial and appeal systems. In addition to these members, we have welcomed the judges of the Intellectual Property High Court and the Tokyo District Court as observers to the Study Group since FY2016. As a result, a judicial perspective has been introduced to the case review process and made the discussions at the meeting more fruitful than ever before.

The Trial and Appeal Department publishes the English version of the abstracts of the report, with a view to disseminating the study outcome overseas. Furthermore, at the “Judicial Symposium on Intellectual Property / TOKYO 2017” held in the fall of 2017, we organized a panel discussion session, focusing on two cases (patent case and trademark case each) taken up by the Study Group in FY2016. We hope that our activities will improve the reliability of the Japanese intellectual property system and further promote the understanding of the trial and appeal practice of the JPO overseas.

Last but not least, as a chairperson of the Study Group, I would like to express my sincere appreciation 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, who have helped us organize the case study meeting, and all those who have participated in the study as the members and observers.

February 2018

Chairperson, the Trial and Appeal Practitioner Study Group

Toshihide ABE

Executive Chief Administrative Judge

Trial and Appeal Department

Japan Patent Office

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

Outline of Study

I. Study Framework

Studies were made on the judgement, etc. of the JPO and the Intellectual Property High Court based on cases of trial/appeal decision and court decision, by each of the 7 groups shown in the organization chart on the next page. The group “Patent – General” dealt with cases with discussion points of the interpretation of the law and procedural aspects.

The members of the groups were selected from the industry practitioners (intellectual property division in companies, etc.), lawyers, patent attorneys and the administrative judges of the JPO to give full consideration to the studies from various angles based on the standpoint of each group. In addition, the judges of the Intellectual Property High Court and the Tokyo District Court participated in some of the groups as observers.

Each of 7 groups consisted of 5 to 9 members, and 50 members and 6 observers participated in these groups.

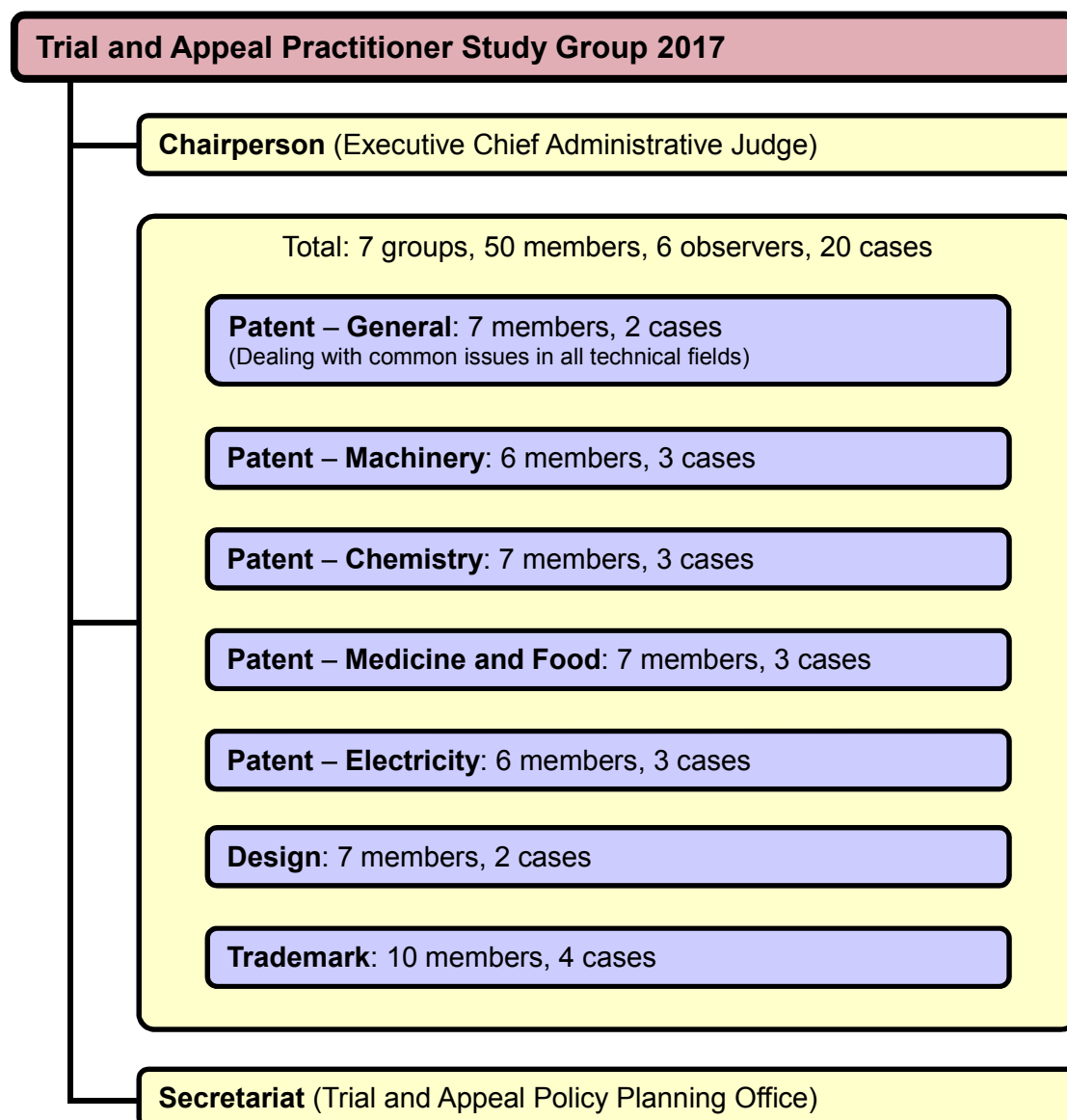
II. Study Method

The study of each case was separately conducted by each group. The members arranged the discussion points in advance, and made discussion on decisions, logical composition or background of the conclusion, etc. of trial/appeal decisions and court decisions.

Each group dealt with 2 to 4 cases, and 20 cases were studied.



Group meeting held on July 21, 2017



Organization chart of the Trial and Appeal Practitioner Study Group 2017

Case 1: Patent – General 1

JPO Docket Number	Trial for invalidation Invalidation No. 2014-800045 (Patent No. 4114820) (Sep. 16, 2014: dismiss a request; revoked) (Jan. 6, 2017: trial decision to maintain the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Aug. 26, 2015 2014 (Gyo-Ke) 10235 (JPO trial decision revoked)
Title of Invention	Detergent composition
Major Issues	The Patent Act Article 167 (prohibition of double jeopardy)
Points	Change of the primary cited invention in the process of determination of an inventive step, and objective scope of the effect of prohibition of double jeopardy

1. Outline of the case

(1) Outline of the JPO decision and the court decision

This is a case related to a patented invention titled "detergent composition," which pertains to the third trial decision rendered by the JPO after the first and second JPO trial decisions to become final and binding (requests were dismissed for both the first and second trial decisions).

While the JPO rendered the third trial decision dismissing a request for a trial for invalidation by the effect of prohibition of double jeopardy based on the second JPO trial decision, the court ruled that the effect of prohibition of double jeopardy based on the second JPO trial decision is not applicable in the present (third) trial for invalidation, due to the reasons that the primary cited invention cited in the present JPO trial decision is different from that of the second JPO trial decision.

(2) Correspondence of the reasons for invalidation that are determined by the JPO as the violation of the effect of prohibition of double jeopardy

First trial for invalidation (first JPO trial decision)	Second trial for invalidation (second JPO trial decision)	Third trial for invalidation (present JPO trial decision)
	Reasons for invalidation: Article 29 (2)	Reasons for invalidation 1: Article 29 (2)
Reasons for invalidation 2: Article 36 (6) (i)		Reasons for invalidation 2: Article 36 (6) (i)

(3) Correspondence of evidence and findings of primary cited invention, etc.

Evidence	Second trial for invalidation (second JPO decision)		Third trial for invalidation: Present JPO trial decision and court decision		
	Evidence A	Primary cited invention, etc.	Evidence A	Primary cited invention, etc.	
				JPO	Court
Nyumon Kireto Kagaku [Chelate chemistry basics, 2nd edition]	Not submitted		A1	Well-known	Primary cited
Publication of Japanese Unexamined Patent Application Publication No.1995-238299	Evidence A No. 3	Well-known	A2	Well-known	(motivation)
UK Patent No. 1439518*	Evidence A No. 1	Primary cited	A3	Primary cited	Secondary cited
Publication of Japanese Unexamined Patent Application Publication No. 1975-3979*	Evidence A No. 2	(Primary cited, 2)	A4		
Publication of Japanese Unexamined Patent Application Publication No. 1984-133382	Evidence A No. 4	Well-known	Not submitted		
Publication of Japanese Unexamined Patent Application Publication No. 1986-188500	Evidence A No. 5	Well-known	Not submitted		
Publication of Japanese Translation of PCT International Application No. 1993-502683	Evidence A No. 6	Well-known	Not submitted		

* UK Patent No. 1439518 and Publication of JP Patent Application No. 1975-3979 belong to the same patent family and they are very similar in content.

2. Outline of major issues discussed

(1) Issue 1 (the present court decision)

The members discussed the following issues: [i] whether the court's finding of the primary cited invention is appropriate; [ii] whether the court decision to the effect that the effect of

prohibition of double jeopardy is not applicable if different inventions are chosen as the primary cited invention is appropriate (who is authorized to choose the primary cited invention and in what situation the primary cited invention is considered to be the same); [iii] (hypothetically) if the first JPO trial decision dismissing a request for a trial for invalidation becomes final and binding, whether the effect of prohibition of double jeopardy could be avoided in the second trial for invalidation by exchanging the primary cited invention for the secondary cited invention; and [iv] how a written request for a trial for invalidation should be written, etc.

On Issue 1-[i], the members agreed that the court's finding is appropriate. On Issue 1-[iii], the members expressed opinions from the standpoint of a patentee or the standpoint of a demandant in a trial for invalidation.

(2) Issue 2 (Relationship with other court decisions)

The members discussed the relationship of the present court decision with the following reference court decisions: [i] Reference court decision 2 (2015 (Gyo-Ke) 10260) rendered after the present court decision; [ii] Reference court decision 3 (2013 (Gyo-Ke) 10226) and Reference court decision 4 (2013 (Gyo-Ke) 10127) rendered prior to the present court decision; and [iii] Reference court decision 5 (1967 (Gyo-Tsu) 28) that indicated the scope of proceedings in a revocation action against the JPO trial decision.

With regard to Issue 2-[i] among these issues, some members commented that Reference court decision 2 interpreted the meaning of the Patent Act Article 167 more broadly than the present court decision, whereas others commented that Reference court decision 2 is identical with the present court decision in substance, finding no difference between them in terms of the interpretation of that clause.

Case 2: Patent – General 2

JPO Docket Number	Trial for invalidation Invalidation No. 2011-800266 (Patent No. 3690864) (Jul. 3, 2013: trial decision to invalidate the patent; trial decision revoked) (Oct. 7, 2014: trial decision to maintain the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, May 29, 2014 2013 (Gyo-Ke) 10228 (JPO trial decision revoked)
Title of Invention	Method for producing a photocatalyst body
Major Issues	The Patent Act Article 38 (the requirement for joint applications)
Points	(i) Interpretation of an agreement on technical guidance as the basis for determining the requirement for joint applications (ii) Finding of the status of a joint inventor and burden of proof of allegation of a third party to be an inventor

1. Outline of the case

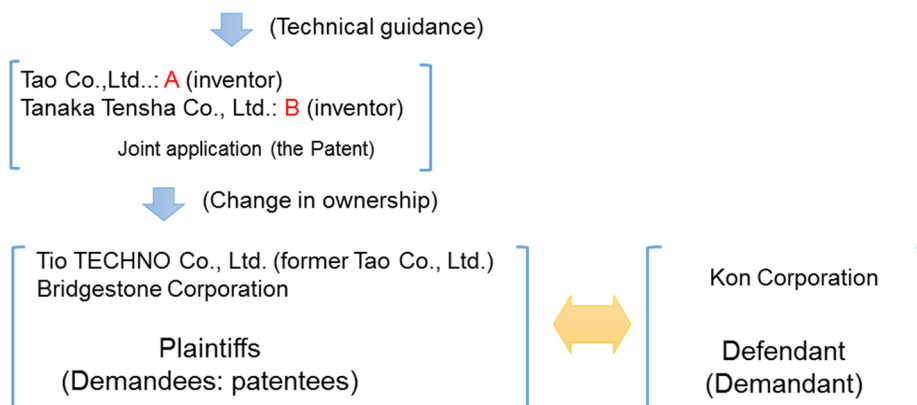
(1) Outline of the JPO trial decision and the court decision

This is a case related to a patented invention titled "method for producing a photocatalyst body," which pertains to a trial for invalidation requested for the reasons of the usurped application and the violation of the requirement for joint applications.

The JPO rendered a trial decision to invalidate the patent on the grounds of the violation of the requirement for joint applications. The court determined that C, who is in charge of providing technical guidance (and is not indicated as an inventor in the patent gazette unlike the inventors A and B), was not involved in the process of completing the characteristic feature of the patented invention in a creative manner and therefore C is not a joint inventor of the invention, and that according to the interpretation of the agreement on technical guidance, the right to obtain a patent shall not belong to the person referred to in the agreement. In conclusion, the court revoked the JPO trial decision.

(2) Relationships among the parties concerned with the JPO trial decision

Saga Ceramics Research Laboratory: C (in charge of providing technical guidance)



2. Major issues discussed

(1) Issues 1 and 2 (interpretation of the agreement on provision of technical guidance to the applicants by a third party (the "Confirmation Letter"))

The members discussed whether the court's determination in this court decision is appropriate with regard to: [i] the interpretation of the term "technical guidance-related invention" in the Confirmation Letter; and [ii] the relevant clauses of the Confirmation Letter and the ownership of the right to obtain the patent.

The members agreed that the court's determination is appropriate with regard to both issues.

The members also discussed the plaintiff's allegation regarding technical guidance-related inventions and the problems that may arise when multiple parties are involved in the process of making an invention, such as in technical guidance, joint research projects, etc.

(2) Issue 3 (finding of the status of a joint inventor)

The members discussed whether the court's determination is appropriate to the effect that C, who provided technical guidance, is not found to be as a joint inventor.

The members agreed that the court's determination on this issue is appropriate. In the course of discussion, they considered the general theory of finding the status of a joint inventor, taking into account academic views and hypothetical cases.

(3) Issue 4 (burden of proof of allegation of a third party claims to be a (joint) inventor)

The members discussed the allocation of the burden of proof of allegation of a third party to be an inventor, based on the reference court decision (2015 (Gyo-Ke) 10230).

The members agreed that, based on the view presented in the reference court decision, when a third party claims to be a joint inventor, the patentee should be considered to bear the burden of proof of allegation of that.

Case 3: Patent – Machinery 1

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2015-15661 (Patent Application No. 2011-83920) (Mar. 28, 2016: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Dec. 26, 2016 2016 (Gyo-Ke) 10113 (JPO appeal decision maintained)
Title of Invention	Laser ignition device
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding and application of well-known art

1. Outline of the case

This case relates to a revocation action against an appeal decision of the JPO that dismissed an appeal against an examiner's decision of refusal of an invention titled "laser ignition device." The JPO dismissed an amendment submitted together with the appeal and rendered an appeal decision to refuse the patent, on the reasons for the amendment not satisfying the independent requirement for patentability (inventive step). Then, the demandant of the appeal (plaintiff) made a revocation action against an appeal decision of the JPO. The court dismissed the plaintiff's request in relation to the reasons for seeking revocation of the appeal decision. Among the reasons for revocation asserted by the plaintiff, the court dismissed the "inappropriate findings as to the Cited Invention and the different features" (reason for revocation 1), and reasons relating to well-known matter 1 (reason for revocation 2-1) and effect (reason for revocation 2-3), in connection with the reasons in connection with the "inappropriate finding as to the different features." For the reasons for revocation relating to well-known matter 2 in connection with the "inappropriate finding as to the different features" (reason for Revocation 2-2), the court determined that there is need to make a decision as to this point.

2. Major issues discussed

(1) Finding of the Invention (whether the target part contains an oxidation catalyst)

A majority of the members agreed with the court decision that the target portion of the Invention contains oxidation catalysts. As the reasons for this, members pointed out that the claim did not specifically disclaim the target portion containing oxidation catalysts, and that there was no reason for finding the Description to disclaim the target portion containing oxidation catalysts. On the other hand, other members pointed out that there is a room for discussion supposing that the applicant is able to submit objective experimental data to prove the inability to achieve the effect of the Invention by the target portion containing oxidation catalysts.

The members also discussed whether the Invention would be granted a patent if the claim is amended to a "disclaimer" which excludes oxidation catalysts from the target part; however, a

majority of the members expressed the opinion that the conclusion would remain the same since it would be difficult to allege effect, etc. associated with this "disclaimer."

(2) Consideration of effects (effect of using a microchip laser)

A majority of the members agreed with the court decision that the effect of using a microchip laser is not considered as a prominent effect. As the reason for this, for the effect of "igniting mixed gas by securely generating plasma" "since it is possible to secure the wide range of brightness of the laser beam," the members pointed out that the Description neither describes such effect as an effect specific to a microchip laser, nor mentions the comparison results with other lasers. In addition, for the effect of "generating gas breakdown," the members pointed out that the claim did not specify the matters serving as the preconditions of such effect, etc. (In addition, some commented that in practice as well, if the structure of an invention could have been easily conceived of by a person ordinarily skilled in the art based on the cited prior art, there are quite a few cases where the invention is found to satisfy the inventive step due to a prominent effect which is difficult for a person ordinarily skilled in the art to expect.

(3) Amendment of claim for obtaining patent by further restricting claims

The members discussed the tentative draft amendment in order to make the Invention granted a patent. Some members expressed an opinion that the Invention can satisfy the requirement of inventive step if it specifies a configuration to enable the use of both target breakdown and gas breakdown, as such specification would make the Invention significantly distinctive from the Cited Invention. On the other hand, some pointed out that the Invention still could have been easily conceived of by a person ordinarily skilled in the art, as the gas breakdown is already disclosed in Evidence A No. 3.

(4) Finding of well-known arts

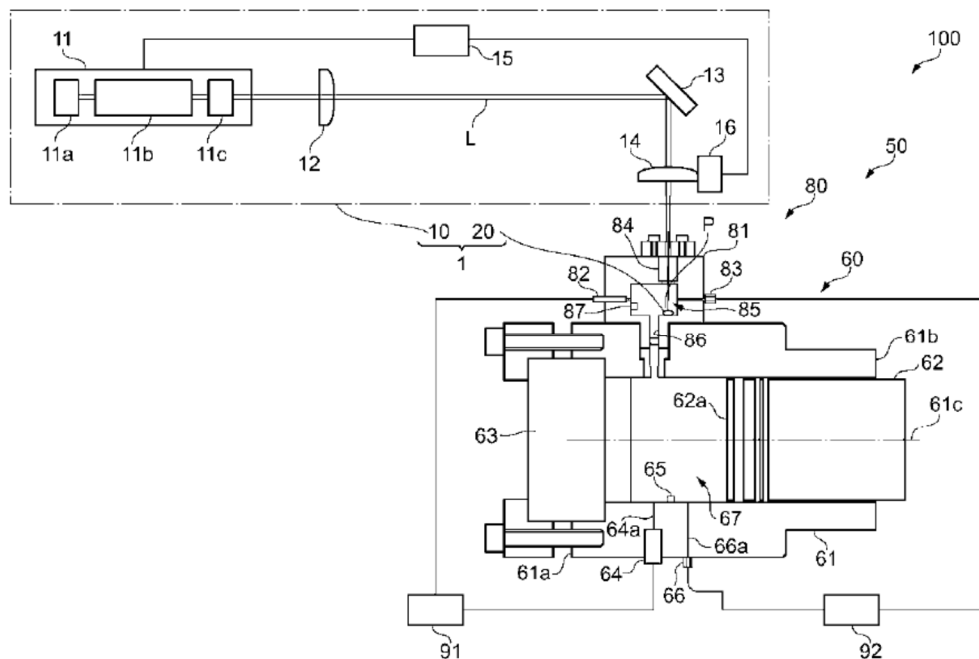
The members discussed the issue of whether the fact that most of the evidence of well-known art and well-known matters 1 and 2 relate to the same person affects the finding well-known art. As to this issue, most of the members agreed that the issue of whether the documents relate to the same person or the quantity of documents would not be a problem, as long as these documents can serve as evidence of a generic nature of the invention, and that these factors would not prohibit the court from finding that the prior art is well-known. In addition, some others pointed to the necessity of paying due regard to use of information on the internet as evidence for the prior art having become well-known.

According to some members, although it is generally difficult to rebut an allegation that an invention is a part of well-known arts, it might be effective to point out the overly higher-level conceptualization and the difference of technical field, depending on the case.

With regard to the difference between well-known art and publicly-known art, some commented that well known-art is more flexible for reasoning and replacing evidence, while others commented that there is not much difference between these when considering the motivation of applying them as the main cited invention.

(5) Motivation (irregularity of procedures)

In this case, the examiner did not point out any motivation for applying the publicly-known arts in the examination process and the approach applying well-known art was relied upon for the first time at the appeal stage. With regard to this issue, most of the members expressed the opinion that there is no violation of procedures as the applicant is not hindered from making sufficient allegations as long as there is no change in the well-known art.



Claimed Invention (FIG. 1)

Case 4: Patent – Machinery 2

JPO Docket Number	Trial for invalidation Invalidation No. 2011-800009 (Patent No. 2851237) (Dec. 21, 2011: trial decision to maintain the patent; trial decision revoked) (Apr. 23, 2013: trial decision to invalidate the patent; trial decision revoked) (Jun. 3, 2014: trial decision to invalidate the patent; final and binding)
Date of Court Decisions Court Docket Number	Court decision of the IP High Court, Dec. 11, 2012 (the first court decision) 2012 (Gyo-Ke) 10038 (JPO trial decision revoked) (Court decision of the IP High Court Oct. 7, 2013 2013 (Gyo-Ke) 10153 (JPO trial decision revoked)) Court decision of the IP High Court Jun. 23, 2016 (the second court decision) 2014 (Gyo-Ke) 10166 (JPO trial decision maintained)
Title of Invention	Book storing and managing device
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding of well-known art and determination on easiness of conceiving of the different features

1. Outline of the case

This is a case of a trial for invalidation of a patent for an invention titled "book storing and managing device." In the first trial decision, the JPO accepted Request for Correction A and dismissed the request for a trial for invalidation on the grounds that the reasons for invalidation alleged by the demandant are unacceptable. In a revocation action against the first trial decision of the JPO, the court ruled that the JPO erred in determining an inventive step because the invention after the correction could have been easily made by a person ordinarily skilled in the art, and hence, the reasons for revocation alleged by the plaintiff (the demandant) are reasonable, and in conclusion, the court revoked the JPO decision. This court decision (the first court decision) became final and binding upon the withdrawal of the final appeal. In the second trial decision, the JPO accepted Request for Correction A but invalidated the patent. The second JPO trial decision was subsequently revoked by a court ruling under the provisions of the Patent Act before the amendment because a request for Trial for Correction B had been filed after the filing of an action to seek revocation of the JPO decision. After that, in the third trial decision, the JPO accepted a Request for Correction B, which was the combination of Request for Correction A with an additional correction, but invalidated the patent on the grounds that the corrected invention lacked an inventive step. In a revocation action against the third trial decision of the JPO, the court determined that there are no errors in the JPO trial decision that found no inventive step in the

corrected invention, and dismissed the request of the plaintiff (the patentee) (the second court decision).

2. Major issues discussed

(1) Reason for Revocation 1 in the second court decision: JPO's errors in finding identical features between Invention 1 and Evidence A No. 4 Invention and overlooking of the different features between them

The court determined that the JPO's errors in finding the identical features cannot be deemed to affect the conclusion and therefore they are not acceptable as reasons for revocation of the JPO trial decision. The members agreed that the court's determination on this point is appropriate because: when examining Different Feature 2, the court took into consideration the feature of Invention 1 that the JPO had overlooked in the course of finding the identical feature, and it concluded that a person ordinarily skilled in the art could have easily conceived of that different feature 2; and both parties made arguments and counterarguments sufficiently, including those on the feature overlooked by the JPO.

(2) Reason for Revocation 2 in the second court decision: the court's determination on easiness of conceiving of Different Feature 2

With regard to Different Feature 2, the court determined that a person ordinarily skilled in the art could have easily conceived of that feature, by making up for what is actually not disclosed in the secondary cited document with the technical matters disclosed in other documents. Opinions were divided among the members. Some members argued that the approach adopted by the court is appropriate because the court only presented the other documents as the basis for finding the matters that were virtually disclosed in the secondary cited document and it did not add the other documents to the secondary cited document and then combine the outcome with the primary cited document. Others argued that the "easiness" found by the court is based on "two easy steps," which can be reached by adding the other documents to the secondary cited document and then combining the outcome with the primary cited document, and therefore said approach cannot be considered to be appropriate.

(3) Reason for Revocation 3 in the second court decision: the court's determination on the easiness of conceiving of Different Feature 3

The court found that the first court decision regarding the determination is binding on Different Feature 3, despite the fact that the claim description concerning this feature had been

corrected. Most members commented that this approach adopted by the court is appropriate because the correction was merely of a formality nature and does not substantially require another examination.

Some members pointed out that in general terms, it is a problem that it is not possible to predict whether or not a court decision has binding force on a correction and also pointed out that guidelines, etc. may be necessary to increase the predictability.

(4) Reason for Revocation 4 in the second court decision: the court's determination on the easiness of conceiving of Different Feature 4

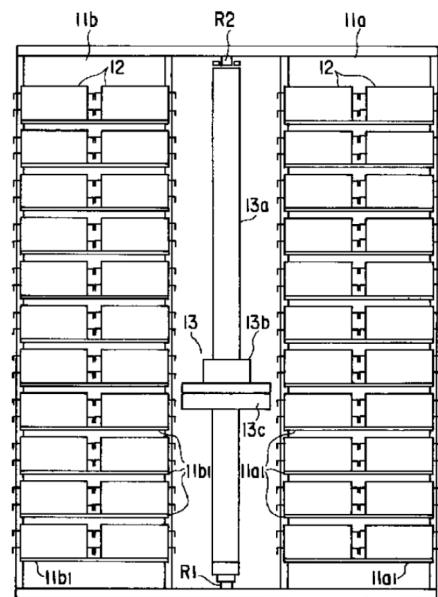
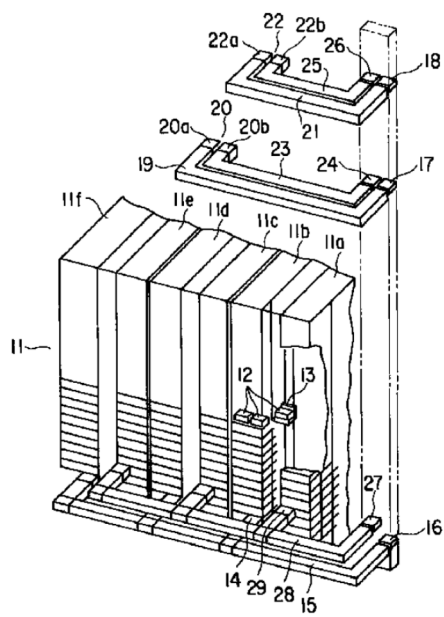
With regard to the feature of Invention 1 concerning Different Feature 4 wherein, of the two containers, the one at the front side is used in preference to the one at the rear side, the court determined that a person ordinarily skilled in the art could have easily conceived of that feature based on the well-known problem without showing any evidence. Opinions were divided among the members. Some members argued that this approach adopted by the court is appropriate because the determination on an inventive step does not always require explicit evidence, and in this case, the court separately provided proper logical support. Others argued that said approach is inappropriate due to the absence of evidence, stating that there may be more than one method of setting priority on the container to be used, and what is more, it is illogical to create a problem by purposely adopting a less efficient structure and then alleging the easiness of adopting another structure to solve that problem.

(5) First JPO trial decision: the necessity for the JPO to determine all different features

All members agreed that it is desirable that the JPO determine all different features even in the case of affirming an inventive step, with a view to solving the dispute at one time.

(6) Points that the patentee could have alleged

Some members expressed their opinions regarding what the patentee could have alleged, such as counterargument on the finding of Evidence A No. 4 Invention, the use of the book size data concerning Different Feature 2, and the doubt about the finding of the well-known problem concerning Different Feature 4.



Patented Invention (FIG. 1 and 4)

Case 5: Patent – Machinery 3

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800126 (Patent No. 3290336) (Mar.19, 2013: trial decision to maintain the patent; final and binding)
Date of Court Decision Court Docket Number	Court Decision of the IP High Court, Nov. 28, 2013 2013 (Gyo-Ke) 10121 (JPO trial decision maintained)
Title of Invention	Dehydration tub of washing machine
Major Issues	The Patent Act Article 36 (6) (ii) (clarity requirement)
Points	Extent to which the statements in the description may be taken into consideration

1. Outline of the case

This is a revocation action against a trial decision of the JPO that dismissed a request for a trial for invalidation of an invention titled "dehydration tub of washing machine." In the trial decision, the JPO dismissed the request for a trial for invalidation, determining that, since it is not that the patented invention failed to meet the clarity requirement, it satisfied the requirement under the Patent Act Article 36, paragraph (6), item (ii). The demandant of the trial for invalidation alleged that there was an error in the JPO trial decision, and filed a revocation action against a trial decision of the JPO. Then, the court determined that the JPO's finding and determination were reasonable and not illegal, and dismissed the plaintiff's request.

2. Major issues discussed

(1) Consideration of statements in the description

The members agreed that, as a generality, it is permissible to consider statements in the description when determining whether an invention meets the clarity requirement under the Patent Act Article 36, paragraph (6), item (ii). Members introduced recent cases in which the court held that statements in the description should be taken into consideration when determining the sufficiency of the clarity requirement.

Some members pointed out that, even if statements in the description could be considered in determining the clarity requirement, it would be possible to decide on the maximum extent thereof from the viewpoint of whether or not such consideration would cause any unexpected detriment to third parties, by referring to judicial precedents.

Some members opined that, in this case, the invention would not have escaped violation of the clarity requirement if it had failed to state, at the least, the comparison standard in the claim. In other words, because the standard "total vertical length (of the filter member)" was stated in the claim, the statements of claims for the patent were not immediately determined to be unclear,

and the invention could be determined to sufficiently meet the clarity requirement by considering the statements in the description.

(2) Detailed discussion on consideration of statements related to the effects

With regard to the statement "the laundry does not touch the joint parts" in the description, the JPO construed it to mean "does not touch easily" and determined the invention to be clear, whereas the court literally construed it to mean "does not touch" and determined the invention to be clear. Regarding this point, some members commented that the JPO may have substantially examined the size of the gap and its technical significance, and made the determination by construing that it is difficult to conclude that the laundry does not touch the joint parts, while on the other hand, the court first literally examined the statements in the description and made the determination by presuming that it is technically possible to design a size where the laundry "does not touch."

Some members commented that, when there are multiple effects as in this case, the claim violates the clarity requirement unless it can be clearly understood in relation to all of the effects, while other members commented that the claim sufficiently meets the clarity requirement if it can be clearly understood in relation to one of the effects.

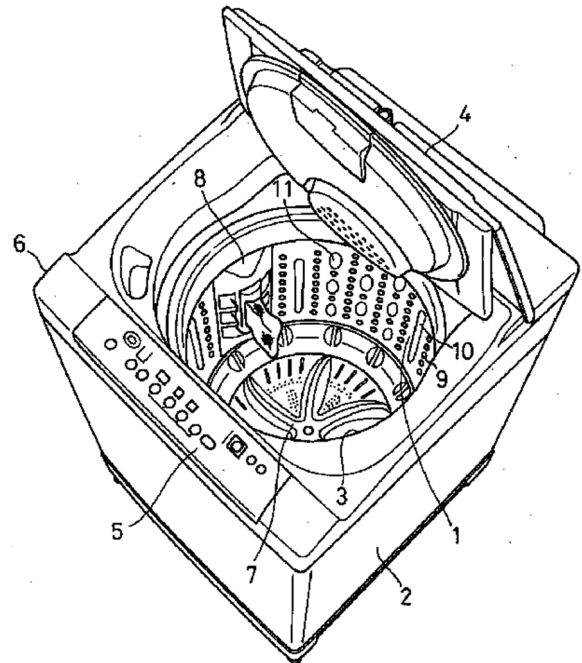
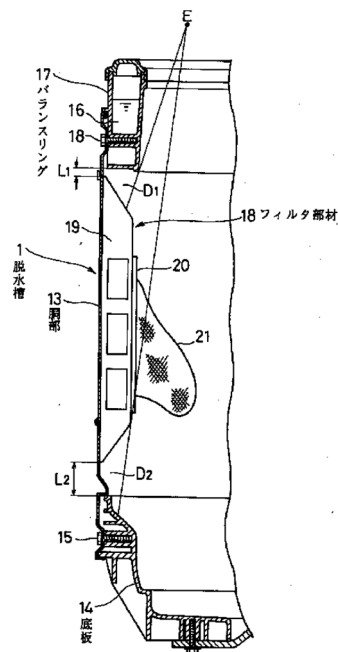
In the court decision on a case demanding compensation for damage incurred from infringement of a patent right pertaining to this patent, the court made in-depth determination on the specific size of the "gap." When this court decision was also taken into account in the consideration, some members indicated that, if the demandant of the trial for invalidation who was also the defendant in the above case submitted evidence to the effect that the laundry touches or gets caught between the joint parts with regard to the defendant's product which was determined in the above case as satisfying the constituent components of the patent, the court could have determined that the patent violates the clarity requirement.

(3) Possibility of limiting claims for patent

When having discussed claims that present no doubts with regard to the clarity requirement, some members pointed out that, generally, the claims could be limited by stating the effects of the invention. In this case, some members commented that it was possible to limit claims based on the "presence of blind spots" among the multiple effects. On the other hand, some members indicated that it is difficult to specify the "presence of blind spots" in text. Some members stated that another possible approach would be to state the effects as an upper level concept, but it is

unknown whether this approach would be effective in this case because it is not easy to state the effects as an upper level concept in this case.

Some members commented that the patentee assumably attempted to obtain a patent based on the current claim from the viewpoint of securing the broadest possible scope of right, while recognizing the possibility that the issue of sufficiently meeting the clarity requirement may arise, and therefore concluded that the risk was considered to be within the patentee's expectation.



1: Dehydration tub, 13: Body part, 14: Bottom plate,
17: Balance ring, 18: Filter member

Patented Invention (FIG. 1 and 5)

Case 6: Patent – Chemistry 1

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800177 (Patent No. 3593817) Oct. 3, 2013: trial decision to invalidate the patent; trial decision revoked) (Apr. 7, 2015: trial decision to maintain the patent; final and binding)
Date of Court Decision Court Docket Number	The first court decision of the IP High Court, Oct. 23, 2014 2013 (Gyo-Ke) 10303 (JPO trial decision revoked) The second court decision of the IP High Court, Jul. 19, 2016 2015 (Gyo-Ke) 10099 (JPO trial decision maintained)
Title of Invention	White polyester film
Major Issues	The Patent Act Article 29 (1) (iii) (novelty)
Points	Finding of the cited invention (determination of the matters implicitly described in the cited document)

1. Outline of the case

This is a trial for invalidation case regarding a patent for an invention titled "white polyester film." The JPO rendered a trial decision to invalidate the patent due to lack of novelty (the first trial decision). The court revoked this trial decision on the grounds that the JPO erred in finding the cited invention (the first court decision). In the trial proceedings of the remanded case, the JPO dismissed the demandant's request for a trial (the second trial decision). The case was again brought to the court, which dismissed the plaintiff's claim (the second court decision).

2. Major issues discussed

(1) Determination of the matters implicitly described in the cited document (Evidence A No. 1 Invention)

Example 12 in Evidence A No. 1 discloses polyester composition B obtained by mixing polyethylene terephthalate with polyester composition A obtained by polycondensation reaction, and describes that the intended film was obtained from polyester composition B. In the first trial decision, the JPO determined, in light of the other descriptions in Evidence A No. 1, that "white polyester film made of polyester composition A" is implicitly described in this evidence, and that the experiment described in Evidence A No. 10 that was conducted to assess polyester composition A served as an additional experiment of Example 12 in Evidence A No. 1. With regard to this determination by the JPO, the court ruled in the first court decision as follows: a film formed with polyester composition A cannot be regarded as a technical matter that is obvious to a person skilled in the art; polyester composition A is nothing more than an intermediate composition generated in the process to obtain polyester composition B with which biaxially-stretched white polyester film is to be produced; Example 12 is not related to forming a film with

polyester composition A; and moreover, none of the other descriptions in Evidence A No. 1 indicates the forming of a film with polyester composition A or takes this as a given. Based on these findings, the court concluded that a "white polyester film made with polyester composition A" cannot be regarded as a matter that is implicitly described in Evidence A No. 1.

A majority of the members agreed with the first court decision, stating that since polyester composition A of Example 12 in Evidence A No. 1 is an intermediate composition generated in the process to obtain polyester composition B with which a film is to be formed, a film made with polyester composition A, which is an intermediate, cannot be regarded as a matter that is described or implicitly described in that evidence.

With regard to the experiment described in the certified experiment results (Evidence A No. 10), almost all members agreed that an experiment should be permitted in order to confirm the unspecified parameters (the product characteristics), but only if it is conducted by reproducing all conditions faithfully.

Some members commented that in this case, Example 12 in Evidence A No. 1 does not describe any specific conditions for polycondensation reaction, and therefore it may not be appropriate for the party who submits the certified experiment results (the demandant of a trial for invalidation) to conduct an experiment under the conditions that could bring about favorable results for that party. Others commented that an experiment should be permitted if it is conducted by applying some combinations of general conditions in light of the common general technical knowledge at that time, and if it shows that it is possible to produce a product that meets the numerical range specified by the claimed invention under all combinations of conditions.

A majority of the members agreed that the experiment in this case should have been conducted not for polyester composition A, which is an intermediate, but for polyester composition B, with which a film is formed in Example 12 in Evidence A No. 1.

(2) Determination of the matters implicitly described in the cited document (Evidence A No. 5 Invention)

Example 4 in Evidence A No. 5 does not specify any conditions for polymerization applied in the production of a polyester composition (e.g. reaction temperature, reaction time, etc.). Both the plaintiff and the defendant conducted experiments by respectively setting conditions for polymerization and submitted certified experiment results regarding Example 4 in Evidence A No. 5. In these experiments, they applied different parameters (values of Tcc-Tg) to produce the polyester composition. Based on the certified experiment results, both the JPO and the court (in the second trial decision and the second court decision) denied the reproducibility of the

experiment as described in Evidence A No. 11 in that the plaintiff reproduced Example 4 in Evidence A No. 5, and determined that it is impossible to confirm, from this experiment, that the polyester composition of Example 4 in Evidence A No. 5 meets the feature of the invention 1 ($30 \leq T_{cc} - T_g \leq 60$).

A majority of the members agreed with the JPO and the court (the second trial decision and the second court decision) in that the experiment described in Evidence A No. 11 cannot be regarded as the reproduction of Example 4 in Evidence A No. 5.

In the second trial decision, the JPO determined as follows: even where the part of the structure that specifies the invention (the value of $T_{cc} - T_g$) is not explicitly described and this specific part of the feature cannot be clearly understood even by taking into consideration the common general technical knowledge of a person skilled in the art, if it is possible to confirm this specific part of the feature by conducting an experiment and producing the product, the invention, including the description in the publication as well as its attributes that can be confirmed by reproducing the example through an experiment, may be assessed as an "invention described in a publication." None of the members expressed an objection to this determination.

However, some members commented that it is necessary, as a prerequisite, to conduct an experiment by reproducing the example faithfully, and that if the party who submits a certified experiment results (the plaintiff) conducted an experiment by selecting conditions that are favorable to that party with regard to undisclosed conditions, such an arbitrary experiment cannot be regarded as an experiment that reproduces the example.

Case 7: Patent – Chemistry 2

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2012-3397 (Patent Application No. 2004-316960) (May 28, 2013: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Mar. 25, 2014 2013 (Gyo-Ke) 10199 (JPO appeal decision maintained)
Title of Invention	Polymer compound, photoresist composition containing such polymer compound, and method for forming resist pattern
Major Issues	The Patent Act Article 29-2 (secret prior art)
Points	Degree of disclosure in the description of an earlier application (disclosure of invention related to chemical substances)

1. Outline of the case

This is a revocation action against an appeal decision of the JPO which dismissed an appeal against an examiner's decision of refusal. The claimed invention (the "Invention") is related to a "polymer compound, photoresist composition containing such polymer compound, and method for forming resist pattern." In the appeal decision, the JPO maintained an examiner's decision of refusal by determining that the Invention was identical with the invention stated in the description of an earlier application and thus could not be patented pursuant to the provisions of the Patent Act Article 29-2. In response to this, the appellant for the appeal (applicant) made a revocation action against an appeal decision alleging that there were errors in the JPO's finding of the invention stated in the description of the earlier application. However, the court dismissed the plaintiff's request by finding that there were no errors in the JPO's finding of the invention stated in the description of the earlier application.

2. Major issues discussed

(1) Issue 1 (Degree of disclosure of the invention related to chemical substances)

It was disputed whether or not the relevant application may be deemed as the earlier application prescribed in the Patent Act Article 29-2. There was no particular objection regarding the fact that the following three requirements must be satisfied in order to find that an invention related to chemical substances is stated as the earlier application prescribed in the Article: [i] the chemical substance per se can be confirmed; [ii] the relevant chemical substance can be manufactured based on the statements in the document and common general technical knowledge; and [iii] the usefulness of the chemical substance is disclosed in the document.

(A) Disclosure of chemical substances

While the compound per se is not specifically disclosed in this case, the final compound which is the subject of this case can be recognized from formulas (1) and (B) stated in the

earlier application. Thus, almost all members of the Study Group agreed that the appeal decision finding that it is equivalent as if the compound per se is stated from the overall description is reasonable.

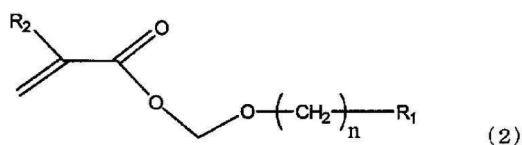
(B) Disclosure of the method of producing

The members agreed that when the method of producing is indicated as a scheme as in this case, even if the reaction condition is not disclosed precisely, if there is a statement sufficient for a person ordinarily skilled in the art to achieve such production, it may be considered that the method of producing has been disclosed.

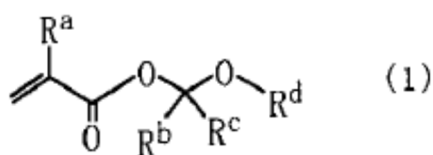
(C) Usefulness

The members agreed that, while a mere description which reads "is useful" gives rise to doubts about the usefulness, taking into account the description including the embodiments, etc. shown in the description of the earlier application, the determination finding that the usefulness of the invention is disclosed is reasonable.

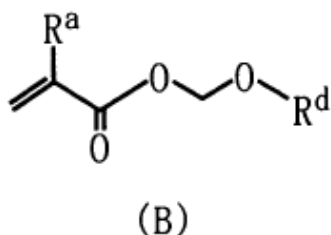
Compound stated in the claims of the present application



Formula (1) stated in the description of the earlier application



Formula (B) stated in the description of the earlier application



Case 8: Patent – Chemistry 3

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2009-22198 (Patent Application No. 2000-124470) (Dec. 25, 2012: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jan. 29, 2014 2013 (Gyo-Ke) 10039 (JPO appeal decision maintained)
Title of Invention	Interlayer membrane for laminated glass and laminated glass
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding of the cited invention and identical features

1. Outline of the case

This is a revocation action against an appeal decision of the JPO which dismissed an appeal against an examiner's decision of refusal. The claimed invention (the "Invention") is related to an "interlayer membrane for laminated glass and laminated glass." In the appeal decision, the JPO maintained an examiner's decision of refusal by determining that the Invention cannot be patented pursuant to the provisions of the Patent Act Article 29 (2) (inventive step). In response to this, the appellant for the appeal (plaintiff) made a revocation action against an appeal decision alleging that there were "errors in the finding of identical features and the overlooking of the difference" (reasons for revocation 1) and "errors in the determination on whether or not a person ordinarily skilled in the art could have easily conceived of the difference" (reasons for revocation 2) in the appeal decision. However, in the court decision, the court dismissed the plaintiff's request by finding that, while there were inappropriate points in the JPO's finding of the cited invention, there are no errors in the finding of the identical features as a conclusion in the appeal decision, and thus all of the reasons for revocation lack legal basis.

2. Major issues discussed

(1) Issue 1 (errors in the finding of the identical features between the Invention and Publication 1 Invention and the overlooking of the difference between them)

A. About holding that the "functional superfine particle" that constitute Publication 1 Invention should be found to be "ATO (conductive antimony- containing tin oxide) superfine particles"

In the court decision, the court held as follows: "In the appeal decision, the JPO found that Publication 1 Invention is an interlayer membrane for laminated glass comprising 'a resin made by adding polyvinyl butyral resin to 3GH of polyether ester which is a plasticizer' based on the statements in embodiment 2 contained in Publication 1. Thus, instead of the 'functional superfine particles comprising various oxides such as SnO₂ [...] and compounds such as 9wt%Sb₂O₃-

SnO₂(ATO) [...] that cover a wide range of functional superfine particles as found in the appeal decision, the 'functional superfine articles' constituting Publication 1 Invention should have appropriately been found as the 'ATO (conductive antimony-containing tin oxide) superfine particles' used in embodiment 2 and included in such wide range. Thus, in this regard, the finding of Publication 1 Invention in the appeal decision is inappropriate."

As a result of the discussion, the members agreed that the contents held in the court decision that, since the JPO found Publication 1 Invention based on the specific structure of embodiment 2, the JPO should have found the "functional superfine particles" of Publication 1 Invention based on embodiment 2 instead of finding them to be those covering a wide range of functional superfine particles and containing various oxides and compounds, was reasonable.

B. About holding that, with respect to the "functional superfine particles" constituting Publication 1 Invention, it has not been disclosed to the extent that every "functional superfine particle" found in the JPO appeal decision provides thermal insulation performance in Publication 1

In the appeal decision, the JPO first found that the "functional superfine particles" can be regarded as the "functional superfine particles" comprising "various oxides" such as "SnO₂," etc. and "compounds" such as "9wt%Sb₂O₃-SnO₂(ATO)," etc. and also found that these "functional superfine particles" provide "thermal insulation performance" in light of the statements in paragraph [0032] of Publication 1 which read "to have them provide performances such as thermal insulation performance, ultra-violet shielding performance, coloring property, light blocking effect, etc. as simple materials, compounds, mixtures or coating films as appropriate and to have them provide various functions and performances required of buildings and vehicles as laminated glass." In contrast, in the court decision, the court held as follows: "according to the statements in paragraphs [0032] and [0033] of Publication 1, the abovementioned various types of functional superfine particles found in the appeal decision 'provide performances such as thermal insulation performance, ultra-violet shielding performance, coloring property, light blocking effect, etc. as appropriate.' It cannot be found that it has been disclosed in Publication 1 to the extent that every such particle provides 'thermal insulation performance.' Therefore, the finding of Publication 1 Invention made in the appeal decision was not appropriate in that the JPO found that the abovementioned various types of functional superfine particles 'provide thermal insulation performance.'"

As a result of the discussion, the members agreed that the contents held in the court decision were reasonable since it could not be recognized that all of the listed substances have "thermal insulation performance" from the statements in Publication 1. In addition, some members pointed

out that it would have been more reasonable to determine the relevant feature as the difference between the Invention and Publication 1 Invention, instead of forcefully finding it as the identical feature between the two inventions, as in the appeal decision and thereby hold that the two inventions do not substantially differ.

C. About holding that the appeal decision was not erroneous in its conclusion in finding that the Invention and Publication 1 Invention share the feature of containing "metal oxide particles with heat ray cutting function"

In the court decision, the court held as follows: "According to [...] the statements in Publication 3, [...] it can be found that the 'ATO (conductive antimony-containing tin oxide) superfine particles' used in embodiment 2 contained in Publication 1 have a 'heat ray cutting function.' [...] The JPO has not erred in finding that the Invention and Publication 1 Invention share the feature of containing 'metal oxide particles with heat ray cutting function' in its conclusion."

Some members pointed out that since the JPO did not cite Publication 3 as the grounds for finding that "ATO" is a metal oxide particle with "heat ray cutting function," the court decision and the JPO appeal decision differ in terms of the logical composition. In addition, some members pointed out that, if any new difference which has not been discussed in the appeal decision is found between the cited invention and the Invention, the appeal decision might be revoked. However, as a result of the discussion, the members agreed that the contents held in the court decision are reasonable, in light of the following pointed out that: [i] the JPO has indicated the parts of the statements in Publication 3 which disclosed that "ATO" has a "heat ray cutting function"; [ii] it is obvious that "ATO" has a "heat ray cutting function"; and [iii] even if the appeal decision is revoked in this regard, the conclusion of lack of inventive step is unlikely to be changed.

Case 9: Patent – Medicine and Food 1

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800145 (Patent No. 3530247) (Aug. 27, 2013: trial decision to maintain the patent; revoked) (Sep. 14, 2015: trial decision to invalidate; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Nov. 10, 2014 2013 (Gyo-Ke) 10271 (JPO trial decision revoked)
Title of Invention	Taste Improver for Alcoholic Beverage and Method Thereof
Major Issues	The Patent Act Article 36 (4) (i) (enablement requirement)
Points	The enablement requirement in the case where the meaning of the terms stated in the object of the invention is unclear

1. Outline of the case

This is a revocation action against a trial decision of the JPO which dismissed a request for a trial for patent invalidation (and which maintain the patent). The title of the invention in question (the "Invention") is a "Taste Improver for Alcoholic Beverage and Method Thereof." In the trial decision, the JPO rejected the request for correction and also determined that there was no violation of the enablement requirement and support requirement and denied the reasons for invalidation based on lack of inventive steps as a result of the proceedings for the patented invention prior to the correction. In response to a revocation action against a trial decision by the demandant (plaintiff) for the trial for patent invalidation, the court revoked the trial decision by determining that the reasons for revocation based on violation of the enablement requirement were well-grounded (the enablement requirement is not met) without the need to determine the reasons for revocation based on violation of the support requirement and lack of inventive steps.

2. Major issues discussed

(1) Issue 1 (determination on the enablement requirement in relation to the "terms")

With respect to the two sensory terms ("burning sensation" and "light taste"), the JPO found that the meaning of the two terms were clear. However, the court found that, while the term "burning sensation" was clear, the term "light taste" was not clear, and thus, the reasons for revocation based on violation of the enablement requirement are well-grounded. The members discussed the appropriateness of such finding made by the court.

Most of the members were of the opinion that the determinations made by the JPO and the court to find the meaning of the term "burning sensation" to be clear were reasonable. Yet, some members raised questions about using the term "burning sensation," which is not necessarily a common term, in the statements of the description without giving a clear definition. With respect to the plaintiff's allegation based on the description in an English-Japanese dictionary, some

members were of the opinion that there is a valid point in the allegation stating that the two terms "burning sensation" and "feeling of burning" do not have the same meaning since the sensation which is felt when alcohol slides down one's throat differs depending on the type of alcohol consumed or the person who drinks it. However, most of the members were of the opinion that it is a common practice to determine the two terms to have the same meaning based on the meaning described in the dictionary unless the terms are defined in the patent description.

With respect to the term "light taste," the court decision was more logical and none of the members directly raised critical opinions. Yet, several members stated that, from the standpoint of applicants, the conclusion presented in the court decision was too harsh and the interpretation of the description made in the trial decision was more understandable. In addition, some expressed that the statements in the description in question were insufficient to recognize whether the term "taste" meant the taste or scent and to understand how the term "taste" was connected to the sensory assessment stated in the description. Meanwhile, some suggested that the meaning of the term "light" could not be interpreted, thereby redundantly making it difficult to provide relief regarding the clarity of the term.

(2) Issue 2 (determination on the enablement requirement and support requirement in relation to the "additive amount of sucralose and trial-and-error process")

The members discussed the appropriateness of finding that the determination made by the JPO in the trial decision that a person ordinarily skilled in the art can decide the additive amount of sucralose in relation to a wide variety of alcoholic beverages based on the statements in the description in question was erroneous.

Some members expressed that it is questionable as to whether or not the burning sensation can be restrained depending on the alcohol concentration and thus the enablement requirement is not met. On the other hand, some members were of the opinion that, even if only two embodiments were presented, there should be no problem if the representative examples were presented.

Case 10: Patent – Medicine and Food 2

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2012-9689 (Patent Application No. 2000-563262) (Jun. 11, 2014: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jul. 30, 2015 2014 (Gyo-Ke) 10233 (JPO appeal decision maintained)
Title of Invention	Phosphatidylcholine as a medicament for the protection of mucosa
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding of the cited invention (in the case where the cited document discloses the experimental results of an experimental animal model), finding of different features, determination on different features

1. Outline of the case

This is a revocation action against a decision of the JPO which dismissed an appeal against an examiner's decision of refusal. The claimed invention (the "Invention") is a medicinal invention titled "phosphatidylcholine as a medicament for the protection of mucosa." In the appeal decision, the JPO found the cited invention based on the scientific paper written in English, which disclosed the experimental results of an experimental animal model, and determined that the Invention lacked an inventive step. The court held that although the JPO erred in finding the cited invention and the different features, its determination on the different features was not substantially erroneous. In conclusion, the court ruled that the Invention lacked an inventive step and dismissed the request by the plaintiff (the appellant of the appeal).

2. Major issues discussed

(1) Issue 1 (the JPO's finding of the cited invention)

The members discussed the JPO's finding of the cited invention, with a focus on whether it was appropriate for the JPO to make a finding by interpreting the concept of "acetic-acid-induced colitis model using a rat" (specific concept) as extending to "colitis model" (generic concept including humans).

Some members pointed out that the JPO gave no reason why it interpreted Publication 1 as describing an invention expressed with a generic concept (extending to humans) although the publication actually described only the experimental results using a rat, and that an invention must not be interpreted as such without reason. In response to this opinion, others commented that: the JPO might have adopted such broad interpretation because an experiment using an animal model is supposed to be applied to humans; if a publication provides data of an experiment using a rat in the experimental result paragraph, but the discussion in its consideration paragraph is not limited to the case of a rat, it may be possible to derive an invention of a general concept from the

invention described in that publication. On the other hand, some members commented that an animal model is used to predict a therapeutic effect for humans through extrapolation of the effect obtained from the animal model, and that it is unrealistic to extend the result of the invention using a rat to humans despite the difference in the metabolic system between them. Others commented that: if an "acetic acid-induced colitis model using a rat" has been established as a disease model of "colitis," it may be possible to find an invention by interpreting the generic concept; however, since the issue of this case is whether or not the model described in the publication is an appropriate disease model of "colitis," the court decision is more proper for having found the cited invention by interpreting the specific concept.

(2) Issue 2 (the court's determination on different feature 1)

The members discussed different feature 1 found by the court between the Invention and the cited invention ("while the Invention relates to 'medication' that contains phosphatidylcholine 'at a concentration effective in treating a disease,' the cited invention relates to a 'medical agent' that contains phosphatidylcholine 'in an amount effective in repairing colonic mucosal damage in an acetic acid-induced colitis model using a rat' "). More specifically, the court held that: it would have been easy for a person skilled in the art to apply the model using a rat in the cited invention to humans, and to apply the acetic acid-induced colitis model in the cited invention to naturally occurring colitis; and it would have also been easy for a person skilled in the art to set a concentration [of phosphatidylcholine] effective in treating a disease based on the cited invention.

With regard to the court's decision that denied an inventive step of a medicinal invention based on the experimental result using an animal, some members commented that the reactivity to a medical agent may differ depending on the animal species, so it cannot be generalized as a theory applicable to all animals. Others commented that: if Publication 1 were a patent document, it might describe the application to humans, but it actually is a scientific paper written only in relation to an animal experiment, and it would not necessarily make any mention of humans; Yet, since medical studies are in essence carried out in anticipation of the application to humans, it is reasonable for the court to reach the conclusion as stated in its court decision. Another commented that, in basic practice, it is appropriate to apply the results of an animal experiment to humans, and if there is any hardship in the process of applying the case of animals to humans and an invention can solve the hardship, there may be possibility that such invention would be recognized as involving an inventive step if the solution is described as a matter used to specify the invention.

(3) Issue 3 (determination on different feature 2 in the JPO appeal decision and the court decision)

With regard to different feature 2 ("while in the Invention, phosphatidylcholine is contained

in a 'pH-dependent delayed-release form,' the cited invention is not specified as such"), both the JPO and the court determined that a person skilled in the art would have easily conceived of different feature 2, on the grounds that it is well known among persons skilled in the art to use a colonic inflammation reducing agent in the form of a pH-dependent delayed-released oral drug dissolved in the colitis.

Some members commented that the determination by the JPO and the court on this issue is a common approach when refusing inventions of medicine relating to enteric coating drugs. No further comment was given in response to this comment.

Case 11: Patent – Medicine and Food 3

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2012-20646 (Patent Application No. 2007-531272) (Oct. 27, 2014: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Mar. 31, 2016 2015 (Gyo-Ke) 10052 (JPO appeal decision maintained)
Title of Invention	Treatment of diseases using nalmefene and its analog
Major Issues	The Patent Act Article 36 (6) (i) and 36 (4) (i) (support requirement and enablement requirement)
Points	Descriptions required to meet the support requirement and enablement requirement in the case of an invention of medicinal use

1. Outline of the case

This is a revocation action against an appeal decision of the JPO, which dismissed an appeal against an examiner's decision of refusal. The claimed invention (the "Invention") is an invention of medicinal use titled "treatment of diseases using nalmefene and its analog." In the appeal decision, the JPO determined that the Invention was unpatentable due to the lack of novelty and the description requirements (support requirement and enablement requirement). The court held that there was no error in the JPO appeal decision regarding the description requirements (support requirement and enablement requirement), and dismissed the request of the plaintiff (the applicant for a patent).

2. Major issues discussed

(1) Issue 1 (appropriateness of the approach employed by the court for determining the description requirements)

The court determined that the description does not contain any objective proof of the effectiveness of a "compound of the formula R-A-X" as medication for preventing or treating viral infections, selected from hepatitis B," and in that case, it is inappropriate to take into consideration any pharmacological test results, etc. submitted after the filing of a patent application. The members discussed the appropriateness of this determination.

The members also discussed whether or not it is appropriate to determine pharmacological test results of a compound submitted after the filing of a patent application in the cases where the pharmacological test results have been disclosed in the description or where only the theoretical grounds have been disclosed in the description.

A. About the court decision

The members commented that the applicant has no choice but to accept the refusal of the belated submission of pharmacological test results because the description does not disclose

anything about the actual pharmacological effect of the invention, that it is understandable for the court to have rejected the belated submission in this case, etc. Thus, the members agreed that the determination by the court in the court decision was appropriate.

B. Cases where pharmacological test results or theoretical grounds of a compound have been disclosed in the description

Some members commented that if a claimed invention does not exceed the scope of disclosure which a person skilled in the art would have been able to recognize that the "problem to be solved by the invention can be solved," based on the pharmacological test results or theoretical grounds disclosed in the description and the common general technical knowledge available at the time of the filing of the application, it may be permissible for the applicant to submit the pharmacological test results after the filing. The members agreed that this approach is consistent with the current examination standards and it is appropriate.

(2) Issue 2 (Appropriateness of the court's determination on the description requirements)

The court determined that in order to recognize that a compound has an effect as "medication for preventing or treating viral infections, selected from hepatitis B," the compound must be described in a manner that a person skilled in the art could have understood that it has an anti-proliferative effect on hepatitis B virus in the living human or animal body. The members discussed whether this determination is appropriate.

In addition, although the court did not explicitly rule on how to determine the description requirements if, in the case of an invention of a new medicinal use of a "compound of the formula R-A-X," the applicant submits pharmacological test results using a publicly known compound that is similar to a "compound of the formula R-A-X" in terms of the chemical structure but is not included in the scope of a "compound of the formula R-A-X," the members discussed this point as well, taking into account the arguments of the plaintiff and the defendant.

A. About the court decision

The court stated that the "compound must be described in a manner that a person skilled in the art could have understood that it has an anti-proliferative effect on hepatitis B virus." On this point, some members commented that it would be sufficient for a person skilled in the art to be able to understand that the compound can be used to prevent or treat a symptom caused by hepatitis B virus, and they raised a question as to whether it is always necessary for a person skilled in the art to be able to understand that the compound has an anti-proliferative effect. In response, others commented as follows: in the case of hepatitis B where there are needs for means

to prevent or treat not only "developments" but also "infections" of the disease (needs for prevention or treatment of asymptomatic hepatitis B carrier); claim 1 described the Invention as medication for preventing or treating "viral infections, selected from hepatitis B," instead of "preventing or treating hepatitis B," and this may be the reason for the court's determination mentioned above.

B. Cases where pharmacological test results of a compound with a similar chemical structure have been submitted

The members agreed that, in this case, the defendant provided grounds (Evidence A No. 1-3) that proves nalmefene (a compound that falls within the scope of claims "compound of the formula R-A-X" described in the application) and naltrexone (a compound that does not fall within the scope of claims "compound of the formula R-A-X") have similar chemical structures, but the results of their pharmacological test results could significantly differ, and hence, it would be difficult for the plaintiff (the applicant) to resolve the description requirements only by submitting pharmacological test results on naltrexone, which is a similar compound to nalmefene.

However, they further agreed that, in general terms, if pharmacological test results on a similar compound have been submitted, and the compound of the Invention can be expected to have the equal effect as that compound based on the common general technical knowledge (if a claimed invention does not exceed the scope of disclosure which a person skilled in the art would have been able to recognize that the "problem to be solved by the invention can be solved"), the description requirements would be resolved.

Case 12: Patent – Electricity 1

JPO Docket Number	Trial for invalidation Invalidation No. 2012-800143 (Patent No. 3477995) (Apr. 26, 2013: trial decision to maintain the patent; trial decision revoked) (Sep. 30, 2014: trial decision to invalidate the patent; trial decision revoked) (Dec. 17, 2015: trial decision to maintain the patent; final and binding)
Date of Court Decisions Court Docket Number	Court decision of the IP High Court, Dec. 24, 2013 (the first court decision) 2013 (Gyo-Ke) 10154 (JPO trial decision revoked) Court decision of the IP High Court, Jun. 30, 2015 (the second court decision) 2014 (Gyo-Ke) 10236 (JPO trial decision revoked)
Title of Invention	Pointer device for vehicle
Major Issues	The Patent Act Article 29 (2) (inventive step; the easiness of conceiving) and the Patent Act Article 126 (5) (requirements of correction; addition of a new matter)
Points	Determination of well-known art and its application; determination of technical significance of invention

1. Outline of the case

This case relates to invalidation of a patent for an invention titled "pointer device for vehicle." In the first trial decision, the JPO dismissed the request for trial, finding that the Invention could not have been easily conceived of by a person ordinarily skilled in the art based on the combination of the cited invention, well-known art, publicly-known art and common general technical knowledge. In a revocation action against a trial decision of the JPO, the court rendered the first court decision revoking the first trial decision, finding that the reason for revocation as alleged by the plaintiff (demandant of the trial) was well-grounded, as the trial decision contained an error in the determination of whether the invention could have been easily conceived of by a person ordinarily skilled in the art. In the second trial proceedings, the JPO rendered the Secondary Trial Decision granting a part of the requests for correction and invalidating the patent, finding that the corrected invention could have been easily conceived of by a person ordinarily skilled in the art based on the combination of the Cited Invention, well-known art and publicly-known art (trial decision to invalidate the patent). In a revocation action against a trial decision of the JPO, the court rendered the second court decision revoking the second trial decision, finding that the reason for revocation as alleged by the plaintiff (patentee) was well-grounded, as the second trial decision contained an error in dismissing a part of the requests for correction, and the corrected invention could not have been easily conceived of by a person ordinarily skilled in the

art.

2. Major issues discussed

(1) Issue 1: Application of well-known art 1 to cited invention 1 in the first trial decision and the first court decision

An issue was discussed in relation to the findings of the technical significance of the patented invention and well-known art 1. The members discussed which is more appropriate, the finding in the first trial decision that the inventions have different features from the aspect of whether the target of visibility is specified or not specified, or the finding in the first court decision that these have a common feature in terms of positive psychological effect. Some members commented that the first trial decision is too confined to the literal interpretation of the "novel visibility " effect, while others commented that the visibility of the speedometer is not an essential element as the invention relates to the brightness of a speedometer after the passengers leave the vehicle, and to this extent, does not require any special attention different from an interior lamp or key cylinder that are well-known art. A majority of the members determined the first court decision to be more appropriate, as the court found that these inventions have a common feature on the point that the invention is meant to have "some positive psychological effect" through fade-out of lighting.

(2) Issue 2: Obstructing factor for applying well-known art 1 to cited invention

The members also discussed which is more appropriate, the finding in the first trial decision that "the cited invention relates to a device by which light is 'immediately' turned off," or the finding in the first court decision that "the cited invention relates to a device by which light is not necessary 'immediately' turned off." Some members commented that the cited invention shall only aim at hiding the indicator panel and the problem to be solved by the cited invention was the elimination of a sense of discomfort, and did not disclose the timing element of turning off the light. A majority of the members supported the finding of the first court decision that the cited invention did not contain any element requiring the light to be "immediately" turned off.

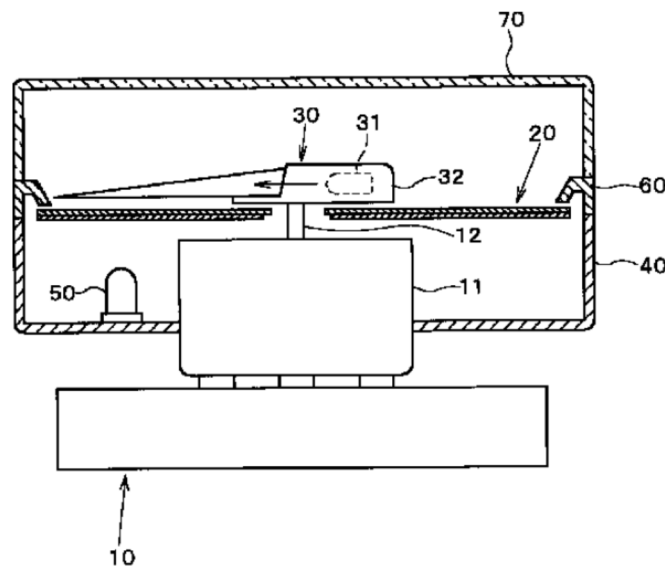
(3) Issue 3: Legality of the request for correction in the second trial decision and the secondary court decision

For the issue of whether correction (a) of correction 1 is a new matter, the member discussed which of the findings, the second trial decision or the secondary court decision, is more appropriate. A majority of the members supported the finding of the secondary court decision that correction (a) is a technical matter derived from the combination of description of the description,

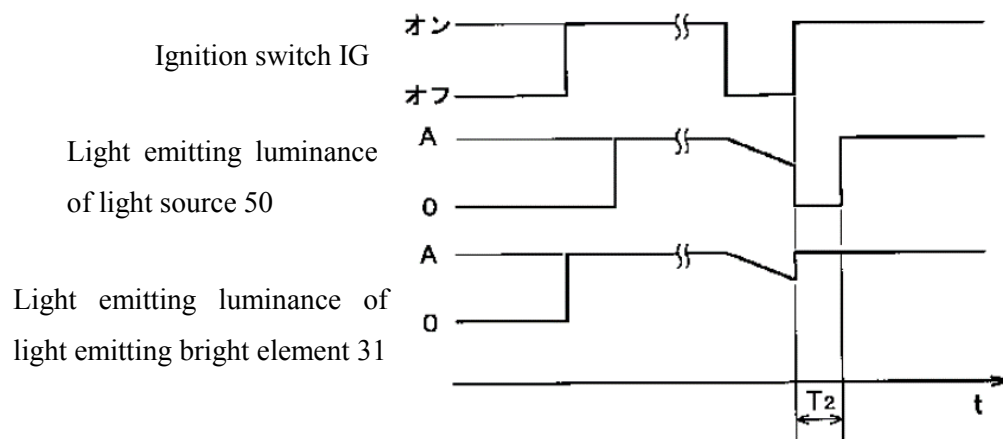
etc. (in particular, an auxiliary line of the ignition switch of figure 6 and paragraph [0021]) and therefore is not an addition of a new matter. Meanwhile, a member commented that an indicator lighting means and a scale panel lighting means should be specified as indivisible inventions and therefore the correction is an addition of a new matter.

(4) Issue 4: the easiness of conceiving of the second trial decision and second court decision as to whether corrected invention 2

Regarding the easiness of conceiving of the corrected invention 2, the members discussed which of the findings, the second trial decision or the second court decision, is more appropriate. A majority of the members supported the finding of the second court decision that it could not have been easily conceived of by a person ordinarily skilled in the art, as it is difficult to find that well-known art 2 discloses a technical matter in which brightness is declined to zero from the fade-out state only in relation to a scale panel lighting means, and the form is different between a cited invention, which is given by applying well-known art 1 to the cited invention, and well-known art 2.



Patented Invention (FIG. 1)



Patented Invention (FIG. 6)

Case 13: Patent – Electricity 2

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2013-6730 (Patent Application No. 2010-527017) (Jun. 10, 2014: appeal decision to maintain the refusal; appeal decision revoked) (Feb. 22, 2016: appeal decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jul. 16, 2015 2014 (Gyo-Ke) 10232 (JPO appeal decision revoked)
Title of Invention	Multi-touch device with a dynamic haptic effect
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding of the cited invention (finding based on an inappropriate Japanese translation of a foreign-language patent gazette), finding of a different feature, and determination concerning the easiness of conceiving of the different feature

1. Outline of the case

This is a revocation action case against an appeal decision of the JPO that dismissed an appeal against an examiner's decision of refusal. The claimed invention titled "multi-touch device with a dynamic haptic effect" relates to an international application (under PCT) (International Publication Number WO2009/042424).

In the appeal decision, the JPO determined that the claimed invention could have been easily conceived of by a person ordinarily skilled in the art based on the cited invention described in the international application published under the PCT in English language (Evidence A No. 1) (International Publication Number WO2006/042309) and well-known art. The JPO held that the appeal against an examiner's decision of refusal filed by the applicant was groundless since a patent shall not be granted for the claimed invention based on the Patent Act Article 29, paragraph (2).

The applicant, who is also an appellant for the appeal against an examiner's decision of refusal, made a revocation action against an appeal decision with the Intellectual Property High Court, as a plaintiff. The court held that translation of the Japanese gazette (Evidence A No. 2) which corresponds to the English gazette (Evidence A No. 1) was inappropriate, but not erroneous in the finding of the cited invention in the JPO appeal decision. However, the court found that the JPO overlooked a different feature between the claimed invention and the cited invention, and erred in determination of an inventive step in relation to another correctly found different feature, and ruled that the reasons for revocation of the JPO appeal decision claimed by the plaintiff are well-grounded. Accordingly, the court revoked the JPO appeal decision by the court decision on this case.

2. Major issues discussed

(1) Issue 1: Finding of a cited invention described in the document in foreign language

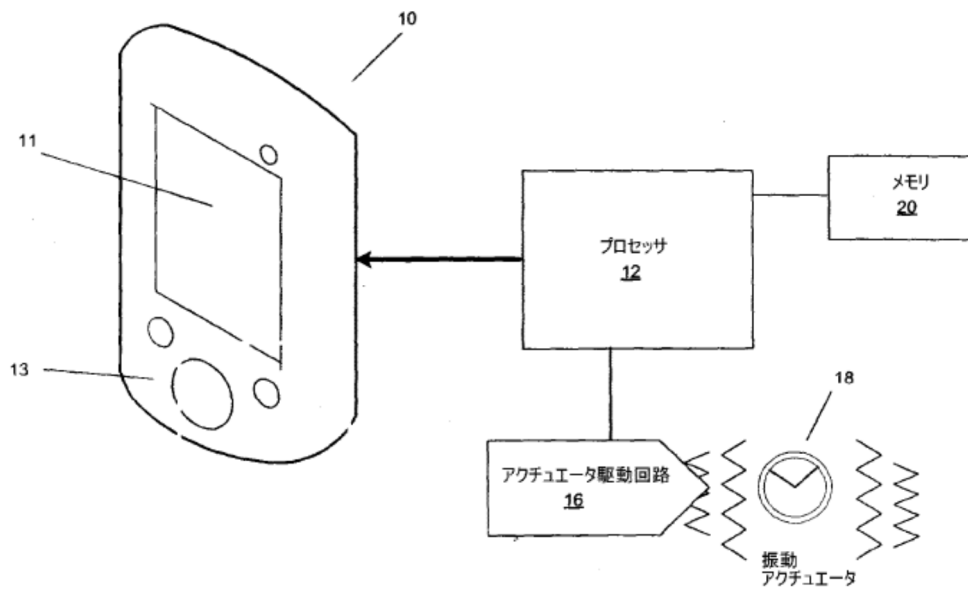
In the appeal decision, the JPO found a cited invention based on a description in the English gazette (Evidence A No. 1) that reads "In one embodiment, the process can be activated by a user who touches a touch-sensitive panel possibly in a predetermined location or locations," by referring to the translation described in the Japanese gazette (Evidence A No. 2) which corresponds to the English gazette (Evidence A No. 1). The court ruled that, because the translation in the Japanese gazette can be understood as finding that a user simultaneously "touches" "multiple" parts of the sensor panel when activating the process, it was not appropriate to find the cited invention by referring to the translation as it is. On such basis, the court presented an appropriate translation that more accurately expressed the finding in the JPO appeal decision. The members discussed whether the act of the court to present such translation was appropriate.

With regard to this point, the majority of members held a view that, in light of the entire statements in the description of the cited invention, the translation in the Japanese gazette was erroneous, or at least, inappropriate, so it was appropriate for the court to present an appropriate translation. There was also a view stating that there was no need for the court to present an appropriate translation, because even if the translation was inappropriate, it was possible to properly construe the meaning in light of the entire statements in the description.

(2) Issue 2: Determination of the inventive step

In the appeal decision, the JPO stated that the cited invention did not disclose that a user simultaneously "touches" "multiple" parts (multi-touch). However, the JPO mentioned that a person ordinarily skilled in the art could easily conceive of applying the multi-touch to the cited invention since the multi-touch was well-known art. In contrast, the court held that the cited invention merely described that there were "multiple" parts that could be touched, so it was not suggested that a person ordinarily skilled in the art could link the cited invention with the multi-touch. The members examined which was appropriate, the JPO's determination or the court's determination.

Regarding this point, many members indicated that even if the multi-touch was well-known art, it would not be immediately linked with the "dynamic haptic effect" of the claimed invention. However, it was also indicated that some limitations may be necessary in order for involvement of an inventive step to be found. Proposed limitations included, for example, further subdividing the "dynamic haptic effect," or adding a limitative constitution that takes such effects into consideration.



12: Processor, 20: Memory, 16: Actuator drive circuit,
18: Vibration actuator

Claimed Invention (FIG. 1)

Case 14: Patent – Electricity 3

JPO Docket Number	Trial for invalidation Invalidation No. 2011-800222 (Patent No. 3401228) (Sep. 3, 2013: trial decision to invalidate the patent; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Sep. 11, 2014 2013 (Gyo-Ke) 10276 (JPO trial decision maintained)
Title of Invention	Point total management system
Major Issues	The Patent Act Article 29 (2) (inventive step)
Points	Finding of the different features, determination on easiness of conceiving of the different features

1. Outline of the case

This is a revocation action against a trial decision of the JPO that accepted a request for a trial for invalidation trial and invalidated the patent. The title of the patented invention is "point total management system." In the trial decision, the JPO determined that a patent shall not be granted for the invention under the Patent Act Article 29, paragraph (2) because it could have been easily made by a person ordinarily skilled in the art based on Evidence A No. 1 invention and well-known art. The demandee for the trial for invalidation (the plaintiff) who is also a patentee filed a revocation action against a trial decision. The court found that each of the reasons for revocation alleged by the plaintiff lacks legal basis, and dismissed the plaintiff's request.

2. Major issues discussed

(1) Issue 1: Finding of the patented invention ("exchange rate" and "adjustment rate")

While referring to the statements of the description and drawings of this case, the court determined that "it cannot adopt the plaintiff's allegation that the common points in the patented invention 1 are different from the "foreign currency exchange rate" in Evidence A No. 1 invention only because different terms, "exchange rate" and "adjustment rate," are used". The members discussed whether this determination by the court is appropriate because the description provides only an example of embodiment of the claimed invention. Almost all members agreed that the court made an appropriate determination on this issue. However, some members commented that, in consideration of the fact that, in the scope of claims, the "exchange rate" is described in association with the "first client" and the "adjustment rate" is described in association with the "second client" respectively, the court might have determined this point as a different feature taking into account the plaintiff's allegation. Others commented that if Evidence A No. 1 invention is regarded as representing only a structure that uses equal rates, the patented invention 1 can be considered to include both a structure that uses equal rates and a structure that uses different rates.

(2) Issue 2: Determination of comparison between the patented invention and the cited invention (comparison between "common points" and "cyber money")

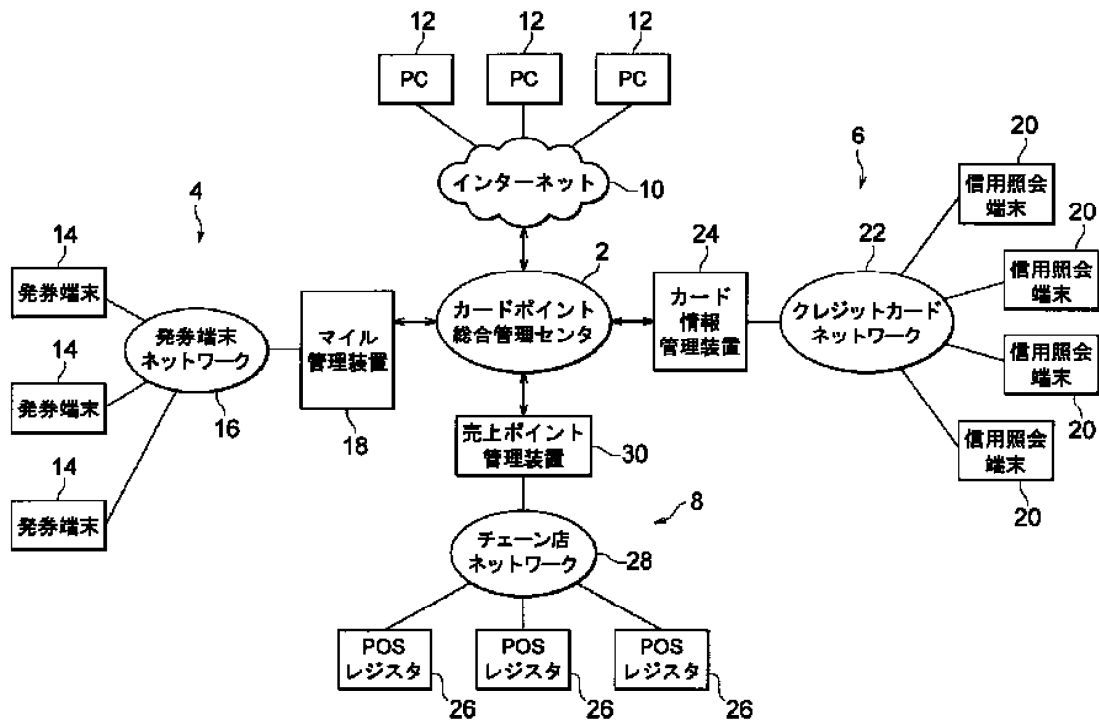
The court determined that "cyber money" in Evidence A No. 1 invention is equivalent to the "common points" in the patented invention 1. The members discussed whether the court's determination on this point is appropriate, and if it is appropriate, whether the real currencies such as cash and bank deposits, instead of virtual currency such as "cyber money," could be deemed to be equivalent to the "common points" in the patented invention 1 because of performing the same function. Almost all members agreed that the court's determination, that "cyber money" and "common points" shall be the same, is appropriate for the following reasons. Despite the difference in the terms used, "cyber money" in Evidence A No. 1 invention and the "common points" in the patented invention 1 shared the function as an intermediary for the exchange of points. The availability outside a system is nothing more than an attribute of an intermediary for the exchange of points. As pointed out in the court decision, even if "cyber money" in Evidence A No. 1 invention represents points that can be used outside a system, "this does not prevent cyber money from performing the same function as the common points."

(3) Issue 3: Well-knownness

The members discussed whether the court decision is appropriate in that it can be interpreted as meaning that being "famous companies" using the technology in question assures that said technology is well-known. Some members commented that Evidence A No. 2 and Evidence A No. 3 are somewhat insufficient as evidence for finding the technology in question to be well-known. Others commented that where the well-knownness of services is concerned, it is sufficient for the services to be provided by famous companies. There was another opinion that the subject matter of this case is well-known to the extent that it does not require any proof and should be described as a well-known matter or well-known services rather than well-known art, and in this respect, it is more like design matters. Those that expressed the latter opinion presumed that the court made a determination on this point merely for the purpose of rejecting the plaintiff's allegation.

The discussion also covered the court's ruling that the services in question "have been well-known among persons skilled in the art in Japan." Some members commented that while the "well-knownness" of a trademark, etc. is determined depending on whether the trademark is well-known in Japan, the geographical area where a patent is well-known has not been recognized as an issue. Others commented that the court limited the scope of persons ordinarily skilled in the

art to those "in Japan," seemingly because it considered this issue to be more concerned with well-knownness of services rather than well-knownness of technology.



2: Card point total management center, 10: Internet, 14: Ticket issuing terminal,
16: Ticket issuing terminal network, 18: Mile management device, 20: Credit authorization
terminal, 22: Credit card network, 24: Card data management device, 26: POS register,
28: Chain store network, 30: Sales point management device

Patented Invention (FIG. 1)

Case 15: Design 1

JPO Docket Number	Trial for invalidation Invalidation No. 2014-880015 (Design Registration No. 1492562) (Apr. 27, 2016: trial decision to invalidate; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Nov. 22, 2016 2016 (Gyo-Ke) 10138 (JPO trial decision maintained)
Article to which the design is applied	Slat for blinds
Major Issues	The Design Act Article 3 (2) (easiness of creation)
Points	Partial design, finding of the cited designs, determination on easiness of creation

1. Outline of the case

This is a revocation action against a trial decision of the JPO that accepted a request for a trial for invalidation and invalidated the design registration. In this registered design, the article to the design is a slat for blinds, and this design is registered as a partial design. The JPO rendered a trial decision to invalidate the design registration, ruling that the registered design is unregistrable under the Design Act Article 3 (2) because it could have been easily created by a person ordinarily skilled in the art based on the combination of the publicly known shapes including Cited Designs 1 to 7, etc. The design right holder who is a demandee filed a revocation action with the court against a trial decision of the JPO on the grounds that the JPO erred in finding the cited designs, erred in determining easiness of creation, etc. The court determined that the reasons for revocation alleged by the plaintiff (the design right holder) lack legal basis and there are no errors in the JPO trial decision. In conclusion, the court dismissed the plaintiff's request.

2. Major issues discussed

(1) Issue 1: appropriateness of division and subdivision of the respective designs into constitutive elements in determining easiness of creation

In determining easiness of creation of the registered design based on Cited Designs 1 to 5, both the JPO and the court determined that two elements shall be combined, one based on Cited Designs 1 and 2, and the other based on Cited Designs 3 to 5, and the members agreed that this determination is appropriate.

(2) Issue 2: appropriateness of how to combine the cited designs in determining easiness of creation

In determining easiness of creation, the demandant adopted Cited Design 1 or 2 as the main cited design and combined them with Cited Designs 3 to 5, whereas the JPO adopted Cited

Designs 3 to 5 as the main cited designs and combined them with Cited Designs 1 and 2. Despite such difference, the JPO's determination stated in the trial decision that adopted Cited Designs 3 to 5 as the main cited designs does not seem odd.

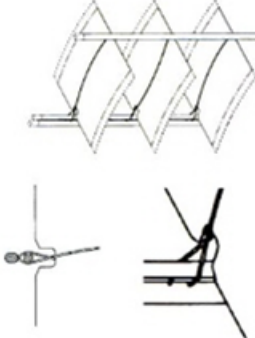


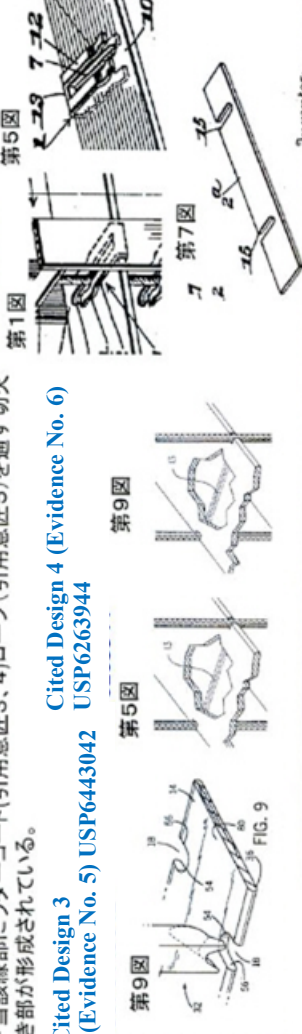
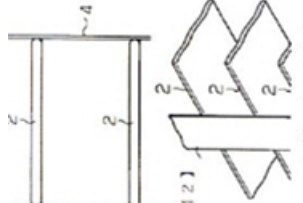
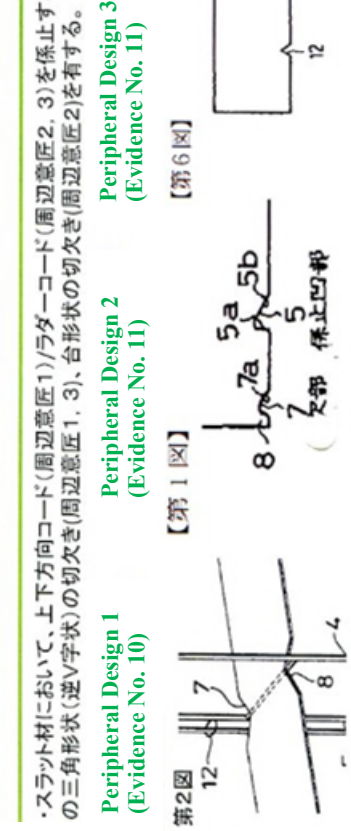
(3) Issue 3: appropriateness of the JPO's determination stated in the trial decision that denied creativity with regard to the position of the lower end of the guiding surface

Many members raised a concern about the JPO's trial decision that: "in the creation of a design, if there is no technical restriction, it can be acknowledged as extremely normal means performed for shaping process in the design of an industrial product and the like to simplify the whole shape by roughly matching a plurality of shape-change-points."

(4) Issue 4: appropriateness of the JPO's determination on the difference in terms of the angle of the slope

While some members pointed out that the JPO failed to give a sufficient explanation for its determination of the V-shape as a "the V-shaped notch regarded as a kind of a generally inverted V-shape", the members agreed that the court reasoned this point with suitable expressions to make up for the defects in the JPO's determination.

Reference 2: List of representative drawings of the cited designs and peripheral designs, submitted by the demandee

<p>Cited Design 1 (Evidence No. 3) Design Registration No. 1465235</p>  <p>◆基本的構成態様 (Ⅰ)切欠部において、昇降コードなどを中央の凹状収容部へガイドするための一对の収容ガイド面であり、 (Ⅱ)正面視において、逆ハの字状となるようにそれぞれ斜面が形成されている。</p> <p>◆具体的構成態様 (ⅰ)平面視は図示されておらず不明である。 (ⅱ)上記各斜面の角度は、引用意匠1は約30度、引用意匠2は約35度である。</p>	<p>Present Registered Design Design Registration No. 1492562</p>  <p>(2013. 3. 1)</p>
<p>Cited Design 2 (Evidence No. 4) JP Unexamined Pat. App. Pub. No. 2011-252265</p>  <p>切欠部 18a, 18b, 18c, 18d, 22a, 22b</p>	<p>Cited Design 3 (Evidence No. 5) USP6443042</p> <p>Cited Design 4 (Evidence No. 6) USP6263944</p> <p>Cited Design 5 (Evidence No. 7) USP2202752</p>  <p>第1図, 第5図, 第7図, 第9図</p> <p>・スラット材の短手方向の縁部が平面/底面側において丸みを帯びて形成されている。 ・当該縁部にラダーコード(引用意匠3、4)ロープ(引用意匠5)を通す切欠き部が形成されている。</p>
<p>Cited Design 6 (Evidence No. 8) JP Unexamined Pat. App. Pub. No. 2011-26804</p>  <p>【図2】</p> <p>・スラット材の短手方向の縁部が平面/底面側において丸みを帯びて形成されている。</p>	<p>Cited Design 7 (Evidence No. 9) JP Unexamined Pat. App. Pub. No. 1997-328975</p> <p>Peripheral Design 1 (Evidence No. 10)</p> <p>Peripheral Design 2 (Evidence No. 11)</p> <p>Peripheral Design 3 (Evidence No. 11)</p>  <p>【第1図】, 【第2図】, 【第6図】</p> <p>・スラット材において、上下方向コード(周辺意匠1)/ラダーコード(周辺意匠2、3)に係止するための三角形状(逆V字状)の切欠き(周辺意匠1、3)、台形状の切欠き(周辺意匠2)を有する。</p>

Case 16: Design 2

JPO Docket Number	Trial for invalidation Invalidation No. 2014-880018 (Design Registration No. 1509040) (Jun. 2, 2016: trial decision to invalidate; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jan. 11, 2017 2016 (Gyo-Ke) 10153 (JPO trial decision maintained)
Article to which the design is applied	Bucket
Major Issues	The Design Act Article 3 (1) (iii) (similarity of designs)
Points	Determination of similarity of designs (influence of the common features on the determination of similarity)

1. Outline of the case

This is a revocation action against a trial decision of the JPO that accepted a request for a trial for invalidation and invalidated the design registration. The article to the design is a bucket. The JPO rendered a trial decision to invalidate the design registration, ruling that the registered design is unregistrable under the Design Act Article 3 (1) (iii) due to its similarity to Cited Design 1. The design right holder who is a demandee filed a revocation action with the court against a trial decision of the JPO. The court determined that there are no errors in the JPO trial decision that determined the registered design to be similar to Cited Design 1, and dismissed the request of the plaintiff (the design right holder).

2. Major issues discussed

(1) Issue 1: Appropriateness of the JPO's finding of the cited design

The members expressed a concern about the active involvement by the JPO panel in the task of specifying the cited design, for which the demandant of a trial for invalidation should be primarily responsible. If it was difficult to specify the cited design, the JPO panel could have had the demandant specify the cited design by making an inquiry, or notified the demandee of the reasons for invalidation.

(2) Issue 2: Appropriateness of the JPO's determination on similarity in the trial decision

The members agreed that although the JPO should have entered into a little more detail on the asperity on the body and the lid, its conclusion that the registered design and Cited Design 1 are similar is appropriate.

(3) Issue 3: Appropriateness of the court's determination on similarity in the court decision

The court made a finding on who are the "consumers," a point that had not been found by the JPO, and ruled that the "consumers" of the articles to which both the registered design and Cited Design 1 are applied are "mainly general consumers." Some members commented that this finding would clarify the criteria for determination, whereas others pointed out that the process of making a finding on the "consumers" might cause problems such as provoking an unnecessary controversy and prolonging the proceedings.

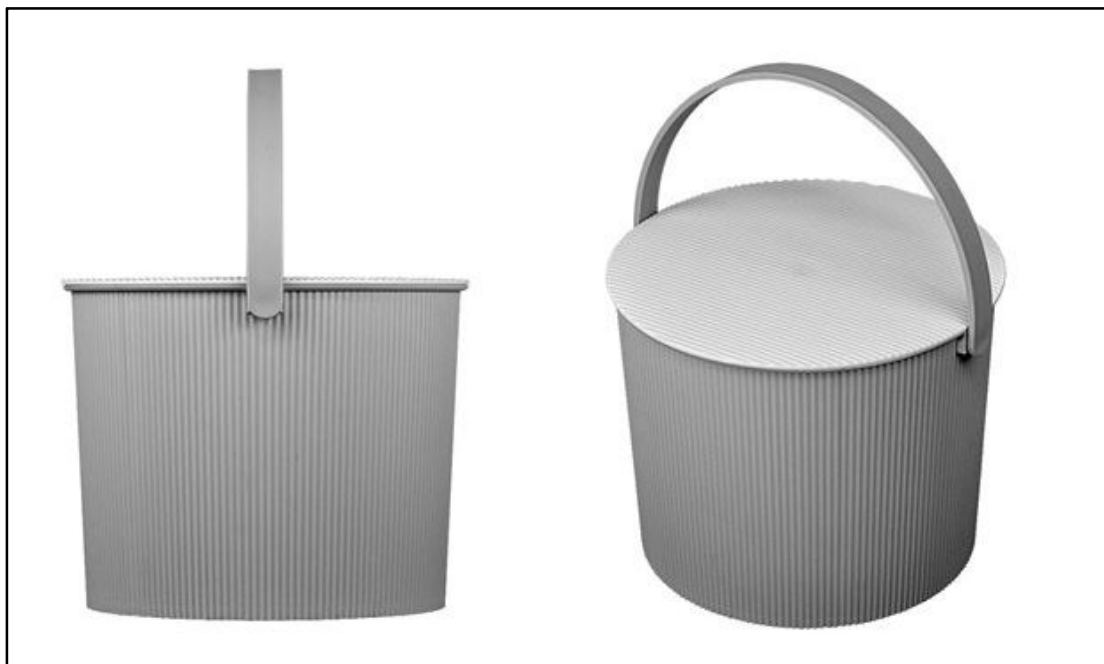
(4) Issue 4: Difference in the pitch of asperity between the designs

Most members commented that the pitch of asperity on the body and lid of the registered design differs from that of Cited Design 1, and the demandee should have argued this point as a different feature. Some members stated that the difference in the pitch was not highlighted in this case because the difference in the shades made by the asperity is not clearly shown.

(5) Issue 5: Significance of Reason for Invalidation 2

With regard to whether it is necessary for the JPO to examine Reason for Invalidation 2 in addition to Reason for Invalidation 1, the members recognized that since the court may revoke a JPO trial decision on the grounds that the JPO did not examine Reason for Invalidation 2, the JPO should examine Reason for Invalidation 2 as well in the proceedings.

Registered design




Cited Design 1

Excerpt from a product catalogue of “*sceltevie*,” published by Hachiman Kasei Co., Ltd., January 2004, p. 12, “a bucket, *omnioutil S 223764(PK)*”



Case 17: Trademark 1

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2015-12355 (Trademark Application No. 2014-67553) (Oct. 28, 2015: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jul. 20, 2016 2016 (Gyo-Ke) 10062 (JPO appeal decision maintained)
Trademark	
Major Issues	Applicability of the Trademark Act Article 4 (1) (xi) (others' registered trademark)
Points	Whether the character part, "FIT," can be extracted from the trademark in the application; Evaluation of the point that the trademark contains a brand name of a corporate group well-known to consumers

1. Outline of the case

This is a revocation action against an appeal decision of the JPO that dismissed an appeal against an examiner's decision of refusal. The JPO determined that the character part, "FIT," in the trademark in the application (the "Trademark") and the cited trademark "**F I T**" are similar in appearance and identical in pronunciation, and also have a common concept, and therefore are similar to each other, and that the Trademark falls under the Trademark Act Article 4 (1) (xi). The applicant (plaintiff) made a revocation action against an appeal decision of the JPO, however, the court also ruled that the Trademark falls under the Trademark Act Article 4 (1) (xi) and that there is no error in the JPO appeal decision to the same effect. The JPO and the court both extracted the character part, "FIT," from the Trademark because the part gives a strong dominant impression as a sign distinguishing the origin of the product, and compared this part with the cited trademark and determined that they are similar to each other.

2. Major issues discussed

(1) Issue 1 (whether they may be observed separately)

When making a determination of the applicability of the Trademark Act Article 4 (1) (xi), the Supreme Court finds that trademarks shall be observed as a whole in principle. Regarding a composite trademark, in case where a part of the constituents is found to give a strong dominant impression to consumers as a sign distinguishing the origin of the relevant goods or services, the Supreme Court finds that it is permissible to compare only that part of the constituents of the trademark with another person's trademark to determine the similarity between them.

In the Trademark, the character part, "FIT," stands out conspicuously not only in terms of the font size but also in terms of color, font type, location and area, etc. and attracts attention of the

viewers more strongly. Therefore, the members agreed that the Trademark has an element to permit that it shall be observed separately even if another character part, "Foxconn," which is a part of the plaintiff's (demandant's) company name, is well-known as a brand of the Foxconn Technology (Hon Hai) Group.

There were also opinions that the determination might have been different if the constituents and mode of the Trademark had been made in unity and that if "Foxconn" and "Foxconn Interconnect Technology" contained in the constituents of the Trademark had been very famous and "FIT" had been well-known to consumers, etc. as their abbreviation, the Trademark as a whole might have been determined as uniformly integrated.

(2) Issue 2 (Actual trade conditions of goods)

The applicant of the Trademark alleges that the manufacture of the goods counts in the transaction of the designated goods of the Trademark. However, the members commented that the applicant's allegation could not be adopted in the JPO appeal decision unless such actual transaction conditions were proved, and that the court also reached the same conclusion.

Some members said that it would be better for the applicant to allege the well-knownness among consumers instead of making the aforementioned allegation.

Designated goods of the Trademark include various goods and their consumers are wide-ranging. Considering the entirety of such consumers, the Trademark may possibly be confused with the cited trademark, therefore, some commented that narrowing the scope would limit the consumers and the Trademark might have been considered distinguishable.

(3) References 1 to 3 (Interception of trademark, partial protection, etc.)

In the "REEBOK ROYAL FLAG case," "REEBOK" was found to be a well-known, famous trademark and the part, "ROYAL FLAG," was found to be distinguishable but not to be an essential part, and as a result, the relevant trademark was registered as a composite trademark incorporating a prior registered trademark, "ROYAL FLAG." Also in the "PAG case," the relevant trademark expressed in an integral manner in constituent and mode was registered as a composite trademark incorporating another person's prior registered trademark, "PAG." Some expressed concerns over a substantial effect of trademark registration in these cases, which may result in having an applicant acquire another person's prior registered trademark.

In relation to partial protection of trademarks, some members pointed out that when a part "B" is observed separately from a prior registered composite trademark "A + B" for proceedings, the applicant is highly likely to intend to make the constituent and mode of this part "B" in the composite

trademark recognized as giving a strong dominant impression as a source identifier (wish to eliminate the possibility of later applications for trademark "B" with this composite trademark).

[Attachment 1: Trademark]



Designated goods (after amendment dated February 26, 2015)

: Class 9 "Switches, electric; Cell switches [electricity]; Control panels [electricity]; Branch boxes [electricity]; Connections, electric; Chargers for electric batteries; Battery chargers, etc."

[Attachment 2: Cited trademark]

F I T

Designated goods

: Class 9 "Distribution or control machines and apparatuses; Rotary inverters; Phase modifiers; Batteries; Electric or magnetic measuring instruments; Electric wires and cables; Electric irons; Electric hair curlers, etc."

Case 18: Trademark 2

JPO Docket Number	Appeal against an examiner's decision of refusal Appeal No. 2012-17723 (Trademark Application No. 2011-73101) (Jun. 23, 2014: decision to maintain the refusal; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Jan. 29, 2015 2014 (Gyo-Ke) 10193 (JPO appeal decision maintained)
Trademark	全国共通お食事券 (English translation the “nationwide meal ticket”) (standard characters)
Major Issues	Applicability of the Trademark Act Article 3 (1) (iii) (quality of the services); Whether Article 3 (2) may be applied (capability to distinguish)
Points	Interpretation of a "mark indicating the quality of the services"; finding of whether the trademark has come to obtain a capability to distinguish the origin in view of its specific mode of use

1. Outline of the case

This is a revocation action to against an appeal decision of the JPO, which dismissed the applicant’s request in the appeal against an examiner's decision of refusal by holding that the trademark in the application (the "Trademark") falls under the Trademark Act Article 3 (1) (iii). The applicant (appellant) alleged that the Trademark does not fall under the Trademark Act Article 3 (1) (iii) and that the Trademark falls under the Trademark Act Article 3 (2). The JPO determined that the request should be dismissed and the applicant (plaintiff) made a revocation action against an appeal decision. However, the court also ruled that there is no error in the JPO appeal decision. The JPO and the court both determined that the Trademark consists solely of a mark that indicates the quality of the designated services in a common manner, and that as the Trademark has always been used together with the indication, "ジェフグルメカード" (hereinafter referred to as the “JF Gourmet Card”), the Trademark has not come to function as a sign distinguishing the origin to have consumers recognize the plaintiff as the origin of the services. Based on these determinations, the JPO and the court did not approve the registration of the Trademark.

2. Major issues discussed

(1) Issue 1 (Interpretation of a "mark indicating the quality of the services")

The court found that the meaning of the words constituting the Trademark is well-known broadly among people in Japan and determined, in consideration of the use of the expressions, such as "全国共通お食事券" (hereinafter referred to as the “nationwide meal ticket”) and "共通〇〇券" (the "nationwide ... ticket”), etc., that the Trademark is recognized as roughly meaning a "cash voucher for meals commonly used at designated restaurants nationwide." The

majority agreed that the court's determination was detailed, proper and appropriate.

The Trademark is merely a enumeration of words which meaning is well-known broadly among people in Japan, and consumers will recognize the entirety thereof as meaning a "cash voucher for meals commonly used at designated restaurants nationwide." Although there are alternative names having the same meaning, such as "全国共通レストラン食事券" ("nationwide common restaurant meal ticket), "全国共通外食券" ("nationwide common dine out meal ticket") or "全国外食店共通食事券" ("nationwide restaurant common meal ticket), the Trademark consists of a combination of words lacking of exclusive adaptability compared with these alternative names. Therefore, the members agreed that it makes sense not to accept the plaintiff's allegation.

In relation to the services to "issue a meal ticket," the court determined that the meal ticket is the object of the act of "issuing" and the outcome of the aforementioned services and that the Trademark falls under the indication of the "quality" of the services. Some members commented that this determination is easy to understand and appropriate.

The members concluded that the court's determination that the Trademark and its designated services are mostly the same in meaning and the Trademark indicates the quality of the relevant services is reasonable.

(2) Issue 2 (Finding of whether the trademark has come to obtain a capability to distinguish the origin in view of its specific mode of use)

Some pointed out that as long as the characters, the "nationwide meal ticket," are not used independently, it is reasonable to determine that the Trademark lacks a capability to distinguish. Additionally, some other members commented that the mode of use of the characters, the "nationwide meal ticket," by the plaintiff cannot be considered as a use as a trademark.

The members agreed that in view of the mode of use of the Trademark by the plaintiff, the word, the "JF Gourmet Card," rather has a function distinguishing the origin.

Additionally, they agreed on the appropriateness of the court decision to the effect that the evidence presented by the plaintiff fails to prove that the Trademark has come to be recognized as indicating the plaintiff as its origin and that the Trademark Act Article 3 (2) cannot be applied.

(3) Issue 3 (existence of a case where the same type of trademark registration has been approved)

Some members suggested that when intending to use an expression, the "nationwide meal ticket," as a trademark, one option is to first file an application and receive an examination result to the effect that it lacks capability to distinguish before starting the use thereof as a trademark,

in order to ensure that it will be “fine to use it.” Another option is to design the constituent characters and file an application for the newly designed trademark to have it registered once having received an examination result to the effect that it lacks capability to distinguish.

In the same manner, there is also an option to file an application for registration of a trademark by adding a figure to the character part, the “nationwide meal ticket.” Some commented that if such trademark had been registered and the right had been established therefor, the trademark could have somewhat restrained Gurunavi, Inc. from filing an application for (or adopting the indication of) “ぐるなび全国共通お食事券” (English translation the “Gurunavi nationwide meal ticket”).

In the case of “全国共通図書券” (hereinafter referred to as the “nationwide book gift card”) (Trademark Registration No. 3232666), which is a case where the same type of trademark registration has been approved as this case, an application was filed immediately after the introduction of the service mark registration system, and the applicability of the Trademark Act Article 3 (2) was finally approved after examinations lasting nearly four years. The “nationwide book gift card” was registered as a trademark because the relevant industry group was well governed and the mark had not been used by any other companies as of the time of the registration and it was confirmed that there would be no possibility of new entrants in the future. Some pointed out that the case was greatly different from this case of the “nationwide meal ticket” in terms of the timing of registration application, use of the trademark, the governance of the relevant industry group, etc.

[Attachment]

- Trademark at issue


“全国共通お食事券” (English translation “the nationwide meal ticket” (standard characters)

- Designated goods and designated services (after amendment dated December 25, 2013)

Class 16 "Printed matters"

Class 36 "Issuance of meal tickets which may be used at member stores nationwide"

Case 19: Trademark 3

JPO Docket Number	Trial for invalidation Invalidation No. 2010-890092 (Trademark Registration No. 5256629) (Aug. 24, 2011: trial decision to maintain the trademark; trial decision revoked) (Sep. 28, 2012: trial decision to invalidate the trademark; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, May 31, 2012 2011 (Gyo-Ke) 10426 (JPO trial decision revoked)
Trademark	
Major Issues	Applicability of the Trademark Act Article 4 (1) (x), (xv) and (xix) (others' well-known trademark, confusion of the source of goods and unfair purposes)
Points	Similarity between the trademark and the cited trademark

1. Outline of the case

In this case, an Italian luxury automobile manufacturer, which is broadly recognized by the pronunciation "ランボルギーニ" (hereinafter referred to as "ranborugīni"), requested a trial for invalidation of a trademark registration against the holder of the trademark right for the trademark in question (the "Trademark") consisting of Alphabetic characters, "Lamborghini," and a figure part. The holder of the trademark right manufactures and sells custom buggies modeled after an automobile manufactured and sold by the Italian luxury automobile manufacturer and has used the Trademark for those custom buggies. The Italian luxury automobile manufacturer requested a trial for invalidation of trademark registration, alleging that the Trademark falls under the Trademark Act Article 4 (1) (vii), (x), (xv) and (xix). The JPO dismissed the request by holding that the Trademark and the cited trademark are not similar. However, the court revoked the JPO trial decision by ruling that the Trademark and the cited trademark are similar to each other and may cause confusion and that the Trademark falls under the Trademark Act Article 4 (1) (x), (xv) and (xix).

2. Major issues discussed

(1) Issue 1 (Determination of similarity: the Trademark Act Article 4 (1) (x))

The members agreed that either is possible; the Trademark and the cited trademark may be determined to be similar in pronunciation, or they may not.

Regarding the appearance of the Trademark and the cited trademark, the members considered that a comparison should be made for the entire mode including a figure part and font types and

that these trademarks give consumers different impressions as a whole. Therefore, majority members commented that the court decision that both trademarks as a whole are similar sounds somewhat assertive and that the court could have determined that they are not similar in terms of appearance.

Regarding “actual trade conditions,” that are taken into account in making a determination of similarity, the Supreme Court held that general and constant trade conditions of all of the designated goods should be taken into consideration. However, “usage of each trademark” and the “actual trade conditions” referred to in this judgment, are the matters to be determined when judging the well-knownness of the cited trademark and unfair purposes of the Trademark. Therefore, the members roughly agreed that those matters are rather specific and should not have been taken into account in making a determination of similarity between the trademarks.

The members also agreed that this court decision was rendered in the absence of the defendant, but otherwise the defendant would have submitted evidence or counterclaims regarding the issue of the similarity and actual trade conditions, which might have naturally changed the course of the discussions and led to a determination based thereon.

(2) Issue 2 (Whether the trademark is likely to cause confusion: the Trademark Act Article 4 (1) (xv))

Some commented that since the Trademark is evidently more like a parody and there is a difference in a range of prices between both parties' goods, it is questionable due to such reasons that the goods to which the Trademark is affixed would mislead consumers to believe that they are goods sold by the well-known “Automobili Lamborghini,” its subsidiaries, etc. (negative about that the trademark is likely to cause confusion about the source of the goods). Some other members stated that there is a possibility that consumers who come into contact with the goods with a parody trademark may mistakenly believe that the sale of the goods (use of the trademark) has been licensed by the holder of the trademark right for the original trademark (the possibility of causing so-called confusion in a broad sense).

Whether the trademark is likely to cause confusion should generally be determined in line with the precedents of the Supreme Court. Some suggested that the court in this case made determinations on the similarity and well-knownness of the trademarks in line with those precedents but that the court should have also given more careful explanations on the aforementioned confusion in a broad sense or other points when determining whether the Trademark is found to cause confusion about the source of the goods.

(3) Issue 3 (Whether there are unfair purposes: the Trademark Act Article 4 (1) (xix))

The requirements for determining “unfair purposes” are rather difficult to meet in practice in trademarks. However, in this case, based on the fact that the plaintiff’s trademark is well-known and famous; the defendant manufactures and sells custom buggies modeled after a supercar manufactured by the plaintiff and carries out PR activities paying attention to the plaintiff; etc., some members commented that “unfair purposes” are recognized and the requirements for determining them are easily met in this case. Others pointed out that whether there are “unfair purposes” should be determined by comprehensively considering the level of the well-knownness and famousness of the original trademark and the level of bad-faith (“unfair purposes”) and therefore, “unfair purposes” may be found even with a low level of bad-faith if the original trademark is very famous.

[Attachment 1: Trademark at issue]

Trademark Registration No. 5256629



[Attachment 2: Evidence A No. 2 Trademark]

Trademark Registration No. 1507740



Case 20: Trademark 4

JPO Docket Number	Trial for rescission Rescission No. 2013-300942 (Trademark Registration No. 1859812) (Aug. 21, 2015: trial decision to rescind the registration; final and binding)
Date of Court Decision Court Docket Number	Court decision of the IP High Court, Mar. 24, 2016 2015 (Gyo-Ke) 10203 (JPO trial decision maintained)
Trademark	Line ライン
Major Issues	The Trademark Act Article 50 (1) (the identicalness from common sense perspective in the case of the rescission of registered trademark not in use)
Points	Of trademarks in use [i] and [ii], whether the part "LINE" can independently function as a mark for distinguishing relevant products from others

1. Outline of the case

In this case, regarding the trademark at issue (Attachment 1), which consists of alphabetic characters "Line" and *katakana* characters "ライン" written horizontally in two lines, the demandant requested a trial for rescission of trademark registration based on the Trademark Act Article 50, paragraph (1) (hereinafter referred to as "trial for rescission of registered trademark not in use"). The demandee (holder of the trademark right) alleged that the demandee used the trademark in use [i] (Attachment 2) during the period required to prove trademark use, based on the fact that the demandee affixed Trademark in Use [i] to the surface of the product "eye liner" and delivered such products to a holder of non-exclusive right to use, and the holder of non-exclusive right to use transferred them to a third party. However, the JPO denied the identicalness from common sense perspective between trademark in use [i] and the trademark at issue and determined that the registration of the trademark at issue should be rescinded. The demandee (plaintiff), who is the holder of the trademark right, made a revocation action against a trial decision of the JPO, and also alleged the use of the trademark in use [ii](Attachment 3), in addition to the use of trademark in use [i]. In the court decision, the court denied the identicalness from common sense perspective between the trademark at issue and trademarks in use [i] and [ii], and dismissed the plaintiff's request.

2. Major issues discussed

(1) Issue 1 (determination of trademark in use [i])

Some members commented that both the JPO and the court considered in detail the size, style, font, meaning (the presence or absence of capability to distinguish), role (phonetic), etc. of each

character constituting trademark in use [i] in detail and took into consideration the fact that characters, "ルボタン ライン" or "ルボタンライン," were used based on other evidence in order to find trademark in use [i]. Therefore, they commented that both the JPO trial decision and the court's court decision are appropriate.

A trial for rescission of registered trademark not in use has a punitive aspect against the holder of the trademark right for not using the registered trademark. Thus, if the right holder alleges and proves the use of the registered trademark in response to the request for a trial for rescission, it has been considered that both the JPO and the court are likely to render a decision to approve the trademark in use as a trademark roughly found to be identical from common sense perspective. Therefore, many of the members commented that the JPO trial decision and the court decision in this case were relatively strict.

(2) Issue 2 (identicalness from common sense perspective between the trademark at issue and trademark in use [i])

Based on determinations of trademark in use [i] by the JPO and the court, trademark in use [i] should inevitably be determined to be not identical from common sense perspective with the trademark at issue. In particular, the explanation by the JPO in this case was in the same meaning as that in the "RHYTHM" case (IP High Court 2012 (Gyo-Ke) 10382), to the effect that registered trademark "rhythm" and trademark in use "NEO (outlined characters on a colored background) RHYTHM" cannot be found to be identical from common sense perspective as the part "NEO" is added and this causes differences in the appearance, pronunciation and concept between the registered trademark and the trademark in use. Some mentioned this point and stated that the determinations by the JPO and the court are appropriate.

Companies often register their house marks and product marks identifying the particular goods or services, respectively, as trademarks, but if a specific house mark is made too similar to the other marks, this may dilute the value of the house marks. Therefore, they tend to make efforts to disseminate a trademark for the house mark and trademarks for the products separately. Therefore, some commented that if a registered trademark is used as close to another trademark as in the case of trademark in use [i] and trademark in use [ii], the plaintiff should devise the means of use or attach an indication of trademark registration (®) so that both trademarks are independently distinguishable.

(3) Issue 3 (actual trade conditions in the cosmetics industry)

According to allegations and proof by the demandee (plaintiff) and the demandant (defendant)

in proceedings at the JPO and the trial at the court, trademarks used in the cosmetics industry can be divided into three phases including house marks, product marks and names with weaker capability to distinguish. Rights are established for each of them, and these trademarks and names are generally used in trades in diverse manners, such as being used separately or in combination, with a product name, etc. Then, it is difficult to grasp and determine the essential part of each trademark used for various products, and some members commented that it is appropriate that the court determined that “the essential part of each trademark should be determined on a case-by-case basis on the premise of the awareness, etc. thereof among consumers and traders.”

(4) Issue 4 (determination of trademark in use [ii])

Evidence regarding trademark in use [ii] was newly presented in the trial procedures at the court, but the reasons for submitting the evidence and the related allegations are not clear from the court decision. Some members commented that in consideration of the determination of trademark in use [i], it was appropriate for the court to determine that “the *katakana* characters "ライン" cannot be found to independently function as a mark for distinguishing relevant products from others, from trademark in use [ii].”

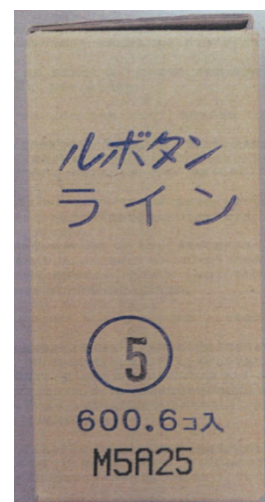
**[Attachment 1:
Trademark at issue]**



**[Attachment 2:
Trademark in Use [i]]**



**[Attachment 3:
Trademark in Use [ii]]**



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REPORT 2017 (Summary)**

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